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Filing date: **06/04/2004**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Dial Brands, Inc.		
Entity	Corporation	Citizenship	Arizona
Address	15501 North Dial Blvd Scottsdale, AZ 85260-1619 UNITED STATES		

Attorney information	Damon L. Boyd SNELL & WILMER LLP 400 East Van Buren Phoenix, AZ 85004 UNITED STATES dboyd@swlaw.com Phone:602 382-6000		
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Registration Subject to Cancellation

Registration No	2576458	Registration date	06/04/2002
Registrant	TEIJIN DUPONT FILMS JAPAN LIMITED		
Goods/Services Subject to Cancellation	Class 017. First Use: 19970401 , First Use In Commerce: 19970401 Goods/Services: PLASTIC FILM FOR INDUSTRIAL AND COMMERCIAL PACKING USE		
Attachments	PetitiontoCancel.pdf (8 pages) SFX51E.pdf (4 pages)		

Signature	/Damon L. Boyd/
Name	Damon L. Boyd
Date	06/04/2004

DIAL BRANDS, INC., a corporation organized and existing under the laws of the State of Arizona, with a mailing address at 15501 North Dial Boulevard, Scottsdale, Arizona 85260-1619, through its related companies and licenses (hereinafter referred to as "Petitioner"), believes that it has been and will continue to be damaged by registration of the mark shown in Registration No. 2,576,458 in International Class 17, and hereby petitions to cancel the same.

As grounds for this Petition for Cancellation, including grounds under the provisions of Section 14 of the Trademark Act of 1946, 15 U.S.C. §§1064, as amended, it is alleged that:

I. HISTORY OF THE "PUREX" MARK AND THE "PUREX" REGISTRATIONS

1. Petitioner's predecessor coined the arbitrary term PUREX on or about October 10, 1923. Petitioner and its predecessors in interest have continuously used the mark PUREX, in typed form and in a number of stylized forms, for over eighty (80) years for cleaning and other products, particularly from about October 10, 1923 until the present time.

2. Over those eighty years, Petitioner and its predecessors in interest have sold to the public in the United States, through various channels of trade in commerce, many different products bearing the PUREX trademarks. Over those years, Petitioner has used the PUREX mark in numerous channels of trade on a wide variety of products in many countries around the world, including the United States, which include, but are not limited to, laundry detergents, fabric softeners, bleaching agents, liquid dishwashing detergents, hard surface cleaners, swimming pool equipment, floor finishes, ammonia, and floor wax removers.

3. Currently, Petitioner's PUREX brand is one of the top laundry detergents in the United States. Petitioner currently posts significant annual sales attributable to goods sold under the PUREX brand and, over the years, has sold billions of dollars worth of PUREX branded products throughout North America, including, among other countries, the United States, Canada, and Mexico, as well as in numerous other countries worldwide. This impressive volume of sales has developed steadily and continuously over eighty years, and with

it, extensive consumer recognition, including recognition by those who have never purchased Petitioner's goods, such that Petitioner's family of PUREX marks has accrued substantial fame and strength.

4. In addition, Petitioner and its predecessors in interest have registered and applied for registration of the mark PUREX alone and together with other formatives many times. Appendix "1" attached hereto sets forth a table listing eighteen (18) registrations and two (2) pending applications, of which sixteen (16) of such registrations are incontestable. These eighteen (18) registrations and two (2) pending applications are described in the following paragraphs.

