

ESTTA Tracking number: **ESTTA237335**

Filing date: **09/17/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Apex, LLC
Granted to Date of previous extension	09/17/2008
Address	100 Main St. Pawtucket, RI 02860 UNITED STATES

Correspondence information	Andrew Gates Apex, LLC 100 Main St. Pawtucket, RI 02860 UNITED STATES theapexcompanies@gmail.com
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Applicant Information

Application No	77243433	Publication date	05/20/2008
Opposition Filing Date	09/17/2008	Opposition Period Ends	09/17/2008
Applicant	Apex Pavers, Inc 834 SE Lincoln Ave. Stuart, FL 34994 UNITED STATES		

Goods/Services Affected by Opposition

Class 037. First Use: 2006/06/01 First Use In Commerce: 2006/06/01 All goods and services in the class are opposed, namely: Construction of Swimming Pools; Paving contractor services; Installation of driveways, patios, walkways, pool decks, remodeled pools, walls, and spa additions

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1847961	Application Date	08/27/1993
Registration Date	08/02/1994	Foreign Priority Date	NONE
Word Mark	APEX		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1942/09/00 First Use In Commerce: 1942/09/00 retail department store services

U.S. Registration No.	2155905	Application Date	05/25/1994
Registration Date	05/12/1998	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 automotive repair and maintenance services Class 042. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 retail automobile parts and accessories stores		

U.S. Registration No.	2562812	Application Date	08/23/1999
Registration Date	04/23/2002	Foreign Priority Date	NONE
Word Mark	APEX ONLINE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/11/01 First Use In Commerce: 1996/11/01 Retail store, mail order purchase and computerized on-line retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, housewares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men# s and ladies# accessories, shoes, athletic footwear, novelties, food and Christmas items		

U.S. Registration No.	2657639	Application Date	11/01/1999
Registration Date	12/10/2002	Foreign Priority Date	NONE
Word Mark	APEX MALL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 SHOPPING MALL SERVICES AND LEASING OF SHOPPING MALL SPACE		

U.S. Registration No.	2443933	Application Date	08/23/1999
Registration Date	04/17/2001	Foreign Priority	NONE

		Date	
Word Mark	APEX STORES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/11/01 First Use In Commerce: 1996/11/01 Retail store, mail order purchase and computerized on-line retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, housewares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic footwear, novelties, food and Christmas items		

U.S. Registration No.	2918976	Application Date	10/27/2003
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	APEX ADVANTAGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 1996/12/01 First Use In Commerce: 2002/09/01 CUSTOM FINISHING AND EMBELLISHMENT OF PROMOTIONAL ITEMS, NAMELY, EMBROIDERY, EMBOSsing, ENGRAVING, CUSTOMIZED PRINTING, IMPRINTING, SCREEN PRINTING AND PAD PRINTING WITH COMPANY NAMES, LOGOS, MONOGRAMS, WORDS, AND/OR PICTURES FOR PROMOTIONAL AND ADVERTISING PURPOSES ON THE GOODS OF OTHERS, NAMELY, SPORTSWEAR, APPAREL AND OTHER PRODUCTS		

U.S. Registration No.	3244685	Application Date	07/12/2006
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving, customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words, and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products		

U.S. Registration No.	3356317	Application Date	07/12/2006
Registration Date	12/18/2007	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Computer services, namely, creating indexes of information, sites, and other resources available on computer networks; computer services, namely, providing search engines for obtaining data on a global computer network

Attachments	75781411#TMSN.gif (1 page)(bytes) 75836787#TMSN.gif (1 page)(bytes) 75781412#TMSN.gif (1 page)(bytes) 78928036#TMSN.jpeg (1 page)(bytes) 78928010#TMSN.jpeg (1 page)(bytes) Notice of Opposition 77243433.pdf (6 pages)(2717287 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Andrew Gates/
Name	Andrew Gates
Date	09/17/2008

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

In the matter of Application Serial No. 77,243,433

-----)	
APEX, LLC)	
	Opposer)	
v.)	Opposition No.:
)	
APEX PAVERS INC.)	
)	
	Applicant)	
-----)	

NOTICE OF OPPOSITION

Apex, LLC, a limited liability company organized and existing under the laws of the State of Rhode Island, having a business address of 100 Main Street, Pawtucket, Rhode Island 02860 ("Opposer"), believes that it will be damaged by registration of Application Serial No. 77,243,433 for the mark APEX PAVERS (and design) as it relates to services in Class 37, namely, Construction of Swimming Pools; Paving contractor services; Installation of driveways, patios, walkways, pool decks, remodeled pools, walls, and spa additions. The grounds for opposition are as follows:

Apex and its Marks

1. Since at least as early as 1924, Opposer and its predecessors and their affiliates (collectively, "Apex") have used the mark "APEX" and other marks incorporating the word "APEX" (collectively the "Apex Marks"). Over the past 84 years, Apex has used the Apex Marks on and in connection with various manufacturing, wholesale, retail, retail stores, on-line

retail, automotive services and sales of automotive parts and accessories, real estate development and construction services, real estate management, and advertising and marketing businesses, among others.

