

ESTTA Tracking number: **ESTTA299481**

Filing date: **08/06/2009**

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	International Actuarial Association/Association Actuarielle Internationale		
Entity	Nonprofit corporation	Citizenship	Switzerland
Address	800-150 Metcalfe Ottawa, ON K2P 1P1 CANADA		

Attorney information	Kenneth E. Liu Gammon & Grange, P.C. 8280 Greensboro Drive, Seventh Floor McLean, VA 22102 UNITED STATES trademark@gg-law.com
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Applicant Information

Application No	77683236	Publication date	07/07/2009
Opposition Filing Date	08/06/2009	Opposition Period Ends	08/06/2009
Applicant	Modi Pritesh P. O. Box 315 San Francisco, CA 94104 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Actuarial services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ACTUARIES WITHOUT FRONTIERS		
Goods/Services	actuarial services; promotion and development of the actuarial profession		

Attachments	ACTUARIES WITHOUT BORDERS Notice of Opposition.pdf (6 pages)(24967 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	/Kenneth E. Liu/
Name	Kenneth E. Liu
Date	08/06/2009

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

In the matter of Application Serial No. 77/683236 for
ACTUARIES WITHOUT BORDERS
Published in the *Official Gazette* on July 7, 2009

International Actuarial Association /)	
Association Actuarielle Internationale)	
)	
v.)	Opposition No. _____
)	
Pritesh Modi)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

In the matter of the Intent-to-Use application of Pritesh Modi (hereinafter “Applicant”) for registration of the mark ACTUARIES WITHOUT BORDERS, Application Serial No. 77/683236, published in the Official Gazette on July 7, 2009 (the “Application”), Opposer International Actuarial Association/Association Actuarielle Internationale (“Opposer” or “IAA”) believes that it will be damaged by registration of the mark shown in Serial No. 77/683236 and hereby opposes the same and states as follows in support of this Notice.

1. Opposer IAA is a not-for-profit corporation organized in Switzerland, with its headquarters in Ottawa, Ontario, Canada. The IAA has national member organizations in sixty-two countries throughout the world. The IAA has five national member organizations in the United States, located in Washington D.C.; Arlington, Virginia (two members); Long Grove, Illinois; and Schaumburg, Illinois (the “U.S. Members”).

2. Actuaries Without Frontiers /Actuaries sans Frontières (“AWF”) operates within the IAA as a “section” (division) of the IAA, and in cooperation with the relevant national

member organizations. AWF seeks to make available actuarial services on a temporary, voluntary basis to assist in the development of social security, pensions, insurance, investments, or healthcare infrastructures. It focuses on providing volunteer services in countries in which there is an under-developed actuarial profession and insufficient financial resources to fund such services.

3. Opposer, either itself or through its U.S. Members, has used the ACTUARIES WITHOUT FRONTIERS mark in commerce since in or about November 2003, and consequently owns common law rights to the mark ACTUARIES WITHOUT FRONTIERS. Such use has been valid and continuous in commerce since the first use and has not been abandoned.

4. Opposer has used the ACTUARIES WITHOUT FRONTIERS mark in commerce to identify its program for, *inter alia*, providing actuarial services, and promotion and development of the actuarial profession.

5. On information and belief, on March 4, 2009, Applicant filed Application Serial No. 77/683236 to register the mark ACTUARIES WITHOUT BORDERS for “actuarial services.” The application was published for opposition in the *Official Gazette* on July 7, 2009.

6. Applicant’s application was filed as an Intent-to-Use application pursuant to Lanham Act Section 1(b). On information and belief, Applicant has, to date, never used the mark ACTUARIES WITHOUT BORDERS in commerce in connection with the services listed in his application.

7. On information and belief, Applicant did not ever use the mark ACTUARIES WITHOUT BORDERS in commerce prior to Opposer’s first use in commerce of the mark ACTUARIES WITHOUT FRONTIERS.

APPLICANT'S MARK IS CONFUSINGLY SIMILAR

8. Opposer hereby incorporates its allegations in paragraphs 1 through 7 of this Notice of Opposition as if fully set forth herein.

9. Applicant's mark is substantially similar to ACTUARIES WITHOUT FRONTIERS. Therefore, when and if used in connection with the services set forth in Applicant's application, it is likely to cause confusion, or to cause mistake, or to deceive the public with respect to the source or origin of Applicant's services or with respect to Opposer's sponsorship thereof or connection or affiliation therewith within the meaning of Section 2(d) of the Trademark Act.

10. The ACTUARIES WITHOUT FRONTIERS mark derives from the translation of the French name of Opposer AWF, Actuaries sans Frontières, of which Applicant is well aware. The French word "frontières", while literally translated as "Frontiers" is more accurately translated as "Borders". Additionally, the primary dictionary meaning of the English word "frontiers" is "borders". Therefore, by attempting to register the mark ACTUARIES WITHOUT BORDERS, Applicant seeks to register a mark that is equivalent in sight, sound, and meaning to Opposer's ACTUARIES WITHOUT FRONTIERS mark.

11. On information and belief, Applicant's ACTUARIES WITHOUT BORDERS mark, when used as a mark for actuarial services, so resembles Opposer's ACTUARIES WITHOUT FRONTIERS mark as to be likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin of Applicant's services, with respect to Opposer's sponsorship thereof or connection or affiliation therewith, and/or other ways.

12. If Applicant is permitted to register and use the ACTUARIES WITHOUT BORDERS mark, confusion in trade resulting in damage and injury to Opposer would be caused

and would result as the applied-for mark is confusingly similar to Opposer's ACTUARIES WITHOUT FRONTIERS mark.

13. Registration of Applicant's mark will damage Opposer, as such registration will give color of exclusive statutory rights to the mark ACTUARIES WITHOUT BORDERS to Applicant in derogation and violation of the prior and superior rights of Opposer.

14. ACTUARIES WITHOUT BORDERS is unregistrable by Applicant as such mark is confusingly similar to, violative of, and/or is in the natural zone of expansion of Opposer's ACTUARIES WITHOUT FRONTIERS mark that was previously used in commerce and has not been abandoned by Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of U.S. Application Serial No. 77/683236, and therefore respectfully requests that the Trademark Trial and Appeal Board sustain this opposition and refuse registration of Applicant's mark.

APPLICANT COMMITTED FRAUD ON THE U.S.P.T.O.

15. Opposer hereby incorporates its allegations in paragraphs 1 through 14 of this Notice of Opposition as if fully set forth herein.

16. Applicant has committed fraud on the U.S. Patent & Trademark Office ("USPTO") by falsely signing the declaration in his application stating that, "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive. . ." (the "Declaration").

17. Applicant Pritesh Modi joined the IAA's Actuaries Without Frontiers section and became a "committee member" (akin to a board member) of the Actuaries Without Frontiers section in or about October 2007.

18. On information and belief, Applicant knew or should have known of Opposer's mark ACTUARIES WITHOUT FRONTIERS before he joined the IAA's Actuaries Without Frontiers section and committee.

19. After having been an Actuaries Without Frontiers section and committee member for approximately one and half years, Applicant knew of Opposer's ACTUARIES WITHOUT FRONTIERS mark prior to the filing of his ACTUARIES WITHOUT BORDERS Intent-to-Use application on March 4, 2009.

20. Further, Applicant received the minutes of at least three AWF section meetings at which discussions had taken place regarding the proper translation of "Actuaries sans Frontières" to "Actuaries Without Borders" and regarding the section's consideration of changing its name to "Actuaries Without Borders."

21. When Applicant signed the ACTUARIES WITHOUT BORDERS application declaration, he knew or should have known that IAA had senior rights in the ACTUARIES WITHOUT FRONTIERS mark and that ACTUARIES WITHOUT BORDERS would be likely to cause confusion, or to cause mistake, or to deceive.

22. Applicant breached his fiduciary duty as member of the AWF section committee and filed Application Serial No. 77/683236 with the USPTO on March 4, 2009, knowing that any representations as to Applicant's rights to use the mark ACTUARIES WITHOUT FRONTIERS and its lack of confusion with existing marks was false.

23. Applicant's Declaration is false.

24. Applicant knew or should have known his Declaration was false at the time of signing.

25. Applicant willfully and deliberately signed a false Declaration.

26. Applicant's false representation was regarding a material fact.

27. Applicant acted with the intent that the USPTO rely on his misrepresentations and grant a registration for the mark ACTUARIES WITHOUT BORDERS.

28. The USPTO relied on Applicant's false representation in approving his application.

29. Applicant's signing of the Declaration above while knowing that IAA had superior rights in a confusingly similar mark and knowingly withholding this information from the U.S. Patent & Trademark Office constitutes fraud.

30. Registration of Applicant's mark will damage Opposer and/or its U.S. Members, as, *inter alia*, such registration will give color of exclusive statutory rights to the mark ACTUARIES WITHOUT BORDERS to Applicant in derogation and violation of the prior and superior rights of Opposer.

WHEREFORE, since Opposer believes that it will be damaged by registration of U.S. Application Serial No. 77/683236, Opposer respectfully requests that the Trademark Trial and Appeal Board sustain this opposition and refuse registration of the Applicant's mark.