

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

BAC

Mailed: November 18, 2002

Opposition No. 124,462

Ecolab Inc.

v.

Cyclo3pss Corporation

Before Hanak, Chapman and Rogers, Administrative Trademark
Judges.

By the Board.

Cyclo3pss Corporation (a Delaware corporation located
in Utah) has filed an application to register on the
Principal Register the mark ECO-WASH for "commercial laundry
machines" in International Class 7, based on applicant's
claimed date of first use and first use in commerce of
February 3, 1998.¹

Ecolab Inc. (a Delaware corporation located in
Minnesota) has opposed registration of applicant's mark,
alleging that opposer is the leading global developer and
marketer of premium cleaning, sanitizing, maintenance and

¹ Application Serial No. 75/898,601 was filed on January 20,
2000.

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repair products and services for a variety of markets, including hospitality, institutional and industrial markets; that a significant portion of opposer's business is directed to providing laundry-related goods and services to, inter alia, hotels, restaurants, healthcare facilities, hospitals, food and beverage processors and commercial laundries; that in addition to laundry-related goods and services, opposer provides, inter alia, a complete line of cleaning and sanitizing products, foodservice products and safety training, and pest elimination services; that opposer adopted the corporate and trade name ECOLAB INC. in 1986 and it has offered virtually all of its various goods and services under the name and mark ECOLAB since 1986; that opposer, through its related companies and predecessors-in-interest, has continuously provided a wide variety of goods and services under its family of "ECO-based" marks, commencing with use of ECO-VAC used on detergent dispensers in November 1964; that virtually all of opposer's goods and services carry its famous house mark ECOLAB; that opposer is the owner of numerous federal registrations for marks containing the ECO formative or prefix (31 were listed in the original notice of opposition); that opposer also owns common law rights in the mark ECO-CLEAN, used since January 1995 on a line of cleaning products for use in the institutional and hospitality industries, and the marks ECO-

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STAR, ECOJET and ECO-PORT, all used in connection with opposer's laundry business; that opposer's family of "ECO" marks is distinctive, well-known and famous; that the term "WASH" contained within applicant's mark is descriptive or generic for commercial laundry machines; that applicant's mark, when used on its goods, so resembles opposer's marks as to be likely to cause confusion, mistake, or deception; and that applicant's mark ECO-WASH is likely to cause dilution of the distinctive quality of opposer's famous ECOLAB house mark and the other marks in opposer's family of "ECO" marks.

In its answer, applicant denies the salient allegations of the notice of opposition, and raises the affirmative defenses of laches and estoppel.

In the trial order mailed by the Board on November 9, 2001, discovery was set to close on May 28, 2002 and opposer's testimony period was set to close on August 26, 2002.

This case now comes up on the following motions:

- (1) applicant's motion for summary judgment (filed April 17, 2002—via certificate of mailing);
- (2) applicant's motion to quash opposer's April 17, 2002 notices of discovery depositions for May 7 and 8, 2002 (filed April 27, 2002—via certificate of mailing);
- (3) opposer's motion for leave to amend its notice of opposition (filed May

22, 2002-via certificate of mailing); and

- (4) opposer's motion for summary judgment (filed May 22, 2002-via certificate of mailing).

About one month prior to the scheduled close of discovery in this case, applicant moved for summary judgment² contending that the prefix "ECO" in opposer's asserted marks has a common meaning in the English language and is not distinctive; that there are numerous third-party registrations including "ECO" owned by parties other than opposer; that opposer's alleged family of marks cannot exist as a matter of law; and that there is no likelihood of confusion between applicant's mark and opposer's alleged family of marks.

In response, opposer filed (i) a brief in opposition to applicant's motion for summary judgment specifically noting in footnote 3 (p. 24) that the Board can grant summary

² In its motion for summary judgment applicant requested that the Board take judicial notice of the materials applicant submitted as Exhibits A-S (dictionary definitions and printouts from the USPTO's Trademark Electronic Search System--TESS). Applicant's requests for judicial notice were superfluous and unnecessary because applicant had actually submitted the materials as exhibits in support of its motion for summary judgment. See TBMP §528.05. Because the materials were physically present in the record, there is no need to take judicial notice thereof. [Of course, evidence submitted in support of and/or in opposition to a summary judgment motion is of record only for purposes of the summary judgment motion. See TBMP §528.05(a).]

