

ESTTA Tracking number: **ESTTA397426**

Filing date: **03/10/2011**

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	Water Tec of Tucson, Inc.		
Entity	Corporation	Citizenship	Arizona
Address	4601 S. 3rd Ave. Tucson, AZ 85714 UNITED STATES		

Attorney information	Dale F. Regelman Quarles & Brady LLP One S. Church Avenue Suite 1700 Tucson, AZ 85701-1621 UNITED STATES dale.regelman@quarles.com, nikia.gray@quarles.com, reena.mendez@quarles.com Phone:520-770-8703		
----------------------	---	--	--

Registration Subject to Cancellation

Registration No	3719837	Registration date	12/01/2009
Registrant	DeGrave, Richard Joseph 3660 N. CALLE DE AMIGOS TUCSON, AZ 85750 UNITED STATES		

Goods/Services Subject to Cancellation


Class 011. First Use: 2008/12/15 First Use In Commerce: 2009/01/31 All goods and services in the class are cancelled, namely: Aquarium filtration apparatus; Aquarium heaters; Electric bath-water purifying apparatus for household purposes; Filters for drinking water; Filters made of fiber for water filtration; Filters, heaters and pumps sold in combination for use in swimming pools; Flow restrictors for reverse osmosis water purification units; Industrial-water purifying apparatus; Ozone sanitizers for air and water; Swimming pool chlorinating units; Swimming pool water cleaning and filtering units; Water filtering apparatus; Water filtering units for aquariums; Water purifying apparatus; Water treatment equipment, namely, reverse osmosis filtration units

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	includes, but are not limited to, the sale of water conditioning units, water filtering units for residential and commercial use; water softening units; water treatment equipment namely, cartridge filtration units, reverse osmosis filtration units and ultraviolet sterilization units, installation of the same, and maintenance of the same

Attachments	Petition to Cancel.pdf (6 pages)(141084 bytes) WATER TEC.jpg
-------------	--

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	/Dale F. Regelman/
Name	Dale F. Regelman
Date	03/10/2011

I hereby certify that this correspondence is being deposited electronically in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date set forth below.

Date of Signature and Deposit: March 10, 2011

By /Reena Mendez/
Reena Mendez

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

In The Matter Of Registration No. 3,719,837
Filing Date: December 9, 2008
For the Mark: WATER IXC

Water Tec of Tucson, Inc.)	
an Arizona corporation)	
)	Petitioner No. _____
Petitioner,)	
)	
v.)	
)	
Richard Joseph DeGrave, an)	PETITION TO CANCEL
Individual,)	
)	
_____ Registrant.)	

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

Petitioner WATER TEC OF TUCSON, INC. ("Water Tec") hereby asserts it is damaged by Registration No. 3,719,837 for the design mark WATER IXC. Water Tec alleges as follows:

THE PARTIES

1. Water Tec is a corporation existing under the laws of Arizona, having an address of 4601 S. 3rd Ave., Tucson, AZ 85714.
2. Water Tec was incorporated on or about March 24, 1993.

3. Water Tec is informed, believes, and therefore alleges, that Richard Joseph DeGrave (hereinafter the "Registrant"), is an individual having an address of 3660 N. Calle De Amigos, Tucson AZ 85750.

FACTUAL OVERVIEW

4. Since 1989, Water Tec has extensively used the mark WATER TEC in standard character, stylized, and design formats (collectively the "WATER TEC Marks") in commerce in the United States connection with the sale, installation, and maintenance of water treatment equipment and services.

5. More specifically, the goods and services provided under the WATER TEC Marks include, but are not limited to, the sale of water conditioning units, water filtering units for residential and commercial use; water softening units; water treatment equipment namely, cartridge filtration units, reverse osmosis filtration units and ultraviolet sterilization units, installation of the same, and maintenance of the same.

6. In connection with providing these goods and services, Water Tec has used the WATER TEC Marks on said water conditioning units, water filtering units, water softening units, water treatment equipment or the packaging of the same as well as in advertisements, catalogs of goods and services, Water Tec's website, letters, mailings, brochures, and the like.

7. Water Tec's use of the WATER TEC Marks on or in connection with the above referenced goods and services has been continuous from 1989 to the present.

8. Water Tec owns Arizona Trade Mark Registration No. 53748 for the design mark



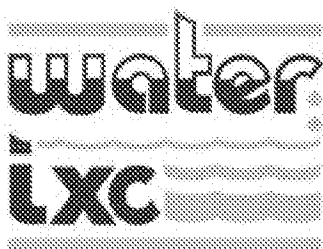
(the "WATER TEC Design Mark") for water filtration and purification and related supplies. As can be seen, the WATER TEC Design Mark includes the text "water tec," two (2) water droplets, and three (3) waves.

