

ESTTA Tracking number: **ESTTA1206808**

Filing date: **05/04/2022**

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	Sullair LLC
Granted to date of previous extension	05/04/2022
Address	3700 E. MICHIGAN BLVD. 1 SULLAIR WAY MICHIGAN CITY, IN 46360 UNITED STATES
Attorney information	TERRENCE J. MCALLISTER OHLANDT, GREELEY, RUGGIERO & PERLE, LLP 10TH FLOOR ONE LANDMARK SQUARE STAMFORD, CT 06901 UNITED STATES Primary email: trademark@ogrp.com Secondary email(s): tmcallister@ogrp.com 12033274500
Docket no.	0015377usl1

Applicant information

Application no.	90632289	Publication date	01/04/2022
Opposition filing date	05/04/2022	Opposition period ends	05/04/2022
Applicant	Ningbo Shiliang Tools Co., Ltd. 160 NINGCI EAST ROAD,JIANGBEI DISTRICT NINGBO, 315000 CHINA		

Goods/services affected by opposition

Class 007. First Use: Mar 9, 2021 First Use In Commerce: Mar 9, 2021 All goods and services in the class are opposed, namely: Air-operated power tools, namely, ratchet wrenches; Air powered tools, namely, screwdrivers; Parts for pneumatic blow guns, namely, inflator tips, inflator valves, valve adapters, nozzles, nipples, couplers, connectors and pivots; Pneumatic grease guns; Pneumatic hammers; Pneumatic jacks; Pneumatic pumps; Pneumatic hand-held drills; Pneumatically operated tire inflation machine

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. registration no.	971264	Application date	07/13/1972
Register	Principal		
Registration date	10/23/1973	Foreign priority date	NONE
Word mark	SULLAIR		
Design mark			
Description of mark	NONE		
Goods/services	Class 007. First use: First Use: Jul 1, 1968 First Use In Commerce: Jul 1, 1968 AIR COMPRESSORS		

U.S. registration no.	1718757	Application date	04/10/1991
Register	Principal		
Registration date	09/22/1992	Foreign priority date	NONE
Word mark	SULLAIR		
Design mark			
Description of mark	NONE		
Goods/services	Class 037. First use: First Use: May 1, 1968 First Use In Commerce: May 1, 1968 maintenance and repair of air and refrigeration compressors, vacuum systems and related equipment		

U.S. registration no.	1071297	Application date	03/01/1976
Register	Principal		
Registration date	08/16/1977	Foreign priority date	NONE
Word mark	SULLAIR		
Design mark			
Description of mark	NONE		
Goods/services	Class 007. First use: First Use: Jul 1, 1968 First Use In Commerce: Jul 1, 1968 AIR COMPRESSORS; [REFRIGERATION COMPRESSORS;] [COMPRESSED AIR GENERATORS;] AND COMPRESSED AIR OPERATED TAMPERS, PAVING BREAKERS, TRENCHERS, DIGGERS, ROCK DRILLS AND TRAILER-MOUNTED VERSIONS OF THE FOREGOING		

U.S. registration no.	2370241	Application date	12/14/1998
Register	Principal		
Registration date	07/25/2000	Foreign priority date	NONE
Word mark	SULLAIR		

Design mark	SULLAIR
Description of mark	NONE
Goods/services	Class 041. First use: First Use: Oct 7, 1989 First Use In Commerce: Oct 7, 1989 Educational seminars and training of others in the operation, maintenance and repair of air and refrigeration compressors, vacuum systems and related equipment

Attachments	75604812#TMSN.png(bytes) SULLAIR- Opp to Slair- 5-4-22-tjm.pdf(148111 bytes)
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Signature	/OGRP-TJM-tjm/
Name	TERRENCE J. MCALLISTER
Date	05/04/2022

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

In the matter of Application Serial No. 90632289 - SLAIR
Published in the *Official Gazette* on January 4, 2022

Sullair, LLC

Opposition No.:

Opposer,

vs.

Ningbo Shiliang Tools Co., Ltd.

Applicant.

NOTICE OF OPPOSITION

Sullair, LLC, is a Limited Liability Company organized under the laws of Indiana, having an office at 3700 E. Michigan Blvd., Michigan City, Indiana (“Opposer”), believes it will be damaged by the issuance of a registration to Ningbo Shiliang Tools Co., Ltd.

a limited company organized under the laws of China, having an office at 160 Ningci East Road, Jiangbei, District Ningbo, China 315000 (“Applicant”), for the proposed trademark SLAIR, which is the subject of a use-based Application No. 90632289, filed April 8, 2021, covering:

Int. Class 7- G & S: Air-operated power tools, namely, ratchet wrenches; Air powered tools, namely, screwdrivers; Parts for pneumatic blow guns, namely, inflator tips, inflator valves, valve adapters, nozzles, nipples, couplers, connectors and pivots; Pneumatic grease guns; Pneumatic hammers; Pneumatic jacks; Pneumatic pumps; Pneumatic hand-held drills; Pneumatically operated tire inflation machine. FIRST USE: 20210309. FIRST USE IN COMMERCE: 20210309

and claiming use of the SLAIR trademark (“Applicant’s application”). Accordingly, Opposer hereby opposes the SLAIR trademark under provisions of Section 13 of the Trademark Act of July 5, 1946 (the “Lanham Act”), as amended, 15 U.S.C. §1063.

As grounds for opposition, it is alleged that:

1. Since at least as early as 1968, Opposer has used the trademark SULLAIR to manufacture, market and sell a wide range of air compressor goods and services in the US and internationally.
2. Opposer's SULLAIR trademark, brand name and company name has played an important role in Opposer's brand identity and Opposer has prominently featured the SULLAIR trademark on its product packaging, web site and materials to market, advertise, promote and sell its goods.
3. Opposer owns the U.S. trademark registration consisting of the trademark SULLAIR (Registration number 0971264) in class 7 G & S: air compressors with a first use in commerce starting in 1968.
4. Opposer owns the U.S. trademark registration consisting of the trademark SULLAIR (Registration number 1718757) in class 037 G & S: maintenance and repair of air and refrigeration compressors, vacuum systems and related equipment with a first use in commerce starting in 1968.
5. Opposer owns the U.S. trademark registration consisting of the trademark SULLAIR (Registration number 1071297 in class 7 G & S: air compressors, and compressed air tampers, paving breakers, trenchers, diggers, rock drills, and trailer -mounted versions of the foregoing with a first use in commerce starting in 1968.
6. Opposer owns the U.S. trademark registration consisting of the trademark SULLAIR (Registration number 2370241 in class 41 for G & S: Educational seminars and training of others in the operation, maintenance and repair of air and refrigeration compressors, vacuum systems and related equipment with a first use in commerce starting in 1989.
7. Opposer claims priority over Applicant's application in view of Opposer's use and registration of the SULLAIR trademark long prior to Applicant's application filing date of April 8, 2021.

8. Opposer, since long prior to Applicant's filing of its application for the trademark SLAIR, has manufactured, promoted and marketed the goods offered under the SULLAIR trademark and brand name. Opposer's goods cover air compressor products and related accessories including air dryers, air receivers, compressed air filters, fluids and lubricants, nitrogen generators, water chillers and machine components and parts. Opposer's facilities are all ISO 9001 certified. The Sullair trademark and brand stands for Reliability, Durability and Performance and is well known brand that serves to distinguish its goods and services. Opposer's goods and services are provided to a vast number of industries including aerospace, food and beverage, automotive, general manufacturing, construction, industrial gases, pharmaceuticals, and mining. Opposer has consistently and continuously promoted its SULLAIR branded goods and services in various social media platforms and traditional advertising and marketing mediums. By reason of such advertising, promotion, marketing and sales, the SULLAIR trademark and brand now enjoys valuable goodwill and enviable reputation in the US and throughout the world. Opposer has consistently won national awards for its goods encompassing awards for product innovation and product of the year.

9. Registration of the proposed trademark SLAIR by Applicant is barred by the provisions of Section 2(d) of the Lanham Act for the reason that it is confusingly similar to Opposer's SULLAIR trademark in overall sight, sound, meaning, connotation, and commercial impression, as to be likely, when used on or in connection with the goods covered under Applicant's application, to cause confusion, or to cause mistake, or to deceive consumers and members of the industry into believing that the goods covered under Applicant's application originate from, are sponsored by, or are otherwise authorized by Opposer, when, in fact, they are not.

10. Upon information and belief, the goods designated in Opposer's SULLAIR trademark registration are related or highly similar to the goods covered by Applicant's application.
11. Upon information and belief, the goods designated in Applicant's application will be advertised, marketed, promoted, and provided through the same channels of trade and will be advertised in the same types of publications and channels as the goods covered by Opposer's SULLAIR trademark and sold to the same classes of the purchasing public for use by the same consumers as the goods covered by Opposer's SULLAIR trademark.
12. Upon information and belief, the goods designated in Applicant's application would be offered to and used by some of the same customers and consumers who would also be in the market for and use the goods included in Opposer's SULLAIR trademark.
13. Registration of Applicant's proposed trademark SLAIR would be a source of damage to Opposer because consumers and members of the industry are likely to attribute the source or sponsorship of Applicants' goods to Opposer.
14. Registration of Applicant's proposed trademark SLAIR would be a source of damage to Opposer because registration would confer upon Applicant statutory presumptions to which Applicant is not entitled in view of Opposer's prior use and registration of the SULLAIR trademark.

WHEREFORE, Opposer prays that registration of Application No. 90632289 for the SLAIR trademark in International Class 7 be denied and that this opposition be sustained in favor of Opposer on the merits, with prejudice, and without leave to refile.

Please direct all correspondence to the undersigned at the address listed below.

Respectfully submitted,

Date: May 4, 2022

By: /Terrence J. McAllister/

Terrence J. McAllister

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