

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

RE/MAX, LLC,

Opposer,

v.

Shenzhen Remax Co., Limited,

Applicant.

Opposition No. _____

Marks: REMAX (Stylized) and
R REMAX & Design

Serial Nos. 79/157,528 and 86/602,454

Filing Dates: 10/21/2014 and 04/20/2015

Publication Dates: 10/13/2015 and 11/03/2015

NOTICE OF OPPOSITION

RE/MAX, LLC, a Delaware limited liability company, located and doing business at 5075 S. Syracuse Street, Denver, Colorado 80237 (hereinafter "Opposer") believes it will be damaged by the registration of REMAX (Stylized), a mark sought to be registered through U.S. Service Mark Application No. 79/157,528, filed on 10/21/2014, and R REMAX & Design, a mark sought to be registered through U.S. Service Mark Application Serial No. 86/602,454, filed on 04/20/2015, owned in both cases by Shenzhen Remax Co., Limited, a Chinese limited company, (hereinafter "Applicant"),¹ and Opposer hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer provides real estate brokerage services throughout the United States and in numerous foreign countries through a network of sub-franchisors, franchisees, and affiliated sales agents who are authorized to use certain service marks of Opposer in connection with real estate brokerage services ("RE/MAX Network").

11/17/2015 56NIM1 00000003 86602454

01 FC:6402

300.00 0P

¹ The owner name is set forth in Application No. 86/602,454 as Shenzhen Reamx Co., Ltd, which name appears to contain a typographical error.



2. Opposer, since at least as early as 1973, has provided real estate brokerage services in interstate commerce through brokerage offices owned and operated by it and, since at least as early as 1975, through the RE/MAX Network, all in connection with its distinctive service marks, "REMAX" (without regard to any particular font style, size, or color), "RE/MAX" (without regard to any particular font style, size, or color), and **RE/MAX** (without regard to any particular size or color), collectively referred to as the "RE/MAX Trademarks."

3. In addition to real estate brokerage and franchising services, Opposer and the RE/MAX Network use the RE/MAX Trademarks on numerous products (the "Branded Products"), including *inter alia* business cards, notepads, postcards, calendars, bookmarks, key-chains, blank USB flash drives, mobile phone and tablet cases, battery chargers, earphones, clothing, hats, bags, and drinkware. The use of the RE/MAX Trademarks on some of these Branded Products dates back to at least the 1980s.

4. Opposer owns the following United States Trademark Registrations and Applications, among others:

Mark	Reg. No./ App. No.	Goods/Services	Filing Date
RE/MAX	4,087,749	Aprons; Baby tops; Baseball caps; Blouses; Boxer shorts; Caps; Coats; Denim jackets; Dress shirts; Fleece pullovers; Golf shirts; Hats; Hooded sweatshirts; Infant and toddler one piece clothing; Jackets; Knit jackets; Knitted caps; Long-sleeved shirts; Pants; Polo shirts; Pullovers; Rainproof jackets; Scarves; Shirts; Short-sleeved shirts; Ski jackets; Sweaters; Sweatpants; Sweatshirts; T-shirts; Vests; Visors; Wind resistant jackets (Class 25)	06/13/11
RE/MAX	4,096,051	Aprons; Baby tops; Baseball caps; Blouses; Boxer shorts; Caps; Coats; Denim jackets; Dress shirts; Fleece pullovers; Golf shirts; Hats; Hooded sweatshirts; Infant and toddler one piece clothing; Jackets; Knit jackets; Knitted caps; Long-sleeved shirts; Pants; Polo shirts; Pullovers; Rainproof jackets; Scarves; Shirts; Short-sleeved shirts; Ski jackets; Sweaters; Sweatpants; Sweatshirts; T-shirts; Vests; Visors; Wind resistant jackets (Class 25)	06/13/11

Mark	Reg. No./ App. No.	Goods/Services	Filing Date
RE/MAX	4,716,532	Hats; Jackets; Shirts; Sweatshirts (Class 25)	10/24/14
RE/MAX	86/547,269	Batteries and battery chargers; Blank digital storage media; Blank USB flash drives; Cases for mobile phones; Computer software for providing real estate listings and real estate information, and for educational content in the field of real estate brokerage and related subjects of interest to real estate professionals, and for program information and scheduling for attendees of educational conferences and trade shows; Headphones; Monopods for handheld digital electronic devices, namely, phones; Protective covers and cases for tablet computers (Class 9)	02/26/15
RE/MAX	86/547,281	Batteries and battery chargers; Blank digital storage media; Blank USB flash drives; Cases for mobile phones; Computer software for providing real estate listings and real estate information, and for educational content in the field of real estate brokerage and related subjects of interest to real estate professionals, and for program information and scheduling for attendees of educational conferences and trade shows; Headphones; Monopods for handheld digital electronic devices, namely, phones; Protective covers and cases for tablet computers (Class 9)	02/26/15
RE/MAX	86/817,848	Attaché cases; Backpacks; Briefcases; Business card cases; Duffel bags; Fanny packs; Golf umbrellas; Hip bags; Luggage; Luggage tags; Messenger bags; Sling bags; Sports bags; Tote bags; Traveling bags; Umbrellas; Wine bags with handles for carrying or holding wine (Class 18)	11/12/15
RE/MAX	86/817,829	Attaché cases; Backpacks; Briefcases; Business card cases; Duffel bags; Fanny packs; Golf umbrellas; Hip bags; Luggage; Luggage tags; Messenger bags; Sling bags; Sports bags; Tote bags; Traveling bags; Umbrellas; Wine bags with handles for carrying or holding wine (Class 18)	11/12/15

Pursuant to 37 CFR section 2.122, current printouts of information from the electronic database records of the USPTO showing the current status and title of the above-listed registrations are attached as Exhibit A. Also included in Exhibit A are current printouts of information from the electronic database records of the USPTO pertaining to the above-listed Class 9 applications and copies of the Class 18 applications submitted to the USPTO.

5. By virtue of Opposer's use of the RE/MAX Trademarks in connection with the goods set forth above and other goods, Opposer has developed substantial common law rights in the RE/MAX Trademarks for use in connection with those goods.

6. Opposer has a network of authorized suppliers of Branded Products bearing the RE/MAX Trademarks, known as "RE/MAX Approved Suppliers" (the "Approved Supplier Network"), who are licensed by Opposer to use the RE/MAX Trademarks in connection with Branded Products offered for sale and sold to the RE/MAX Network. These suppliers provide a broad range of products and materials bearing the RE/MAX Trademarks that are used by Opposer and the RE/MAX Network for distribution in the United States.

7. As a result of the distribution of a substantial volume of authorized Branded Products by the RE/MAX Network in the United States, the RE/MAX Trademarks are recognized in the United States as identifying products originating from, authorized or sponsored by, or associated with Opposer. The public has come to associate the RE/MAX Trademarks with Opposer as a source of high quality Branded Products designed to remind consumers of Opposer and its high quality real estate brokerage and related services.

8. Applicant filed U.S. Trademark Application Serial No. 79/157,528 on 10/21/2014, and U.S. Trademark Application Serial No. 86/602,454 on 04/20/2015, seeking to register the marks REMAX (Stylized) and R REMAX & Design, respectively, as shown below ("Applicant's Marks"):

REMAX



9. By Application No. 79/157,528, Applicant seeks to register REMAX (Stylized) as a trademark in connection with "Electronic pens for use with visual display units; blank USB flash

drives; quantity indicators, namely scales; radios; portable telephones; headphones; materials for electricity mains, namely, electric wires and cables; Electric connections in the nature of plugs, sockets and other contacts; battery chargers; photographic cameras” in International Class 9, goods that are identical or very closely related to goods offered under the RE/MAX Trademarks.

10. By Application No. 86/602,454, Applicant seeks to register R REMAX & Design as a trademark in connection with “Animal skin, namely moleskin; Backpacks; Bags for sports; Handbags; Haversacks; Leather cases; Purses and wallets; Travelling trunks; Trunks; Valises” in International Class 18, goods that are identical or very closely related to goods offered under the RE/MAX Trademarks.

11. Application No. 79/157,528 was published in the Official Gazette for opposition on 10/13/2015, and Application No. 86/602,454 was published for opposition on 11/03/2015. Therefore, this Notice of Opposition is timely filed.

12. The goods offered or to be offered under Applicant’s Marks overlap with goods provided by Opposer directly, by the RE/MAX Network, or through the Approved Supplier Network. For example, at least the blank USB flash drives, headphones, battery chargers, backpacks, bags for sports, handbags, haversacks, leather cases, and valises offered or to be offered under Applicant’s Marks overlap with the following goods provided by Opposer directly, by the RE/MAX Network, or through the Approved Supplier Network: battery chargers, blank digital storage media, blank USB flash drives, cases for mobile phones, headphones, protective cases for tablet computers, backpacks, briefcases, business card cases, duffel bags, luggage, messenger bags, sling bags, sports bags, tote bags, and traveling bags.

13. Opposer has priority based on its prior use in commerce of its RE/MAX Trademarks before the Application filing dates and before any date of first use that may be alleged by

Applicant, both specifically with respect to the overlapping goods identified in Paragraph 12 above and otherwise.

14. Applicant's Marks, when used in connection with the goods identified in application Serial Nos. 79/157,528 and 86/602,454 are likely to cause confusion, or to cause mistake, or to deceive consumers as to the source of Applicant's goods or as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship, or approval of Applicant's goods or other commercial activities.

15. Opposer has not in any way authorized Applicant's use of any RE/MAX Trademarks for the goods set forth in Application Serial Nos. 79/157,528 and 86/602,454.

16. The registration of Applicant's Marks on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, the common law and the Trademark Act, and would be damaging to Opposer.

WHEREFORE, Opposer RE/MAX, LLC believes that it would be damaged by registration of Applicant's Marks and respectfully prays that U.S. Service Mark Application Serial No. 79/157,528 for REMAX (Stylized) and U.S. Service Mark Application Serial No. 86/602,454 for R REMAX & Design be rejected, that no registrations be issued thereon, and that this opposition be sustained in favor of Opposer.

Respectfully submitted this 12th day of November, 2015.

RE/MAX, LLC

By: Ashley Krause

Ashley Krause

Adam Lindquist Scoville

RE/MAX, LLC

5075 South Syracuse Street

Denver, Colorado 80237

(303) 770-5531

ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 12th day of November, 2015, service of the foregoing **Notice of Opposition** was effected by the method set forth below, addressed as follows:

Shenzhen Reamx Co., LTD
Huaning Road, Bao'an District, Shenzhen
Shenzhen 518109
China
Service via Federal Express

Liang Gong
10685-B Hazelhurst Dr.
14729
Houston, TX 77043
Service via Federal Express

CORRESPONDENTS OF RECORD



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

Ashley Krause
(Typed or Printed Name of Person Signing Certificate)

Ashley Krause
(Signature)

11/12/15
(Date)