

ESTTA Tracking number: **ESTTA149135**

Filing date: **07/03/2007**

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	BBVA Bancomer, S.A. Institucion De Banca Multiple, Grupo Financiero BBVA Bancomer		
Entity	Joint Stock Company	Citizenship	Mexico
Address	Avda. Universidad, 1200 Colonia XOCO, Mexico D.F., 03339 MEXICO		

Attorney information	Henry H. Skillman Dann, Dorfman, Herrell and Skillman 1601 Market Street Suite 2400 Philadelphia, PA 19103 UNITED STATES hskillman@ddhs.com Phone:(215) 563-4100		
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Applicant Information

Application No	76644700	Publication date	06/26/2007
Opposition Filing Date	07/03/2007	Opposition Period Ends	07/26/2007
Applicant	Bancomercio de El Salvador, Inc. 5512 Columbia Pike Arlington, VA 22204 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2000/05/00 First Use In Commerce: 2000/05/00 All goods and seVICES in the class are opposed, namely: ELECTRONIC FUNDS TRANSFER SERVICES, NAMELY, WIRE MONEY TRANSMISSION SERVICES
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Applicant Information

Application No	76644702	Publication date	06/05/2007
Opposition Filing Date	07/03/2007	Opposition Period Ends	07/05/2007
Applicant	Bancomercio de El Salvador, Inc. 5512 Columbia Pike Arlington, VA 22204 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and seVICES in the class are opposed, namely: ELECTRONIC FUNDS TRANSFER SERVICES, NAMELY, WIRE MONEY TRANSMISSION SERVICES
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1249276	Application Date	03/05/1982
Registration Date	08/23/1983	Foreign Priority Date	NONE
Word Mark	BANCOMER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1977/11/00 First Use In Commerce: 1977/11/00 Banking Services		

Attachments	NoticeOfOpposition.pdf (4 pages)(157841 bytes)
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Signature	/Henry H. Skillman/
Name	Henry H. Skillman
Date	07/03/2007

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

BBVA Bancomer, S.A. Institucion De Banca Multiple, Grupo Financiero BBVA Bancomer, Opposer	:	Opposition No.
	:	
	:	Appl. No. 76644700 (1A)
	:	Mark: BANCOMERCIO (Standard Characters)
	:	Published in OG: June 26, 2007
v.	:	
	:	and
Bancomercio de El Salvador, Inc.	:	
	:	Appl. No. 76644702 (1B)
Applicant	:	Mark: BANCOMERCIO (and Design)
	:	Published in OG: June 5, 2007

CERTIFICATE OF ELECTRONIC FILING

I certify that this correspondence is being electronically filed with the Electronic System for Trademark Trials and Appeals at the United States Patent and Trademark Office.

July 3, 2007

Date


Joan Rodgers

NOTICE OF OPPOSITION

BBVA Bancomer, S.A. Institucion De Banca Multiple, Grupo Financiero BBVA Bancomer, a joint stock company of Mexico, having a place of business at Avda. Universidad, 1200 Colonia XOCO, 03339 Mexico D.F. (hereinafter "Opposer" or "BBVA BANCOMER"), believes that it will be damaged by Application Serial Nos. 76/644,700 and 76/644,702, both filed August 11, 2005, seeking registration on the Principal Register of the mark "BANCOMERCIO" by Bancomercio de El Salvador, Inc., a Virginia corporation (hereinafter "Applicant"), for the services of electronic funds transfer services, namely, wire money transmission services, and respectively published for opposition in the Official Gazettes dated June 26, 2007 and June 5, 2007, and Opposer hereby opposes the registration of the "BANCOMERCIO" trademark under Section 13 of the Lanham Act, 15 U.S.C. §1063.

The grounds for opposition on information and belief are as follows:

1. Applicant, Bancomercio de El Salvador, Inc., seeks to register the mark "BANCOMERCIO" for "electronic funds transfer services, namely, wire money transmission services" in International Class 036, as evidenced by the publication of said marks.

2. BBVA BANCOMER is the owner of the registered trademark, BANCOMER, US Reg. No. 1,249,276, registered August 23, 1983 and renewed May 10, 2003. The services identified in the registration are banking services in International Class 036.

3. BBVA BANCOMER is also the owner of its US subsidiary, "Bancomer Transfer Services, Inc.", a US corporation of California, providing money transfer services in the United States under the company name, Bancomer Transfer Services, Inc.

4. BBVA BANCOMER is a Mexican bank which owns subsidiaries throughout the Western Hemisphere providing banking and money transfer services to the public in the United States and elsewhere.

5. On information and belief, Applicant has not used the service mark "BANCOMERCIO" alone prior to May 2000, which is the date of first use alleged in Applicant's Application Serial No. 76644700 and had not used BANCOMERCIO in combination with other terms prior to September 12, 1999, which is the date of first use alleged in Applicant's Reg. No. 2,665,410, for BANCOMERCIO DE EL SALVADOR, INC.

6. Since a date long before the filing of Applicant's Applications Serial Nos. 76/644,700 and 76/644,702, Opposer has used the trade names BANCOMER and BANCOMER TRANSFER SERVICES, INC. in connection with the marketing of banking and money transfer services in the United States and internationally, and such use is currently ongoing.

7. The use of the names BANCOMER and BANCOMER TRANSFER SERVICES, INC. by Opposer in connection with marketing of banking and money transfer services has been valid and continuous since a date well in advance of Applicant's first use date and such use by Opposer has not been abandoned.

8. The trade names BANCOMER and BANCOMER TRANSFER SERVICES, INC. are symbolic of extensive goodwill and recognition generated through substantial effort in use and promotion of these trade names.

9. Opposer's registered trademark, BANCOMER, was granted on Application Serial No. 73/353,167 filed March 5, 1983 and continues in force by acceptance of declarations under Sections 8 & 15 on September 20, 1988 and under Sections 8 & 9 on May 10, 2003.

10. Opposer's US subsidiary, Bancomer Transfer Services, Inc., was incorporated in California on May 27, 1993 and remains in good standing.

11. Through its subsidiary, Opposer has had use of the registered trademark, BANCOMER, and the trade name, BANCOMER TRANSFER SERVICES, INC., and said use is continuing in connection with the marketing of money transfer services and said use has not been abandoned.

12. Opposer's registered BANCOMER service mark and company name BANCOMER TRANSFER SERVICES, INC. are symbolic of goodwill and recognition built up by Opposer based on considerable time and effort in use and promotion of the marks.

13. The trademark, BANCOMERCIO, sought to be registered by Applicant, incorporates and closely resembles BBVA BANCOMER'S registered trademark, BANCOMER, and BBVA BANCOMER'S company name, BANCOMER TRANSFER SERVICES, INC. and, when applied to Applicant's activities, is likely to cause confusion, mistake, and/or deception, as proscribed by Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), resulting in damage and injury to Opposer, Opposer's reputation and goodwill and its valuable trade names, trademarks and business.

14. Applicant's adoption of the designation "BANCOMERCIO" as a trademark is without license or permission of BBVA BANCOMER and is likely to deceive persons by creating the erroneous impression that Applicant's services are related to Opposer and Opposer's services, or are connected in some way with Opposer or Opposer's services, or are the same as Opposer's services, and registration of Applicant's mark increases the likelihood of

confusion between Opposer and Applicant, and Opposer's services and Applicant's services to the detriment of Opposer and the public, and any faults or imperfections in Applicant's services marketed in association with the "BANCOMERCIO" mark sought to be registered will reflect adversely on Opposer and Opposer's goodwill and reputation and may disparage Opposer's services unless this Opposition is sustained.

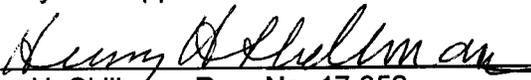
15. Applicant's mark, by reason of its similarity to Opposer's marks and trade names, will enable Applicant to gain a foothold in Opposer's market, by exploiting subliminal or subconscious association with Opposer and Opposer's well known marks and trade names.

Respectfully submitted,

DANN, DORFMAN, HERRELL AND SKILLMAN, P.C.
Attorneys for Opposer

JULY 3, 2007

Date


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