9. Water Tec owns Arizona Trade Mark Registration No. 53749 for the trade mark WATER TEC OF TUCSON for water filtration and purification and related supplies.

10. Water Tec owns Arizona Trade Mark Registration No. 53750 for the trade mark WATER TEC for water filtration and purification and related supplies.

11. Water Tec owns Arizona Trade Name Registration No. 447991 for the trade name WATER TEC OF TUCSON for water filtration and purification and related supplies.

12. Registrant filed its Application to register as a design mark



(the "WATER IXC Design Mark") with the United States Patent Trademark Office ("USPTO") as Serial No. 77/629812 on or about December 9, 2008, under 15 U.S.C. §1051(b). The WATER IXC Design Mark includes the text "water ixc," two (2) water droplets, and three (3) waves.

13. A Notice of Allowance for application Serial No. 77/629812 was issued by the USPTO on September 29, 2009. On October 6, 2009, Registrant filed a Statement of Use

alleging a first date of use anywhere on or about December 15, 2008, and further alleging a first date of use in commerce on or about January 1, 2009.

14. Registration No. 3,719,837 for the WATER IXC Design Mark issued on December 1, 2009 covering "Aquarium filtration apparatus; Aquarium heaters; Electric bath-water purifying apparatus for household purposes; Filters for drinking water; Filters made of fiber for water filtration; Filters, heaters and pumps sold in combination for use in swimming pools; Flow restrictors for reverse osmosis water purification units; Industrial-water purifying apparatus; Ozone sanitizers for air and water; Swimming pool chlorinating units; Swimming pool water cleaning and filtering units; Water filtering apparatus; Water filtering units for aquariums; Water purifying apparatus; Water treatment equipment, namely, reverse osmosis filtration units," in International Class 11.

15. Registrant's use of the WATER IXC Design Mark is confusingly similar to Water Tec's use of the WATER TEC Marks, and in particular is confusingly similar to the WATER TEC Design Mark.

16. Registrant's registration of the WATER IXC Design Mark gives Registrant prima facie exclusive rights to the mark, despite that Water Tec is the senior use of the WATER TEC Marks, including the WATER TEC Design Mark, and causes harm and damage to Water Tec.

Count I
Confusing Similarity

17. The allegations of Paragraphs 1 through 16, inclusive, are incorporated herein.

18. The goods recited in the Registration No. 3,719,837, namely "Water purifying apparatus; Water treatment equipment, namely, reverse osmosis filtration units," are closely related to the goods sold by Water Tec under the WATER TEC Marks, and in particular the WATER TEC Design Mark.

19. Water Tec first used the WATER TEC Marks in commerce in connection with Water Tec's above-recited goods and services at least twenty (20) years before Registrant's first date of use in commerce, and more than nineteen (19) years before Registrant filed its application for registration.

20. Registrant's Mark so nearly resembles the WATER TEC Marks, and in particular the WATER TEC Design Mark, that when Registrant's Mark is used in commerce it is likely to and has caused confusion, mistake, or deception of the public within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).

21. Registrant's Mark so nearly resembles the WATER TEC Marks, and in particular the WATER TEC Design Mark, that when Registrant's Mark is used in commerce it is likely to and has caused confusion, mistake, or deception of the public within the meaning of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a).

22. Registration No. 3,719,837 gives Registrant prima facie exclusive rights to the WATER IXC Design Mark, a mark which is confusingly similar to the WATER TEC Marks, and in particular the WATER TEC Design Mark, and has damaged and injured Water Tec, the senior user.

23. By reason of the foregoing, Registration No. 3,719,837 has caused, and is causing, injury and damage to Water Tec.

24. If Registration No. 3,719,837 is permitted to remain on the Principal Register, Water Tec will continue to be damaged.

WHEREFORE, Water Tec of Tucson, Inc. believes it is damaged by Registration No. 3,719,837 and prays that it is cancelled.

Water Tec is electronically remitting on even date herewith the amount of THREE HUNDRED DOLLARS (\$300.00) as the filing fee for the instant Petition to Cancel. In the

event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account 17-0055.

RESPECTFULLY SUBMITTED this 10th day of March, 2011.

QUARLES & BRADY LLP
One South Church Avenue
Suite 1700
Tucson, AZ 85701-1621

By /Dale F. Regelman/
Dale F. Regelman, Reg. No. 45,625
Nikia Gray, Reg. No. 57,770
QUARLES & BRADY, LLP
Attorneys for Water Tec of Tucson, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on March 10, 2011, a true copy of the foregoing PETITION TO CANCEL was served via First Class Mail, postage paid, upon: Richard Joseph DeGrave, 3660 N. Calle De Amigos, Tucson AZ 85750.

By /Reena Mendez/
Reena Mendez