

ESTTA Tracking number: **ESTTA900550**

Filing date: **06/01/2018**

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	RELIN AMERICA, INC.
Granted to Date of previous extension	06/02/2018
Address	24024 Frederick Road Clarksburg, MD 20871 UNITED STATES
Correspondence information	John L. Welsh WELSH FLAXMAN & GITLER LLC 2000 Duke St, Suite 100 Alexandria, VA 22314 UNITED STATES Email: mail@iplawsolutions.com, welsch@iplawsolutions.com Phone: 7039201122

Applicant Information

Application No	79217700	Publication date	04/03/2018
Opposition Filing Date	06/01/2018	Opposition Period Ends	06/02/2018
International Registration No.	1368002	International Registration Date	02/28/2017
Applicant	SML VERWALTUNGS GMBH Grosse Ahlmeile 31 76865 Rohrbach FED REP GERMANY		

Goods/Services Affected by Opposition

<p>Class 001. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Chemicals used in industry, science, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; tempering and soldering chemicals for metals; adhesives used in industry; chemicals for sewer remediation, soil consolidation and for building construction all included in this class; chemical sealing preparations, namely, chemical compounds of adhesives and fillers for repairing seals all included in this class</p>
<p>Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Machines and machine tools for sewer remediation, soil consolidation and building construction; mechanical devices for pipeline remediation; mechanical installations and apparatus for sewer inspection, sewer remediation and soil consolidation; motors and engines except for land vehicles; machine coupling and transmission components except for land vehicles</p>
<p>Class 017. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Raw or partly processed rubber, gutta-</p>

percha, raw or partly processed gum, asbestos, and mica; products in semi-processed plastic materials, namely, plastics in extruded form for use in manufacture; packing and insulating materials; stopping materials, namely, sealing materials; flexible pipes, not of metal

Class 019. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Building materials, namely, non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings

Class 037. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Building construction; repair, in particular remediation of sewers, pipes, drains, shafts and house connection pipes; services in the field of sewer construction, sewer remediation, soil conditioning all included in this class; sewer cleaning and pipe cleaning; installation services, namely, in relation to ducts, pipes, drains, sewers, shafts and house connections


Class 042. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Scientific and technological services, namely, scientific research in the field of sewer remediation, sewer cleaning and soil consolidation; design and development of computer hardware and software; engineering services; technical consultancy in the fields of sewer remediation, sewer cleaning and soil consolidation; inspection services, namely, leak testing of shafts, buildings, sewer systems; sewer inspection; technical documentation in the field of sewer remediation; technical design and planning of sewerage systems; providing expertise, namely, engineering consulting services in the fields of sewer remediation, sewer cleaning and soil consolidation

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4991821	Application Date	10/01/2015
Registration Date	07/05/2016	Foreign Priority Date	NONE
Word Mark	RELINE AMERICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 2006/12/31 First Use In Commerce: 2006/12/31 Installation of nonmetal liners for rehabilitation of industrial, storm, and sanitary sewer pipes; Rental of construction equipment and installation equipment used in the rehabilitation of industrial, storm, and sanitary sewer pipes; Maintenance and/or repair of equipment used in the rehabilitation of industrial, storm, and sanitary sewer pipes; Technical support services, namely, technical advice related to the installation of nonmetal liners and installation equipment used for rehabilitation of industrial, storm, and sanitary sewer pipes		

	<p>Class 040. First use: First Use: 2006/12/31 First Use In Commerce: 2006/12/31 Custom manufacture of nonmetal liners and installation equipment used for re- habilitation of industrial, storm, and sanitary sewer pipes</p> <p>Class 041. First use: First Use: 2006/12/31 First Use In Commerce: 2006/12/31 Training services in the field of rehabilitation of industrial, storm, and sanitary sewer pipes</p>
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Attachments	86775346#TMSN.png(bytes) opp7504.pdf(133514 bytes) Exhibits7504.pdf(180365 bytes)
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Signature	/jlw/
Name	John L. Welsh
Date	06/01/2018

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

RELINER AMERICA, INC.)	
)	Opposition No.: _____
Opposer,)	
)	
v.)	Serial No.: 79/217,700
)	
SML VERWALTUNGS GMBH,)	Mark: Reline
)	
Applicant.)	
)	

Published in the Official Gazette on April 3, 2018, Opposition date extended to June 2, 2018.

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RELINER AMERICA, INC., a corporation organized under the laws of Maryland, located and doing business at 24024 Frederick Road, Clarksburg, MD 20871, (“Opposer”) believes that it will be damaged by registration of U.S. Trademark Application Serial No. 79/217,700 (the “Application”) for the mark Reline (“Applicant’s Mark”) filed by SML VERWALTUNGS GMBH (“Applicant”) and therefore opposes the same.

As grounds in support of the opposition, Opposer asserts the following:

1. By the Application filed on February 28, 2017, Applicant seeks to obtain registration on the Principal Register of the mark Reline for the following:

“Chemicals used in industry, science, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; tempering and soldering chemicals for metals; adhesives used in industry; chemicals for sewer remediation, soil consolidation and for building construction all included

in this class; chemical sealing preparations, namely, chemical compounds of adhesives and fillers for repairing seals all included in this class” in International Class 001 based on Applicant’s §66(a) claim of a foreign priority date of August 29, 2016;

“Machines and machine tools for sewer remediation, soil consolidation and building construction; mechanical devices for pipeline remediation; mechanical installations and apparatus for sewer inspection, sewer remediation and soil consolidation; motors and engines except for land vehicles; machine coupling and transmission components except for land vehicles” in International Class 007 based on Applicant’s §66(a) claim of a foreign priority date of August 29, 2016;

“Raw or partly processed rubber, gutta-percha, raw or partly processed gum, asbestos, and mica; products in semi-processed plastic materials, namely, plastics in extruded form for use in manufacture; packing and insulating materials; stopping materials, namely, sealing materials; flexible pipes, not of metal” in International Class 017 based on Applicant’s §66(a) claim of a foreign priority date of August 29, 2016;

“Building materials, namely, non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings” in International Class 019 based on Applicant’s §66(a) claim of a foreign priority date of August 29, 2016;

“Building construction; repair, in particular remediation of sewers, pipes, drains, shafts and house connection pipes; services in the field of sewer construction, sewer remediation, soil conditioning all included in this class; sewer cleaning and pipe cleaning; installation services, namely, in relation to ducts, pipes, drains, sewers, shafts and house connections” in International Class 037 based on Applicant’s §66(a) claim of a foreign priority date of August 29, 2016; and

“Scientific and technological services, namely, scientific research in the field of sewer remediation, sewer cleaning and soil consolidation; design and development of computer hardware and software; engineering services; technical consultancy in the fields of sewer remediation, sewer

cleaning and soil consolidation; inspection services, namely, leak testing of shafts, buildings, sewer systems; sewer inspection; technical documentation in the field of sewer remediation; technical design and planning of sewerage systems; providing expertise, namely, engineering consulting services in the fields of sewer remediation, sewer cleaning and soil consolidation” in International Class 042 based on Applicant’s §66(a) claim of a foreign priority date of August 29, 2016.

2. Since at least as early as 1990, long before the August 29, 2016 priority date of the Application, the earliest date upon which Applicant can rely, Opposer has been, and still is, engaged in the business of providing identical goods and services as Applicant under the mark RELINE AMERICA (hereinafter “RELINE AMERICA Mark”).

3. Prior to the priority date of the Application, Opposer has continuously used and promoted its RELINE AMERICA Mark. Opposer’s RELINE AMERICA Mark is the subject of substantial and continuous marketing and promotion by Opposer in connection with its goods and services. Opposer’s goods and services bearing its RELINE AMERICA Mark have been and/or are currently sold or distributed throughout the U.S.

4. Opposer has and continues to widely market and promote its RELINE AMERICA Mark in the industry and to consumers by, for example, displaying the RELINE AMERICA Mark: on its website; at tradeshow; in marketing brochures; on its goods; in industry publications; and on its equipment.

5. By virtue of Opposer’s continuous and substantial use, the RELINE AMERICA Mark has become an identifier of Opposer such that consumers have come to recognize the RELINE

AMERICA Mark with Opposer. As a result, Opposer has built up, at great expense and effort, valuable goodwill in its RELINE AMERICA Mark and has developed strong common law rights in the RELINE AMERICA Mark through extensive use in interstate commerce. Opposer relies on its common law rights in its RELINE AMERICA Mark, which rights predate the priority date of the Application.

6. In addition to Opposer's common law rights, Opposer owns and relies on U.S. Service Mark Registration No. 4,991,821 (the "'821 Registration") for the mark RELINE AMERICA for services identical to Applicant in International Classes 37, 40 and 41, which registration issued July 5, 2016 and is based on an application filed in the United States Patent and Trademark Office ("PTO") on October 1, 2015. The filing date of Opposer's '821 Registration is prior to the priority date of the Application. A true and correct copy of the '821 Registration is attached hereto as Exhibit 1 and made of record.

7. The '821 Registration is valid, subsisting, unrevoked and uncanceled; as such constitutes *prima facie* evidence of the validity of the registered mark and of the registration thereof, and of Opposer's ownership of the mark shown therein. Opposer's registration also constitutes notice to Applicant of Opposer's claim of ownership of the mark shown therein as provided in Sections 7(b), 22 and 33(a) of the Trademark Act.

8. Prior to the priority date of the Application, the earliest date upon which Applicant can rely, Opposer has continuously used and promoted the RELINE AMERICA Mark in interstate commerce in connection with its goods and services, including the services identified in the '821 Registration. In addition, Opposer's RELINE AMERICA Mark, is well established and was well known in the industry long before the priority date of the Application.

9. In addition to its common law rights in the RELINE AMERICA Mark and its '821 Registration, Opposer on February 16, 2017 filed a U.S. Service Mark Application Serial No. 87/338,690, for the mark "RELINE" (hereinafter "the '690 Application") for services in International Classes 37, 40 and 41 which are substantially identical to those listed in the Application of Applicant. A printout, from the PTO TESS database, of the details of the '690 Application is attached hereto as Exhibit 2 and made of record.

10. By virtue of the '821 Registration, the '690 Application and its continued use of the RELINE AMERICA Mark, Opposer has standing to bring this Opposition.

11. Applicant seeks an unrestricted federal registration for Applicant's Mark covering the goods and services set forth in the Application. As such, if a registration issues for Applicant's Mark, such registration will constitute *prima facie* evidence of Applicant's exclusive right to use the registered mark in commerce on or in connection with the listed goods and services throughout the United States with no limitation thereon.

12. Upon information and belief, Applicant was on actual notice of Opposer's prior rights in Opposer's RELINE AMERICA Mark before adopting and seeking to register the confusingly similar and virtually identical mark for their goods and services. As a matter of law, based on Opposer's federal trademark registration for its mark, Applicant was deemed on constructive notice of Opposer's rights in the mark.

13. Applicant's Mark is virtually identical in appearance to Opposer's '821 Registration and RELINE AMERICA Mark.

14. Applicant's application and the presumption of exclusivity that would come from a registration to Applicant of the mark sought to be registered is inconsistent with the prior rights of Opposer in their mark and the statutory grant of rights flowing from its own trademark registration.

COUNT I: CLAIM FOR RELIEF UNDER 15 U.S.C. § 1052- DILUTION

15. Opposer incorporates by reference paragraphs 1 through 14 as if fully set forth herein.

16. Section 2 of the Lanham Act, 15 U.S.C. § 1052, as amended on August 5, 1999, provides that trademark applications may be opposed if the mark applied for is likely to cause dilution as set forth in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

17. Opposer's RELINE AMERICA Mark, well known in the industry and throughout the United States, has been used for over 25 years. The mark is inherently distinctive, has become associated exclusively with Opposer by reason of Opposer's extensive promotion and use of the mark for many decades on or in connection with a wide variety of products and services, is the subject of a U.S. Federal Service Mark registration, is widely recognized as a designation of source of Opposer's goods and services.

18. Applicant's priority date of the Application in connection with their goods and services is after Opposer's RELINE AMERICA Mark was used, became famous, and was registered in the U.S. Patent and Trademark Office.

19. Since Applicant's Mark is virtually identical to Opposer's famous, registered, and long used mark, and registration of the mark to Applicant inevitably will call to mind Opposer and would therefore dilute or would be likely to dilute Opposer's RELINE AMERICA Mark by impairing the distinctiveness of Opposer's mark to identify exclusively goods and services from Opposer, registration of Applicant's Mark, herein opposed, violates Section 2 of the Lanham Act, 15 U.S.C. § 1052.

20. By reason of the foregoing, Opposer will be damaged by the registration of the mark to Applicant.

COUNT II: CLAIM FOR RELIEF UNDER 15 U.S.C. § 1052(a) - FALSE SUGGESTION OF CONNECTION WITH AN INSTITUTION

21. Opposer incorporates by reference paragraphs 1 through 20 as if fully set forth herein.

22. Opposer has been using the RELINE AMERICA Mark as a service mark for over 25 years and the RELINE AMERICA Mark is known throughout the United States.

23. Applicant's mark is virtually identical to the RELINE AMERICA Mark and the '821 Registration of Opposer, that long has been used by Opposer and that was adopted by Opposer well prior to any date on which Applicant can rely.

24. The RELINE AMERICA Mark is uniquely and unmistakably associated with Opposer and is a famous mark associated exclusively with Opposer.

25. Opposer is not connected with Applicant, Applicant's activities or any of the activities performed by the Applicant under the mark.

26. The RELINE AMERICA Mark is of sufficient fame and reputation that any use of the virtually identical mark by Applicant would lead the public to mistakenly presume a connection between Applicant and Opposer or otherwise would falsely suggest a connection with Opposer. Accordingly, registration of Applicant's Mark violates Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

27. By reason of the foregoing, Opposer will be damaged by the registration of the trademark to Applicant.

COUNT III: CLAIM FOR RELIEF UNDER 15 U.S.C. § 1052(d)- LIKELIHOOD OF CONFUSION

28. Opposer incorporates by reference paragraphs 1 through 27 as if fully set forth herein.

29. Opposer's rights in the RELINE AMERICA Mark were established long prior to any date on which Applicant can rely.

30. Applicant seeks to register a mark confusingly similar to Opposer's famous RELINE AMERICA Mark and the '821 Registration which has long designated not only Opposer's services but also its goods.

31. Applicant's use of a confusingly similar mark to that of Opposer's for goods and services that are confusingly similar to the goods and services that Opposer sells, is likely to create the erroneous impression that Applicant's various goods and services originate from or are otherwise associated with Opposer, that Opposer is responsible for the goods and services, or that Applicant's use of the mark, Reline, is endorsed by, or is in some way connected with Opposer, and will cause injury and harm to Opposer.

32. Registration of the mark, in connection with the goods and services set forth the Application is likely to cause confusion, cause mistake or to deceive the public into the false belief that the goods offered by Applicant under the mark comes from, or otherwise are sponsored by, or are connected with Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

33. By reason of the foregoing, Opposer will be damaged by the registration of the trademark to Applicant.

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 79/217,700 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Please charge Deposit Account No. 01-2221 to cover the opposition fee and any additional fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

WELSH FLAXMAN & GITLER LLC

Dated: June 1, 2018

By: /jlw/
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Stewart L. Gitler
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Attorneys for Opposer,
Reline America, Inc.

EXHIBIT 1

United States of America

United States Patent and Trademark Office

RELINE AMERICA

Reg. No. 4,991,821

Registered July 5, 2016

Int. Cls.: 37, 40 and 41

SERVICE MARK

PRINCIPAL REGISTER

RELINE AMERICA, INC. (MARYLAND CORPORATION)
24024 FREDERICK ROAD
CLARKSBURG, MD 20871

FOR: INSTALLATION OF NONMETAL LINERS FOR REHABILITATION OF INDUSTRIAL, STORM, AND SANITARY SEWER PIPES; RENTAL OF CONSTRUCTION EQUIPMENT AND INSTALLATION EQUIPMENT USED IN THE REHABILITATION OF INDUSTRIAL, STORM, AND SANITARY SEWER PIPES; MAINTENANCE AND/OR REPAIR OF EQUIPMENT USED IN THE REHABILITATION OF INDUSTRIAL, STORM, AND SANITARY SEWER PIPES; TECHNICAL SUPPORT SERVICES, NAMELY, TECHNICAL ADVICE RELATED TO THE INSTALLATION OF NONMETAL LINERS AND INSTALLATION EQUIPMENT USED FOR REHABILITATION OF INDUSTRIAL, STORM, AND SANITARY SEWER PIPES, IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 12-31-2006; IN COMMERCE 12-31-2006.

FOR: CUSTOM MANUFACTURE OF NONMETAL LINERS AND INSTALLATION EQUIPMENT USED FOR REHABILITATION OF INDUSTRIAL, STORM, AND SANITARY SEWER PIPES, IN CLASS 40 (U.S. CLS. 100, 103 AND 106).

FIRST USE 12-31-2006; IN COMMERCE 12-31-2006.

FOR: TRAINING SERVICES IN THE FIELD OF REHABILITATION OF INDUSTRIAL, STORM, AND SANITARY SEWER PIPES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 12-31-2006; IN COMMERCE 12-31-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,659,673.

SER. NO. 86-775,346, FILED 10-1-2015.

ZACHARY BELLO, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

EXHIBIT 2

RELINE

Word Mark	RELINE
Goods and Services	IC 037. US 100 103 106. G & S: Installation of nonmetal liners for rehabilitation of industrial, storm, and sanitary sewer pipes; Rental of construction equipment and installation equipment used in the rehabilitation of industrial, storm, and sanitary sewer pipes; Maintenance and repair of equipment used in the rehabilitation of industrial, storm, and sanitary sewer pipes; Technical support services, namely, technical advice related to the installation of nonmetal liners and installation equipment used for rehabilitation of industrial, storm, and sanitary sewer pipes. FIRST USE: 20170215. FIRST USE IN COMMERCE: 20170215 IC 040. US 100 103 106. G & S: Manufacture of nonmetal liners and installation equipment including vehicles and curing equipment used for rehabilitation of industrial, storm, and sanitary sewer pipes. FIRST USE: 20170215. FIRST USE IN COMMERCE: 20170215 IC 041. US 100 101 107. G & S: Training services, namely, classes and workshops in the field of rehabilitation of industrial, storm, and sanitary sewer pipes. FIRST USE: 20170215. FIRST USE IN COMMERCE: 20170215
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	87338690
Filing Date	February 16, 2017
Current Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) RELINE AMERICA, INC. CORPORATION MARYLAND 24024 Frederick Road Clarksburg MARYLAND 20871
Attorney of Record	John L. Welsh
Prior Registrations	4991821
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE