



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



RLH Industries, Inc. )  
Opposer, )  
v. )  
Trans Continental Equipment Ltd. )  
Applicant. )

01-10-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #40

Opposition No. 91151964

Box TTAB  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202

**OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

RLH Industries, Inc., through its undersigned counsel, hereby moves the Board, pursuant to Rule 56 of the Federal Rules of Civil Procedure, for entry of summary judgment in favor of Opposer in the above captioned opposition proceeding.

The motion is brought and premised on the following grounds:

1. Opposer's CHIM-FLEX mark has been in use by Opposer and its predecessor in interest for many years throughout the United States on the goods recited therein, and its registration thereon No. 1,730,636 issued on November 10, 1992 has become incontestable by the filing of a Section 15 Declaration by Opposer's predecessor in interest.

2. Applicant seeks to register a mark that is substantially similar to Opposer's registered mark and is using that mark on goods substantially identical to those sold by Opposer under its mark.

3. There is no genuine issue as to any material fact dispute concerning:
  - a. The similarity of the parties respective marks.
  - b. The identical nature of the parties products sold under the parties respective marks.
  - c. The likelihood of confusion mistake and/or deception that will be caused by Applicant's intended use and attempted registration of the mark herein opposed.

4. Registration of the Applicant's mark is precluded under 15 U.S.C.

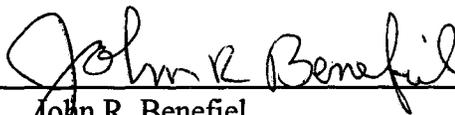
§1052(d) and Opposer is entitled on the basis of the undisputed facts and reasonable inferences drawn therefrom, to summary judgment in this proceeding.

Opposer's motion is supported by the legal memorandum submitted herewith, including the Declaration of Robert M. Huta and attached exhibits filed in connection with that memorandum.

RLH Industries, Inc.

Date: January 10, 2003

By: \_\_\_\_\_



John R. Benefiel  
280 Daines Street, Suite 100 B  
Birmingham, Michigan 48009  
(248) 644-1455  
Attorney for Opposer

**CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)**

It is hereby certified that this correspondence, along with any items referred to as being attached or enclosed, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on January 10, 2003.

By: \_\_\_\_\_

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**MEMORANDUM IN SUPPORT OF OPPOSER'S**  
**MOTION FOR SUMMARY JUDGMENT**

**INTRODUCTION**

RLH Industries, Inc., Opposer in the above styled proceeding, has moved the Trademark Trial and Appeal Board for entry of summary judgment against Applicant Trans Continental Equipment, Ltd.

This motion is timely inasmuch as this proceeding has not yet entered Opposer's testimony phase.

The present proceeding involves Applicant's attempt to register the mark CHIMNEYFLEXible LINERS in special form and in combination with drawing design on the principal register. Applicant has disclaimed the phrase CHIMNEYFLEXible LINERS apart from the mark as shown.

The mark was published for opposition on March 19, 2002 and was timely opposed on or about March 28, 2002 by Opposer.

Applicant subsequently served its Answer on September 6, 2002.

On June 27, 2002, the Board set the discovery and trial schedule in this case.

Both parties have pursued discovery.

Opposer's motion relies on its prior Registration No. 1,730,636, two certified copies submitted in proper form herewith as Exhibit 1 attached to the Declaration of Robert M. Huta and the statements and other Exhibits of the Declaration of Robert M. Huta.

Opposer has opposed registration of Applicant's mark on the basis that there is a likelihood of confusion with Opposer's prior Registration trademark No. 1,730,636 under Section 2(d).

To support its motion, Opposer need only point out the absence of evidence supporting the right of Applicant to register its mark. Opposer here submits evidence that there is no factual issue present, the resolution of which is necessary to the Board making a determination of the ultimate legal conclusion of the existence of a likelihood of confusion between the mark sought to be registered and Applicant's prior registered mark.

#### UNDISPUTED FACTS

Applicant seeks registration of the mark CHIMNEYFLEXible LINERS combined with a drawing design feature. The application was filed on June 4, 1999, claiming priority of a Canadian trademark application no. 1013353, filed on April 27, 1999.

Applicant had previously registered the trademark CHIMNEYFLEX in Canada

for the same goods, and had used the same in the U.S. and Canada, Exhibit 4, Huta Declaration.

Opposer sent a letter to Applicant on or about October 1, 1998 objecting to Applicant's use of the CHIMNEYFLEX mark.

In reaction to that letter, Applicant decided to use the mark CHIMNEYFLEXible LINERS in the U.S. (Exhibit 4 of Huta Declaration).

The present application was subsequently filed on an intent-to-use basis. In an Office Action dated September 29, 1999, the Examiner initially refused registration under Section 2(d) because of the existence of Opposer's Registration No. 1,730,636, stating that by putting the "ible" portion in lower case letters, the CHIMNEYFLEX portion became dominant.

Applicant subsequently changed the intent-to-use basis of registration to also rely on the prior Canadian trademark registration application.

The Examiner suspended the application pending receipt of a certified copy of the Canadian application and continued the refusal under Section 2(d). Subsequently, after entry of a disclaimer of the entire text portion of the mark, the Examiner approved the application for publication.

Opposer's Registration 1,730,636 was issued on November 10, 1992 on the mark CHIM-FLEX, and has been in use on flexible metal chimney liners in the United States by Opposer since at least 1988.

