

ESTTA Tracking number: **ESTTA544018**

Filing date: **06/19/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Water Pik, Inc.
Granted to Date of previous extension	06/19/2013
Address	1730 East Prospect Road Fort Collins, CO 80553-0001 UNITED STATES
Attorney information	Charlene M. Krogh, Lee Johnston Dorsey & Whitney LLP 1400 Wewatta Street Suite 400 Denver, CO 80202-5549 UNITED STATES krogh.charlene@dorsey.com, docketing-dv@dorsey.com, johnston.lee@dorsey.com

**Applicant Information**

Application No	85633680	Publication date	02/19/2013
Opposition Filing Date	06/19/2013	Opposition Period Ends	06/19/2013
Applicant	Performar Int'l Corp. Suite E 9528 E Rush Street South El Monte, CA 91733 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 011. First Use: 2008/09/01 First Use In Commerce: 2011/03/20  
All goods and services in the class are opposed, namely: Plumbing fittings, namely, shower sprayers, shower mixers, and shower drains

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	978418	Application Date	12/26/1972
Registration Date	02/12/1974	Foreign Priority Date	NONE

Word Mark	WATERPIK
Design Mark	
Description of Mark	NONE
Goods/Services	Class U013 (International Class 011). First use: First Use: 1972/07/07 First Use In Commerce: 1972/07/07 SHOWERHEADS

U.S. Registration No.	4207280	Application Date	06/10/2011
Registration Date	09/11/2012	Foreign Priority Date	NONE
Word Mark	WATERPIK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1972/07/07 First Use In Commerce: 1972/07/07 Faucets; faucet handles; shower heads; hand held shower heads and metal hoses sold as a unit; shower systems consisting primarily of shower head, hose for shower head, brackets, waterway plumbing fittings, namely, shower and faucet control valves, faucet, shower trim and spout, sold as a unit; faucet system consisting primarily of faucet, faucet handles, drain, waterway plumbing fittings, namely, water inlet tube connector, filter cartridges and faucet control valves, sold as a unit		

U.S. Registration No.	2515115	Application Date	02/13/2001
Registration Date	12/04/2001	Foreign Priority Date	NONE
Word Mark	WATERPIK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2000/08/01 First Use In Commerce: 2000/08/01 SHOWERHEADS, [ PERSONAL CARE FOOT SPAS AND BATH SPAS ]		

U.S. Registration No.	4207281	Application Date	06/10/2011
Registration Date	09/11/2012	Foreign Priority Date	NONE
Word Mark	WATERPIK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2000/08/01 First Use In Commerce: 2000/08/01 Faucets; faucet handles; shower heads; hand held shower heads and metal hoses sold as a unit; shower systems consisting primarily of shower head, hose for shower head, brackets, waterway plumbing fittings, namely, shower and faucet control valves, faucet, shower trim and spout, sold as a unit; faucet system consisting primarily of faucet, faucet handles, drain, waterway plumbing fittings, namely, water inlet tube connector, filter cartridges and faucet control		

	valves, sold as a unit
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Attachments	notice of opposition.pdf(231871 bytes ) Exhibit A to Notice of Opposition.pdf(2005550 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/cmk2112/
Name	Charlene M. Krogh, Lee Johnston
Date	06/19/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of U.S. Trademark Application Serial No. 85/633,680

Mark: PIC (Stylized)

Published on February 19, 2013

Water Pik, Inc.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.
	)	
Performar Int'l Corp.	)	
	)	
Applicant.	)	

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**NOTICE OF OPPOSITION**

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Water Pik, Inc., a corporation organized and existing under the laws of Delaware, having a principal place of business at 1730 East Prospect Road, Fort Collins, CO 80553 ("Opposer"), believes it will be damaged by the registration of the mark PIC (Stylized) shown in Application Serial No. 85/633,680 ("Application"), filed by Performar Int'l Corp. ("Applicant") on May 23, 2012, and having been granted an extension of time to oppose until June 19, 2013, hereby opposes the Application.

As grounds of opposition, Opposer alleges the following:

1. Opposer Water Pik, Inc. is a leader in the development and sale of innovative personal hygiene products, including shower heads, faucets, and accessories for shower and faucet installations.

2. Beginning at least as early as 1972, Opposer, or its predecessor-in-interest, marketed, distributed and sold its shower head products under the trademark WATER PIK. Since at least as early as 2000, Opposer began using the mark WATERPIK (with no space) in connection with all of its products. Since that time, Opposer has made widespread and continuous use its WATERPIK mark.

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Mark: PIC (Stylized)



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3. During this time, Opposer has expended significant sums of time, effort and money in advertising and promoting its products under its WATER PIK and WATERPIK marks. Opposer currently sells and markets products under its WATERPIK mark in the United States, Canada, and over 60 countries worldwide.

4. Since at least as early as 1972, well prior to both the filing date of the application herein opposed and the first use of the PIC (Stylized) mark claimed by Applicant, Opposer has made widespread and continuous use of the marks WATER PIK and WATERPIK in United States commerce in connection with shower head products in International Class 11.