5. Petitioner is the owner of United States Trademark Registration No. 211,650 for its mark "PUREX (Stylized)" registered April 13, 1926 for general cleaning preparations in liquid form with incidental water softening properties in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

6. Petitioner is also the owner of United States Trademark Registration No. 312,493 for its mark "PUREX 'IS DIFFERENT' (Stylized)" registered May 1, 1934 for bleach and water softener in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

7. Petitioner is also the owner of United States Trademark Registration No. 578,630 for its mark "PUREX (Stylized)" registered August 11, 1953 for general cleaning preparations in liquid and dry forms having bleaching, cleaning and disinfecting properties now classified in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

8. Petitioner is also the owner of United States Trademark Registration No. 798,694 for its mark "PUREX-TRA (Stylized)" registered November 16, 1965 for liquid bleach in Interna-

tional Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

9. Petitioner is also the owner of United States Trademark Registration No. 847,740 for its mark "PUREX and Design" registered April 16, 1968 for household detergents, household cleansers and toilet soap in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

10. Petitioner is also the owner of United States Trademark Registration No. 847,538 for its mark "PUREX and Design" registered April 16, 1968 for cleaning, scouring and polishing wads in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

11. Petitioner is also the owner of United States Trademark Registration No. 854,332 for its mark "PUREX" registered August 6, 1968 for wax remover and heavy duty cleanser for industrial purposes in International Class 1, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

12. Petitioner is also the owner of United States Trademark Registration No. 854,006 for its mark "PUREX" registered August 6, 1968 for scrubbable floor finish in the nature of a water emulsified lacquer resin in International Class 2, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

13. Petitioner is also the owner of United States Trademark Registration No. 1,052,724 for its mark "PUREX" registered November 16, 1976 for laundry detergent in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

14. Petitioner is also the owner of United States Trademark Registration No. 1,062,573 for its mark "PUREX (Stylized)" registered April 5, 1977 for laundry detergents in International Class 3, which registration is valid and subsisting, in full force and effect, and incontestable under Section 15 of the Trademark Act.

15. Petitioner is also the owner of United States Trademark Registration No. 1,435,216 for its mark "PUREX (Stylized) and Design" registered April 7, 1987 for laundry and household bleaching and cleaning preparations in liquid and dry forms in International Class 3, which registration is valid and subsisting, and in full force and effect, and incontestable under Section 15 of the Trademark Act.

16. Petitioner is also the owner of United States Trademark Registration No. 1,698,689 for its mark "PUREX and Design" registered July 7, 1992 for laundry and household bleaching and cleaning preparations in liquid and dry forms in International Class 3, which registration is valid and subsisting, and in full force and effect, and incontestable under Section 15 of the Trademark Act.

17. Petitioner is also the owner of United States Trademark Registration No. 1,747,647 for its mark "PUREX RINSE 'N SOFT" registered January 19, 1993 for fabric softeners for laundry use in International Class 3, which registration is valid and subsisting, and in full force and effect, and incontestable under Section 15 of the Trademark Act.

18. Petitioner is also the owner of United States Trademark Registration No. 1,876,275 for its mark "PUREX" registered January 31, 1995 for laundry bleach in International Class 3, which registration is valid and subsisting, and in full force and effect, and incontestable under Section 15 of the Trademark Act.

19. Petitioner is also the owner of United States Trademark Registration No. 1,947,415 for its mark "BABY SOFT BY PUREX" registered January 9, 1996 for laundry detergents in International Class 3, which registration is valid and subsisting, and in full force and effect, and incontestable under Section 15 of the Trademark Act.

20. Petitioner is also the owner of United States Trademark Registration No. 1,980,777 for its mark "NEW BABY SOFT DETERGENT FROM PUREX and Design" registered June 18, 1996 for laundry detergents in International Class 3, which registration is

valid and subsisting, and in full force and effect, and incontestable under Section 15 of the Trademark Act.

21. Petitioner is also the owner of United States Trademark Registration No. 2,400,944 for its mark "PUREX ADVANCE" registered October 31, 2000 for laundry detergents in International Class 3, which registration is valid and subsisting, and in full force and effect.

22. Petitioner is also the owner of United States Trademark Registration No. 2,437,300 for its mark "DOUBLE ACTION PUREX ADVANCE" registered March 20, 2001 for laundry detergents in International Class 3, which registration is valid and subsisting, and in full force and effect.

23. Petitioner is also the owner of United States Trademark Application Serial No. 78/242,013 for its mark "PUREX BABY" filed April 25, 2003 for laundry care preparations, namely, laundry detergents, fabric softeners, wrinkle reducers and stain removers in International Class 3.

24. Petitioner is also the owner of United States Trademark Application Serial No. 78/285,584 for its mark "PUREX SOFT" filed August 11, 2003 for laundry care preparations, namely, laundry detergents, fabric softeners, wrinkle reducers and stain removers in International Class 3.

25. Petitioner is also the owner of United States Trademark Application Serial No. 78/317,594 for its mark "PURE CLEAN. PURE VALUE. PUREX" filed October 23, 2003 for laundry care preparations, namely, laundry detergent and fabric softeners in International Class 3. .

26. Petitioner is also the owner of United States Trademark Application Serial No. 78/317,598 for its mark "PURE FRESH. PURE VALUE. PUREX." filed October 23, 2003 for laundry care preparations, namely, laundry detergent and fabric softeners in International Class 3.

27. Petitioner is also the owner of United States Trademark Application Serial No. 78/317,599 for its mark "PURE SOFT. PURE VALUE. PUREX." filed October 23, 2003 for laundry care preparations, namely, laundry detergent and fabric softeners in International Class 3.

II. **LACK OF OTHER "PUREX" MARKS**

28. With almost no exceptions, Petitioner's PUREX trademarks are the only marks found on the Federal register which use the PUREX formative, and the same has been true for eighty (80) years. In fact, prior to 1925, only one other mark is found on the Federal register, namely, Morton's mark "PUREX (Stylized)®" for salt, registered August 5, 1924 as U.S. Reg. No. 187,453. Similarly, since 1925, only one other mark comprising or containing the formative "PUREX", other than the trademarks of Petitioner, has been registered. That sole registration is the subject of this cancellation petition, namely Teijin DuPont Films Japan Limited's registration for "PUREX" for plastic film for industrial and commercial packing use. One other PUREX application is now pending, namely application U.S. Serial No. 76/431,555 filed July 11, 2002 by Degussa Aktiengesellschaft, a German company seeking to register the mark PUREX as a trademark for "carbon black for use as a filler in the manufacturing of synthetic mechanical rubber goods" in International Class 1, pursuant to 15 U.S.C. §1126(e) and based upon a German registration. On October 20, 2003, Petitioner filed a Notice of Opposition regarding Degussa's application U.S. Serial No. 76/431,555, and that opposition case is pending under Opposition Proceeding No. 91158484.

III. **PETITIONER'S "PUREX" MARK IS INHERENTLY DISTINCTIVE**

29. Specifically coined to function as a trademark, Petitioner's PUREX mark is fanciful and thus inherently strong. Petitioner's PUREX mark has no other meaning except in connection with Dial's own PUREX brand products, and consumers recognize the mark as such. Given the strength and distinctiveness of its PUREX mark, Petitioner has a broad right to exclude others from using its mark.

IV. **PETITIONER'S "PUREX" MARK IS FAMOUS**

30. The duration and scope of Petitioner's use, sales, and advertising of its products sold under the PUREX mark support the fame of Petitioner's PUREX mark in the United States. As a result, the PUREX mark is among the most famous, widely recognized, and highly respected marks in the United States, so much so that even the courts have commented, in an unsolicited fashion, that Dial has acquired significant goodwill under its PUREX mark. Specifically, the Court of Appeals for the Second Circuit exemplified Dial as a major corporation in the household cleaning industry that has significant goodwill attached to its own name as well as to the trademarks it owns, specifically PUREX. *Clorox Co. v. Sterling Winthrop, Inc.*, 117 F.3d 50 (2d Cir. 1997).

31. In fact, Petitioner's family of PUREX marks has accrued such strength and has become so distinctive to the public, that it is famous, and even those of the public who have not purchased Petitioner's goods associate the mark PUREX with Petitioner even apart from Petitioner's goods.

