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OF THE TTAB

Mailed: August 12, 2003

Hearing:  
June 3, 2003

Paper No. 17  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Millipore Corporation

v.

APS Water Services Inc.

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Opposition No. 122,225  
to application Serial No. 75/935,347  
filed on February 16, 2000

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Susan G.L. Glovsky of Hamilton, Brook, Smith & Reynolds,  
P.C. for Millipore Corporation.

Charles H. Melville of Strauss & Troy for APS Water Services  
Inc.

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Before Seeherman, Hohein and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An intent-to-use application has been filed by APS  
Water Services Inc. (a California corporation) to register  
the mark LABWATER.COM for "laboratory water purification  
units and filters" in International Class 9.

**Opposition No. 122225**

Millipore Corporation (a Massachusetts corporation) has opposed the application, alleging that opposer is the owner of the mark LAB WATER for use on laboratory water purification units and filters; that opposer has continuously used the mark LAB WATER in connection with laboratory water purification units and filters since prior to 1997; that opposer's "LAB WATER trademark is of significant value to Opposer as an identification of source in connection with the promotion and offering of its goods and services" (paragraph 4); that opposer's LAB WATER mark distinguishes its goods and services from those of others; that "Applicant's products include replacement purification units for Opposer's apparatus" (paragraphs 6); that Applicant is marketing its LABWATER.COM products to customers of Opposer's products" (paragraph 7); and that applicant's mark, when used on or in connection with its goods, would so resemble opposer's previously used mark as to be likely to cause confusion, mistake, or deception.

Applicant, in its answer, admits that "its products include replacement purification units for Opposer's apparatus," but denies the remaining salient allegations of the notice of opposition. Applicant also asserts the

**Opposition No. 122225**

"affirmative defenses" of (i) opposer's failure to establish its standing, and (ii) "laches and acquiescence."<sup>1</sup>

The record consists of the pleadings; the file of the opposed application; opposer's testimony, with exhibits, of (i) Patricia A. Nassau, opposer's marketing services manager for the Americas, Lab Water Division, and (ii) Gary A. O'Neill, Ph.D., opposer's director of clinical and OEM business; and applicant's testimony, with exhibits, of Mitchell Wilson, applicant's founder and president, who is also a former employee of opposer.

Both parties have filed briefs on the case; and both parties were represented at the oral hearing held before the Board on June 3, 2003.

**Preliminary Matters**

First, we will determine applicant's objection on the basis of hearsay to the testimony of opposer's witness Dr. Gary O'Neill with regard to two asserted instances of actual confusion.<sup>2</sup> (Applicant's brief, p. 13, footnote 5). Dr. O'Neill testified that the two involved instances were reports entered into opposer's computerized customer

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<sup>1</sup> The issue of opposer's standing, being an element of opposer's case, will be determined later in this decision. Applicant's defenses of laches and acquiescence were not tried, and were not argued by applicant in its brief. Thus, these defenses are considered to have been waived by applicant.

<sup>2</sup> Although there were objections made during each of the testimony depositions taken in this proceeding, neither party preserved any other objection in its brief (except the one set forth above). Thus, all other objections are considered waived. See TBMP §707.04 (2d ed. 2003).

**Opposition No. 122225**

complaint system by opposer's telephone support personnel; and that he receives electronic copies of these reports daily regarding customer complaints and problems. Inasmuch as opposer has an internal routine customer complaint reporting system, and the witness oversees the complaints (at least for the division in which he works) by receiving and reviewing all customer complaints daily, we find that the testimony about these reports is admissible. See Fed. R. Evid. 803(6). (However, as a practical matter, this ruling is of little consequence as will be clear from our decision on the issue of likelihood of confusion, *infra*.)

Another matter to be determined initially is what specific issues are before the Board. Opposer pleaded only use of "LAB WATER" as a mark used by opposer for goods and services. In its brief and at the oral argument, opposer argued that it had established trade name use and/or use analogous to trademark use. Upon review of the entire record, it is clear that these issues were tried (i.e., opposer's use of the trade name "Lab Water" as a division of opposer corporation, and opposer's use thereof in a manner analogous to trademark use). These issues were also argued by both parties in their briefs on the case and at oral argument. Thus, the notice of opposition is deemed amended to conform to the evidence pursuant to Fed. R. Civ. P. 15(b) to include a claim of opposer's prior trade name use and of

**Opposition No. 122225**

use analogous to trademark use. See TBMP §507.03(b) (2d ed. June 2003). To be clear, opposer's claim is likelihood of confusion based on prior common law rights in "LAB WATER" as a trademark, service mark, trade name and use analogous to trademark use.

Applicant did not plead as an affirmative defense that opposer's asserted mark is merely descriptive. However, again it is clear that the issue was tried by the parties and was argued in their briefs as well as at oral argument. Accordingly, applicant's answer to the notice of opposition is deemed amended to conform to the evidence pursuant to Fed. R. Civ. P. 15(b) to include an affirmative defense that opposer's mark is merely descriptive. Specifically, we consider applicant's answer to include the affirmative defense that opposer's mark and trade name "LAB WATER" is neither inherently distinctive nor has it acquired distinctiveness for laboratory water purification units and filters and, thus, because opposer has only a merely descriptive term, it lacks rights on which it can base a claim of priority and likelihood of confusion.

**The Parties**

Opposer, Millipore Corporation, is a high-tech corporation with divisions such as Analytical, BioProcess,

**Opposition No. 122225**

Lab Water, and Microelectronics.<sup>3</sup> According to Dr. Gary O'Neill, when he joined the company in 1990 there was a

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<sup>3</sup> The Microelectronics Division was sold in April 2001 (Nassau dep., pp. 112-113, 160).

**Opposition No. 122225**

product line within the Analytical Division called "the lab water products," which were "a series of products, systems, consumables and services that were sold to users of high purity water in the laboratory." (Dep., pp. 18-19.) Over time this single product line within a division became its own separate operating division, with the announcement of the formation of the Lab Water Division on December 30, 1994. (Opposer's Exhibit 42.) This division of opposer corporation designs and manufactures water purification products, consumables and accessories. The products (e.g., water systems, filters, UV lamp accessories, storage reservoirs, spare parts) are used by opposer's customers "for the production of varying qualities of pure water." Opposer also offers "validation services" and "field service." (Nassau dep., pp. 17, 18 and 21.) Opposer does not sell water.

The customers for opposer's involved goods and services are "in general lab markets [and] clinical lab markets" and "end users, lab managers, lab supervisors, facilities managers, and purchasing agents" (Nassau dep., p. 14). "Scientists and researchers in university, pharmaceutical, and environmental research settings, both university and industry settings; and ... clinical laboratory personnel, laboratory managers and laboratory supervisors in hospital

**Opposition No. 122225**

settings" are all customers for the involved goods and services. (O'Neill dep., pp. 72-73.)

According to opposer's two witnesses, opposer has used "LAB WATER" as a mark for products and services sold to users of high purity water in the laboratory since 1990 (O'Neill dep., p. 19); and as the name of a corporate division since 1994. Again, according to these witnesses, the term "LAB WATER" is used in all mailings to customers, at trade shows, in articles written for journals, in "Applications Notes" issued by opposer's various divisions, and on opposer's Internet web site (which was developed in 1994, with the Lab Water products being the first products listed thereon) (O'Neill dep. pp. 21 - 22). "Millipore Lab Water Systems" appears on the back of t-shirts sent to customers in North America who responded to an offer in opposer's "Waterline" publication. (O'Neill dep., p. 61.) "MILLIPORE Lab Water" appears on shirts worn by opposer's employees at the trade show where opposer launched its "new Milli-Q ultrapure water systems" in 2001. (Nassau dep., p. 67.)

Applicant, APS Water Services Inc., was founded in 1991 by Mitchell Wilson after he left the employ of opposer, Millipore Corporation. Mr. Wilson worked for opposer from 1984 until 1991, working in the Analytical Division in various jobs, including service technician, field engineer,

**Opposition No. 122225**

sales representative, customer service manager, and regional operations manager. While at Millipore Corporation, Mr. Wilson was responsible for "selling and installing and maintaining water purification equipment." (Wilson dep., p. 10.)

Applicant corporation provides "laboratory water purification products for scientific and high technology industries." (Wilson dep., p. 14.)