5. In addition to its common law rights, Opposer is the owner of the following United States trademark registrations, which cover shower head and faucet products:

<b>MARK</b>	<b>CLASS / GOODS</b>	<b>APPLICATION No.</b>	<b>REGISTRATION No.</b>
WATERPIK  [Note this registration was originally for the mark WATER PIK. The registration was amended in 2008 to reflect the mark as one word]	11: Showerheads	72444556	978418
WATERPIK	11: Faucets; faucet handles; shower heads; hand held shower heads and metal hoses sold as a unit; shower systems consisting primarily of shower head, hose for shower head, brackets, waterway plumbing fittings, namely, shower and faucet control valves, faucet, shower trim and spout, sold as a unit; faucet system consisting primarily of faucet, faucet handles, drain, waterway plumbing fittings, namely, water inlet tube connector, filter cartridges and faucet control valves, sold as a unit.	85343409	4207280
WATERPIK & Design (3 Dots)	11: Showerheads	76209439	2515115

			
WATERPIK & Design (3 Dots)  	11: Faucets; faucet handles; shower heads; hand held shower heads and metal hoses sold as a unit; shower systems consisting primarily of shower head, hose for shower head, brackets, waterway plumbing fittings, namely, shower and faucet control valves, faucet, shower trim and spout, sold as a unit; faucet system consisting primarily of faucet, faucet handles, drain, waterway plumbing fittings, namely, water inlet tube connector, filter cartridges and faucet control valves, sold as a unit.	85343425	4207281

True and correct copies of the Certificates of Registration for the foregoing registrations are attached hereto as **Exhibit A**.

6. Opposer's registrations are valid, subsisting and in full force and effect. In addition, registration numbers 978418 and 2515115 have obtained incontestable status.

7. As a result of many years of use, promotion and advertisement, the consuming public and trade have come to recognize and do recognize the WATERPIK mark as being uniquely identified and associated with Opposer. Opposer derives substantial goodwill and value from the aforesaid recognition, association and identification by the consuming public and trade.

8. Applicant filed the Application on May 23, 2012 for the mark PIC (Stylized) for use in connection with "Plumbing fittings, namely, shower sprayers, shower mixers, and shower drains" in International Class 11.

9. The Application was filed under Section 1(A) of the Trademark Act, and Applicant has claimed September 1, 2008 as the date of first use of the PIC (Stylized) mark in connection with the goods identified in the application and March 20, 2011 as the date of first use of the PIC (Stylized) mark in U.S. commerce in connection with the goods identified in the application.

10. On information and belief, Opposer's WATER PIK and WATERPIK marks have been in use in U.S. commerce long prior to the filing of the Application by Applicant and/or any use of the mark PIC (Stylized) by Applicant.

11. On information and belief, the goods identified in the Application are identical, complementary and/or highly related to the products offered by Opposer in connection with its WATERPIK mark.

12. On information and belief, the products identified in the Application will be offered in the same channels of trade and offered to the same class of purchasers as those products offered by Opposer in connection with its WATERPIK mark.

13. Applicant's PIC (Stylized) mark so resembles the WATERPIK mark owned by Opposer and is likely, when used in connection with the goods covered by the subject application, to cause confusion, to cause mistake or to deceive, with consequent injury to Opposer and the public.

14. Specifically, and without limitation, the marketing and offering of Applicant's aforementioned products under the mark PIC (Stylized) is likely to cause consumers to believe that Applicant's products are those of Opposer, or that Applicant's products are connected with the products and services of Opposer, or that Applicant is somehow related, sponsored or endorsed by Opposer. Accordingly, Applicant's mark is not entitled to registration pursuant to 15 U.S.C. §1052(d). Further, Applicant's mark falsely suggests a connection with Opposer in violation of 15 U.S.C. §1052(a).

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15. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

16. Further, registration of Applicant's mark is likely to cause dilution by blurring or dilution by tarnishment of Opposer's famous and distinctive mark, WATERPIK, in violation of 15 U.S.C. §§ 1125(c) and 1052(f).

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that Application Serial No. 85/633,680 be denied.

ATTORNEYS FOR OPPOSER

Please recognize as attorney for Opposer in this proceeding Charlene Krogh and Lee Johnston of Dorsey & Whitney, LLP, 1400 Wewatta Street, Suite 400, Denver, Colorado 80202-5549. Please address all communications regarding this opposition proceeding to above attorneys.

Dated: June 19, 2013.

Respectfully submitted,  
DORSEY & WHITNEY LLP

By: \_\_\_\_\_

  
Charlene M. Krogh  
Lee Johnston  
1400 Wewatta Street, Suite 400  
Denver, Colorado 80202-5549  
Tel: (303) 629-3400  
Fax: (303) 629-3450  
krogh.charlene@dorsey.com  
johnston.lee@dorsey.com

ATTORNEYS FOR OPPOSER WATER PIK, INC.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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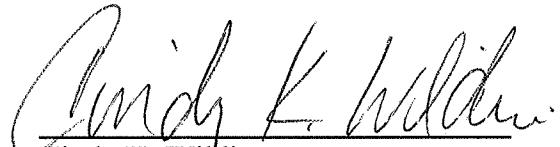
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **Notice of Opposition** is being served upon Applicant Performer Int'l Corp., Inc. by mailing said copy on June 19, 2013, via first-class mail, postage prepaid, addressed to:

Helen B. Jiang, Esq.  
Law Offices of Helen B. Jiang  
923 E Valley Blvd, Ste 112A  
San Gabriel, California 91776

Dated: June 19, 2013

  
Cindy K. Wildin