32. As such, Petitioner's family of PUREX marks has enjoyed increasing fame for decades and, in particular, is famous under 15 U.S.C. §1125(c). With reference to pending Opposition Proceeding No. 91158484 and the instant Petition for Cancellation, Petitioner has taken and continues to take steps to vigorously protect against encroachment upon and tarnishment and/or dilution of its famous PUREX marks.

V. **REGISTRANT'S MARK IS IDENTICAL AND THUS CONFUSINGLY SIMILAR TO PETITIONER'S DISTINCTIVE, FAMOUS "PUREX" MARK**

33. Registrant's mark is identical in spelling and sound to Petitioner's distinctive and famous PUREX marks. When one considers the respective overall impressions of Registrant's mark and Petitioner's, it is clear that consumer confusion, mistake and deception are likely, if not inevitable.

VI. REGISTRANT'S MARK IS IDENTICAL AND THUS LIKELY TO CAUSE DILUTION OF PETITIONER'S DISTINCTIVE, FAMOUS "PUREX" MARK

34. Registrant's mark is identical in spelling and sound to Petitioner's distinctive and famous PUREX marks. Registrant's mark is likely to cause dilution of Dial's distinctive and famous PUREX marks.

VII. INJURY TO PETITIONER AND REQUEST FOR RELIEF

35. No issue exists as to priority. Registrant's date of filing with respect to its subject registration, namely March 18, 1999, and its date of first use in commerce, namely April 1, 1997, are predated at least seventy-six years and seventy-four years, respectively, by the earliest dates of Petitioner's first use as set forth in Petitioner's registrations.

36. In view of, *inter alia*, the strong distinctiveness and widespread fame of Petitioner's PUREX mark, coupled with the fact the Registrant's mark is identical, consumers are likely to associate Registrant's products with Petitioner's PUREX mark irrespective of any differences between Registrant's and Petitioner's respective products. Consumer confusion, tarnishment, damage and injury to Petitioner are inevitable.

37. Allowing continued registration of Registrant's mark would allow Registrant to unfairly trade upon Petitioner's substantial goodwill developed in its aforesaid PUREX marks.

38. Moreover, even if consumers are not confused as to the different origins of the products, if Registrant's mark is permitted to continue to be registered under Reg. No. 2,576,478, the distinctive quality of Petitioner's famous marks will be diluted, and Petitioner will suffer great injury in violation of 15 U.S.C. §1125(c).




WHEREFORE, the Petitioner prays that this Petition for Cancellation be sustained in favor of Petitioner, and that Registration No. 2,576,458 be cancelled.

The filing fee of \$300.00 required under Section 2.6(a)(16) for a single party petitioning to cancel one single-class registration is being submitted herewith electronically via a charge to Deposit Account No. 19-2814.



Dial Brands, Inc.
U.S. Trademarks for the mark "PUREX"

No.	Mark	Goods/Services/Int Class No.	Filing Date	Application No.	Registration Date	Registration No.	Status
1	PURE CLEAN. PURE VALUE. PUREX	Laundry care preparations, namely, laundry detergent and fabric softeners (Int. Class 03).	10/23/2003	78/317,594			Pending.
2	PURE FRESH. PURE VALUE. PUREX.	Laundry care preparations, namely, laundry detergent and fabric softeners (Int. Class 03).	10/23/2003	78/317,598			Pending.
3	PURE SOFT. PURE VALUE. PUREX.	Laundry care preparations, namely, laundry detergent and fabric softeners (Int. Class 03).	10/23/2003	78/317,599			Pending.
4	PUREX BABY	Laundry care preparations, namely, laundry detergents, fabric softeners, wrinkle reducers; stain removers (Int. Class 03).	4/25/2003	78/242,013			Pending.
5	PUREX SOFT	Laundry care preparations, namely, laundry detergents, fabric softeners, wrinkle reducers; stain removers (Int. Class 03).	8/11/2003	78/285,584			Pending.
6	DOUBLE ACTION PUREX ADVANCE	Laundry detergents (Int. Class 03).	5/16/2000	76/049,443	3/20/2001	2,437,300	Registered.
7	PUREX ADVANCED	Laundry detergents (Int. Class 03).	4/19/1999	75/686,651	10/31/2000	2,400,944	Registered.
8	PUREX RINSE 'N SOFT	Fabric softeners for laundry use (Int. Class 03)	7/23/1990	74/081,018	1/19/1993	1,747,647	Registered and incontestable.

