



12-23-2002

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

TTAB

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

In re Application Serial No.: 78/066,081

For the Mark: A VOICE ABOVE THE CROWD

Applicant: Commins, Karen S.

Filed on: May 28, 2001

RE/MAX INTERNATIONAL, INC.,

Opposer,

v.

KAREN S. COMMINS,

Applicant.

Opposition No.: _____

"EXPRESS MAIL" MAILING LABEL NUMBER: EL922586247US

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" Service under 37 CFR § 1.10 on the date indicated above and is addressed to:
 BOX TTAB - FEE, ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 Crystal Drive, Arlington, VA 22202-3513 on December 23, 2002.

LEBOEUF, LAMB, GREENE & MACRAE, LLP

By: *Sandra Lee Bourassa, PLS*
 Sandra Lee Bourassa, PLS

BOX TTAB - FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

RE/MAX International, Inc., a Colorado corporation, located and doing business at 8390 East Crescent Parkway, Suite 600, Greenwood Village, Colorado 80111 (hereinafter "Opposer") believes that it will be damaged by the registration of A VOICE ABOVE THE CROWD, a mark sought to be registered through U. S. Trademark Application Serial No. 78/066,081 filed on May 28, 2001, by Karen S. Commins, (hereinafter "Applicant"), and Opposer hereby opposes same.

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The grounds for opposition are as follows:

1. Throughout the United States and in foreign countries, real estate brokerage services are provided through a network of franchisees and affiliated independent contractor/sales associates who are authorized to use the RE/MAX trademarks in connection with providing real estate brokerage services (the "RE/MAX Network").

2. Since at least as early as 1978, those affiliated with the RE/MAX Network have provided real estate brokerage services in interstate commerce under Opposer's distinctive registered trademarks, including, "ABOVE THE CROWD!". Opposer is the owner of U.S. Trademark Registration No. 2,202,802 for its service mark "ABOVE THE CROWD!" (attached hereto as Exhibit A). Opposer is the owner of Federal Trademark Registration Number 1,158,371 for its service mark "ABOVE THE CROWD."

3. Opposer, since at least as early as 1978, has provided "franchise sales and support services, namely, offering technical assistance in the establishment and/or operation of real estate brokerage services" in interstate commerce in connection with its distinctive registered trademark, "ABOVE THE CROWD." Opposer is the owner of Federal Trademark Registration Number 2,210,739 for its service mark "ABOVE THE CROWD."

4. All of the foregoing registrations and common law rights are collectively referred to as the "ABOVE THE CROWD marks."

5. The ABOVE THE CROWD marks are used on a variety of advertising media including business cards, newspapers and other print media, signs, billboards, banners, brochures, coffee mugs and other advertising and promotional items.

6. As a result of substantial sales and extensive advertising and promotion, the ABOVE THE CROWD marks have become widely and favorably known as identifying (i) real estate brokerage services originating from, sponsored by or associated with Opposer and/or the RE/MAX Network; and/or (ii) franchise sales and support originating from, sponsored by or associated with Opposer. Indeed, the ABOVE THE CROWD marks are famous. The public has

to associate the ABOVE THE CROWD marks with Opposer and/or the RE/MAX Network as a source of high quality real estate brokerage services and/or franchise sales and support services.

7. Applicant filed U.S. Trademark Application Serial No. 78/066,081 on May 28, 2001, seeking to register A VOICE ABOVE THE CROWD as a trademark in connection with "audio recording and production for others to be used for radio and television commercials, movie trailers, voice mail message centers, computer games, corporate multimedia presentations, narrations, audio books, in-store announcements, animated characters and web pages," in International Class 41. Applicant's first use of the A VOICE ABOVE THE CROWD mark occurred on September 1, 1999 and Applicant's first use of the A VOICE ABOVE THE CROWD mark in commerce occurred on September 1, 1999.

8. Applicant's mark, A VOICE ABOVE THE CROWD, when used in connection with the services identified in Application Serial No. 78/066,081 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between Applicant and Opposer and/or the RE/MAX Network, as to the origin, sponsorship, or approval of Applicant's goods, services or other commercial activities.

9. Opposer's ABOVE THE CROWD marks are of sufficient fame and reputation among consumers that, when Applicant's A VOICE ABOVE THE CROWD mark is used in connection with the services set forth in Applicant's Application, a false connection with Opposer and/or the RE/MAX Network will be presumed by consumers.

10. Applicant's A VOICE ABOVE THE CROWD mark, when used in connection with the services identified in Application Serial No. 78/066,081, is likely to dilute the distinctive quality of Opposer's famous ABOVE THE CROWD marks.

11. Applicant's use of A VOICE ABOVE THE CROWD for the services set forth in Application Serial No. 78/066,081 is not authorized by Opposer.

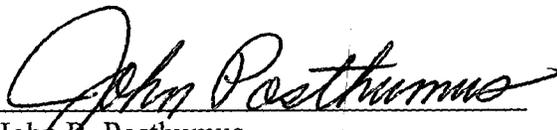
12. The registration of Applicant's A VOICE ABOVE THE CROWD mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, the common law and the Trademark Act, and would be damaging to Opposer.

WHEREFORE, Opposer RE/MAX INTERNATIONAL, INC. prays that this opposition be sustained, that U.S. Trademark Application Serial No. 78/066,081 for A VOICE ABOVE THE CROWD be rejected, and that registration by Applicant be refused and denied.

A duplicate copy of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) are enclosed herewith.

Respectfully submitted this 23 day of December, 2002.

LEBOEUF, LAMB, GREENE & MACRAE, LLP

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ATTORNEYS FOR OPPOSER

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

Maintenance Requirements

Section 8: This registration will be cancelled after six (6) years by the Commissioner of Patents and Trademarks, *UNLESS, before the end of the sixth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an affidavit of continued use as required by Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately five years after the date shown on this registration to determine the requirements and fees for filing a Section 8 affidavit that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the affidavit.

Section 9: This registration will expire by law after ten (10) years, *UNLESS, before the end of the tenth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an application for renewal of the registration as required by Section 9 of the Trademark Act of 1946, 15 U.S.C. §1059, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately nine years after the date shown on this registration to determine the requirements and fees for filing a Section 9 application for renewal that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the application for renewal.

Int. Cls.: 35 and 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,202,802

United States Patent and Trademark Office

Registered Nov. 10, 1998

**SERVICE MARK
PRINCIPAL REGISTER**

*Above
the
Crowd!*

RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
8390 EAST CRESCENT PARKWAY, SUITE 600
GREENWOOD VILLAGE, CO 80111

FOR: FRANCHISE SALES AND SUPPORT
SERVICES, NAMELY, OFFERING TECHNICAL
ASSISTANCE IN THE ESTABLISHMENT AND/
OR OPERATION OF REAL ESTATE BROKER-
AGE SERVICES, IN CLASS 35 (U.S. CLS. 100,
101 AND 102).

FIRST USE 10-7-1978; IN COMMERCE
10-7-1978.

FOR: REAL ESTATE BROKERAGE SERV-
ICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-7-1978; IN COMMERCE
10-7-1978.

OWNER OF U.S. REG. NOS. 1,158,371 AND
1,596,780.

SER. NO. 75-351,190, FILED 9-3-1997.

KIM BRACEY, EXAMINING ATTORNEY