

TTAB

03-07-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64

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

In re Application Serial No.: 76/189,923

For the Mark: REXCO

Applicant: Larry R. Hauptert

Filed on: January 3, 2001

RECEIVED 20 MAR 9 2001

RE/MAX INTERNATIONAL, INC.,
Opposer,
v.
LARRY R. HAUPERT
Applicant.

Opposition No.: _____

"EXPRESS MAIL" MAILING LABEL NUMBER: EL922586370US
I hereby certify that this paper and 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 March 7, 2003.
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 REXCO, a mark sought to be registered through U. S. Trademark Application Serial No. 76/189,923, filed on January 3, 2001, by Larry R. Hauptert, an individual residing in the state of California (hereinafter "Applicant"), and Opposer hereby opposes same.

The grounds for opposition are as follows:

1. Opposer is a major, well-established company that provides real estate brokerage services throughout the United States through a network of franchisees, sub-franchisors and affiliated sales agents who are authorized to use Opposer's registered trademarks in connection with real estate brokerage services.

2. Opposer, since at least as early as 1974, has provided real estate brokerage services in interstate commerce through brokerage offices owned and operated by it and, since at least as early as 1977, through its sub-franchisors, franchisees, and affiliated sales agents, all in connection with its distinctive registered trademarks, "REMAX" and "RE/MAX". Opposer is the owner of U.S. Trademark Registration Nos. 1,139,014; 1,339,510; and 2,403,626 for its service mark "RE/MAX," and the owner of U.S. Trademark Registration Nos. 2,106,387 and 2,054,698 for its service mark "REMAX."

3. The common law and federal registration rights of RE/MAX are collectively referred to as the "RE/MAX marks."

4. The RE/MAX marks are used on a variety of advertising media including yard signs, business cards, newspapers and other print media, directional signs, open house signs, hot and cold air balloons, television commercials, billboards, bus stop benches, transit buses, moving vans, banners, brochures, coffee mugs and other advertising and promotional items.

5. Since at least as early as 1974, Opposer and Opposer's Affiliates have invested over two billion dollars to develop, promote and maintain the RE/MAX marks in the United States and worldwide. More specifically, Opposer's Affiliates have used the RE/MAX marks in connection with over nine million home sale transactions in the United States and worldwide, resulting in over one trillion dollars in sales volume from as early as 1974 to present date.

6. As a result of substantial sales and extensive advertising and promotion, the RE/MAX marks have become widely and favorably known as identifying real estate brokerage services originating from, sponsored by or associated with Opposer. Indeed, the RE/MAX marks are famous. The public has to associate the RE/MAX marks as a source of high quality real estate brokerage services.

7. Applicant filed U.S. Trademark Application Serial No. 76/189,923 on January 3, 2001, seeking to register REXCO as a trademark in connection with "real estate acquisition, investment, brokerage, leasing and management" in International Class 36 and "real estate development" in International Class 37.

8. Applicant's mark, REXCO, when used in connection with the goods identified in Application Serial No. 76/189,923 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship, or approval of Applicant's goods, services or other commercial activities.

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

10. Applicant's REXCO mark, when used in connection with the goods identified in Application Serial No. 76/189,923, is likely to dilute the distinctive quality of Opposer's famous RE/MAX marks.

11. Applicant's use of REXCO for the services set forth in Application Serial No. 76/189,923 is not authorized by Opposer.

12. The registration of Applicant's REXCO 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. 76/189,923 for REXCO be rejected, and that registration by Applicant be refused and denied.