For applicant's information, the Board generally will take judicial notice of dictionary definitions (see TBMP §712), but we will not take judicial notice of registrations or other records of the USPTO. See *Wright Line Inc. v. Data Safe Services Corporation*, 229 USPQ 769, footnote 5 (TTAB 1985).

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judgment on likelihood of confusion and dilution to opposer without a cross-motion from opposer; (ii) the above-mentioned motion to amend the notice of opposition by more specifically setting forth additional common law "ECO" marks, clarifying the registered marks asserted, and adding the ground that applicant's application is void ab initio because applicant has not used the mark ECO-WASH on the identified goods -- "commercial laundry machines"; and (iii) the above-mentioned motion for summary judgment on the ground that applicant's application is void ab initio for failure to use the mark on the identified goods.

The Board has not received any further papers in this case from either party. Thus, only applicant's motion for summary judgment is contested; and applicant's motion to quash³, opposer's motion to amend the notice of opposition, and opposer's motion for summary judgment on the added ground are each uncontested.

In arguing against applicant's motion for summary judgment opposer contends that there are genuine issues of material fact as to the existence of opposer's family of "ECO" formative marks, the similarities/dissimilarities

³ Applicant's motion to quash two discovery depositions is granted as conceded by opposer. See Trademark Rule 2.127(a). Moreover, the Board presumes that applicant's motion for summary judgment and opposer's notice of the discovery depositions crossed in the mail; and that the noticed discovery depositions of applicant did not take place.

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between each of opposer's various "ECO" marks and applicant's mark ECO-WASH, the extent of overlap or relatedness of the goods and services, the level of sophistication of the respective purchasers and users, the fame of opposer's various "ECO" marks, the number and nature of third-party uses of similar marks for similar goods or services, and applicant's intent in adopting the mark ECO-WASH, all of which preclude entry of summary judgment on the issue of likelihood of confusion. Opposer further contends that applicant has not proven as a matter of law either (i) that opposer's "ECO" marks are not famous and/or (ii) that registration of applicant's mark would not cause dilution of opposer's marks.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970

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F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, supra.

Based on the record before us, we find that there are genuine issues of material fact, (including, but not limited to, those listed above as part of opposer's argument) and that applicant is not entitled to judgment as a matter of law on the issues of likelihood of confusion and/or dilution. Accordingly, applicant's motion for summary judgment is denied. Further, we decline to enter summary judgment in the non-moving party's (opposer's) favor on either of the issues of likelihood of confusion or dilution.

We turn next to opposer's motion for leave to amend the notice of opposition. The motion is granted as conceded pursuant to Trademark Rule 2.127(a). See also, Fed. R. Civ. P. 15(a); and TBMP §507.02. Opposer's amended notice of opposition (filed May 22, 2002—via certificate of mailing) is accepted, and the amended pleading includes a claim that applicant's application is void ab initio.

Finally, we turn to opposer's motion for summary judgment. Opposer contends that applicant's application is

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void ab initio because applicant has not used the mark ECO-WASH on its identified goods ("commercial laundry machines") prior to the filing date of the application; that applicant uses the mark ECO-WASH in connection with an ozone generation and injection system which is placed next to, and is for use with, a commercial laundry machine; that applicant does not manufacture, market or sell "commercial laundry machines"; that the documents and information supplied to opposer by applicant in response to opposer's discovery requests demonstrate that applicant's only use of the mark ECO-WASH in commerce, if at all, is on an ozone generation and injection system, a separate item from the commercial laundry machine with which it is used; and that because applicant has not used the mark on the identified goods, the application is void ab initio.

As noted above, applicant filed no response to opposer's motion for summary judgment. Thus, pursuant to Trademark Rule 2.127(a), applicant has conceded this motion. Regarding applications held void ab initio based on the applicant's failure to use the mark on the identified goods, see, e.g., *E. I. du Pont de Nemours and Co. v. Sunlyra International Inc.*, 35 USPQ2d 1787, 1791 (TTAB 1995); and *CPC International Inc. v. Skippy Inc.*, 3 USPQ2d 1456, 1460 (TTAB 1987).

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Accordingly, opposer's motion for summary judgment is granted; summary judgment is entered against applicant on the ground that applicant's application is void ab initio; the opposition is sustained only on the ground that applicant's application is void ab initio; and registration to applicant is refused.