

ESTTA Tracking number: **ESTTA711232**

Filing date: **11/27/2015**

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	Unimin Corporation
Granted to Date of previous extension	11/28/2015
Address	258 Elm Street New Canaan, CT 06840 UNITED STATES
Attorney information	Gregory S. Vickers Rankin, Hill & Clark LLP 23755 Lorain Road, Suite 200 North Olmsted, OH 44070 UNITED STATES docketing@rankinhill.com, martin@rankinhill.com

**Applicant Information**

Application No	86618479	Publication date	09/29/2015
Opposition Filing Date	11/27/2015	Opposition Period Ends	11/28/2015
Applicant	Specification Products, LLC Suite 510 Fishers, IN 46038 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 001. First Use: 2015/02/01 First Use In Commerce: 2015/02/20 All goods and services in the class are opposed, namely: Chemical compounds for curing concrete; Concrete additives; Concrete admixtures
--

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	4522545	Application Date	05/10/2012
Registration Date	04/29/2014	Foreign Priority Date	NONE
Word Mark	ELEMENT		

Design Mark	<b>ELEMENT</b>
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2013/09/00 First Use In Commerce: 2013/09/00 Lime, calcined lime, hydrated lime, and/or quicklime used for industrial, chemical and manufacturing processes and applications; lime, calcined lime, hydrated lime, and/or quicklime for use as a ph modifier and reagent for industrial and manufacturing operations; lime, calcined lime, hydrated lime, and/or quicklime used as a scrubbing media in industrial processes and power plants; lime, calcinedlime, hydrated lime, and/or quicklime used in industrial water treatment and mine runoff

Attachments	85621992#TMSN.png( bytes ) UNM-39562_Notice_of_Opposition.pdf(102547 bytes )
-------------	---

### **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	/Gregory S. Vickers/
Name	Gregory S. Vickers
Date	11/27/2015

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

In the Matter of:  
Trademark Application Serial No. **86/618479**  
Filed: May 4, 2015  
For the Mark: **ELEMENT FIVE & Design**  
Published in the *Official Gazette* on September 29, 2015  
Opposer's Reference No. UNM-39562

Unimin Corporation	)	
	)	
Opposer	)	
v.	)	Opposition No. _____
	)	
Specification Products, LLC	)	
	)	
Applicant	)	
	)	

**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451  
Attention: TTAB

Unimin Corporation, a Delaware corporation, with offices at 258 Elm Street, New Canaan, CONNECTICUT 06840 (hereinafter “Unimin” or “Opposer”), believes it will be damaged by the registration of the word phrase and design shown in the application bearing S.N. 86/618479 and hereby opposes registration of said word phrase and design. Application S.N. 86/618479 was published for opposition on September 29, 2015. Opposer filed a thirty day extension of time wherein the current due date to file a Notice of Opposition is November 28, 2015.

By and through its undersigned attorney, Unimin hereby opposes Application S.N. 86/618479. The grounds for this Opposition are as follows:

1. Upon information and belief, Specification Products, LLC, a Limited Liability Company of Indiana, with a business address at Suite 510 7 Launch Way Fishers Indiana 46038 (hereinafter “Applicant”), filed a used based application to register “ELEMENT FIVE THE

COMPLETE CONCRETE SLAB SYSTEM” & Design (hereinafter “the ELEMENT FIVE Design”), Application S.N. 86/618479 lists “Chemical compounds for curing concrete; Concrete additives; Concrete admixtures” in International Class 1, on May 4, 2015 (hereinafter “the ‘479 application”). The ‘479 application claimed use at the time of filing and a first use date of February 1, 2015.

2. Upon information and belief, the ‘479 application is a Logo application wherein the word phrase “ELEMENT FIVE” of the ‘479 application is a dominant element of the mark.

3. Upon information and belief, use was claimed in the application wherein first use was claimed as February 1, 2015.

4. Upon information and belief, Applicant did not use the ELEMENT FIVE Design for the goods recited in the ‘479 application prior to February 1, 2015.

5. Upon information and belief, Applicant did not use the ELEMENT FIVE Design for the goods recited in the ‘479 application prior to January 1, 2015.

6. Upon information and belief, Applicant did not use the ELEMENT FIVE Design for the goods recited in the ‘479 application prior to January 1, 2014.

