

ESTTA Tracking number: **ESTTA34010**

Filing date: **05/25/2005**

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	RE/MAX International, Inc.
Granted to Date of previous extension	05/25/2005
Address	8390 E. Crescent Pkwy., Suite 600 Greenwood Village, CO 80111 UNITED STATES

Attorney information	Shelley K. Barton Greenberg Traurig, LLP 1200 17th Street, Suite 2400 Denver, CO 80202 UNITED STATES bartons@gtlaw.com, strongg@gtlaw.com, bourassas@gtlaw.com, posthumusj@gtlaw.com, mcwhirtl@gtlaw.com Phone:303-572-6500
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Applicant Information

Application No	78314798	Publication date	01/25/2005
Opposition Filing Date	05/25/2005	Opposition Period Ends	05/25/2005
Applicant	RE3W Worldwide Limited Chancery Hall, 52 Reid Street		

Hamilton, HM 12 BERMUDA

Goods/Services Affected by Opposition

Class 036.

All goods and services in the class are opposed, namely: COMPUTER SERVICES, NAMELY, PROVIDING INFORMATION CONCERNING REAL ESTATE AND REAL ESTATE TRANSACTIONS VIA THE INTERNET

Class 042.

All goods and services in the class are opposed, namely: PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE COMPUTER SOFTWARE FOR USE IN SEARCHING AND RETRIEVING INFORMATION, SITES, AND OTHER RESOURCES CONCERNING REAL ESTATE ON COMPUTER NETWORKS; PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE COMPUTER SOFTWARE FOR USE AS A DIRECTORY OF REAL ESTATE INFORMATION, REAL ESTATE SITES, AND RESOURCES WHICH ARE AVAILABLE ON COMPUTER NETWORKS

Related Proceedings	Serial No. 78/314,801 for REstreets
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Attachments	REFILE 5-24-05.pdf (20 pages)
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Signature	/Shelley K. Barton/
Name	Shelley K. Barton
Date	05/25/2005

IN THE UNITED STATES PATENT AND SERVICE MARK OFFICE
BEFORE THE SERVICE MARK TRIAL AND APPEAL BOARD

In re Application Serial No.: 78/314,798

For the Mark: REFILE

Applicant: RE3W Worldwide Limited

Filed on: October 16, 2003

RE/MAX INTERNATIONAL, INC.,

Opposer,

v.

RE3W WORLDWIDE LIMITED,

Applicant.

) Opposition No.: _____

I hereby certify that this paper and fee is being filed with the U.S. Patent & Trademark Office via ESTTA, on May 25, 2005.

By:  GREENBERG TRAURIG, LLP
Lynne McWhirt

NOTICE OF OPPOSITION

RE/MAX International, Inc., a Colorado corporation, located and doing business at 8390 East Crescent Parkway, Suite 600, Greenwood Village, Colorado 80111 (hereinafter "Opposer") believes that it will be damaged by the registration of REFILE, a mark sought to be registered through U. S. Service Mark Application Serial No. 78/314,798, filed on October 16, 2003, by RE3W Worldwide Limited, a company organized under the laws of the British Virgin Islands (hereinafter "Applicant"), and Opposer hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is a major, well-established company that provides real estate brokerage services throughout the United States through a network of franchisees, sub-franchisors and

affiliated sales agents who are authorized to use Opposer's registered service marks in connection with real estate brokerage services ("Opposer's Affiliates").

2. Opposer, since at least as early as 1974, has provided real estate brokerage services in interstate commerce through brokerage offices owned and operated by it and, since at least as early as 1977, through Opposer's Affiliates, all in connection with its distinctive registered service marks, "REMAX" and "RE/MAX". Opposer is the owner of U.S. Trademark Registration Nos. 1,139,014; 1,339,510; 2,403,626; and 2,468,858 for its mark "RE/MAX," and the owner of U.S. Trademark Registration Nos. 2,106,387 and 2,054,698 for its service mark "REMAX." (Exhibit A).

