

ESTTA Tracking number: **ESTTA615553**

Filing date: **07/14/2014**

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	07/13/2014
Address	100 main st Pawtucket, RI 02860 UNITED STATES

Correspondence information	Joshua Glass Apex, LLC 100 main st Pawtucket, RI 02860 UNITED STATES trademarks@theapexcompanies.com
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Applicant Information

Application No	79133081	Publication date	01/14/2014
Opposition Filing Date	07/14/2014	Opposition Period Ends	07/13/2014
International Registration No.	1167888	International Registration Date	01/04/2013
Applicant	VMI Holland B.V. Gelriaweg 16 NETHERLANDS		

Goods/Services Affected by Opposition

Class 037. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: installation of tire manufacturing machines and rubber machines for the tire and rubber industry, for others

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.	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.	3856808	Application Date	07/12/2006
Registration Date	10/05/2010	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Automobile repair and maintenance		

U.S. Registration No.	2454720	Application Date	10/19/1999
Registration Date	05/29/2001	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1998/11/13 First Use In Commerce: 1998/11/13 anti-theft alarms for vehicles, namely programmable anti-theft alarms, horns, trunk releases, flashing parking lights, shock sensors, plug-in connectors and starter disable relays all for vehicles, and all sold together as a unit		

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.	3766492	Application Date	05/27/2009
Registration Date	03/30/2010	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 Retail store services featuring a wide variety of consumer goods of others; Retail store services featuring a wide variety of consumer goods		

U.S. Registration No.	4027851	Application Date	07/28/2010
Registration Date	09/20/2011	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 035. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 Retail store services featuring a wide variety of consumer goods of others; Retail store services featuring a wide variety of consumer goods; Online retail store services featuring a wide variety of consumer goods of others; Online retail store services featuring a wide variety of consumer goods		
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U.S. Registration No.	2562812	Application Date	08/23/1999
Registration Date	04/23/2002	Foreign Priority Date	NONE

Word Mark	APEX ONLINE		
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Design Mark			
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Description of Mark	NONE		
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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's accessories, shoes, athletic footwear, novelties, food and Christmas items		
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U.S. Registration No.	2657639	Application Date	11/01/1999
Registration Date	12/10/2002	Foreign Priority Date	NONE

Word Mark	APEX MALL		
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Design Mark			
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Description of Mark	NONE		
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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		
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U.S. Registration No.	2443933	Application Date	08/23/1999
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Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	APEX STORES		
Design Mark	<p>APEX STORES</p>		
Description of Mark	NONE		
Goods/Services	<p>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</p>		

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	<p>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, EMBOSSEING, 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</p>		

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	<h1>APEX COMPANIES</h1>		
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	<h1>APEX COMPANIES</h1>		
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		

U.S. Registration No.	3557603	Application Date	07/12/2006
Registration Date	01/06/2009	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		

Design Mark	APEX COMPANIES
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Shopping Mall services, namely, leasing and management of shopping mall space; real estate management; financial services in the nature of investments and financing in the field of real estate, securities, debt, venture capital and loans Class 037. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Real estate development

U.S. Registration No.	4004233	Application Date	10/08/2008
Registration Date	08/02/2011	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark	Apex		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 Arranging of educational services, namely, educational demonstrations; provision of classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest in the nature of business marketing and healthy lifestyles		

U.S. Registration No.	4004232	Application Date	10/08/2008
Registration Date	08/02/2011	Foreign Priority Date	NONE
Word Mark	APEX UNIVERSITY		

Design Mark	<h1>Apex University</h1>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1994/00/00 First Use In Commerce: 1995/01/01 Arranging of educational services, namely, educational demonstrations; provision of classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest in the nature of business marketing and healthy lifestyles

Related Proceedings	91212947
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Attachments	78981143#TMSN.png(bytes) 75826147#TMSN.png(bytes) 77745712#TMSN.png(bytes) 85095005#TMSN.png(bytes) 75781411#TMSN.png(bytes) 75836787#TMSN.png(bytes) 75781412#TMSN.png(bytes) 78928036#TMSN.png(bytes) 78928010#TMSN.png(bytes) 78928052#TMSN.png(bytes) 77588785#TMSN.png(bytes) 77588760#TMSN.png(bytes) Notice of Opposition - Apexer Basiq 7.14.14.pdf(35331 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	/Joshua Glass/
Name	Joshua Glass
Date	07/14/2014

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

In the matter of Serial No. 79/133,081

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APEX, LLC)	
	Opposer)	
v.)	Opposition No.:
)	
VMI HOLLAND B.V.)	
	Applicant)	
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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. 79/133,081 as it relates to services in Class 7, namely Machines for processing rubber, steel wire and synthetic wire, machine structural parts therefor, all used for vehicle tire building and building vehicle tire components for passenger car tires, light-truck, medium and heavy truck tires and for agricultural tires; machine tools used for vehicle tire building and building vehicle tire components for passenger car tires, light-truck, medium and heavy truck tires and for agricultural tires, in Class 37, namely Installation of tire manufacturing machines and rubber machines for the tire and rubber industry, for others, and in Class 42, namely Design and development of tire manufacturing machines and machines for processing rubber for the tire and rubber industry, as well as technical advice regarding the manufacturing of these machines,

namely, technical advice regarding product research and development and product development consultation concerning these machines.

The grounds for opposition are as follows:

Apex and its Marks

1. Since at least as early as 1924, Apex and its predecessors and their affiliates have used the mark “APEX” and other marks incorporating the word “APEX” (the “Apex Marks”) on and in connection with various automotive, tire, manufacturing, rubber products, wholesale, retail, on-line retail, commercial and residential real estate, and other businesses.

2. Apex is the owner of common law rights in the marks APEX, APEX ONLINE, APEX STORES, and APEX COMPANIES as a result of the continuous use of the APEX mark since at least as early as 1924 in connection with tires, automotive repair and maintenance services and retail automobile parts and accessories store services, as a result of its continuous use of the APEX mark since at least as early as September 1924 for retail services, as a result of its continuous use of the APEX ONLINE and APEX STORES marks since at least as early as November 1996 in connection with retail services and as a result of continuous use of the APEX COMPANIES mark in connection with tires and automotive repair and maintenance, among other things, since at least as early as September 2002.

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

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
APEX	2,155,905	5/12/1998	Automotive repair and maintenance services (Class 37); retail automobile parts and accessories stores (Class 42)
APEX	3,856,808	10/05/2010	Automobile repair and maintenance

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
COMPANIES			(Class 37);
APEX	2,454,720	3/6/2001	Anti-theft alarms for vehicles, namely programmable anti-theft alarms, horns, trunk releases, flashing parking lights, shock sensors, plug-in connectors and starter disable relays all for vehicles, and all sold together as a unit (Class 12)
APEX	1,847,961	8/2/1994	Retail department store services (Class 42)
APEX	3,766,492	3/30/2010	Retail store services featuring a wide variety of consumer goods of others; Retail store services featuring a wide variety of consumer goods (Class 35)
APEX	4,027,851	9/20/2011	Retail store services featuring a wide variety of consumer goods of others; Retail store services featuring a wide variety of consumer goods; Online retail store services featuring a wide variety of consumer goods of others; Online retail store services featuring a wide variety of consumer goods (Class 35)
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)

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
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 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)

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
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)
APEX COMPANIES	3,557,603	1/6/2009	Shopping Mall services, namely, leasing and management of shopping mall space; real estate management; financial services in the nature of investments and financing in the field of real estate, securities, debt, venture capital and loans (Class 36); Real estate development (Class 37)
APEX	4,004,233	8/2/2011	Arranging of educational services, namely, educational demonstrations; provision of classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest in the nature of business marketing and healthy lifestyles (Class 41)
APEX UNIVERSITY	4,004,232	8/2/2011	Arranging of educational services, namely, educational demonstrations; provision of classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest in the nature of business marketing and healthy lifestyles (Class 41)

4. Registration Nos. 1,847,961; 2,155,905; 2,454,720; 2,562,812; 2,657,639; 2,443,933 have been renewed pursuant to the provisions of the Lanham Act, and are incontestable.