7. Upon information and belief, the ‘479 application makes no claim to color in the ELEMENT FIVE Design.

8. Upon information and belief, the ELEMENT FIVE Design of the ‘479 application is used by Applicant with the words “ ELEMENT” and “FIVE” presented in different colors that emphasizes the word “ELEMENT” in the ELEMENT FIVE Design.

9. Upon information and belief, the word “FIVE” describes an ingredient, quality, characteristic, function, feature, purpose and/or use of the goods listed in the ‘479 application wherein the word “ELEMENT” is the dominant feature of the mark.

10. The goods listed in the ‘479 application are “Chemical compounds for curing concrete; Concrete additives; Concrete admixtures” without any limitation on the specific types of materials wherein the ‘479 application provide protection for all chemical compounds for curing concrete, for all concrete additives, and for all concrete admixtures. These chemicals and/or materials include minerals.

11. The goods listed in the ‘479 application cover all minerals that can, among other uses, be used as a compounds for curing concrete, a concrete additives, and/or a concrete admixtures.

12. The goods listed in the '479 application makes no limitation as to the type of material, but only as to how the materials are used.

13. Upon information and belief, the word phrase "THE COMPLETE CONCRETE SLAB SYSTEM" in the '479 application has been disclaimed.

14. Upon information and belief, the word phrase "THE COMPLETE CONCRETE SLAB SYSTEM" in the '479 application has little or no trademark significance.

15. The word phrase "ELEMENT FIVE" of the '479 application is presented in a significantly larger and more stylized font than the word phrase "THE COMPLETE CONCRETE SLAB SYSTEM" in the '479 application wherein upon information and belief the word phrase "THE COMPLETE CONCRETE SLAB SYSTEM" in the '479 application has little or no significance in the overall commercial impression of the ELEMENT FIVE Design of the '479 application.

16. Upon information and belief, the word "ELEMENT" of the word phrase "ELEMENT FIVE" is the dominant portion of this word phrase.

17. Opposer is the owner of Registration No. 4,522,545 for the mark ELEMENT which was filed on May 10, 2012 and which recites, *inter alia*, "Lime, calcined lime, hydrated lime, and/or quicklime used for industrial, chemical and manufacturing processes and applications" in International Class 1; (hereinafter "the '545 registration"). This filing is valid and subsisting, in full force and effect, and is conclusive evidence of Opposer's exclusive right to use the ELEMENT Mark for the goods and services referenced therein.

18. The ELEMENT mark in the '545 registration is a Standard Character Mark, which makes no claim to any particular font style, size, color or logo.

19. The goods listed in the '545 registration include no limitation to the uses of the mineral/chemical products wherein these materials can be used as compound for curing concrete, a concrete additive, and/or a concrete admixture.

20. Opposer is also the owner of common law rights in its ELEMENT mark which is used for Opposer's mineral products including, but not limited to, the goods recited in the '545 registration.

21. Opposer sells a wide range of mineral products and sells these mineral products for many uses including, but not limited to, compounds for curing concrete, a concrete additive, and/or a

concrete admixture as is best understood from this description. Upon information and belief, the goods listed in the '479 application include goods sold in the concrete industry.

22. Opposer sells a wide range of minerals in the concrete industry wherein, upon information and belief, the same consumer purchases, or could purchase, both the goods sold by Applicant and Opposer.

23. Opposer sells a wide range of minerals wherein, upon information and belief, the same consumer purchases both the goods sold by Applicant and Opposer in the same commercial transaction.

24. Upon information and belief, Applicant's goods listed in the '479 application are identical, overlap, at least similar to and/or complementary with the goods in Opposer's '545 registration.

25. Opposer has used its ELEMENT mark to identify its products listed in the '545 registration long prior to the filing date of Applicant's '479 application and the date of first use claimed in the '479 application.

26. Opposer has invested a substantial amount of time, effort and money to promote its goods sold under Opposer's ELEMENT Mark.

27. Opposer's extensive and continuous use of ELEMENT has generated substantial revenue and valuable goodwill and reputation.

### **COUNT 1**

Opposer incorporates the allegations of paragraphs 1-27 as is stated herein.

28. Opposer has priority trademark rights in Opposer's ELEMENT Mark to identify its products long prior to the filing date of the '479 application and claimed first use dates of Applicant's '479 application.

29. Applicant's '479 application for the ELEMENT FIVE Design consists of or comprises a word phrase which so resembles Opposer's ELEMENT Mark, including the '545 registration, as to be likely, when used on or in connection with the goods sought to be registered by Applicant to cause confusion, or to cause mistake, or to deceive.

30. Applicant's '479 application for the ELEMENT FIVE Design includes the word phrase ELEMENT FIVE as a dominant element that consists of or comprises a phrase which so resemble Opposer's ELEMENT Mark, including the '545 registration, as to be likely, when used on or in connection with the goods sought to be registered by Applicant, to cause confusion, or to cause mistake, or to deceive.

31. The ELEMENT FIVE Design as is set forth in the '479 application, is confusingly similar to Opposer's ELEMENT Mark, and registration of the ELEMENT FIVE Design to Applicant is therefore likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer and, therefore, would damage Opposer.

## **COUNT II**

Opposer incorporates the allegations of paragraphs 1-31 as is stated herein.

32. Applicant seeks registration of the ELEMENT FIVE Design on goods such that use of the ELEMENT FIVE Design is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer or as to the origin, sponsorship or approval of Applicant's goods by Opposer.

33. Opposer has priority trademark rights in Opposer's ELEMENT Mark to identify its products over any rights Applicant may have in the ELEMENT FIVE Design of Applicant's '479 application.

34. Applicant seeks registration of the ELEMENT FIVE Design which consists of or comprises a word phrase which so resembles the '545 registration and/or Opposer's common law rights in ELEMENT and variations thereof previously used in the United States by Opposer as to be likely, when used on or in connection with the goods listed in the '479 application, to cause confusion, or to cause mistake, or to deceive.

35. Applicant seeks registration of the ELEMENT FIVE Design which consists of or comprises a word phrase which would improperly prevent any natural extensions of Opposer's ELEMENT Mark that Opposer would be damaged if the '479 application was allowed to register.

36. Opposer, therefore, believes it will be damaged by the registration of the '479 Application to Applicant.

### **COUNT III**

Opposer incorporates the allegations of paragraphs 1-36 as is stated herein.

37. Applicant seeks registration of the ELEMENT FIVE Design on goods such that use of the ELEMENT FIVE Design is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer or as to the origin, sponsorship or approval of Applicant's goods by Opposer and Applicant knew, or should have known, of Opposer's ELEMENT Marks when filing the '479 application and; therefore, committed fraud on the Trademark Office.

### **COUNT IV**

Opposer incorporates the allegations of paragraphs 1-37 as is stated herein.

38. Upon information and believe, Applicant was not using the ELEMENT FIVE Design on all goods listed in the '479 when the '479 application was filed and Applicant knew, or should have known, that there was no use of the ELEMENT FIVE Design for all goods originally listed in the '479 application when filing the '479 application and; therefore, committed fraud on the Trademark Office.

**PRAYER FOR RELIEF**

WHEREFORE, Opposer prays that application S.N. 86/618479 be denied, that Applicant be enjoined from obtaining registration of S.N. 86/618479, that no registration be issued to Applicant and that this opposition be sustained.

It is respectfully requested that the filing fees, and/or any additional fess, be charged to Deposit Account No. 18-0160, our Order No. UNM-39562. Opposer further requests that all correspondence in this matter be addressed to the undersigned.

Date: November 27, 2015

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By /Gregory S. Vickers/  
Gregory S. Vickers, Reg. No. 45180

23755 Lorain Road, Suite 200  
North Olmsted, Ohio 44070-2224  
(216) 566-9700

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

In the Matter of:  
Trademark Application Serial No. **86/618479**  
Filed: May 4, 2015  
For the Mark: **ELEMENT FIVE & Design**  
Published in the *Official Gazette* on September 29, 2015  
Opposer's Reference No. UNM-39562

Unimin Corporation	)	
	)	
Opposer	)	
v.	)	Opposition No. _____
	)	
Specification Products, LLC	)	
	)	
Applicant	)	
	)	

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served on:

Mr. Greg Bell  
Specification Products, LLC  
7 Launch Way Ste 510  
Fishers, Indiana 46038-1559  
Phone Number: 317-371-2081

by first class mail, postage prepaid, on **November 27, 2015**.

By  /Gregory S. Vickers/