

ESTTA Tracking number: **ESTTA729228**

Filing date: **02/24/2016**

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	Westguard Insurance Company
Granted to Date of previous extension	02/24/2016
Address	16 South River Street Wilkes-Barre, PA 18702 UNITED STATES
Attorney information	Jeffrey H. Kaufman Muncy, Geissler, Olds & Lowe, P.C. 4000 Legato Road, Suite 310 Fairfax, VA 22033 UNITED STATES mailroom@mg-ip.com,jhk@mg-ip.com Phone:703-649-3800

Applicant Information

Application No	86656400	Publication date	10/27/2015
Opposition Filing Date	02/24/2016	Opposition Period Ends	02/24/2016
Applicant	David S. KATZ Westborough Executive Park Westborough, MA 015812859 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 2013/00/00 First Use In Commerce: 2013/00/00 All goods and services in the class are opposed, namely: Litigation services; legal consultationservices; legal services; and legal consulting services in the field of business and commercial litigation, personal injury litigation and employment defense

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. Registration No.	2250453	Application Date	09/15/1997
Registration Date	06/01/1999	Foreign Priority Date	NONE
Word Mark	YOUR BUSINESS IS OUR BUSINESS		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1992/01/31 First Use In Commerce: 1997/10/10 underwriting of workers' compensation insurance

Attachments	Notice of Opposition.pdf(330506 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	/Jeffrey H. Kaufman/
Name	Jeffrey H. Kaufman
Date	02/24/2016

Attorney Docket No.: WGRD.US.00030.L

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

_____)	
WESTGUARD INSURANCE COMPANY,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	Appln. Serial No. 86/656,400
DAVID S. KATZ,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

WESTGUARD INSURANCE COMPANY, a corporation duly organized and existing under the laws of Pennsylvania, with an office at 16 South River Street, Wilkes-Barre, Pennsylvania 18702 (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No. 86/656,400, filed June 9, 2015, under the Trademark Act of 1946, in the name of David S. Katz, published for opposition in the *Official Gazette* of October 27, 2015, for the mark WE MAKE YOUR BUSINESS OUR BUSINESS.

The grounds of Opposition are as follows:

1. Opposer, WESTGUARD INSURANCE COMPANY, a corporation duly organized and existing under the laws of Pennsylvania, having its principal place of business at 16 South River Street, Wilkes-Barre, Pennsylvania 18702.
2. Prior to Applicant's claimed date of first use, Opposer has used, and is now using Opposer's mark YOUR BUSINESS IS OUR BUSINESS (hereinafter sometimes referred to as

“Opposer's Mark”), in connection with insurance underwriting services marketed and offered by Opposer in commerce.

3. Opposer is the owner of, and will rely herein, upon the following federal registration, pursuant to Trademark Rule 2.122(d)(1):

<u>MARK</u>	<u>REG. NO.</u>	<u>SERVICES</u>	<u>ISSUE DATE</u>
YOUR BUSINESS IS OUR BUSINESS	2,250,453	underwriting of workers' compensation insurance	June 1, 1999

Printed information from the TARR and Assignment electronic databases of the USPTO showing the current status and title of this Registration are attached. Said registration is valid and subsisting and is *prima facie* evidence of Opposer's exclusive right to use Opposer's Mark in commerce in connection with the services specified in the registration. Registration No. 2,250,453 has achieved incontestable status.

4. As a result of Opposer's use of Opposer's Mark in connection with Opposer's services, Opposer's Mark has become associated with Opposer, and Opposer has established goodwill in connection with the sales of services under its mark.

5. Upon information and belief, on June 9, 2015, Applicant filed an application for registration of the alleged WE MAKE YOUR BUSINESS OUR BUSINESS trademark for “Litigation services; legal consultation services; legal services; and legal consulting services in the field of business and commercial litigation, personal injury litigation and employment defense.” Said application was assigned Serial No. 86/656,400, and was published for Opposition in the *Official Gazette* of October 27, 2015.

6. Applicant's WE MAKE YOUR BUSINESS OUR BUSINESS mark is a simulation and colorable imitation of, and so resembles Opposer's Mark as to be likely, when applied to the proposed services of Applicant, to cause confusion or mistake or to deceive the

relevant consuming public resulting in damage and detriment to Opposer and its reputation, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

7. Upon information and belief, Opposer and Applicant are both engaged in the sale and promotion of their respective services through the same channels of trade and to the same general class of consumers.

8. Opposer, upon information and belief, avers that members of the relevant consuming public are likely to be confused, mistaken, or deceived as to the origin and sponsorship of Applicant's services marketed under Applicant's alleged WE MAKE YOUR BUSINESS OUR BUSINESS mark and misled into believing that such services are offered by, rendered by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

9. Opposer, upon information and belief, avers that it will be damaged by the continued use and registration by Applicant of the alleged WE MAKE YOUR BUSINESS OUR BUSINESS mark, as set forth in Applicant's Trademark Application Serial No. 86/656,400, in that the mark is confusingly similar to Opposer's Mark and is used in connection with services related to the services offered by Opposer.

WHEREFORE, Opposer, WESTGUARD INSURANCE COMPANY, believes and avers that it is being and will continue to be damaged by registration of the WE MAKE YOUR BUSINESS OUR BUSINESS mark as aforesaid, and requests that said Application Serial No. 86/656,400 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JEFFREY H. KAUFMAN, a member of the law firm of MUNCY, GEISSLER, OLDS & LOWE, P.C., a member of the Bar of the Commonwealth of Virginia, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

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