

ESTTA Tracking number: **ESTTA633105**

Filing date: **10/15/2014**

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	MartinBirzle
Granted to Date of previous extension	10/15/2014
Address	AM Rosengarten 3 Frankenthal, 67227 GERMANY

Attorney information	Imran F. Vakil Nexio, PC 23 Corporate Plaza Dr. Suite 150 Newport Beach, CA 92660 UNITED STATES ivakil@nexiolaw.com Phone:(949) 478-6830
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Applicant Information

Application No	86133186	Publication date	06/17/2014
Opposition Filing Date	10/15/2014	Opposition Period Ends	10/15/2014
Applicant	Sol NY Corp. 2417 Jericho Turnpike, #299 Garden City Park, NY 11040 UNITED STATES		

Goods/Services Affected by Opposition

Class 011. First Use: 2013/11/01 First Use In Commerce: 2013/11/01
All goods and services in the class are opposed, namely: Electric vaporizers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2235638	Application Date	02/13/1997
Registration Date	03/30/1999	Foreign Priority Date	NONE
Word Mark	ROOR		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 0 First Use In Commerce: 0 glass bowls; glass boxes; [lamp glass brushes; busts, figures, figurines, sculptures, statuettes and statues made of crystal, china, earthenware, glass, porcelain and terra cotta;] glass casters; [glass fabrics for industrial use; glassfibers for reinforcing plastics and non-textile purposes; enameled, ground plate, opal, opaline, polished plate, pressed, smoothed plate, speckled, spun, stained, stamped, and unwrought glass;] glass beverage ware and bowls; [containers for household use, namely, glass bulbs; glass etched by acid; plate glass for cars; glass for signal lights and headlights on vehicles; unfinished glass for vehicle windows; glass mosaics not for buildings;] glass rods, stoppers, [threads for non-textile purposes and yarns;] glass tubes not for scientific purposes [; glass wool not for insulation; jars for jams and jellies made of earthenware, glass and porcelain; glass knobs; glass mugs and pans; ornaments made of china, crystal, glass, porcelain and terra cotta, not for Christmas trees; stained glass decorations and figurines]

U.S. Registration No.	2307176	Application Date	07/07/1998
Registration Date	01/11/2000	Foreign Priority Date	03/20/1998
Word Mark	ROOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 CLOTHING, NAMELY, SHIRTS, PANTS, JACKETS, SWEATERS, SOCKS, HATS, CAPS AND FOOTWEAR Class 034. First use: First Use: 0 First Use In Commerce: 0 SMOKER'S ARTICLES, NAMELY, CIGARETTES, CIGARS, TOBACCO POUCHES, HUMIDORS, TOBACCO SPITTOONS, CHEWING TOBACCO, SMOKING TOBACCO AND MATCHES		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ROOR		
Goods/Services	Smoker's articles, including inter alia, vaporizers		

U.S. Registration No.	3675839	Application Date	01/21/2009
Registration Date	09/01/2009	Foreign Priority Date	NONE
Word Mark	ROOR		
Design Mark			
Description of Mark	The mark consists of the term "ROOR" instylized font with the last "R" facing backwards.		
Goods/Services	Class 034. First use: First Use: 1996/10/10 First Use In Commerce: 1996/10/10 SMOKER'S ARTICLES, NAMELY, GLASS PIPES,BONGS, WATER PIPES, WATER PIPES OF GLASS		

Attachments	75241572#TMSN.png(bytes) 75514874#TMSN.png(bytes) 77653139#TMSN.png(bytes) 1 -Opposition Complaint TTAB.pdf(512316 bytes)
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Certificate of Service

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Signature	/Imran F. Vakil/
Name	Imran F. Vakil
Date	10/15/2014

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Corp, 2417 Jericho Turnpike, #299 Garden City Park NEW YORK
11040

/ Imran F. Vakil /

/ Imran F. Vakil /

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

October 15, 2014

Opposition No. _____
Serial No. 86/133,186
Ref: **ESTTA** _____

In the matter of:

Trademark Application Serial No. 86/133,186
For the mark ROOR
Published in the Official Gazette on June 17, 2014

MARTIN BIRZLE, Opposer

v.

SOL NY CORP., Applicant

NOTICE OF OPPOSITION

The Opposer's name, address, and entity information is as follows:

Birzle, Martin

Am Rosengarten 3 Frankenthal Fed Rep Germany 67227

The above-identified opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1. Applicant Sol NY Corp. (“SOL”) is a New York corporation.
2. Opposer Martin Birzle (“Birzle”) is a German national with its principal place of business in Frankenthal, Germany.
3. Headquartered in Germany since 1995, Mr. Martin Birzle is an award-winning designer and manufacturer of smoker's products manufactured and sold under the trademark “ROOR”. ROOR products are widely recognized and highly acclaimed for being innovative and artistically superior. Amongst the products that Birzle makes and sells are borosilicate jointed-glass water pipes that feature the finest glassblowing craftsmanship and are commonly considered extraordinary artworks. Birzle also manufactures and sells many other smoker’s articles under the “ROOR” marks, including without limitation, vaporizers, electronic lighters, ashtrays, cigarette papers, cigarette filters, cigarette holders, as well as related fan merchandise (hats, t-shirts, key chains, etc.). Indeed, Birzle’s enterprise is one of the leading companies in the smoking industry. He has gained numerous awards and recognition for his innovative products and designs.
4. For nearly two decades, Birzle distinguished himself as the premiere manufacturer of smoker’s articles because of his unwavering use of quality materials and focus on scientific principles to facilitate a superior smoking experience. Birzle’s painstaking attention to detail is evident in many facets of authentic RooR products. It is precisely because of the unyielding quest for quality and unsurpassed innovation that RooR products have a significant following and appreciation amongst consumers in the United States. Birzle’s ROOR Products have been sold in the United States commencing as early as October 1996.
5. In the United States, Birzle has continually offered and marketed his smoker’s articles under the “ROOR” mark since 1996. Indeed, Birzle has received national exposure for his smoker’s articles under the “ROOR” mark. More recently, since as early as 2011, Birzle has entered into certain exclusive manufacturing and distribution contracts with Sream, Inc., in the United States.

6. Birzle is also the exclusive owner of federally-registered and common law trademarks, including but not limited to the marks listed below:

MARK	REG. NO.	ABRIDGED LIST OF GOODS AND SERVICES
ROOR	3,675,839	Smoker's Articles, Namely, Glass Pipes... Water Pipes...
ROOR	2,307,176	Smoker's Articles, Namely, Cigarettes, Cigars, Tobacco Pouches, Humidors, Tobacco Spittoons, Chewing Tobacco, Smoking Tobacco And Matches
ROOR	2,235,638	glass bowls...enameled, ground plate, opal, opaline, polished plate, pressed, smoothed plate, speckled, spun, stained, stamped, and unwrought glass

In addition, Birzle has used, and continues to use stylized versions of the “ROOR” trademarks which are depicted below:



(the common law/unregistered and registered versions of Birzle marks are collectively referred to as the “**Roor Marks**”)

7. Birzle has spent substantial time, money and effort in developing consumer recognition and awareness of the RooR Marks. This recognition is also due, in part, to the collaborative efforts of Birzle’s licensees. Through the extensive use of the mark, Birzle has built up and developed significant goodwill in the entire RooR

product line. A wide array of websites, magazines, and specialty shops include advertising of RooR's products which are immediately identifiable.

8. The superiority of the Birzle's RooR products is not only readily apparent to consumers, who yearn for its higher quality in the marketplace, but to industry professionals as well. Birzle's RooR products unique style and functional superiority has earned the brand accolades in leading trade magazines and online publications. Indeed, it's exactly because consumers recognize the quality and innovation associated with Birzle's RooR branded products that consumers are willing to pay higher prices for them.
9. As a result of such long standing use and investment, Birzle is entitled to the exclusive use and benefit of the "ROOR" mark, which has been in continuous use in the United States since 1996 in the smoker's articles space generally.
10. In the Spring of 2014, Birzle became aware that SOL filed a U.S. filed a United States Trademark Application for the "ROOR" mark for smoker's articles (or more specifically for "Electric vaporizers") in international class 011, under application number 86/133,186 on December 2, 2013 as a 15 U.S.C. §1051(a) application. SOL claims to have started promoting, advertising, and/or offering infringing products under the "ROOR" mark at least as early as November 2013. An example of Applicant's infringing products, as depicted in Applicant's amended to its statement of use (filed April 27, 2014), is reproduced below:



11. Because of the fame of Birzle RooR product line, as well as the identical use of a stylized mark, Birzle contends that SOL was aware of Birzle's use of one or more ROOR Marks prior to filing U.S. Trademark Application No. 86/133,186.
12. On information and belief, Birzle's goods are offered in the same economic market and to the same segment of consumers as the Defendant's infringing goods. Specifically, both Birzle's goods and the infringing goods are typically sold in retail smoke shops throughout the United States, usually less than 20 feet apart from one another.
13. In contravention to 15 U.S.C. §1052(d), SOL's conduct has confused and is likely to confuse the public, and cause deception and mistake among the consuming public and trade by creating the erroneous impression that SOL's goods have been or are approved, sponsored, endorsed or guaranteed by, or in some way are affiliated with, Birzle.
14. Birzle contends, for the foregoing reasons, that applicant's application to register the mark "ROOR" is improper and unjustified in that applicant has no legitimate rights to use the mark in commerce, necessitating denial of the registration application.

WHEREFORE Birzle prays that this Court grant Opposers' Opposition proceeding, and deny the registration of United States Application Number 86/133,186 to Applicant.

Respectfully submitted,

NEXIO PC

/ Imran F. Vakil/

Imran F. Vakil

Attorneys for Opposer

23 Corporate Plaza Dr.

Suite 150

Newport Beach, California 92660

Phone: (949) 478-6830

Fax: (949) 478-1275

Attorneys for Opposer



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