Applicant obtained the domain name "LABWATER.COM" on August 29, 1999 from InterNIC Registration Services. (Wilson dep., pp. 15-16, Exhibit B). Subsequent to that date, applicant used the mark on the website and also began using it on its products. Mr. Wilson testified that applicant used the term "LABWATER.COM" in these ways prior to the filing date of its intent-to-use based application on February 16, 2000. However, his testimony does not precisely establish earlier dates of first use of the mark. (Wilson dep., p. 41. See also, dep., pp. 19 and 47-50.) Applicant has given away promotional items such as hats and t-shirts with, inter alia, the words "LabWater.com" thereon, all sometime after August 29, 1999.

**Standing**

There is no issue as to standing. Applicant acknowledges that opposer and applicant "are competitors in the business of supplying products, systems, and consumables

**Opposition No. 122225**

to users of high purity water in the laboratory."

(Applicant's brief, p. 3.) In addition, in its answer, applicant admits that its products include replacement purification units for opposer's systems.<sup>4</sup>

**Priority**

Opposer pleaded prior common law trademark and service mark rights in the term "LAB WATER." Prior trade name use as well as use analogous to trademark use were added as claims under Fed. R. Civ. P. 15(b), as explained above. Applicant's affirmative defense that opposer's use of the term "LAB WATER" is merely descriptive and has not been shown to be inherently distinctive or to have acquired distinctiveness was also added under Fed. R. Civ. P. 15(b). Finally, opposer contended that its mark and trade name is not merely descriptive, but if the Board finds that it is descriptive, then opposer asserted that its mark and trade name "LAB WATER" have acquired distinctiveness.

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<sup>4</sup> Applicant did not plead but argued in its brief that opposer cannot be damaged by any registration to applicant because opposer's use of "lab water" and "laboratory water" is "merely descriptive of high purity water for use in the laboratory environment -- the environment in which (or for which) the products of Opposer are used, and hence clearly falls within the definition of 'fair use....'" as that doctrine is codified in Section 33(b)(4) of the Trademark Act, 15 U.S.C. §1115(b)(4).

To the extent that applicant is asserting that opposer lacks standing because of this "lack of damage," we find this argument to be unpersuasive. The defenses set forth in Section 33 of the Trademark Act apply to civil actions regarding use, not registrability. Moreover, whether or not opposer could assert this defense if it were sued for trademark infringement has no effect on its standing to bring this opposition.

**Opposition No. 122225**

In order to demonstrate priority opposer must establish common law rights in a mark or trade name or use analogous to trademark/service mark use, and if the term is held to be merely descriptive, then opposer must establish the term had acquired distinctiveness, prior to applicant's first use or constructive use date.

Applicant obtained a domain name on August 29, 1999, and filed its intent-to-use based application on February 16, 2000. While applicant contends that it began using "LABWATER.COM" as a trademark "shortly after" the web site went up on the Internet (Wilson dep., p. 49), there is no evidence of any specific date of such use. See *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1851-1852 (Fed. Cir. 1993). Inasmuch as the acquisition of a domain name is not, by itself, evidence of use of the term as a trademark, and because applicant has not proven use of "LABWATER.COM" as a mark as of any specific date, applicant is entitled only to the filing date of its application, February 16, 2000, as the earliest date upon which it can rely in this proceeding.

A party asserting a claim under Section 2(d) of the Trademark Act must establish prior use of a trademark, or service mark, or trade name or other indication of origin. See *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d

**Opposition No. 122225**

1039 (Fed. Cir. 1990); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

Under the case of *Otto Roth & Co. v. Universal Foods Corp.*, supra, 209 USPQ at 43, a plaintiff opposing registration of a trademark on the ground of likelihood of confusion with the plaintiff's own unregistered term cannot prevail unless the plaintiff shows its term is distinctive of its goods, either inherently, or through acquired distinctiveness, or through "whatever other type of use may have developed a trade identity."

We consider first whether, and if so, when, opposer established common law trademark/service mark, trade name or use analogous to trademark/service mark use. The record shows that opposer offered to laboratory users of high purity water a line of "lab water products" (consisting of "products, systems, consumables and services") (O'Neill dep., pp. 18-19) through its Analytical Products Division in 1990. Further, opposer created a Lab Water Division which was publicly announced on December 30, 1994.

However, having carefully reviewed all of the documentary and testimonial evidence, we find that "LAB WATER" is a merely descriptive term for laboratory water purification units and filters, and that opposer's uses would not be viewed by the consuming public as a trademark for such goods. Further, there is no evidence of opposer's

**Opposition No. 122225**

asserted service mark of "LAB WATER," and there is no convincing evidence of use analogous to trademark use.

First, the term "lab water" is merely descriptive of opposer's goods. Although we are aware that opposer does not sell water, it is clear that opposer sells systems and products used by its customers to achieve various grades of purity in the water used in their laboratories, and that "lab water" is a term used to refer to such products or systems and to the water that is produced by the use of such equipment.<sup>5</sup> See, for example, the following uses by opposer:

The time is right to buy a new water purification system for your lab. If you act now, any Millipore lab water system purchase you make will be discounted by an additional 8% beyond your already low GSA pricing. Opposer's Exhibit No. 3 (a GSA pricing flier);

More than 75 percent of Millipore's products are consumables. Take this new lab water purification system. ...; All laboratories need pure water. ... Over the past twenty-five years we have built a strong brand name with our Milli-Q® Water Purification systems. ... Every laboratory needs a lab water purification system. .... Opposer's Exhibit No. 16 (excerpts from annual reports);

Pure Science It's our total dedication to improving productivity, whether you're developing assays or

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<sup>5</sup> We have emphasized uses which are seen by customers and potential customers, rather than uses which are for internal use at opposer corporation.

**Opposition No. 122225**

decontaminating fluids. It's our focus on fitting a system to your application, from designing screening plates compatible with your robots to customizing lab water systems to your particular process....  
Opposer's Exhibit No. 30 (opposer's 1999/2000 catalog);

Milli-Q® Ultrapure Water Systems  
... Millipore's new Explore Data software allows users to access their lab water system through a computer interface, and is incorporated in both Milli-Q and Elix systems.  
Opposer's Exhibit No. 34 (opposer's 2001-2002 catalog); and

Millipore offers you a free luncheon invitation...Get all the pure water you need...Millipore has the right purification systems for your high-purity lab water applications....  
Dear Colleague,  
...We would like the opportunity to share our knowledge of lab water with you and help identify the best water purification system for your application....  
Sincerely,  
Glen Gagnon  
Director of Sales and Service  
Lab Water Division  
(Exhibit No. 37 introduced in cross-examination at Nassau dep., copy of a promotion-direct mailer/flier, and a copy of a fulfillment letter sent with literature as a follow up to the promotion).

In these examples, opposer does not use the term in the manner of a trademark. Even in those examples in which opposer has capitalized the term, the use is, at best, ambiguous. That is, it is more likely that consumers will

**Opposition No. 122225**

view the term "lab water" as merely describing the purpose of the system. See, for example:

Millipore's new generation of laboratory water systems utilize a range of traditional and emerging technologies... Millipore's Lab Water Specialists have a wealth of information you won't find anywhere else. Dial 1-800-MILLIPORE ... to speak with a Millipore lab water expert.

Opposer's Exhibit No. 28 (opposer's 1999 U.S. price list);

You can count on Millipore Lab Water Experts. ... We're Your Source for Pure Lab Water. ...Millipore systems combine the latest water purification technologies. Milli-Q® ultrapure water systems incorporate... . Contact a lab Water expert today....

Opposer's Exhibit No. 33 (opposer's Spring 2000 catalog);

as well as the following wording on displays at opposer's trade show booths (e.g., the Experimental Biology Trade Show, PITTCON, and "table-top" booths at local one-day trade shows or customer events):

"MILLIPORE Your Lab Water Application Specialists" and "MILLIPORE Your Life Science Applications Specialists" (Opposer's Exhibit No. 9);

"MILLIPORE Engineered Lab Water Systems" and "New! Milli-Q® Element for ICP-MS Water for Ultra Trace Analysis" and "New! Simplicity™ Personal Water Systems" (opposer's Exhibit No. 10);

**Opposition No. 122225**

"MILLIPORE  
New Lab Solutions" and  
"Lab Water Solutions  
Biotech Applications"  
(Opposer's Exhibit No. 11);

"Lab Water Product Selection Guide"  
(Opposer's Exhibit No. 12); and

"Engineered Lab Water Systems  
-Turnkey A7E Lab Designs from the Water  
Experts  
...  
-General Lab to Ultrapure Water Quality"  
(Opposer's Exhibit No. 13).

The testimony of the various witnesses also militates against a finding that opposer has either regarded or promoted "LAB WATER" as a trademark. Ms. Patricia Nassau, opposer's marketing services manager for the Americas Lab Water Division, employed by opposer since 1994, was asked on cross-examination if there were any instances where she, being responsible for correct usage of the symbols "TM," "SM" and "®," used any of these symbols with "Lab Water." The answer was "No." (Nassau dep., p. 154). She was also asked if she knew of any instance where opposer included "lab water" or "laboratory water" in the legend on any of its publications listing trademarks, and she testified that she could not recall any. She also testified that opposer did not use a "TM" or "SM" or "®" by the words "lab water" or "laboratory water." (Nassau dep., pp. 202-204.)

Dr. Gary O'Neill, opposer's director of clinical and OEM business, employed by opposer since 1990, testified that

**Opposition No. 122225**

part of his job is selecting trademarks and checking with legal counsel thereon; that he never checked with legal counsel about "lab water" or "laboratory water" as trademarks (O'Neill dep., pp. 85-87); and that he had no knowledge of any instance where "lab water" or "laboratory water" appeared on any of opposer's packaging or boxes or labels (O'Neill dep., pp. 98-99).

Applicant's witness, Mitchell Wilson, applicant's founder and president, testified that during his six years working for opposer, Millipore Corporation (1984-1991), he wrote sales literature, gave quotations, and wrote narratives on system designs; that Millipore had a policy regarding use of trademarks and signifying a term as a trademark and giving credits at the bottom of the documents; and that during his time at Millipore, "lab water" was frequently used but never as a trademark. (Wilson dep., pp. 11-13.) Although it is not clear to what extent opposer used the term "LAB WATER" prior to Mr. Wilson's departure, his testimony does show that opposer had a settled policy regarding trademark use, and the testimony of opposer's witnesses shows that this policy was apparently not followed for the term "LAB WATER."

In view of this evidence, we find that "LAB WATER" is a merely descriptive term, and that consumers would not regard opposer's use of the term as a trademark. Thus, we find

**Opposition No. 122225**

that opposer has failed to demonstrate that "LAB WATER" has acquired distinctiveness as opposer's trademark.

With respect to opposer's claim of service mark rights in "LAB WATER," there is no evidence in the record of any service mark use whatsoever. As for use analogous to trademark use, in order to establish use analogous to trademark use, opposer must establish that "the analogous use is of such a nature and extent as to create public identification of the target term with the opposer's product or service." *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). When the evidence falls short of establishing the critical inference of identification in the mind of the relevant consumers, then analogous use has not been established. See *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 569 F.2d 1130, 196 USPQ 808 (CCPA 1978). For the same reasons we have found there is no trademark use, we find that opposer has not demonstrated use analogous to trademark use. That is, opposer's uses of "LAB WATER" are either merely descriptive uses or are ambiguous uses at best.

In summary, we find that this record does not support trademark use, or service mark use (there being virtually no evidence of use of the term as a service mark), or use analogous to trademark use, and thus opposer has not established common law rights in "LAB WATER" as a mark.

**Opposition No. 122225**

Further, we find that opposer's use of the term "LAB WATER" on its involved goods to be merely descriptive of the purpose or function of opposer's products, i.e., producing grades of purified water for use in the laboratory. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 1215 (CCPA 1978.)

Turning then to opposer's claim of prior trade name use, we find that opposer has established trade name use of the term "LAB WATER" through its continuous use since December 30, 1994 of the term as the name of its "Lab Water Division." See *Swingline, Inc. v. Ardco, Inc.*, 215 USPQ 436 (TTAB 1982). We recognize that this trade name use has not been totally consistent. Specifically, opposer has sometimes used "Laboratory Water Division" (see e.g., opposer's Exhibit No. 17-pages M 00207, M 00213, M 00219 and M 00226 (fulfillment letters), and opposer's Exhibit Nos. 53-55 ("Waterline" newsletters). Nonetheless, we find this record establishes that opposer organized a "Lab Water Division" in late 1994 and has continuously used "Lab Water" as the name of one of opposer's divisions.