5. Registration Nos. 2,918,976, 3,244,685 and 3,356,317 are incontestable.

Applicant and its Marks

6. Upon information and belief, **VMI HOLLAND B.V.** (“Applicant”) is a Dutch company with offices at BENELUX Gelriaweg 16 NL-8161 RK Epe NETHERLANDS.

7. Applicant is the record owner of the following U.S. Trademark Application for the mark APEXER BASIQ:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Goods and Services</u>
79/133,081	1/4/2013	Machines for processing rubber, steel wire and synthetic wire, machine structural parts therefor, all used for vehicle tire building and building vehicle tire components for passenger car tires, light-truck, medium and heavy truck tires and for agricultural tires; machine tools used for vehicle tire building and building vehicle tire components for passenger car tires, light-truck, medium and heavy truck tires and for agricultural tires (Class 7); Installation of tire manufacturing machines and rubber machines for the tire and rubber industry, for others (Class 37); Design and development of tire manufacturing machines and machines for processing rubber for the tire and rubber industry, as well as technical advice regarding the manufacturing of these machines, namely, technical advice regarding product research and development and product development consultation concerning these machines (Class 42)

COUNT I: LIKELIHOOD OF CONFUSION

8. Apex repeats and incorporates herein by reference the averments in the preceding paragraphs.

9. The goods and services listed in Serial No. 79/133,081 are closely related to those of Apex, in particular, to Apex’s long history in rubber products, tires, manufacturing,

automotive repair and maintenance services and retail automobile parts and accessories stores services.

10. On information and belief, Apex is the prior user of the APEX mark. Apex began using APEX in connection with rubber products, tires, automotive repair and maintenance services and retail automobile parts and accessories stores at least as early as 1924, began using APEX in connection with retail services at least as early as September 1924, began using APEX ONLINE and APEX STORES in connection with retail services at least as early as November 1996, and began using APEX COMPANIES in connection with tires, automotive repair and maintenance at least as early as September 2002. Applicant's intent to use their mark is subsequent to Opposer's actual date of first use of the Apex Marks for identical or closely related goods and services.

11. Apex has expended considerable effort and expense in promoting its APEX service marks and the goods and the services sold under such marks, with the result that the purchasing public has come to know, rely upon and recognize the products and services of Apex by such marks.

12. Applicant's APEXER BASIQ mark is confusingly similar to Apex's APEX service marks and is likely to cause confusion, deception or mistake to Apex's irreparable damage and injury, in violation of Section 2(d) of the Lanham Act, 15 USC §1052(d).

COUNT II: DILUTION

13. Apex repeats and incorporates herein reference the averments in the preceding paragraphs.

14. Apex is damaged and will continue to be damaged because Applicant's registration of the APEXER BASIQ mark would dilute the distinctive quality of Apex's APEX Marks.

PRAYER FOR RELIEF

WHEREFORE, Apex respectfully requests that this Opposition be sustained and that registration to Applicant for the APEXER BASIQ mark in International Classes 7, 37 and 42 be denied.

The filing fee of \$300 for this Notice of Opposition is being submitted electronically with this Notice.

Respectfully submitted,

APEX, LLC

By: /Joshua Glass/
Joshua Glass
Apex, LLC
100 Main Street
Pawtucket, RI 02860
Tel: 401-729-7219
Fax: 401-723-9452
jglass@theapexcompanies.com

Dated: July 14, 2014

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Notice of Opposition is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this 14th day of July, 2014.

/Joshua Glass/
Joshua Glass

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION is being deposited with the U.S. Postal Service with sufficient postage as first class mail this 14th day of July, 2014 in an envelope addressed to Applicant's attorney of record at the following address:

Paul Fields
Leason Ellis LLP
One Barker Avenue, Fifth Floor
White Plains, NY 10601

/Joshua Glass/
Joshua Glass