3. The common law and federal registration rights of RE/MAX are collectively referred to as the "RE/MAX Marks."

4. The RE/MAX Marks are used on a variety of advertising media including yard signs, business cards, newspapers and other print media, directional signs, open house signs, hot and cold air balloons, television commercials, billboards, bus stop benches, transit buses, moving vans, banners, brochures, coffee mugs and other advertising and promotional items.

5. Since at least as early as 1974, Opposer and Opposer's Affiliates have invested over two billion dollars to develop, promote and maintain the RE/MAX Marks in the United States and worldwide. More specifically, Opposer's Affiliates have used the RE/MAX Marks in connection with over nine million home sale transactions in the United States and worldwide, resulting in over one trillion dollars in sales volume from as early as 1974 to present date.

6. As a result of substantial sales and extensive advertising and promotion, the RE/MAX Marks have become widely and favorably known as identifying real estate brokerage services originating from, sponsored by or associated with Opposer. Indeed, the RE/MAX Marks are

famous. The public has to associate the RE/MAX Marks as a source of high quality real estate brokerage services.

7. Applicant filed U.S. Trademark Application Serial No. 78/314,798 on October 16, 2003, seeking to register REFILE as a trademark in connection with "computer services, namely, providing information concerning real estate and real estate transactions via the Internet" in International Class 36 and "providing temporary use of on-line non-downloadable computer software for use in searching and retrieving information, sites, and other resources concerning real estate on computer networks; providing temporary use of on-line non-downloadable computer software for use as a directory of real estate information, real estate sites, and resources which are available on computer networks" in International Class 42.

8. Applicant's mark, REFILE, when used in connection with the goods identified in Application Serial No. 78/314,798 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship, or approval of Applicant's goods, services or other commercial activities.

9. Opposer's RE/MAX name and the RE/MAX Marks are of sufficient fame and reputation among consumers that, when Applicant's REFILE mark is used in connection with the goods set forth in Applicant's Application, a false connection with Opposer will be presumed by consumers.

10. Applicant's REFILE mark, when used in connection with the goods identified in Application Serial No. 78/314,798, is likely to dilute the distinctive quality of Opposer's famous RE/MAX Marks.

11. Applicant's use of REFILE for the services set forth in Application Serial No. 78/314,798 is not authorized by Opposer.

12. The registration of Applicant's REFILE mark 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 INTERNATIONAL, INC. prays that this opposition be sustained, that U.S. Service Mark Application Serial No. 78/314,798 for REFILE be rejected, and that registration by Applicant be refused and denied.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

The Director is hereby authorized to charge the \$300.00 fee to Deposit Account No. 502775. If there are any additional fees due, the Director is hereby authorized to charge such additional fees to Deposit Account No. 502775.

Respectfully submitted this 25th day of May, 2005.

GREENBERG TRAURIG, LLP

By: Shelley K. Barton

John R. Posthumus
Gayle L. Strong
Shelley K. Barton
1200 17th Street, Suite 2400
Denver, Colorado 80202
(303) 572-6500

ATTORNEYS FOR OPPOSER

EXHIBIT A



Nº 1139014

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

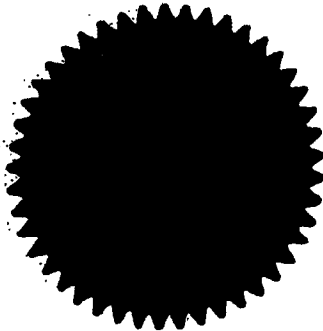
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-sixth day of August, 1980.

Silvery H. Diamond

COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is still in use or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$10.00 for each class must accompany the affidavit.

Int. Cls.: 35 and 36

Prior U.S. Cl.: 101

Reg. No. 1,139,014

Registered Aug. 26, 1980

United States Patent and Trademark Office

SERVICE MARK

Principal Register

RE/MAX

**Re/Max of America, Inc. (Colorado corporation)
5555 S. Trenton Way
Englewood, Colo. 80110**

**For: RENDERING TECHNICAL AID AND ASSIST-
ANCE TO OTHERS IN THE ESTABLISHMENT AND
OPERATION OF A REAL ESTATE BROKERAGE
AGENCY, in CLASS 35 (U.S. CL. 101).**

First use Jan. 30, 1973; in commerce Jun. 1, 1973.

