

ESTTA Tracking number: **ESTTA554090**

Filing date: **08/14/2013**

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

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|---------------------------------------|---|
| Name | Champion Roofing, Inc. |
| Granted to Date of previous extension | 10/02/2013 |
| Address | 219 William Bensenville, IL 60106 UNITED STATES |

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| Attorney information | James J. Saul Faegre Baker Daniels LLP 311 South Wacker Drive Suite 4400 Chicago, IL 60606 UNITED STATES tmmpls@faegrebd.com, james.saul@faegrebd.com, marc.levy@faegrebd.com, brian.brown@faegrebd.com Phone:(312) 356-5053 |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 85702939 | Publication date | 06/04/2013 |
| Opposition Filing Date | 08/14/2013 | Opposition Period Ends | 10/02/2013 |
| Applicant | Champion Window Manufacturing and Supply Co., LLC 12121 Champion Way Cincinnati, OH 45241 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 037. First Use: 2012/08/08 First Use In Commerce: 2012/08/08 Opposed goods and services in the class: Roofing installation; Roofing repair; Roofing services |
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Grounds for Opposition

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|--------------------------------------|---|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | common-law basis for opposition use in commerce as early as February 19, 1999 |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|-----------------------|-----------------------|------------|
| U.S. Application No. | 85899610 | Application Date | 04/09/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | CHAMPION ROOFING INC. | | |

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|---------------------|--|
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 037. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 Roofing services, consultation, contracting, installation, and repair |

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|----------------------|---|-----------------------|------------|
| U.S. Application No. | 85899615 | Application Date | 04/09/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | CHAMPION ROOFING INC. | | |
| Design Mark | | | |
| Description of Mark | The mark consists of a square that has been divided into three parts horizontally, the center part being larger than the top and bottom parts, which are of equal size, the top part contains the word "CHAMPION", the center part contains the image of a weightlifter that is holding a barbell for which the weights are represented by images of rooftops, the bottom part contains the words "ROOFING INC.". | | |
| Goods/Services | Class 037. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 Roofing services, consultation, contracting, installation, and repair | | |

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| Attachments | Notice of Opposition 85702939.pdf(203370 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 | /James J. Saul/ |
| Name | James J. Saul |
| Date | 08/14/2013 |

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

Champion Roofing, Inc.,) U.S. Trademark Application Serial No. 85/702,939
)
Opposer,) Mark: CHAMPION
)
v.) Opposition No.: _____
)
Champion Window Manufacturing)
and Supply Co., LLC, aka)
Champion Window)
)
Applicant.

NOTICE OF OPPOSITION

Champion Roofing, Inc., an Illinois corporation, having a principal place of business at 219 William Street, Bensenville, Illinois, believes it will be damaged by the registration of the mark "CHAMPION" that is the subject of U.S. Trademark Application Serial No. 85/702,939 (the "Application") and hereby opposes the same. In support of its opposition, Opposer, by and through its attorneys, states as follows:

1. Opposer is a state of the art roofing specialist that provides customized installation of roofing systems for commercial businesses, industrial facilities, and residences.
2. Opposer is certified as a roofing installer by various prominent roofing system manufacturers in the industry including Firestone Building Products Company, GenFlex Roofing Systems and Johns Manville.
3. Opposer, since as early as 1999, has owned a roofing contractor license - license number 104011864 - with the Illinois Department of Financial and Professional Regulation. Said license is valid through June 2015.

4. Opposer has used the trade name and service mark CHAMPION ROOFING, INC. (the “CHAMPION ROOFING mark”) in conjunction with commercial and residential commercial roofing services in the United States since at least as early as 1999.

5. Opposer has made extensive and continuous sales of its roofing systems and roofing services under the CHAMPION ROOFING mark.

6. Opposer has spent significant amounts of revenue and resources in the sale and marketing of its roofing services over the last 14 years bearing the CHAMPION ROOFING mark. For example, Opposer has used the CHAMPION ROOFING mark to sponsor player awards advertised during the television broadcast of a 2012 Chicago Bears professional football game and a 2013 Chicago Blackhawks Stanley Cup Finals game.

7. Through its marketing efforts and long-standing, continuous use of the CHAMPION ROOFING mark in conjunction with roofing services in the greater Chicago metropolitan area, the relevant purchasing public has come to associate CHAMPION ROOFING exclusively with Opposer.

8. Through its marketing efforts and long-standing, continuous use of the CHAMPION ROOFING mark in conjunction with roofing services in the greater Chicago metropolitan area, Opposer has also developed exceedingly valuable goodwill in the CHAMPION ROOFING mark for roofing services.

9. Opposer is the owner of all right, title, and interest in and to U.S. Trademark Application Serial No. 85/899,610 for the CHAMPION ROOFING mark for “roofing services, consultation, contracting, installation, and repair” as well as U.S. Trademark Application Serial No. 85/899,615 for the CHAMPION ROOFING and design mark for “roofing services, consultation, contracting, installation, and repair.”

10. On or about August 14, 2012, Champion Window Manufacturing and Supply Co., LLC, aka Champion Window, a limited liability company organized under the laws of Delaware (“Applicant”) has, through its Application, sought to register the mark “CHAMPION” for the "installation of doors and windows; roofing installation; roofing repair; roofing services.”

11. On May 15, 2013, that Application was published for opposition.

12. On June 27, 2013, Opposer filed a request with the Trademark Trial and Appeal Board ("TTAB") for an extension of time to oppose that Application. On that same day, the TTAB granted Opposer's request for an extension of time to oppose.

13. On July 23, 2013, Applicant’s pending application for “CHAMPION” - the subject of U.S. Trademark Application Serial No. 85/702,939 - was referenced by the United States Patent and Trademark Office as a potential bar to the registration of Opposer’s CHAMPION ROOFING mark for “roofing services, consultation, contracting, installation, and repair” (U.S. Trademark Application Serial No. 85/899,610) and its CHAMPION ROOFING and design mark for “roofing services, consultation, contracting, installation, and repair” (U.S. Trademark Application Serial No. 85/899,615).

14. Opposer is the senior user and therefore has priority because Opposer has used its CHAMPION ROOFING mark for roofing services since at least as early as 1999, while the Application at issue claims a date of first use anywhere and date of first use in interstate commerce as August 8, 2012. The mark set forth in U.S. Application Serial No. 85/702,939 is confusingly similar to Opposer’s CHAMPION ROOFING mark.

15. Applicant's roofing services listed in the Application are identical to the roofing services provided by Opposer under the CHAMPION ROOFING mark.

16. The conditions surrounding the marketing of Applicant's roofing services and Opposer's roofing services under its CHAMPION ROOFING mark are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that they come from the same, common source.

17. Opposer will be damaged by the registration of the CHAMPION mark by Applicant because such registration will grant to Applicant *prima facie* evidence of the exclusive right to use the mark in conjunction with Applicant's roofing services and such use would be likely to cause confusion or mistake or to deceive as to the affiliation, connection, or association of Applicant with Opposer and as to the origin, sponsorship, and approval of Applicant's roofing services by Opposer.

18. Such confusion would also irreparably harm Opposer in that any defects or fault found with Applicant's services, or other commercial activities would be erroneously attributed to Opposer, thereby harming Opposer's reputation and damaging its substantial goodwill in the CHAMPION ROOFING mark.

19. Not only is the mark sought to be registered in U.S. Application Serial No. ~~85/702,939~~ likely to cause confusion, but the mark - as used in commerce in the U.S. - has in fact caused, and will likely continue to cause, actual confusion among consumers, all to Opposer's detriment.

20. Opposer will be further damaged and suffer irreparable harm should it not be able to register U.S. Trademark Application Serial No. 85/899,610 and U.S. Trademark Application Serial No. 85/899,615, thereby denying it the rights and benefits typically associated with owning a nationwide, federal trademark registration.

For all of the foregoing reasons, Opposer will be damaged by the registration of the "CHAMPION" mark sought to be registered by Applicant.

WHEREFORE, Opposer respectfully requests that the TTAB deny registration of Applicant's "CHAMPION" mark sought through the Application.

Respectfully submitted,

/S/
James J. Saul
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Brian D. Brown
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Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this notice is being filed with the Trademark Trial and Appeal Board, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, by using the ESTTA electronic filing system, this 14th day of August 2013.

/S/
Brian D. Brown

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "Notice of Opposition" has been served on Applicant's Attorney, William S. Wyler, with Schwartz Manes Ruby & Slovin, 2900 Carew Tower, 441 Vine Street, Cincinnati, Ohio 45202 via first class mail, today August 14, 2013.


Jeanne A. Cook