2. Opposer is the owner of common law rights in the mark "APEX", as a result of the continuous use of the APEX mark by Apex since at least as early as 1924.

3. Opposer owns the following U.S. registrations for its APEX trademarks and service marks, among others:

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
APEX	1,847,961	8/2/1994	Retail department store services (Class 42)
APEX	2,155,905	5/12/1998	Automotive repair and maintenance (Class 37); retail automobile parts and accessories stores (Class 42)
APEX ONLINE	2,562,812	4/23/2002	Retail store, mail order purchase and computerized online retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, house wares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic foot wear, novelties, food and Christmas items (Class 35)
APEX MALL	2,657,639	12/10/2002	Shopping mall services and leasing of shopping mall space (Class 36)
APEX STORES	2,443,933	4/17/2001	Retail store, mail order purchase and computerized online retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, house

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
			wares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic foot wear, novelties, food and Christmas items (Class 35)
APEX ADVANTAGE	2,918,976	1/18/2005	Custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products (Class 40)
APEX COMPANIES	3,244,685	5/22/2007	Custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products (Class 40)
APEX COMPANIES	3,356,317	12/18/2007	Computer services, namely, creating indexes of information, sites and other resources available on computer networks; computer services, namely, providing search engines for obtaining data on a global computer network (Class 42)

4. Registration No. 1,847,961 for the mark APEX, and Registration No. 2,155,905 for the mark APEX have been renewed pursuant to the provisions of the Lanham Act, and are incontestable.

5. Registration No. 2,562,812 for the mark APEX ONLINE and Registration No. 2,443,933 for the mark APEX STORES are incontestable.

6. Apex has spent a considerable amount of money, time and energy in connection with the advertising, marketing and promotion of products and services bearing the APEX mark. Apex has also extensively used a pyramid symbol (among other symbols) with the APEX Marks. As a result, the APEX mark has become famous, and the pyramid shape associated with the APEX Marks has become famous, and the public has come to identify the APEX mark and the pyramid shape with Apex.

7. A timely Request for Extension of Time to Oppose Applicant's application was filed by Opposer.

Applicant and its Marks

8. Upon information and belief, Apex Pavers, Inc. ("Applicant") is a Florida corporation with an address at 834 SE Lincoln Avenue, Stuart, Florida 34994.

9. Applicant is the record owner of the following U.S. Trademark Application for the mark APEX PAVERS (and design):

<u>Application No.</u>	<u>Filing Date</u>	<u>Goods and Services</u>
77,243,433	7/31/07	Construction of Swimming Pools; Paving contractor services; Installation of driveways, patios, walkways, pool decks, remodeled pools, walls, and spa additions in Class 37

COUNT I: LIKELIHOOD OF CONFUSION

10. Opposer repeats and incorporates herein by reference the averments in the preceding paragraphs.

11. Applicant's APEX PAVERS (and design) mark is very similar in appearance and commercial impression to Opposer's APEX MARKS and Apex's use of its pyramid shape.

12. The goods and services listed in Application No. 77,243,433 are closely related to those of Apex, in particular, to Apex's real estate development and construction services and real estate management businesses.

13. On information and belief, Apex is the prior user of the APEX mark and the pyramid shape. Consequently, Applicant's date of first use for its mark is subsequent to Opposer's actual date of first use of its APEX MARKS and the pyramid shape for the identical or closely related goods and services.

14. In light of the foregoing, Applicant's APEX PAVERS (and design) trademark for the services recited in the opposed application is confusingly similar to Opposer's APEX MARKS and is likely to cause confusion or mistake, and to deceive the public into believing that Applicant's services originate or are some way sponsored, licensed associated or otherwise authorized by Opposer in violation of Section 2(d) of the Lanham Act, 15 USC §1052(d).

COUNT II: DILUTION

15. Opposer repeats and incorporates herein by reference the averments in the preceding paragraphs.

16. Opposer would be damaged and would continue to be damaged because Applicant's future use and registration of the APEX PAVERS (and design) mark would dilute the distinctive quality of Opposer's APEX MARKS.