Because we find that opposer has established trade name use, we must now determine, due to the mere descriptiveness of the name "LAB WATER," whether opposer has established acquired distinctiveness of its descriptive trade name prior to the filing date of applicant's application. This has not

**Opposition No. 122225**

been done. Opposer has the burden of establishing a prima facie case that its trade name has become distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness. However, the more highly descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha*, supra at 1008. See also, 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §15:28 (4th ed. 2001).

Opposer points to several facts it contends establish it has acquired distinctiveness in "Lab Water/Lab Water Division." These include use of the term for ten years prior to the filing date of applicant's application, annual sales figures, annual advertising costs, and the scope of its publicity. However, although Dr. O'Neill testified that when he joined opposer they had a product line called the lab water products (O'Neill dep., p. 19), there is no evidence of trademark or service mark or trade name use of "Lab Water" in 1990, and in fact, the products under this line were referred to as "product line L1." (O'Neill dep.,

**Opposition No. 122225**

p. 25.) The Lab Water Division was not established until December 30, 1994.

Dr. O'Neill also testified that "the total revenues of the Lab Water Division in North America are in the tens of millions of dollars." (O'Neill dep., p. 29.) Advertising costs for North America for products and services sold by opposer's Lab Water Division were \$405,000 in 1995, grew to \$1,161,000 in 1998, fell to \$810,000 in 2000 and were budgeted at \$1,045,000 for 2001. About 90% of the advertising figures relate to the United States, and 10% to Canada. (O'Neill dep., p. 28-29.)

The question here is acquired distinctiveness of the trade name "Lab Water Division." The evidence shows no use of the trade name on packaging and labels; and, in fact, Dr. O'Neill testified he had never seen the term on packaging, boxes or labels. (O'Neill dep., pp. 98-99.) Several of opposer's documents are internal corporate documents which utilize "Lab Water Division," but such documents do not establish purchaser perception and acquired distinctiveness. Other uses, such as those showing an executive's name and title above either "Lab Water Division" or "Laboratory Water Division" are simply not convincing that this trade name has acquired distinctiveness. Simply put, based on the evidence of record, we cannot conclude that opposer's sales and

**Opposition No. 122225**

advertising figures prove acquired distinctiveness of the trade name.

Opposer characterizes the scope of publicity as "extensive" and including "promotions, trade shows, and seminars" and "mailings" as well as personnel wearing shirts and t-shirts bearing "Lab Water" at trade shows (brief, p. 25). However, the evidence of record does not support opposer's contention. That is, this record does not reflect significant publicity regarding opposer's use of the trade name "Lab Water Division." The evidence submitted may show some popularity or success of opposer's overall sales of all products offered under all of its numerous trademarks (e.g., Milli-Q, Elix, RiOs, Milli-RX, Milli-RO, Super-Q, Simplicity) sold through its Lab Water Division, but it does not establish that the trade name "Lab Water Division" identifies and distinguishes the goods offered by opposer in the minds of relevant purchasers and users. Opposer has provided no evidence that its publicity and/or sales efforts have resulted in the purchasing public regarding "Lab Water" or "Lab water Division" as opposer's trade name and not a merely descriptive term.

We find that opposer's trade name "Lab Water Division" did not acquire distinctiveness prior to February 16, 2000. Therefore, opposer has not established priority in this case.

### Likelihood of Confusion

We have found that opposer has not established use of "LAB WATER" as a trademark, a service mark, or use analogous to trademark use; that while opposer has established use of "Lab Water Division" as a trade name, it is merely descriptive; and that opposer has not established acquired distinctiveness of its trade name prior to applicant's filing date (February 16, 2000). Inasmuch as opposer has not established priority of use, it cannot prevail herein. Nonetheless, in the interest of rendering a complete decision, we will determine the issue of likelihood of confusion. The marks are essentially identical (the appearance of ".com" in applicant's mark is of no trademark significance,<sup>6</sup> and the lack of a space between the words "lab" and "water" in applicant's mark likewise creates no significant difference in the marks), and the parties' goods include identical (laboratory water purification units and

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<sup>6</sup> We are aware of applicant's argument that "the addition of the '.com' to a contemplated mark for a product is arbitrary and does constitute a significant difference" (brief, p. 5). However, based on the evidence of applicant's use of the ".com" designation in this record, we cannot agree that that portion of applicant's mark carries any trademark significance. Rather, the ".com" portion of applicant's mark is merely part of a domain address, and as a top level domain (TLD), it lacks trademark significance. See *555-1212.com, Inc. v. Communication House International, Inc.*, 157 F.Supp. 2d 1084, 59 USPQ2d 1453 (N.D.CA. 2001); *In re Martin Container Inc.*, 65 USPQ2d 1058 (TTAB 2002); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002); and *In re Page*, 51 USPQ2d 1660 (TTAB 1999). See also, TMEP §§1209.03(m) and 1215.04 (3d ed. 2002)(Revised May 2003); and 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:17.1 (4th ed. 2001).

**Opposition No. 122225**

filters) and closely related goods. We therefore find that there is a likelihood of confusion in this case where the virtually identical mark is used by both opposer and applicant on the same goods. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

**Trademark Rule 2.131 Remand of Applicant's Application**

As applicant acknowledges in its brief (p. 3):

[Applicant and opposer] are competitors in the business of supplying products, systems, and consumables to users of high purity water in the laboratory. Applicant readily acknowledges that Millipore (and everyone else in the business) has used the words "laboratory water" and its shorthand "lab water" to describe what they do. These companies do not supply products to produce "drinking water," but rather products to produce very high purity "lab water" - that is, water for use in the laboratory where a much higher level of purity is required.

During the testimony of applicant's witness, Mitchell Wilson, exhibits showing applicant's uses were submitted.

These include such uses as the following:

Laboratory Water Purification filters  
and membranes for all popular laboratory  
water purification systems  
...  
GOT LAB WATER? <http://www.labwater.com>

**Opposition No. 122225**

(Applicant's Exhibit I, sales literature); and

One stop shopping for all your laboratory water needs.

...

At LabWater.Com we supply high quality laboratory water purification products to top universities, hospitals, pharmaceutical companies and other high tech industries across the globe.

APS **ULTRA** Brand products can save you up to 50% on replacement filters and membranes for your Millipore, Barnstead or other laboratory water system. We also offer a complete range of laboratory grade water systems.

(Emphasis in original.)

Click here for APS ULTRA brand replacement filter catalog for Millipore, Barnstead and Continental Modulab water systems in PDF format.

(Applicant's Exhibit D, pages from applicant's website)

In view of applicant's acknowledgment that "LAB WATER" is a merely descriptive term for its goods, and inasmuch as we have found that "LAB WATER" is merely descriptive for laboratory water purification units and filters, we hereby remand applicant's application Serial No. 75/935,347 seeking to register the mark "LABWATER.COM" for "laboratory water purification units and filters" to the Examining Attorney pursuant to Trademark Rule 2.131 for consideration of a refusal to register the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). See *Midland International Corp. v. Midland Cooperatives, Inc.*, 434 F.2d 1399, 168 USPQ 107 (CCPA 1970); and *First International*

**Opposition No. 122225**

Services Corp. v. Chuckles Inc., 5 USPQ2d 1628, n. 6 (TTAB 1988). See also, TBMP §805 (2d ed. June 2003).

In addition to applicant's acknowledgement that the term "LAB WATER" is merely descriptive of its goods, as we have previously stated, the term ".COM" in applicant's mark is a reference to the TLD portion of its domain name and has no source-indicating significance. (See footnote 6, *infra*.) As TMEP §1215.04 (3d ed. 2002) states, "[i]f a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §2(e)(1), on the ground that the mark is merely descriptive."

**Decision:** The opposition is dismissed. However, the application will be remanded to the Examining Attorney under Trademark Rule 2.131 at the appropriate time (*i.e.*, following the expiration of the time for appeal, or if an appeal is filed, following the final decision thereon, if it remains appropriate to remand).