

ESTTA Tracking number: **ESTTA302187**

Filing date: **08/20/2009**

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	Barclays Global Investors, N.A.		
Entity	National Banking Association	Citizenship	USA
Address	400 Howard Street San Francisco, CA 94105 UNITED STATES		

Attorney information	Susan L. Heller Greenberg Traurig, LLP 2450 Colorado Avenue, Suite 400E Santa Monica, CA 90404 UNITED STATES latm2@gtlaw.com Phone:3105867700		
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Applicant Information

Application No	77480356	Publication date	07/21/2009
Opposition Filing Date	08/20/2009	Opposition Period Ends	08/20/2009
Applicant	Pax World Management Corp. Suite 400 30 Penhallow Street Portsmouth, NH 03801 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Mutual fund investment and investment advisory services, all relating to investment in publicly traded companies

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3379667	Application Date	07/25/2006
Registration Date	02/05/2008	Foreign Priority Date	NONE
Word Mark	ISHARES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2006/08/18 First Use In Commerce: 2006/08/18 Banking services, mutual fund investment advisory services, investment management services and financial services in the nature of pooled investment funds

U.S. Registration No.	3111466	Application Date	02/07/2005
Registration Date	07/04/2006	Foreign Priority Date	NONE

Word Mark	ISHARES
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Design Mark	
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Description of Mark	The mark consists of the word iShares in upper and lower case letters.
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Goods/Services	Class 036. First use: First Use: 2000/05/15 First Use In Commerce: 2000/05/15 Banking services, mutual fund investment advisory services, investment management services and financial services in the nature of pooled investment funds
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U.S. Registration No.	2422249	Application Date	08/20/1999
Registration Date	01/16/2001	Foreign Priority Date	NONE

Word Mark	ISHARES
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Design Mark	ISHARES
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2000/05/15 First Use In Commerce: 2000/05/15 bank services, mutual fund investment advisory services, investment management services and financial services in the nature of pooled investment funds

Related Proceedings	U.S. Serial No. 77/480,332; Mark: sShares
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Attachments	78937373#TMSN.jpeg (1 page)(bytes) 78562037#TMSN.jpeg (1 page)(bytes) 75781033#TMSN.gif (1 page)(bytes) etf.pdf (10 pages)(1812713 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	/slh/gl/
Name	Susan L. Heller
Date	08/20/2009

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

In the matter of Application Serial No. 77/480,356
For the mark sSharesETF
Published in the *Official Gazette* on July 21, 2009

Barclays Global Investors, N.A., a)	Opposition No. _____
National Banking Association,)	
)	
Opposer,)	
)	
vs.)	
)	
Pax World Management Corp., a Delaware)	
Corporation,)	
)	
Applicant)	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

1. Opposer Barclays Global Investors, N.A. (“BGI”) is a National Banking Association located at 400 Howard Street, San Francisco, California 94105.
2. BGI believes that it will be damaged if the above-referenced mark is registered, and hereby opposes the registration.
3. Upon information and belief, Applicant Pax World Management Corporation (“Applicant”) is a Delaware Corporation located at 30 Penhallow Street, Suite 400, Portsmouth, New Hampshire 03801.
4. BGI, with and through its affiliated entities, is the world’s largest manager and sponsor of exchange traded funds (“ETFs”), a type of investment security. BGI’s ETFs have

been branded under the “iShares” mark since 2000, and cover a comprehensive range of asset classes, market sectors and segments, investment styles, and geographic locations. Indeed, BGI is the market leader in ETFs based on its iShares product range, managing more than 300 ETFs trading in 12 global markets. Based in part on the success of its iShares brand, BGI has consistently been ranked as one of the top asset managers both in the U.S. and globally. Moreover, BGI has been at the forefront of developing and offering innovative investment products for over thirty years, and has received numerous industry awards and widespread recognition for the quality and success of its products and services. Through many years of use and the expenditure of significant monies and effort, the distinctive iShares mark has achieved fame and represents enormous value and goodwill to BGI.

5. BGI owns both common law rights and federal registrations for the iShares mark, and has been using the mark in commerce in connection with banking services, mutual fund investment advisory services, investment management services, and financial services in the nature of pooled investment funds, since at least as early as May 2000. BGI filed its application for registration of the ISHARES word mark on August 20, 1999, and this mark was ultimately registered on January 16, 2001 pursuant to Registration Number 2422249. This registration is in full force and effect and is incontestable within the meaning of Section 15 of the Lanham Act. BGI thereafter filed its application for registration of the “iShares” stylized mark on February 7, 2005, and this mark was ultimately registered on July 4, 2006 pursuant to Registration Number 3111466. Attached hereto as Exhibit A are copies of the Certificates of Registration issued from the U.S. Patent and Trademark Office (“PTO”) for the iShares family of marks in the U.S.

6. BGI also owns common law rights and federal registrations for the related  mark, which is also used in connection with banking services, mutual fund

investment advisory services, investment management services, and financial services in the nature of pooled investment funds in International Class 36. BGI filed its application for registration of the  iShares mark on July 25, 2006, and this mark was ultimately registered on February 5, 2008 pursuant to Registration Number 3379667. BGI has been using the  iShares mark continuously in commerce since at least as early as August 18, 2006.

7. By virtue of BGI's extensive use and promotion of its iShares mark in connection with the offering of banking services, mutual fund investment advisory services, investment management services, and financial services in the nature of ETFs, or pooled investment funds, the service mark iShares has come to be recognized by the relevant public as identifying banking, financial, and ETF services originating from or uniquely associated with BGI.

8. Furthermore, based on the cost and effort that BGI has expended in developing, promoting, and advertising the mark, the iShares mark has become strong, distinctive, and famous in the United States within the meaning of the Lanham Act, particularly with regard to the market for investment securities.

9. Applicant filed for registration of the sSharesETF mark on May 21, 2008, indicating its intent to use the mark in connection with "Mutual fund investment and investment advisory services, all relating to investment in publicly traded companies" in International Class 36. Applicant's sSharesETF mark was published for opposition on July 21, 2009, and the filing basis as of today's date remains Section 1(b) of the Trademark Act based on Applicant's intent to use the sSharesETF mark in commerce.

10. BGI's first use of the iShares mark predates Applicant's first use of the sSharesETF mark in commerce in connection with mutual fund investment and investment advisory services. In addition, BGI's registrations for its iShares, ISHARES, and  iShares

marks predate Applicant's application for sSharesETF in connection with mutual fund investment and investment advisory services.

11. Applicant's sSharesETF application specifically provides that its services are in the nature of "mutual fund investment and investment advisory services," which are identical to the services offered under the iShares mark. Moreover, the mark itself references ETFs. Accordingly, Applicant offers or intends to offer its services to the same class of consumers of BGI's ETF products, including investors who understand that iShares-branded products are famous within the market for investment securities.

12. Applicant's sSharesETF mark is also confusingly similar to BGI's well-known iShares mark in appearance. The distinguishing and dominant feature of the sSharesETF mark is the term "sShares," which, like BGI's mark, consists of a stylized lower-case letter in front of the term "Shares" beginning with a capital "S." The existence of the "ETF" suffix in Applicant's mark is irrelevant, as this is merely a commonly used abbreviation for "exchange traded fund," which is highly descriptive of both Applicant's and BGI's services. The fact that Applicant's mark starts with a different letter, namely an "s", is not sufficient to negate the likelihood of confusion resulting from the near identical nature of the marks in appearance and format.

13. Given the fame and reputation of the iShares mark in the field of financial, investment, and ETF-related services, it is likely that consumers will mistakenly believe that Applicant's sSharesETF mark is connected or associated with BGI, or that BGI has, to some degree, sponsored or endorsed Applicant's services. Accordingly, Applicant's mark is likely to cause confusion, mistake, and/or deception among the consuming public regarding the source, affiliation, and/or sponsorship between BGI and its services, and Applicant and its services.