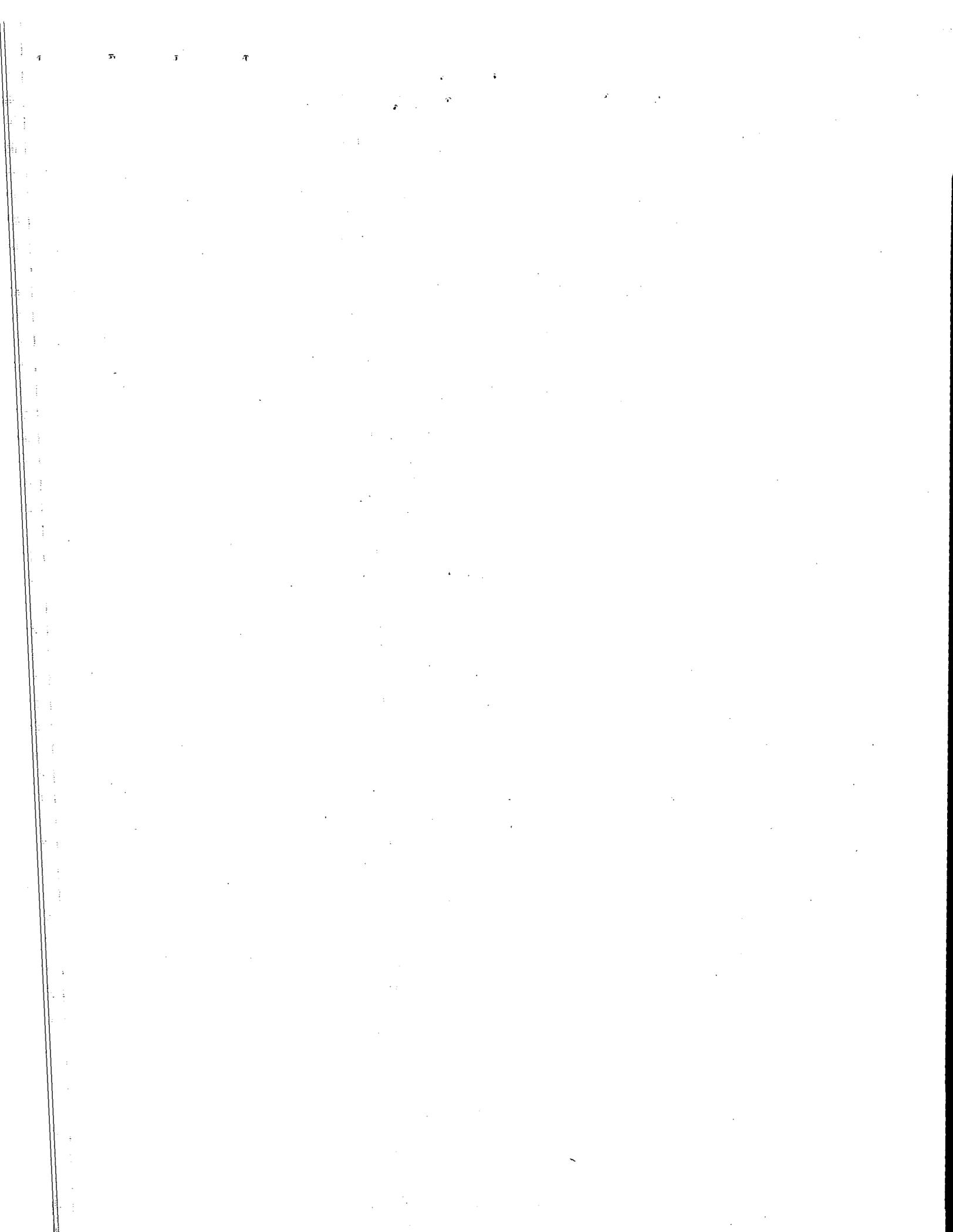
A duplicate copy of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) are enclosed herewith.

Respectfully submitted this 7th day of March, 2003.

LEBOEUF, LAMB, GREENE & MACRAE, LLP

By: 
George G. Matava
John R. Posthumus
Nancy L. Dempsey
633 17th Street, Suite 2000
Denver, Colorado 80202
(303) 291-2600

ATTORNEYS FOR OPPOSER





Nº 1139014

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

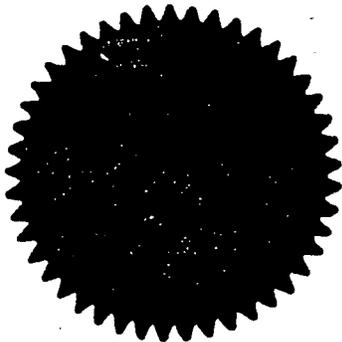
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-sixth day of August, 1980.

Silvery H. Diamond

COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is still in use or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$10.00 for each class must accompany the affidavit.

Int. Cls.: 35 and 36

Prior U.S. Cl.: 101

Reg. No. 1,139,014

Registered Aug. 26, 1980

United States Patent and Trademark Office

SERVICE MARK

Principal Register

RE/MAX

Re/Max of America, Inc. (Colorado corporation)
5555 S. Trenton Way
Englewood, Colo. 80110

For: RENDERING TECHNICAL AID AND ASSIST-
ANCE TO OTHERS IN THE ESTABLISHMENT AND
OPERATION OF A REAL ESTATE BROKERAGE
AGENCY, in CLASS 35 (U.S. CL. 101).

First use Jan. 30, 1973; in commerce Jun. 1, 1973.

For: REAL ESTATE BROKERAGE SERVICES, in
CLASS 36 (U.S. CL. 101).

First use Jan. 30, 1973; in commerce Jun. 1, 1973.

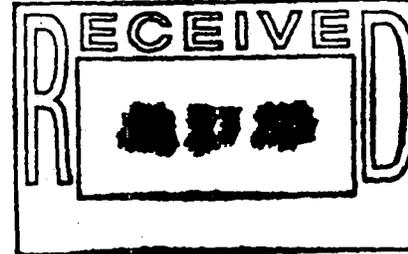
Ser. No. 113,283. Filed Jan. 21, 1977.