Applicant uses the CHIMNEYFLEXible LINERS mark on this same type of product, and sells its goods in direct competition with Opposer (Huta Declaration).

Opposer learned of Applicant's continued use of the CHIMNEYFLEX mark and also that Applicant began use of the CHIMNEYFLEXible LINERS mark and objected to the use

of either mark in the U.S. (Huta Declaration). Opposer also learned of the present trademark registration application and caused the present opposition to be instituted.

## ARGUMENT

### I. COMPARISON OF THE MARKS

It is clear that applicant sought to achieve the same commercial impression by the CHIMNEYFLEXible LINERS and CHIMNEYFLEX marks by its use of the lower case “ible” suffix, Exhibit 5 of the Huta Declaration contains an admission as to that issue. Furthermore, Applicant by its own admission, has used the marks interchangeably in the U.S.

A comparison of the marks CHIMNEYFLEX or CHIMNEYFLEXible LINERS and CHIM-FLEX on the same goods leads to a conclusion of a likelihood of confusion since the mark CHIMNEY FLEX incorporates verbatim all the same words of the CHIM-FLEX mark. This is similar to the situation in Trek Bicycle Corp. v Fier, 56 USPQ2d 1527 (TTAB 2000).

Also, the degree of similarity required declines where, as here, the goods are virtually identical, Trek Bicycle, supra.

### II. THE EFFECT OF THE DISCLAIMER

Applicant has submitted a disclaimer of all of the words CHIMNEYFLEXible LINERS. However, this does not remove the disclaimed matter from consideration in making a determination of likelihood of confusion, In re Shell Oil Co., 26 USPQ2d 1687 (TTAB 1993).

Also, it is noted that Opposer’s registration has become uncontestable and that no disclaimer was entered in its registration such that these words themselves cannot be argued to be

merely descriptive or weak identifiers.

III. THE GOODS ARE IDENTICAL

As noted above, both parties use their respective marks on flexible metal chimney liners, and thus the recitation in the present application presumably includes within its scope the exact same goods, sold in the same trade channels in direct competition with each other. This reduces the degree of similarity required to find a likelihood of confusion, as noted above.

IV. INSTANCES OF ACTUAL CONFUSION SUPPORT A LIKELIHOOD OF CONFUSION FINDING

The Declaration of Robert M. Huta also establishes that there have been instances of actual confusion in the marketplace. This fact is a powerful indicator of the likelihood of confusion.

V. APPLICANT ADOPTED ITS MARK WITH FULL KNOWLEDGE OF OPPOSER'S MARK

Applicant has admitted (Exhibit 5, Huta Declaration) that it adopted the mark with full knowledge of Opposer's mark and registration.

CONCLUSION

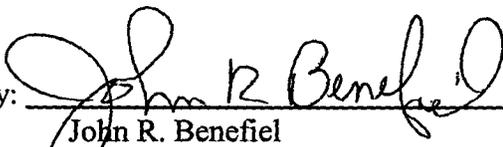
The record establishes that there is an absence of any genuine issue as to a material fact, and summary judgment is therefore proper. The factors cited all support a finding of a likelihood of confusion and entry of judgement against the Applicant is proper, which action

is respectfully requested. Any doubt should be resolved in favor of the prior registrant, particularly where as here, the mark was admittedly adopted with full knowledge of Opposer's trademark and registration.

RLH Industries, Inc.

Date: January 10, 2003

By: \_\_\_\_\_

  
John R. Benefiel  
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Birmingham, Michigan 48009  
(248) 644-1455  
Attorney for Opposer

**CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)**

It is hereby certified that this correspondence, along with any items referred to as being attached or enclosed, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on January 10, 2002.

By: \_\_\_\_\_

TTAB

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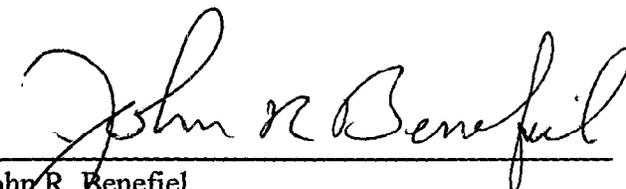
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TRADEMARK TRIAL AND APPEAL BOARD

**CERTIFICATE OF SERVICE**

It is hereby certified that Opposer's Motion for Summary Judgment; Memorandum in Support of Opposer's Motion for Summary Judgment; and Declaration Robert Huta were mailed first class mail postage prepaid, on this 10<sup>th</sup> day of January, 2003 to the attorney for Applicant as follows:

Mark B. Harrison  
Venable  
P.O. Box 34385  
Washington, D.C. 20043-9998

  
\_\_\_\_\_  
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(248) 644-1455  
Attorney for Opposer

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

In Re Application of : RLH Industries, Inc. V. Trans Continental Equipment Ltd.

Opposition No. : 91151964

**CERTIFICATE OF EXPRESS MAILING**

Assistant Commissioner for Patents  
Washington, D. C. 20231

Sir:

I hereby certify that the accompanying Opposer's Motion for Summary Judgment, Memorandum in Support of Opposer's Motion for Summary Judgment, and Declaration of Robert Huta, along with any items referred to as being attached or enclosed, is being deposited with the United States Postal Service, Express Mail Customer Receipt No. EL720609191US on January 10, 2003.

Date: January 10, 2003

By:   
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Reg. No. 24,889

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