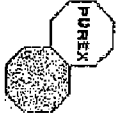




Dial Brands, Inc.
U.S. Trademarks for the mark "PUREX"

No.	Mark	Goods/Services/Int Class No.	Filing Date	Application No.	Registration Date	Registration No.	Status
9	 (PUREX and Design)	Laundry and household bleaching and cleaning preparations in liquid and dry forms (Int. Class 03)	4/8/1991	74/154,905	7/7/1992	1,698,689	Registered and incontestable.
10	 (NEW BABY SOFT DETERGENT FROM PUREX and Design)	Laundry detergent (Int. Class 03).	3/20/1995	74/649,163	6/18/1996	1,980,777	Registered and incontestable.
11	PUREX (PUREX and Design)	Laundry bleach (Int. Class 03)	3/14/1994	74/499,875	1/31/1995	1,876,275	Registered and incontestable.
12	BABY SOFT BY PUREX	Laundry detergents (Int. Class 03).	2/25/1994	74/494,593	1/9/1996	1,947,415	Registered and incontestable.
13	 (PUREX and Design)	Laundry and household bleaching and cleaning preparations in liquid and dry forms (Int. Class 03)	5/20/1986	73/599,899	4/7/1987	1,435,216	Registered and incontestable.

Dial Brands, Inc.
U.S. Trademarks for the mark "PUREX"

No.	Mark	Goods/Services/Int Class No.	Filing Date	Application No.	Registration Date	Registration No.	Status
14	PUREX (PUREX (Stylized))	Laundry detergent (Int. Class 03).	4/21/1976	73/084,655	4/5/1977	1,062,573	Registered and incontestable.
15	PUREX (PUREX (Stylized))	Laundry detergent (Int. Class 03).	4/12/1976	73/083,618	11/16/1976	1,052,724	Registered and incontestable.
16	PUREX (PUREX (Stylized))	General cleaning preparations in liquid and dry forms having bleaching, cleaning, and disinfecting properties (Int. Class 03)	12/20/1952	71/639834	8/11/1953	578,630	Registered and incontestable.
17	 (PUREX and Design)	Household detergents, household cleansers and toilet soap (Int. Class 03)	11/13/1967	72/284,556	4/16/1968	847,740	Registered and incontestable.
18	 (PUREX and Design)	Wax remover and heavy duty cleanser for industrial purposes (Int. Class 01)	11/13/1967	72/284,555	8/6/1968	854,332	Registered and incontestable.

Dial Brands, Inc.
U.S. Trademarks for the mark "PUREX"

No.	Mark	Goods/Services/Int Class No.	Filing Date	Application No.	Registration Date	Registration No.	Status
19	 (PUREX and Design)	Scrubable floor finish in the nature of a water emulsified lacquer resin (Int. Class 02)	11/13/1967	72/284,554	8/6/1968	854,006	Registered and incontestable.
20	 (PUREX and Design)	Cleaning, scouring and polishing wads (Int. Class 03)	11/13/1967	72/284,553	4/16/1968	847,538	Registered and incontestable.
21	 (PUREX and Design)	Liquid bleach (Int. Class 03)	9/21/1964	72/202,308	11/16/1965	798,694	Registered and incontestable.
22	 (PUREX "IS DIFFERENT" and Design)	Bleach and water softener (Int. Class 03)	5/31/1930	71/302,017	5/1/1934	312,493	Registered and incontestable.
23	 (PUREX and Design)	General cleaning preparations in liquid form with incidental water softening properties (Int. Class 03)	9/5/1925	71/219,909	4/13/1926	211,650	Registered and incontestable.