

ESTTA Tracking number: **ESTTA513362**

Filing date: **12/28/2012**

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	RPM International Inc.
Granted to Date of previous extension	01/09/2013
Address	2628 Pearl Road Medina, OH 44256 UNITED STATES
Attorney information	Juliet P. Castrovinci Calfee, Halter & Griswold LLP The Calfee Building 1405 East Sixth Street Cleveland, OH 44114-1607 UNITED STATES ipdocket@calfee.com Phone:216-622-8200

Applicant Information

Application No	85589025	Publication date	09/11/2012
Opposition Filing Date	12/28/2012	Opposition Period Ends	01/09/2013
Applicant	RPM Radiant Corp 1519 132nd St SE Suite C-304 Everett, WA 98208 UNITED STATES		

Goods/Services Affected by Opposition

Class 019. First Use: 2011/02/10 First Use In Commerce: 2011/02/10 All goods and services in the class are opposed, namely: Construction materials, namely, non-metal flooring materials


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. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	RPM		
Goods/Services	Non-metal flooring products, including but not limited to specialty coatings, sealants, fiberglass mats and gratings, decorative concrete products and other construction materials.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	RPM INTERNATIONAL		
Goods/Services	Non-metal flooring products, including but not limited to specialty coatings, sealants, fiberglass mats and gratings, decorative concrete products and other construction materials.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	Non-metal flooring products, including but not limited to specialty coatings, sealants, fiberglass mats and gratings, decorative concrete products and other construction materials.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	Non-metal flooring products, including but not limited to specialty coatings, sealants, fiberglass mats and gratings, decorative concrete products and other construction materials.

Attachments	RPM Logo B&W.JPG AN RPM COMPANY Logo.JPG 01803902.PDF (9 pages)(84380 bytes)
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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	/Juliet P. Castrovinci/
Name	Juliet P. Castrovinci
Date	12/28/2012

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

In the matter of application Serial No. 85/589,025
Published in the Official Gazette on September 11, 2012

RPM INTERNATIONAL INC.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
RPM RADIANT CORP.,	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

RPM International Inc., a corporation organized under the laws of the State of Delaware, and having an office at 2628 Pearl Road, Medina, Ohio 44256 (“Opposer”), believes that it will be damaged by registration of the mark “RPM and Design” (the “Opposed Mark”) requested in the application of RPM Radiant Corp. fka TRG Floors Inc. (“Applicant”) having Serial No. 85/589,025 (the “’025 Application”) and hereby opposes registration of the Opposed Mark.

As grounds of opposition, Opposer states that:

1. Through its own efforts as well as the efforts of related companies and/or their predecessors-in-interest, Opposer has developed a valuable common law trade identity for itself and its wholly-owned subsidiaries that is represented by trade designations that are composed of wholly or predominately by the term “RPM” and this identity was established well before any potential claim of priority by Applicant in the Opposed Mark.

2. Opposer is the ultimate parent entity of a number of wholly owned subsidiary operating companies that are in the business of manufacturing and distributing a wide variety of

products that have residential, commercial and/or industrial application, including but not limited to specialty coatings, sealants, construction materials and related products.

3. One of Opposer's subsidiaries was incorporated in 1947 as "Republic Powdered Metals, Inc."

4. Starting in 1947 and for many years afterwards, the term "RPM" and/or the corporate name "RPM, Inc." appeared prominently and/or in a trademark fashion on one or more of the products of Republic Powdered Metals, Inc.

5. Starting in 1947, Republic Powdered Metals, Inc. commonly referred to itself and was referred to as others as "RPM" or "RPM, Inc."

6. Starting in the 1960s, Republic Powdered Metals, Inc. embarked on a strategy of growth by acquisition, a strategy that continues today and which has resulted in Opposer currently having numerous subsidiary operating companies with a total of more than eighty manufacturing facilities in a total of twenty countries. Opposer has grown both by acquiring companies (or some or all of the assets thereof) in businesses competitive or related to the businesses of its existing subsidiaries, as well as companies in product market areas new to Opposer.

7. An entity named RPM, Inc. was formed in 1971 to serve as a holding company for the collection of business acquired by Republic Powdered Metals, Inc. and served as the ultimate parent entity of numerous operating companies until 2002.