**For: REAL ESTATE BROKERAGE SERVICES, in
CLASS 36 (U.S. CL. 101).**

First use Jan. 30, 1973; in commerce Jun. 1, 1973.

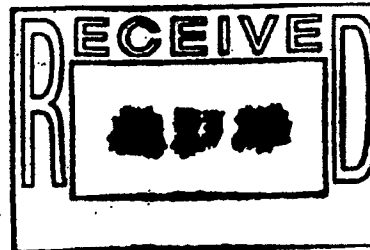
Ser. No. 113,283. Filed Jan. 21, 1977.

MARC BERGSMAN, Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
 2900 Crystal Drive
 Arlington, Virginia 22202-3513

REGISTRATION NO: 1139014 SERIAL NO: 73113283 MAILING DATE: 07/09/2001
 REGISTRATION DATE: 08/26/1980
 MARK: RE/MAX
 REGISTRATION OWNER: RE/MAX INTERNATIONAL, INC.
 CORRESPONDENCE ADDRESS:



GARY L. WEIL, ESQ.
 RE/MAX INTERNATIONAL, INC.
 8390 EAST CRESCENT PARKWAY
 SUITE 600
 GREENWOOD VILLAGE, CO 80111-2800

NOTICE OF ACCEPTANCE
 15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL
 15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
 035 036.

HENSON, EVERETT J
 PARALEGAL SPECIALIST
 POST-REGISTRATION DIVISION
 (703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION



Nº 1339510

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

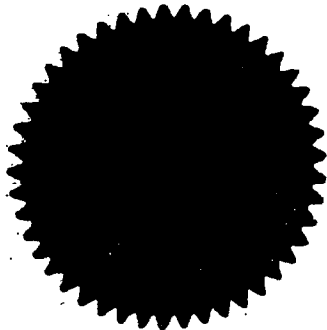
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this fourth day of June, 1985.

A handwritten signature in cursive script, reading "Ronald J. Figg".

Acting Commissioner of Patents and Trademarks

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office **Reg. No. 1,339,510**
Registered June 4, 1985

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

**RE/MAX OF AMERICA, INC. (COLORADO
CORPORATION)
5251 S. QUEBEC
ENGLEWOOD, CO 80111**

**FOR: INSURANCE BROKERAGE SERVICES,
IN CLASS 36 (U.S. CL. 102).**

**FIRST USE 4-1-1980; IN COMMERCE
4-1-1980.
OWNER OF U.S. REG. NO. 1,139,014.**

SER. NO. 510,503, FILED 11-26-1984.

SHARON R. MARSH, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,403,626

Registered Nov. 14, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

**RE/MAX INTERNATIONAL, INC. (COLORADO COR-
PORATION)
8390 EAST CRESCENT PARKWAY, SUITE 600
GREENWOOD VILLAGE, CO 80111**

**FOR: PROVIDING A WEBSITE ON GLOBAL COM-
PUTER NETWORKS FEATURING INFORMATION IN
THE FIELD OF REAL ESTATE, IN CLASS 36 (U.S.
CLS. 100, 101 AND 102).**

**FIRST USE 8-1-1995; IN COMMERCE 8-1-1995.
OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607
AND OTHERS.**

SER. NO. 75-712,611, FILED 5-24-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



A handwritten signature in cursive script, appearing to read "J. Ford".

