

ESTTA Tracking number: **ESTTA634771**

Filing date: **10/23/2014**

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	Basement Specialists, Inc.		
Entity	Corporation	Citizenship	Wisconsin
Address	4335 S. 114th Street Greenfield, WI 53228 UNITED STATES		

Correspondence information	Linda C. Emery von Briesen & Roper, s.c. 411 East Wisconsin Avenue Suite 1000 Milwaukee, WI 53202 UNITED STATES lemery@vonbriesen.com Phone:4142871274
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### Applicant Information

Application No	86219172	Publication date	10/07/2014
Opposition Filing Date	10/23/2014	Opposition Period Ends	11/06/2014
Applicant	Basement Repair Specialists LLC 2194 S Memorial Dr. Appleton, WI 54915 UNITED STATES		

### Goods/Services Affected by Opposition

Class 037. First Use: 2010/01/25 First Use In Commerce: 2010/01/25  
All goods and services in the class are opposed, namely: Building construction and repair; Foundation contractor services; Repair of basement walls and foundations

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86277348	Application Date	05/09/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BASEMENT SPECIALISTS		

Design Mark	<b>Basement Specialists</b>
Description of Mark	NONE
Goods/Services	Class 037. First use: First Use: 1981/01/01 First Use In Commerce: 1981/01/01 Reinforcement, waterproofing and repairing of basement foundations

Attachments	86277348#TMSN.png( bytes ) 2014-10-23 Notice of Opposition.PDF(202536 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	/LCE/
Name	Linda C. Emery
Date	10/23/2014

1. Opposer has offered its basement foundation reinforcement, waterproofing, and repair services under the mark “BASEMENT SPECIALISTS” (“Senior Mark”) since at least as early as 1981.
2. Opposer has openly and continuously used the Senior Mark in connection with its services since at least as early as 1981, and has built up substantial goodwill in its Senior Mark.

3. Opposer owns a pending trademark application filed on May 9, 2014 for the Senior Mark “BASEMENT SPECIALISTS,” Serial No. 86277348, for use in connection with “Reinforcement, waterproofing and repairing of basement foundations,” in Class 37.

4. Applicant seeks to register the mark “BASEMENT REPAIR SPECIALISTS, LLC (and DESIGN)” (“Junior Mark”) as a mark for the following services: “Building construction and repair; foundation contractor services; repair of basement walls and foundations.”

5. On information and belief, Applicant filed its application for the Junior Mark on March 12, 2014, under Section 1(a) of the Lanham Act, claiming a date of first use of January 25, 2010.

6. Applicant’s applied-for Junior Mark is confusingly similar to Opposer’s Senior Mark.

7. Applicant’s application is for services that are identical, highly related, and/or overlapping to Opposer’s services.

8. Opposer has been using the Senior Mark in the United States in connection with basement foundation reinforcement, waterproofing and repair services since at least as early as 1981, a date prior to any priority date to which Applicant is entitled.

9. Opposer’s use of the Senior Mark has been valid and continuous since its date of first use and has not been abandoned. Opposer’s Senior Mark is symbolic of the extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in promotion of its services.

10. In view of the fact that both the word portion of the parties' respective marks and the parties' services are highly similar, Applicant's Junior Mark so resembles Opposer's Senior Mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive the public into believing that Applicant's services originate from, or are in some way sponsored by, licensed by, associated with or otherwise authorized by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C.A. § 1052(d), resulting in damage and injury to Opposer.

11. If Applicant is granted the registration for the Junior Mark herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its Junior Mark. Such registration would be a further source of damage and injury to Opposer, and would likely stand in the way of Opposer's good faith attempt to register its Senior Mark "BASEMENT SPECIALISTS."

12. In view of the above, Applicant is not entitled to federal registration of its alleged Junior Mark "BASEMENT REPAIR SPECIALISTS, LLC (and DESIGN)," as Opposer has priority of use of the "BASEMENT SPECIALISTS" Senior Mark in commerce in connection with identical, highly related and/or overlapping services.

13. By reason of all the foregoing, Opposer will be gravely damaged by the registration of Applicant's Junior Mark.

WHEREFORE, Opposer, Basement Specialists, Inc., by its undersigned attorney, respectfully requests that this Notice of Opposition be sustained and that registration of the mark "BASEMENT REPAIR SPECIALISTS, LLC (and DESIGN)", Serial No. 86219172, be refused.

Respectfully submitted,



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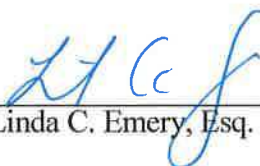
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Dated: October 23, 2014

### **CERTIFICATE OF ELECTRONIC FILING**

I hereby certify a copy of this Notice of Opposition is being deposited with the United States Trademark Trial and Appeal Board via electronic submission on October 23, 2014.

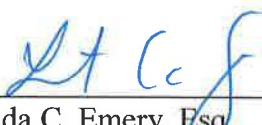
  
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Linda C. Emery, Esq.

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION is being deposited with the United States Postal Service with sufficient postage as first class mail this 23rd day of October, 2014, in an envelope addressed to Applicant's counsel of record and Applicant at the following address:

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Dated October 23, 2014