8. Opposer was incorporated under the corporate name RPM International Inc. in 2002 as part of a corporate reorganization of various companies at the time owned by RPM, Inc., which became a subsidiary of Opposer and was subsequently renamed.

9. Opposer is and has been widely and well-known in the relevant marketplaces as, commonly refers to itself as, and is commonly referred to by others as “RPM” and/or, since 2002, “RPM International.”

10. With the permission and encouragement of Opposer and, before Opposer came into being, with the permission and encouragement of first Republic Powdered Metals, Inc. and later RPM, Inc., each and every subsidiary of Opposer that is an operating company has for many years held itself out as and currently holds itself out publicly as “an RPM Company.” This is accomplished in a variety of ways. For example, the most immediately apparent way is that the “an RPM Company” Logo (the “RPM Designation”) appears on the vast majority of the products offered for sale by the operating companies. Also, the homepages or “about us” pages of many of the operating companies include statements that the companies are “subsidiaries of RPM International Inc.” and many include either the RPM Designation or some other stylized “RPM” logo.

11. Opposer currently has a number of subsidiary holding companies, including but not limited to several that specifically incorporate the term “RPM” into their official corporate name, including but not limited to “RPM Building Solutions Group, Inc.” (“RPM Building Solutions Group”) and “RPM Performance Coatings, Inc.” (“RPM Performance Coatings Group”). In addition to holding themselves out as “RPM Companies,” the operating subsidiaries falling into either the RPM Building Solutions Group and the RPM Performance Coatings Group often hold themselves out as members of one of those groups, which further establishes their identity as “RPM Companies.”

12. Opposer also has an operating subsidiary known as RPM Wood Finishes Group, Inc.

13. Opposer's operating subsidiaries offer for sale and sell a wide variety of products, including but not limited to many products that have residential, commercial and/or industrial flooring applications. For example, Fibergrate Composite Structures Incorporated, a member of the RPM Performance Coatings Group, manufactures and distributes fiberglass reinforced plastic products, including but not limited to grating products that have flooring applications such as mats and platforms. Also, the Increte Systems division of The Euclid Chemical Company, a member of the RPM Building Solutions Group, manufactures and distributes decorative concrete products, including but not limited to products that have flooring applications such as decorative patio or basement floors. Other operating subsidiaries, such as DAP Products, Inc. and Rust-Oleum Corporation, manufacture and distribute a variety of coatings, sealants or related products that have flooring applications.

14. Many of Opposer's operating subsidiaries are and have been for many years active participants in the construction materials business and collectively these subsidiaries currently own dozens of U.S. trademark registrations that cover a variety goods in International Class 019, which is the classification in which non-metallic building materials are classified by the United States Patent and Trademark Office for registration purposes.

15. The net sales of Opposer's operating subsidiaries has been in excess of \$3,000,000,000 every year since 2006, in excess of \$2,000,000,000 in 2004-2005 and in excess of \$1,900,000,000 in 2002.

16. As a result of significant success and recognition in the a variety of relevant marketplaces, including but not limited to the specialty coatings, sealants and construction materials marketplace, Opposer, through its own efforts and the efforts of its wholly-owned

subsidiaries, has developed for itself and its subsidiaries a valuable and well known trade identity as “RPM” and/or, since 2002, “RPM International.”

17. One of Opposer’s operating subsidiaries is an entity known as Radiant Color NV.

18. As recently as early 2011, Opposer acquired a group of companies operating under the name Legend Brands. The corporate headquarters for Legend Brands is in Burlington, Washington, which is less than fifty miles from the main address of Applicant as given in the application that is the subject of this opposition proceeding. All of the Legend Brands companies now hold themselves out as “RPM Companies.”

19. Applicant is the of-record owner of U.S. Trademark Registration No. 3,762,088, which covers the standard character mark RPM in International Class 019 for “construction materials, namely, non-metal backer board for the installation of mats used with electric radiant heat cable and wiring” (the “’088 Registration”). The application that matured into the ‘088 Registration was filed on May 6, 2008 at a time when Applicant was named TRG Floors, Inc. The ‘088 Registration issued on March 23, 2010 based on a claimed first use date of September 1, 2006. The ‘088 Registration is the subject of a cancellation proceeding being commenced by Opposer contemporaneously with the above-captioned opposition proceeding.

20. Applicant changed its name from TRG Floors, Inc. to RPM Radiant Corp. on or about March 19, 2012, shortly before filing the ‘025 Application.

21. Applicant filed the ‘025 Application on April 4, 2012. In the ‘025 Application, Applicant requests registration of the Opposed Mark in International Class 019 for “construction materials, namely, non-metal flooring materials,” which is a broader category of goods than the goods identified in the ‘088 Registration.

22. The '025 Application was made pursuant to Section 1(a) and is based on a claimed first use date of February 10, 2011.

23. The '025 Application was published in the Official Gazette on September 11, 2012, and Opposer timely and properly obtained an extension of time to oppose through January 9, 2013.

24. On information an belief, there is no issue as to priority vis-à-vis the Opposed Mark and the common law trade identity rights relied on by Opposer as the basis of opposition inasmuch as Applicant's earliest claim of use of the Opposed Mark is February 10, 2011, which almost ten years after the formation of Opposer, forty years after the formation of RPM, Inc. and almost sixty-five years after the formation of Republic Powdered Metals, Inc. Similarly, the earliest priority date that Applicant can claim is the April 4, 2012 filing date for the '025 Application, which affords Applicant even less priority than its claimed first use date.

25. The dominant element of the Opposed Mark is the term "RPM," which is identical in all respects to the dominant element of the trade identity of Opposer as well as the RPM Designation used by the operating subsidiaries doing business in the flooring and other construction materials industries to designate their status as RPM Companies.

26. On information and belief, Opposer's trade identity of RPM and the Opposed Mark are likely to create the same or at least a highly similar commercial impression amongst potential purchasers of flooring and other construction materials.

27. On information and belief, the flooring and other construction materials offered for sale and sold by one or more of Opposer's operating subsidiaries are subsumed within the category of goods identified in the '025 Application -- non-metal flooring materials-- and as a

result, the goods of the respective parties for purposes of this proceeding are identical and/or are closely related.

28. Inasmuch as Applicant has not included a channel of trade restriction in the goods identification in the '025 Application, the non-metal flooring materials that are the subject of the application must be assumed to travel through all of the ordinary channels of trade for such products, including but not limited to the channels of trade through which the flooring and other construction material products of Opposer's subsidiaries travel.

29. On information and belief, the prospective purchasers and/or end-users of non-metal flooring products overlap significantly with the prospective purchasers and/or end-users of the flooring and other construction material products of one or more of Opposer's operating subsidiaries.

30. On information and belief, the circumstances surrounding the marketing of non-metal flooring materials are such that such goods are likely to be encountered by the same potential purchasers and/or end users that are targeted by one or more of Opposer's operating subsidiaries, thus likely giving rise to the mistaken belief that they emanate from the same source.

31. On information and belief, Applicant's registration and use of the Opposed Mark for the goods specified in the '025 Application will damage Opposer by creating a likelihood of confusion as to the source, origin or sponsorship of Applicant's non-metal flooring material products and the flooring and other construction material products of one or more of Opposer's subsidiaries among potential purchasers and/or end-users of the goods of both parties.

32. On information and belief, Applicant's registration and use of the Opposed Mark for the goods specified in the '025 Application will damage Opposer by creating among potential

purchasers and/or end-users of the goods of both parties a likelihood of confusion as to the affiliation, connection or association Applicant with Opposer (or one or more of its wholly owned subsidiaries) or as to the origin, sponsorship or approval of Applicant's goods, services or commercial activities by Opposer (or one or more of its wholly owned subsidiaries) subsidiaries.

33. If Applicant is granted a registration for the Opposed Mark as a result of the '025 Application, Applicant will obtain at least a prima facie exclusive right to the use of RPM and Design as a mark throughout the United States in connection with the goods identified in the '025 Application. Such registration would damage and injure Opposer by hampering the expansion of use of the RPM trade identity of Opposer and its operating subsidiaries.

WHEREFORE, Opposer prays that the Opposition be sustained and registration of the Opposed Mark be refused to Applicant.

Respectfully submitted,

Dated: December 28, 2012

/Juliet P. Castrovinci/
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Attorney of Record for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served on the correspondent of record as indicated in the records of the U.S. Patent and Trademark Office by mailing a true copy thereof by regular mail, postage prepaid, this 28th day of December, 2012, in envelopes addressed as follows:

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