Director of the United States Patent and Trademark Office

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,468,858

United States Patent and Trademark Office

Registered July 17, 2001

**TRADEMARK
PRINCIPAL REGISTER**

RE/MAX

RE/MAX INTERNATIONAL, INC. (COLORADO CORPORATION)
8390 EAST CRESCENT PARKWAY
SUITE 600
GREENWOOD VILLAGE, CO 80111

FOR: COMPUTER SOFTWARE, NAMELY A CD ROM THAT ENABLE USERS TO ASK FOR AND RECEIVE BUSINESS INFORMATION IN THE NATURE OF OFFICE ADDRESSES, PHONE AND FACSIMILE NUMBERS, AS WELL AS LANGUAGES SPOKEN BY, AND PRIMARY REAL ESTATE SPECIALIZATION OF, INDIVIDUAL REAL ESTATE AGENTS; CD ROM ACCOUNTING AND BILLING SOFTWARE; A CD ROM MULTIMEDIA HOME LISTING PRESENTATION THAT PROVIDES INFORMATION ON MARKETING STRATEGIES FOR PROPERTY, WITH CALENDARING AND PROPERTY COMPARISON FEATURES; A CD ROM THAT PROVIDES INFORMATION ON CRIME STATISTICS, EDUCATIONAL OPPORTUNITIES, AND OTHER DEMOGRAPHIC INFORMATION REGARDING NEIGHBORHOODS THROUGHOUT

THE UNITED STATES: AN INFORMATIONAL CD ROM ON HOW TO RECRUIT REAL ESTATE AGENTS; AN INFORMATIONAL CD ROM ON HOW TO ENHANCE PRODUCTIVITY OF REAL ESTATE AGENTS WHICH ENABLES A USER TO SCHEDULE AND CALENDAR EVENTS, AND TRACK CONTACTS AND HOME LISTING INFORMATION IN DATABASES; AND A CD ROM WITH CALENDARING AND TRACKING FEATURES THAT PROVIDES INFORMATION ON HOW TO OPERATE AND MANAGE A REAL ESTATE OFFICE; ALL IN THE REAL ESTATE INDUSTRY, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 3-1-1989; IN COMMERCE 3-1-1989.

OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607 AND OTHERS.

SER. NO. 75-702,664, FILED 5-10-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

The United States of America



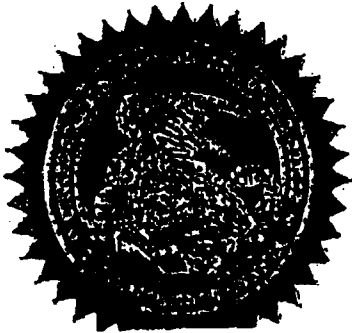
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A copy of the Mark and pertinent data from the application are part of this certificate.

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Nicholas P. Erdici

Acting Director of the United States Patent and Trademark Office

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,106,387

United States Patent and Trademark Office

Registered Oct. 21, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
5445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80155

FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.

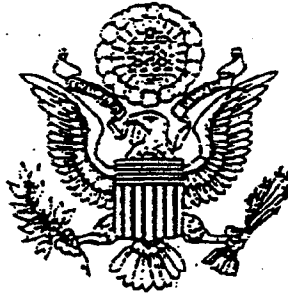
OWNER OF U.S. REG. NO. 1,339,510.

SER. NO. 75-068,799, FILED 3-7-1996.

FOR: REAL ESTATE BROKERAGE SERV-
ICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

RUSS HERMAN, EXAMINING ATTORNEY

The United States of America



**CERTIFICATE OF REGISTRATION
PRINCIPAL REGISTER**

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

The United States of America



**CERTIFICATE OF REGISTRATION
PRINCIPAL REGISTER**

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A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,054,698

United States Patent and Trademark Office

Registered Apr. 22, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

**RE/MAX INTERNATIONAL INC. (COLORADO
CORPORATION)
3445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80111**

**FOR: FRANCHISE SERVICES, NAMELY, OF-
FERING TECHNICAL ASSISTANCE IN THE
ESTABLISHMENT AND/OR OPERATION OF
REAL ESTATE BROKERAGE FIRMS. IN
CLASS 35 (U.S. CLS. 100, 101 AND 102).**

**FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.**

**OWNER OF U.S. REG. NOS. 1,139,014 AND
1,173,586.**

SER. NO. 75-068,927, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY