

ESTTA Tracking number: **ESTTA85265**

Filing date: **06/14/2006**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Opus Corporation		
Entity	Corporation	Citizenship	Minnesota
Address	10350 Bren Road West Minnetonka, MN 55343 UNITED STATES		

Name	Opus Northwest Construction Corporation		
Entity	Corporation	Citizenship	Minnesota
Address	10350 Bren Road West Minnetonka, MN 55343 UNITED STATES		

Name	Opus South Corporation		
Entity	Corporation	Citizenship	Florida
Address	4200 West Cypress Street Suite 444 Tampa, FL 33607 UNITED STATES		

Name	Opus Architects & Engineers, Inc.		
Entity	Corporation	Citizenship	Minnesota
Address	10350 Bren Road West Minnetonka, MN 55343 UNITED STATES		

Attorney information	Kristin L.C. Haugen Briggs and Morgan, P.A. 2200 IDS Center 80 South Eighth Street Minneapolis, MN 55402 UNITED STATES khaugen@briggs.com Phone:612.977.8474		
----------------------	---	--	--

Applicant Information

Application No	78707317	Publication date	05/16/2006
Opposition Filing Date	06/14/2006	Opposition Period Ends	06/15/2006
Applicant	Opustone, LLC 3200 NW 77th Court Miami, FL 33122 UNITED STATES		

Goods/Services Affected by Opposition

Class 035.

All goods and services in the class are opposed, namely: Retail store services featuring natural stone tiles, marble slabs, sinks, pavers, coping, stone sealers, glass tiles, tables, columns, statues, doors

Attachments	OPUSTONE_-_Notice_of_Opposition.pdf (6 pages)(20410 bytes)
Signature	/KLCH/
Name	Kristin L.C. Haugen
Date	06/14/2006

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

In re Application Serial No.	:	78707317
For the Mark	:	OPUSTONE
Filed	:	September 6, 2005
Published in the Trademark Official Gazette on	:	May 16, 2006

Opus Corporation,
Opus Northwest Construction Corporation,
Opus South Corporation, and
Opus Architects & Engineers, Inc.,

Opposers,

v.

Opustone, LLC,

Applicant.

Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

Opus Corporation ("Opus"), Opus Northwest Construction Corporation ("Opus Northwest"), Opus South Corporation ("Opus South"), and Opus Architects & Engineers, Inc. ("Opus A&E") and their affiliates (collectively, "Opposer") believe, in good faith, that they will be damaged by registration of the mark shown in the above-identified application ("Application"), and hereby oppose the registration.

Opposer's grounds for opposition are as follows:

1. Opus is a Minnesota corporation with its principal place of business at 10350 Bren Road West, Minnetonka, Minnesota 55343. Opus Northwest is a Minnesota corporation and wholly owned subsidiary of Opus, with its principal place of business at 10350 Bren Road West, Minnetonka, Minnesota 55343. Opus South is a Florida corporation with its principal place of business at 4200 West Cypress Street, Suite 444, Tampa, Florida 33607. Opus A&E is a Minnesota corporation with its principal place of business at 10350 Bren Road West, Minnetonka, Minnesota 55343.

2. Pursuant to 15 U.S.C. § 1055, the use of the OPUS Marks by any and all related companies inures to the benefit of the registrant, Opus Northwest.

3. Opus Northwest owns the federally registered mark OPUS, Registration No. 1,262,651, dated December 27, 1983 (the "OPUS Word Mark"), registered in connection with leasing, purchasing, selling and managing land and buildings for others; construction services, namely, constructing commercial, residential, governmental, and industrial buildings for others; and architectural, engineering and design services (in international classes 36, 37 and 42, respectively). Opus first used the OPUS Word Mark in 1975 and has used it continuously since then.

4. Opus Northwest owns the federally registered mark OPUS plus hexagonal design (the "OPUS Design Mark"), Registration No. 2,520,075, dated December 18, 2001, registered in connection with managing and leasing real property, namely, land and commercial, industrial and professional complexes to and for others; real estate investment; real estate brokerage; construction services in the field of building commercial, industrial and professional complexes for others; real estate development; and architectural and engineering consulting services,

namely, designing land developments and building improvements including commercial, industrial and professional complexes (in international classes 36, 37 and 42, respectively). Opus first used the OPUS Design Mark in 1989 and has used it continuously since then.

5. Opus Northwest licenses the OPUS Word Mark and the OPUS Design Mark (collectively, the "Registered OPUS Marks") to Opus, Opus South, Opus A&E and other affiliates of Opus Northwest for use throughout the United States.

6. Opposer sells a full range of integrated services across the United States under the Registered OPUS Marks, including real estate development, architecture and engineering, construction, property management, financing, leasing and sales services. Its construction projects include industrial, institutional, office, retail and residential developments. Opposers' services include without limitation the design of interior and exterior spaces and the selection and installation of appropriate construction materials therefor including, but not limited to, natural stone tiles, marble slabs, sinks, pavers, coping, stone sealers, glass tiles, columns, statues and doors.

7. Opposer has used the trade name "OPUS" since approximately June, 1982.

8. Opposer owns the domain name opuscorp.com.

9. Commencing long prior to the filing date of Applicant's Application, Opposer has prominently used, and is now using, Opposer's Registered OPUS Marks. Opposer has extensively advertised, promoted and offered Opposer's services under the Registered OPUS Marks to the public through various channels of trade and commerce with the result that Opposer's customers and the public in general have come to know and recognize Opposer's Registered OPUS Marks and associate the same with Opposer and services offered by Opposer.

Opposer's Registered OPUS Marks have thus attained significant good will and Opposer has acquired substantial common law rights in the mark OPUS and the trade name OPUS.

10. Upon information and belief, Opposer alleges that any use of the alleged OPUSTONE mark by Applicant occurred long after Opposer's adoption and continuous use and registration of Opposer's OPUS Word Mark. Applicant, therefore, knew or should have known of Opposer's OPUS Word Mark.

11. Applicant's proposed mark is substantially similar to Opposer's Registered OPUS Marks. Specifically, Applicant's proposed mark is identical to Opposer's OPUS Word Mark with the mere addition of the descriptive word, STONE. Likewise, Applicant's proposed mark is identical to the word component of Opposer's OPUS Design Mark with the mere addition of the descriptive word, STONE.

12. The services that are recited in the Application, i.e., retail store services featuring natural stone tiles, marble slabs, sinks, pavers, coping, stone sealers, glass tiles, columns, statues and doors are all services related to construction. The same or similar construction services are provided by Opposer.

13. The services that are recited in the Application, namely construction material services, are related to services recited in the Registered OPUS Marks; e.g., construction services.

14. Applicant's proposed mark is likely to be confused with Opposer's Registered OPUS Marks because the word marks are substantially identical and the services are the same, similar or related services.

15. Applicant's proposed mark is likely to be confused with Opposer's common law service mark and trademark rights in the mark OPUS for real estate development, architecture and engineering, construction, property management, financing, leasing and sales services.

16. Applicant's proposed mark is likely to be confused with Opposer in that the proposed mark is substantially identical to Opposer's trade name, the use of which in the United States occurred long before the filing date of the Application or the alleged first use date in the Application.

17. Opposer, upon information and belief, avers that its customers and the public in general are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's services rendered under Applicant's service mark, and misled into believing that such goods and services are rendered by, emanate from or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

18. According rights of federal registration to the mark that is the subject of the Application is inimical to the superior rights of the Opposer to use the mark in connection with the same, similar or related services.

Dated: _____

BRIGGS AND MORGAN, P.A.

By _____
John B. Lunseth, II (#065341)
Kristin L.C. Haugen (#276170)

2200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402
Telephone: (612) 977-8400
Facsimile: (612) 977-8650

ATTORNEYS FOR OPPOSERS
OPUS CORPORATION, OPUS
NORTHWEST CONSTRUCTION
CORPORATION, OPUS SOUTH
CORPORATION AND OPUS
ARCHITECTS & ENGINEERS, INC.