14. In addition, the sSharesETF mark is so similar to the prior registered and famous iShares mark as to dilute the distinctive quality of the iShares mark.

15. The registration of Applicant's mark for the services identified would therefore be inconsistent with BGI's rights in its iShares mark, and will cause damage to BGI and BGI's rights in the same.

16. By virtue of the foregoing, Applicant's sSharesETF application should be rejected, and registration of the term sSharesETF as a trademark in Applicant's name should be denied and refused.

Enclosed is BGI's check in the amount of \$300.00 representing the required filing fee. Authorization is hereby provided to charge any deficiency to Deposit Account 50-2638.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: August 20, 2009

By: 

Susan L. Heller
Christina M. Liu
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Tel: (310) 586-6564
Fax: (310) 586-0564
hellers@gtlaw.com

Attorneys for BARCLAYS GLOBAL
INVESTORS, N.A.

PROOF OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on August , 2009, addressed as follows:

Jeffrey C. Spear
Orr & Reno, P.A.
1 Eagle Square
Concord, New Hampshire 03301-4903



Grace Linker
Sr. Trademark Paralegal

EXHIBIT A

U.S. Registrations for iShares Family of Marks

Int. Cl.: 36

Prior U.S. Cls.: 100, 101, and 102

Reg. No. 2,422,249

United States Patent and Trademark Office

Registered Jan. 16, 2001

**SERVICE MARK
PRINCIPAL REGISTER**

ISHARES

BARCLAYS GLOBAL INVESTORS N. A. (UNITED STATES CORPORATION)
45 FREMONT STREET
SAN FRANCISCO, CA 94105

FOR: BANK SERVICES, MUTUAL FUND INVESTMENT ADVISORY SERVICES, INVESTMENT MANAGEMENT SERVICES AND FINANCIAL SERVICES

IN THE NATURE OF POOLED INVESTMENT FUNDS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-15-2000; IN COMMERCE 5-15-2000.

SN 75-781,033, FILED 8-20-1999.

RICHARD DONNELL, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,111,466

Registered July 4, 2006

**SERVICE MARK
PRINCIPAL REGISTER**

iShares

BARCLAYS GLOBAL INVESTORS, N.A. (UNITED STATES NATIONAL BANKING ASSOCIATION)
45 FREMONT STREET
SAN FRANCISCO, CA 94105

FOR: BANKING SERVICES, MUTUAL FUND INVESTMENT ADVISORY SERVICES, INVESTMENT MANAGEMENT SERVICES AND FINANCIAL SERVICES IN THE NATURE OF POOLED INVESTMENT FUNDS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-15-2000; IN COMMERCE 5-15-2000.

OWNER OF U.S. REG. NO. 2,422,249.

THE MARK CONSISTS OF THE WORD ISHARES IN UPPER AND LOWER CASE LETTERS.

SER. NO. 78-562,037, FILED 2-7-2005.

GINA FINK, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 3,379,667

Registered Feb. 5, 2008

SERVICE MARK
PRINCIPAL REGISTER



BARCLAYS GLOBAL INVESTORS, N.A. (UNITED STATES FEDERALLY CHARTERED BANKING INSTITUTION)
45 FREMONT STREET
SAN FRANCISCO, CA 94105

FOR: BANKING SERVICES, MUTUAL FUND INVESTMENT ADVISORY SERVICES, INVESTMENT MANAGEMENT SERVICES AND FINANCIAL SERVICES IN THE NATURE OF POOLED INVESTMENT FUNDS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 8-18-2006; IN COMMERCE 8-18-2006.

OWNER OF U.S. REG. NOS. 2,422,249 AND 3,111,466.

THE COLOR(S) BLUE, GREEN AND BLACK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE COLOR BLACK APPEARS IN THE WORDING ISHARES. THREE GEOMETRIC BOXES TO THE LEFT OF THE WORDING ARE IN THE COLORS GREEN FOR THE TOP BOX AND BLUE FOR THE TWO LOWER BOXES.

SN 78-937,373, FILED 7-25-2006.

TARAH HARDY, EXAMINING ATTORNEY