

ESTTA Tracking number: **ESTTA1084838**

Filing date: **09/28/2020**

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	Tetra GmbH
Granted to Date of previous extension	09/27/2020
Address	HERRENTEICH 78 MELLE, 49324 GERMANY
Attorney information	MICHELLE L. ZIMMERMANN LEYDIG, VOIT & MAYER, LTD. TWO PRUDENTIAL PLAZA, 180 N. STETSON AVE SUITE 4900 CHICAGO, IL 60601 UNITED STATES Primary Email: mzimmermann@leydig.com Secondary Email(s): kmigliorini@leydig.com 312-616-5600
Docket Number	289809

Applicant Information

Application No.	88456631	Publication date	03/31/2020
Opposition Filing Date	09/28/2020	Opposition Period Ends	09/27/2020
Applicant	Planet Water, LLC 16071 NORTH 76TH STREET, SUITE 102 SCOTTSDALE, AZ 85260 UNITED STATES		

Goods/Services Affected by Opposition

Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Water pumps for water treatment equipment, namely, pumps for collecting, filtering, storing and dispensing water
Class 011. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Water treatment equipment, namely, water treatment machines for filtering and dispensing water
Class 019. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Water treatment equipment, namely, non-metal water storage basins for collecting and storing water

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1000438	Application Date	11/12/1973
Registration Date	12/31/1974	Foreign Priority Date	NONE
Word Mark	AQUASAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1973/10/11 First Use In Commerce: 1973/10/11 CHEMICAL WATER CONDITIONER FOR AQUARIUMS		

Attachments	AQUASAFE - Notice of Opposition.pdf(178334 bytes)
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Signature	/Michelle L. Zimmermann/
Name	MICHELLE L. ZIMMERMANN
Date	09/28/2020

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

Tetra GmbH)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	Serial No. 88/456,631
)	
Planet Water, LLC)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Tetra GmbH (“Opposer”), a German limited liability company, located and doing business at Herrenteich 78, Melle, Germany 49324, hereby brings this Opposition against Application Serial No. 88/456,631 for the mark “AQUASAFE” (the “Application” or “Applicant’s Mark”), filed by Planet Water, LLC (“Applicant”), an Arizona limited liability company, located at 16071 North 76th Street, Suite 102, Scottsdale, Arizona 85260. The Application was published in the Official Gazette on March 31, 2020, and Opposer secured an extension of time that expires on September 27, 2020. Opposer believes it will be damaged by the Application and therefore opposes the same.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer is a leading supplier of pet products worldwide, including aquarium products and related items.
2. Opposer is the owner of the AQUASAFE trademark (“Opposer’s Mark”).
3. Opposer, through its predecessors-in-interest, has continuously used its AQUASAFE mark in U.S. commerce in connection with chemical water treatment for aquariums since at least as early as 1973.

4. Opposer is the owner of U.S. Registration No. 1,000,438 for the mark AQUASAFE covering “chemical water conditioner for aquariums” in Class 1 (“Opposer’s Registration”). Registration information is attached hereto as Exhibit A.

5. In Application Serial No. 88/456,631, Applicant seeks to register the mark AQUASAFE for use in connection with the following goods (“Applicant’s Goods”):

Class 7:

Water pumps for water treatment equipment, namely, pumps for collecting, filtering, storing and dispensing water

Class 11:

Water treatment equipment, namely, water treatment machines for filtering and dispensing water

Class 19:

Water treatment equipment, namely, non-metal water storage basins for collecting and storing water

6. Applicant filed the Application June 3, 2019 based on intent-to-use.
7. Opposer’s use of Opposer’s Mark predates Applicant’s filing date.
8. Applicant’s Mark is identical or highly similar to Opposer’s Mark in appearance, pronunciation, and overall commercial impression.
9. The goods covered in the Application are related to the goods covered in Opposer’s Registration.
10. The goods covered in the Application will be sold through similar channels of trade and will be marketed to similar consumers as the goods covered in Opposer’s registration.
11. Due to the similarity of the marks at issue, the goods involved, the channels of trade, and the relevant consumers, as well as other factors, confusion is likely as between

Applicant's Mark and Opposer's Mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

12. Registration of Applicant's Mark is likely to cause confusion or mistake in the minds of the public, and to lead the relevant public into believing that Applicant's Goods are Opposer's, or endorsed by or sponsored by, or otherwise affiliated or connected with Opposer, all to the damage and injury of Opposer and the relevant public.

13. In view of the above, the grant of registration for Applicant's Mark, as sought in the Application, should be denied based on a likelihood of confusion, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, by its undersigned attorneys, Opposer respectfully requests that this Notice of Opposition be sustained, and that registration of Application Serial No. 88/456,631 be refused.

Respectfully submitted,

Date: September 28, 2020

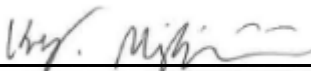


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Kyle A. Migliorini
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Chicago, Illinois 60601-6731
(312) 616-5600
trademark@leydig.com

Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the attached Notice of Opposition was filed electronically with the Trademark Trial and Appeal Board on September 28, 2020.



Kyle A. Migliorini

Exhibit A

Int. Cl. : 1

Prior U.S. Cl. : 6

United States Patent Office

Reg. No. 1,000,438

Registered Dec. 31, 1974

TRADEMARK

Principal Register

AQUASAFE

Tetra Sales (U.S.A.) Corporation (California corporation)
21393 Curtis St.
Hayward, Calif. 94545

For: CHEMICAL WATER CONDITIONER FOR
AQUARIUMS, in CLASS 1 (U.S. CL. 6).
First use Oct. 11, 1973; in commerce Oct. 11, 1973.

Ser. No. 6,046, filed Nov. 12, 1973.

R. M. ROSS, Examiner

Generated on: This page was generated by TSDR on 2020-07-28 09:35:22 EDT

Mark: AQUASAFE

US Serial Number: 73006046

Application Filing Date: Nov. 12, 1973

US Registration Number: 1000438

Registration Date: Dec. 31, 1974

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Dec. 22, 2014

Mark Information

Mark Literal Elements: AQUASAFE

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: CHEMICAL WATER CONDITIONER FOR AQUARIUMS

International Class(es): 001 - Primary Class

U.S Class(es): 006

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 11, 1973

Use in Commerce: Oct. 11, 1973

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: TETRA GMBH

Owner Address: HERRENTEICH 78
MELLE GERMANY 49324

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country GERMANY
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Thilo C. Agthe

Docket Number: 5045-373

Attorney Primary tm-group@wg-law.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent Thilo C. Agthe
Name/Address: WUERSCH & GERING LLP
100 Wall Street, 10th Floor
NEW YORK, NEW YORK UNITED STATES 10005

Phone: 212-509-5050

Fax: 212-509-9559

Correspondent e- tm-group@wg-law.com thilo.agthe@wg-law.com a
mail: lina.morris@wg-law.com

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 22, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Dec. 22, 2014	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	77315
Dec. 22, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	77315
Dec. 22, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Dec. 02, 2014	TEAS SECTION 8 & 9 RECEIVED	
Oct. 23, 2007	CASE FILE IN TICRS	
Jan. 31, 2005	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jan. 31, 2005	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Aug. 12, 2004	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Dec. 08, 2004	TEAS SECTION 8 & 9 RECEIVED	
Nov. 20, 2003	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Dec. 01, 1994	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Oct. 04, 1994	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Mar. 09, 1981	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Dec. 22, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 7

Registrant: TETRA SALES (U.S.A.) CORPORATION

Assignment 1 of 7

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0270/0569](#)

Pages: 2

Date Recorded: Jul. 17, 1975

Supporting Documents: No Supporting Documents Available

Assignor

Name: [TETRA SALES \(USA\) CORPORATION](#)
Legal Entity Type: CORPORATION
Execution Date: Jul. 07, 1975
State or Country Where Organized: CALIFORNIA

Assignee

Name: [BIKAL CORPORATION](#)
Legal Entity Type: CORPORATION
State or Country Where Organized: CALIFORNIA
Address: 21393 CURTIS STREET
HAYWARD, CALIFORNIA 94545
DBA, AKA, TA, Formerly: DBA TETRA SALES (USA)

Correspondent

Correspondent Name: HARRIS ZIMMERMAN
Correspondent Address: SUITE 1432
1330 BROADWAY
OAKLAND, CA 94612

Domestic Representative - Not Found

Assignment 2 of 7

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL
Reel/Frame: [0282/0937](#) **Pages:** 1
Date Recorded: Mar. 22, 1976
Supporting Documents: No Supporting Documents Available

Assignor

Name: [BIKAL CORPORATION](#)
Legal Entity Type: CORPORATION
Execution Date: Feb. 19, 1976
State or Country Where Organized: CALIFORNIA
DBA, AKA, TA, Formerly: DBA TETRA SALES (USA)

Assignee

Name: [TETRAWERKE DR. RER. NAT. ULRICH BAENSCH GMBH HERRENTEICH](#)
Legal Entity Type: A LIMITED LIABILITY COMPANY
State or Country Where Organized: GERMANY
Address: 4520 MELLE, GERMANY

Correspondent

Correspondent Name: MICHAEL J. GUARINO
Correspondent Address: 201 TABOR ROAD
MORRIS PLAINS, NJ 07950

Domestic Representative - Not Found

Assignment 3 of 7

Conveyance: CHANGE OF NAME 19880419
Reel/Frame: [0930/0295](#) **Pages:** 7
Date Recorded: Feb. 12, 1993
Supporting Documents: No Supporting Documents Available

Assignor

Name: [TETRAWERKE DR. RER. NAT. ULRICH BAENSCH, GMBH](#)
Legal Entity Type: CORPORATION
Execution Date: Apr. 19, 1988
State or Country Where Organized: GERMANY

Assignee**Name:** [TETRA HEIMTIERBEDARF GMBH](#)**Legal Entity Type:** CORPORATION**State or Country Where Organized:** GERMANY**Address:** WARNER-LAMBERT COMPANY MS. BELINDA I. BERMAN
201 TABOR ROAD
MORRIS PLAINS, NEW JERSEY 07950**Correspondent****Correspondent Name:** MS. BELINDA I. BERMAN**Correspondent Address:** ASST. TRADEMARK COUNSEL
WARNER-LAMBERT COMPANY
201 TABOR ROAD
MORRIS PLAINS, NJ 07950**Domestic Representative - Not Found****Assignment 4 of 7****Conveyance:** CHANGE OF NAME**Reel/Frame:** [2026/0223](#)**Pages:** 7**Date Recorded:** Jan. 19, 2000**Supporting Documents:** [assignment-tm-2026-0223.pdf](#)**Assignor****Name:** [TETRA HEIMTIERBEDARF GMBH](#)**Execution Date:** Oct. 31, 1997**Legal Entity Type:** UNKNOWN**State or Country Where Organized:** No Place Where Organized Found**Assignee****Name:** [TETRA HEIMTIERBEDARF GMBH & CO. KG](#)**Legal Entity Type:** LIMITED PARTNERSHIP**State or Country Where Organized:** GERMANY**Address:** HERRENTEICH 78
MELLE, GERMANY 49324**Correspondent****Correspondent Name:** WARNER-LAMBERT COMPANY**Correspondent Address:** ELIZABETH G. REGAN
201 TABOR ROAD
MORRIS PLAINS, NJ 07950**Domestic Representative - Not Found****Assignment 5 of 7****Conveyance:** MERGER**Reel/Frame:** [2771/0118](#)**Pages:** 5**Date Recorded:** Dec. 31, 2003**Supporting Documents:** [assignment-tm-2771-0118.pdf](#)**Assignor****Name:** [TETRA HEIMTIERBEDARF GMBH & CO. KG](#)**Execution Date:** Dec. 06, 2001**Legal Entity Type:** LIMITED PARTNERSHIP**State or Country Where Organized:** GERMANY**Assignee****Name:** [TETRA WERKE HOLDING GMBH](#)**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where Organized:** GERMANY**Address:** HERRENTEICH 78
MELLE, GERMANY 49324**Correspondent****Correspondent** THILO C. AGTHE

Name:

Correspondent 11 HANOVER SQUARE, 19TH FLOOR
Address: NEW YORK, NY 10005

Domestic Representative - Not Found

Assignment 6 of 7

Conveyance: CHANGE OF NAME

Reel/Frame: [2772/0878](#)

Pages: 14

Date Recorded: Jan. 06, 2004

Supporting [assignment-tm-2772-0878.pdf](#)
Documents:

Assignor

Name: [TETRA WERKE HOLDING GMBH](#)

Execution Date: Dec. 23, 2002

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country GERMANY
Where Organized:

Assignee

Name: [TETRA GMBH](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country GERMANY
Where Organized:

Address: HERRENTEICH 78
MELLE, GERMANY 49324

Correspondent

Correspondent THILO C. AGTHE
Name:

Correspondent 11 HANOVER SQUARE, 19TH FLOOR
Address: NEW YORK, NY 10005

Domestic Representative - Not Found

Assignment 7 of 7

Conveyance: SECURITY INTEREST

Reel/Frame: [5512/0568](#)

Pages: 9

Date Recorded: May 07, 2015

Supporting [assignment-tm-5512-0568.pdf](#)
Documents:

Assignor

Name: [SPECTRUM BRANDS, INC.](#)

Execution Date: Mar. 31, 2015

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Name: [TELL MANUFACTURING, INC.](#)

Execution Date: Mar. 31, 2015

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Name: [SALIX ANIMAL HEALTH, LLC](#)

Execution Date: Mar. 31, 2015

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country DELAWARE
Where Organized:

Name: [UNITED INDUSTRIES CORPORATION](#)

Execution Date: Mar. 31, 2015

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Assignee

Name: [WELLS FARGO BANK, NATIONAL ASSOCIATION](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country UNITED STATES
Where Organized:

Address: 7000 CENTRAL PARKWAY, SUITE 550
ATLANTA, GEORGIA 30328

Correspondent

Correspondent BARNES & THORNBURG LLP
Name:

Correspondent 225 SOUTH SIXTH STREET, SUITE 2800
Address: MINNEAPOLIS, MN 55402-4662

Domestic Representative - Not Found

Proceedings

Summary

Number of 1
Proceedings:

Type of Proceeding: Opposition

Proceeding [91221682](#)
Number:

Filing Date: Apr 21, 2015

Status: Terminated

Status Date: Aug 04, 2015

Interlocutory BENJAMIN U OKEKE
Attorney:

Defendant

Name: Aqua Safe Systems (2009) Ltd.

Correspondent MICHAEL D COOPER
Address: 1007 FORT STREET, SUITE 201
VICTORIA CANADA , BC V8V3K5

Correspondent e-mail: email@tcllp.ca , lduckett@tcllp.ca

Associated marks

Mark	Application Status	Serial Number	Registration Number
AQUASAFE	Abandoned - After Inter-Partes Decision	85773730	

Plaintiff(s)

Name: Tetra GmbH

Correspondent WILLIAM M BRYNER
Address: KILPATRICK TOWNSEND & STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON SALEM NC UNITED STATES , 27101

Correspondent e-mail: bbryner@ktslaw.com , mrafter@ktslaw.com , svayner@ktslaw.com , kteilhaber@ktslaw.com , tmadmin@ktslaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
AQUASAFE	REGISTERED AND RENEWED	73006046	1000438

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 21, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 27, 2015	Jun 06, 2015
3	PENDING, INSTITUTED	Apr 27, 2015	
4	NOTICE OF DEFAULT	Jun 17, 2015	
5	BD DECISION: SUSTAINED	Aug 03, 2015	
6	TERMINATED	Aug 04, 2015	