MARC BERGSMAN, Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE
 Patent and Trademark Office
 OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
 2900 Crystal Drive
 Arlington, Virginia 22202-3513

REGISTRATION NO: 1139014 SERIAL NO: 73113283 MAILING DATE: 07/09/2001
 REGISTRATION DATE: 08/26/1980
 MARK: RE/MAX
 REGISTRATION OWNER: RE/MAX INTERNATIONAL, INC.
 CORRESPONDENCE ADDRESS:



GARY L. WEIL, ESQ.
 RE/MAX INTERNATIONAL, INC.
 8390 EAST CRESCENT PARKWAY
 SUITE 600
 GREENWOOD VILLAGE, CO 80111-2800

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
 035 036.

HENSON, EVERETT J
 PARALEGAL SPECIALIST
 POST-REGISTRATION DIVISION
 (703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION



Nº 1339510

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this fourth day of June, 1985.

A handwritten signature in cursive script, appearing to read "Ronald J. Higgins".

Acting Commissioner of Patents and Trademarks

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,339,510

Registered June 4, 1985

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

RE/MAX OF AMERICA, INC. (COLORADO
CORPORATION)
5251 S. QUEBEC
ENGLEWOOD, CO 80111

FOR: INSURANCE BROKERAGE SERVICES,
IN CLASS 36 (U.S. CL. 102).

FIRST USE 4-1-1980; IN COMMERCE
4-1-1980.

OWNER OF U.S. REG. NO. 1,139,014.

SER. NO. 510,503, FILED 11-26-1984.

SHARON R. MARSH, EXAMINING ATTORNEY

Int. Cl.: 36

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

United States Patent and Trademark Office

Reg. No. 2,403,626

Registered Nov. 14, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

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

FOR: PROVIDING A WEBSITE ON GLOBAL COM-
PUTER NETWORKS FEATURING INFORMATION IN
THE FIELD OF REAL ESTATE, IN CLASS 36 (U.S.
CLS. 100, 101 AND 102).

FIRST USE 8-1-1995; IN COMMERCE 8-1-1995.
OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607
AND OTHERS.

SER. NO. 75-712,611, FILED 5-24-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

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 Director of the United States Patent and Trademark Office; 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 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.



A handwritten signature in cursive script, appearing to read "J. T. ...".

Director of the United States Patent and Trademark Office

Int. Cl.: 36

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

Reg. No. 2,106,387

United States Patent and Trademark Office

Registered Oct. 21, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
5445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80155

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

FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.

OWNER OF U.S. REG. NO. 1,339,510.

SER. NO. 75-068,799, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY

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.

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Bence Lehman

Commissioner of Patents and Trademarks

Int. Cl.: 35

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

Reg. No. 2,054,698

United States Patent and Trademark Office

Registered Apr. 22, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

RE/MAX INTERNATIONAL INC. (COLORADO
CORPORATION)
5445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80111

FOR: FRANCHISE SERVICES, NAMELY, OF-
FERING TECHNICAL ASSISTANCE IN THE
ESTABLISHMENT AND/OR OPERATION OF
REAL ESTATE BROKERAGE FIRMS. IN
CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.

OWNER OF U.S. REG. NOS. 1,139,014 AND
1,173,386.

SER. NO. 75-068,927, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION
PRINCIPAL REGISTER

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Bence Lehman

Commissioner of Patents and Trademarks

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER (GENERAL)
(With Certificate of Mailing by Express Mail)

Applicant/Registrant: **LARRY R. HAUPERT**
Serial No.: **76/189,923**
Registration No.: **n/a**
Trademark: **REXCO** ✓

Docket No.
06416-00307

03-07-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #64

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Transmitted herewith is/are the following document(s):

Notice of Opposition (in duplicate); Check for \$600.00 filing fee; Certificate of Mailing by Express Mail (thereon); Postcard

No fee is required.

Please charge Deposit Account No. _____ in the amount of _____
A duplicate copy of this sheet is enclosed.

A check in the amount of **\$600.00** is attached.
Any excess or insufficiency should be credited or debited to Deposit Account No. _____
A duplicate copy of this sheet is enclosed.

John R. Posthumus
by *Gayle L. Strong*
Signature

John R. Posthumus, Esq., Reg. No. 36,245
by Gayle L. Strong, Esq., Reg. No. 36,842
LeBoeuf, Lamb, Greene & MacRae, L.L.P.
633 Seventeenth Street, Suite 2000
Denver, Colorado 80202
303-291-2600

Dated: **March 7, 2003**

I certify that this document and fee is being deposited on **March 7, 2003** with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive,

Sandra Lee Bourassa, PLS
Signature of Person Mailing Correspondence

Sandra Lee Bourassa, PLS

Typed or Printed Name of Person Mailing Correspondence

EL922586370US

"Express Mail" Mailing Label Number

CC: