

ESTTA Tracking number: **ESTTA324281**

Filing date: **12/28/2009**

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 | ACE Limited |
| Granted to Date of previous extension | 01/06/2010 |
| Address | Barengasse 32 Zurich, CH-8001 SWITZERLAND |

| | |
|----------------------|---|
| Attorney information | Alfred W. Zaher Blank Rome LLP One Logan Square130 North 18th Street Philadelphia, PA 19103 UNITED STATES dwyer-s@blankrome.com, zaher@blankrome.com |
|----------------------|---|

Applicant Information

| | | | |
|--------------------------------|--|---------------------------------|------------|
| Application No | 77344625 | Publication date | 09/08/2009 |
| Opposition Filing Date | 12/28/2009 | Opposition Period Ends | 01/06/2010 |
| International Registration No. | NONE | International Registration Date | NONE |
| Applicant | Allied Sovereign and Equitable Assurance Company Ltd. Ground Floor Dayrells Ct. Business Centre, Dayrell Rd Christ Church, BB14030 BARBADOS | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 036. All goods and services in the class are opposed, namely: Insurance services, namely, administration and management of personal wealth and asset protection in the form of estate planning, succession structure, custodial accounts and investment management |
|---|

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 77078870 | Application Date | 01/09/2007 |
| Registration Date | NONE | Foreign Priority Date | NONE |

| | |
|---------------------|---|
| Word Mark | SOVEREIGN RISK INSURANCE LTD |
| Design Mark |  |
| Description of Mark | The mark consists of the word "SOVEREIGN" with a spherical object above - inside the spherical object are two individuals. Below "SOVEREIGN" is the wording "RISK ASSURANCE LTD". |
| Goods/Services | Class 036. First use: Insurance, reinsurance and underwriting services in the field of political risk |

| | | | |
|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 77072383 | Application Date | 12/28/2006 |
| Registration Date | NONE | Foreign Priority Date | NONE |

| | |
|---------------------|--|
| Word Mark | SOVEREIGN |
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 036. First use: Insurance, reinsurance and underwriting services in the field of political risk |

| | |
|---------------------|----------|
| Related Proceedings | 91192269 |
|---------------------|----------|

| | |
|-------------|--|
| Attachments | 77078870#TMSN.jpeg (1 page)(bytes) 77072383#TMSN.jpeg (1 page)(bytes) SOVEREIGNOPPOS.pdf (21 pages)(370024 bytes) |
|-------------|--|

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 | /Sean W. Dwyer/ |
| Name | Sean W. Dwyer |
| Date | 12/28/2009 |

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

| | | |
|----------------------------------|---|-------------------------|
| ACE Limited, | : | |
| a corporation of Switzerland, | : | |
| | : | |
| Opposer, | : | Serial No. : 77/344,625 |
| | : | |
| v. | : | |
| | : | |
| Allied Sovereign and | : | |
| Equitable Assurance Company Ltd. | : | |
| | : | |
| Applicant. | : | |
| | : | |

Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

Pursuant to Federal Rule of Civil Procedure 15(a) and 37 C.F.R. § 2.101 et seq., Opposer respectfully requests that the Board accept a Notice of Opposition against the mark ALLIED SOVEREIGN AND EQUITABLE ASSURANCE. We respectfully request that the above-indicated Notice of Opposition be instituted and that, in due course, notification be sent regarding answer dates and testimony periods. Please charge our Deposit Account No. 02-2555 for fees due in connection with the filing of this Notice of Opposition.

Respectfully submitted,
ACE LIMITED

Date: December 28, 2009

By: _____
Alfred W. Zaher
Sean W. Dwyer
Its Attorneys

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

In re Application of Allied Sovereign and Equitable Assurance Company Ltd.

Application No.: 77/344,625

Filed: December 5, 2007

Mark: ALLIED SOVEREIGN AND EQUITABLE ASSURANCE

| | |
|----------------------------------|---|
| ACE Limited, | : |
| a corporation of Switzerland, | : |
| | : |
| Opposer, | : |
| | : |
| v. | : |
| | : |
| Allied Sovereign and | : |
| Equitable Assurance Company Ltd. | : |
| | : |
| Applicant. | : |

Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

NOTICE OF OPPOSITION

Opposer ACE Limited, a corporation of Switzerland located at Barengasse 32, Zurich, Switzerland 8400, believes that it would be damaged by the registration of the mark shown in Application Serial No. 77/344,625 and hereby opposes the same under the provision of Section 13 of the Trademark Act of December 5, 2007, as amended, 15 U.S.C. § 1063.

As grounds of opposition, it is alleged that:

1. On December 28, 2006 Opposer filed U.S. Application No. 77/072,383 for the mark SOVEREIGN and on January 9, 2007 Opposer filed U.S. Application No. 77/078,870 for the mark SOVEREIGN RISK INSURANCE LTD , both for “insurance, reinsurance and underwriting services in the field of political risk” (hereinafter the SOVEREIGN mark) See printouts from the U.S.P.T.O. database attached as Exhibit A.

2. Opposer is the owner of all rights, title and interests in and to the SOVEREIGN mark, as set forth in Application Nos. 77/072,383 and 77/078, 870. Opposer's applications are valid and subsisting and are conclusive evidence of Opposer's exclusive right to its use of the SOVEREIGN mark in connection with insurance services.

3. Opposer’s constructive use dates are December 28, 2006 and January 29, 2007 respectively.

**APPLICANT'S MARK IS CONFUSINGLY SIMILAR
TO THE MARK OWNED BY OPPOSER**

4. On December 5, 2007, Applicant filed, Application No. 77/344,625 for registration of the mark ALLIED SOVEREIGN AND EQUITABLE ASSURANCE (hereinafter "Applicant's Mark") for “insurance services, namely, administration and management of personal wealth and asset protection in the form of estate planning, succession structure, custodial accounts and investment management.” Applicant's Mark was published for opposition in the Official Gazette dated . See printouts from the U.S.P.T.O. database attached as Exhibit B.

5. The application is filed intent to use.

6. Opposer's constructive use dates predate both Applicant's filing date.

7. Applicant's Mark is confusingly similar in sight, sound and meaning to the SOVEREIGN mark.

8. The services with which Applicant uses its mark are identical or closely related to services protected under the SOVEREIGN mark. Moreover, the services to be provided by the parties in connection with their respective marks are likely both to be offered in the same and/or similar channels of trade, and to the same and/or similar customers.

9. The use and registration of Applicant's mark to identify its services is likely to cause confusion, mistake and deception as to the source, origin, sponsorship or association with Opposer. Further, Applicant's use of Applicant's mark will interfere with Opposer's intended use of the SOVEREIGN mark and will impede Opposer in the free use of the SOVEREIGN mark.

10. Any defects, objections or faults found with the services offered, sold or rendered by Applicant under Applicant's mark, because of the false association with Opposer, would inflict upon and seriously injure the reputation of Opposer.

11. The grant of a Certificate of Registration to Applicant for the subject mark would be inconsistent with and in derogation of Opposer's prior rights and would therefore cause damage and injury to Opposer under 15 U.S.C. § 1052(d) and deception of and confusion to the public.

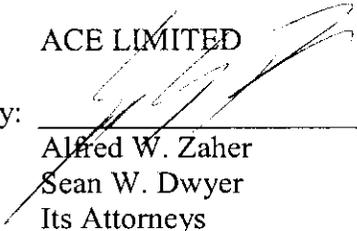
WHEREFORE, Opposer prays that this opposition be sustained and that Application
Serial No. 77/344,625 be refused Registration.

Respectfully submitted,

ACE LIMITED

Date: December 28, 2009

By: _____


Alfred W. Zaher
Sean W. Dwyer
Its Attorneys

BLANK ROME LLP
ONE LOGAN SQUARE
PHILADELPHIA, PA 19103
(215) 569-5539

CERTIFICATE OF ELECTRONIC FILING

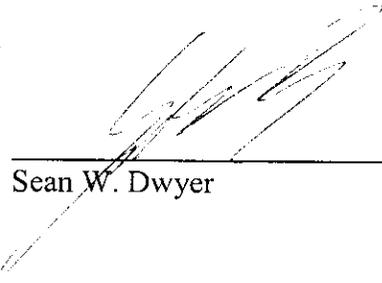
I hereby certify that this correspondence is addressed to the Trademark Trial and Appeal Board, Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, and is being deposited via the Electronic System for Trademark Trials and Appeals (ESTTA) on December 28, 2009.

Sean W. Dwyer

CERTIFICATE OF SERVICE

I, Sean W. Dwyer, do hereby certify that I have on December 28, 2009, mailed via first class mail, the foregoing Notice of Opposition to the following:

Jeffrey S. Ellsworth
Wegman, Hessler and Vanderburg
6055 Rockside Woods, Blvd
N Ste 200
Cleveland, OH 44131



Sean W. Dwyer

Exhibit A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-12-28 15:29:49 ET

Serial Number: 77072383 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

SOVEREIGN

(words only): SOVEREIGN

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2009-03-17

Filing Date: 2006-12-28

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 116

Attorney Assigned:
LAWRENCE SUSAN KASTRINER

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-10-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. ACE Limited

Address:
ACE Limited
Barengasse 32

Zurich CH-8001

Switzerland

Legal Entity Type: Corporation

State or Country of Incorporation: Cayman Islands

GOODS AND/OR SERVICES

International Class: 036

Class Status: Active

Insurance, reinsurance and underwriting services in the field of political risk

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-04-29 - Assignment Of Ownership Not Updated Automatically

2009-03-17 - Opposition instituted for Proceeding

2009-03-13 - Applicant/Correspondence Changes (Non-Responsive) Entered

2009-03-13 - TEAS Change Of Owner Address Received

2008-12-02 - Extension Of Time To Oppose Received

2008-11-18 - Published for opposition

2008-10-29 - Notice of publication

2008-10-15 - Law Office Publication Review Completed

2008-10-15 - Approved for Pub - Principal Register (Initial exam)

2008-10-15 - LIE Checked Susp - To Atty For Action

2008-10-15 - Assigned To LIE

2008-04-12 - Report Completed Suspension Check Case Still Suspended

2008-04-12 - Assigned To LIE

2007-10-11 - Notification Of Letter Of Suspension E-Mailed

2007-10-11 - LETTER OF SUSPENSION E-MAILED

2007-10-11 - Suspension Letter Written

2007-09-27 - Teas/Email Correspondence Entered

2007-09-27 - Communication received from applicant

2007-09-27 - TEAS Response to Office Action Received

2007-03-28 - Non-final action e-mailed

2007-03-28 - Non-Final Action Written

2007-03-27 - Assigned To Examiner

2007-01-03 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Alfred W. Zaher

Correspondent

ALFRED W. ZAHER

BLANK ROME LLP

ONE LOGAN SQUARE 130 NORTH 18TH STREET

PHILADELPHIA, PA 19103

Phone Number: 215-569-5364

Fax Number: 215-832-5364



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)[Assignments on the Web](#) > Trademark Query**Trademark Assignment Abstract of Title****Total Assignments: 1****Serial #:** 77072383**Filing Dt:** 12/28/2006**Reg #:** NONE**Reg. Dt:****Applicant:** ACE Limited**Mark:** SOVEREIGN**Assignment: 1****Reel/Frame:** [3977/0299](#)**Received:** 04/27/2009**Recorded:** 04/27/2009**Pages:** 26**Conveyance:** CHANGE OF INCORPORATION**Assignor:** [ACE LIMITED](#)**Exec Dt:** 12/16/2008**Entity Type:** CORPORATION**Citizenship:** CAYMAN ISLANDS**Assignee:** [ACE LIMITED](#)

BARENGASSE 32

ZURICH, SWITZERLAND 8001

Entity Type: CORPORATION**Citizenship:** SWITZERLAND**Correspondent:** ALFRED W. ZAHER

BLANK ROME LLP

ONE LOGAN SQUARE

PHILADELPHIA, PA 19103

Search Results as of: 12/28/2009 03:29 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350.
Web interface last modified: October 18, 2008 v.2.0.2[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-12-28 15:30:16 ET

Serial Number: 77078870 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark



(words only): SOVEREIGN RISK INSURANCE LTD

Standard Character claim: No

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2009-07-08

Filing Date: 2007-01-09

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 116

Attorney Assigned:
LAWRENCE SUSAN KASTRINER

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-12-10

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. ACE Limited

Address:
ACE Limited
Barengasse 32

Zurich CH-8001

Switzerland

Legal Entity Type: Corporation

State or Country of Incorporation: Cayman Islands

GOODS AND/OR SERVICES

International Class: 036

Class Status: Active

Insurance, reinsurance and underwriting services in the field of political risk

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "RISK INSURANCE LTD"

Description of Mark: The mark consists of the word "SOVEREIGN" with a spherical object above - inside the spherical object are two individuals. Below "SOVEREIGN" is the wording "RISK ASSURANCE LTD".

Design Search Code(s):

02.01.02 - Men depicted as shadows or silhouettes of men; Silhouettes of men

02.07.01 - Groups, males

02.09.11 - Humans engaged in other work; Humans, including men, women and children, depicted engaged in other work

26.19.01 - Spheres (geometric)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-07-08 - Opposition instituted for Proceeding

2009-04-29 - Assignment Of Ownership Not Updated Automatically

2009-03-13 - Applicant/Correspondence Changes (Non-Responsive) Entered

2009-03-13 - TEAS Change Of Owner Address Received

2009-01-30 - Extension Of Time To Oppose Received
2009-01-13 - Published for opposition
2008-12-24 - Notice of publication
2008-12-10 - Law Office Publication Review Completed
2008-12-10 - Approved for Pub - Principal Register (Initial exam)
2008-12-09 - LIE Checked Susp - To Atty For Action
2008-06-09 - Notification Of Letter Of Suspension E-Mailed
2008-06-09 - LETTER OF SUSPENSION E-MAILED
2008-06-09 - Suspension Letter Written
2008-05-21 - Teas/Email Correspondence Entered
2008-05-21 - Communication received from applicant
2008-05-21 - TEAS Response to Office Action Received
2007-11-26 - Notification Of Non-Final Action E-Mailed
2007-11-26 - NON-FINAL ACTION E-MAILED
2007-11-26 - Non-Final Action Written
2007-11-01 - Teas/Email Correspondence Entered
2007-11-01 - Communication received from applicant
2007-11-01 - Assigned To LIE
2007-09-28 - TEAS Response to Office Action Received
2007-03-28 - Non-final action e-mailed
2007-03-28 - Non-Final Action Written
2007-03-27 - Assigned To Examiner
2007-01-18 - Notice Of Design Search Code And Pseudo Mark Mailed
2007-01-17 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Alfred W. Zaher

Correspondent

ALFRED W. ZAHER

BLANK ROME LLP

ONE LOGAN SQUARE 130 NORTH 18TH STREET

PHILADELPHIA, PA 19103

Phone Number: 215-569-5364

Fax Number: 215-832-5364



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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title**Total Assignments: 1****Serial #:** 77078870**Filing Dt:** 01/09/2007**Reg #:** NONE**Reg. Dt:****Applicant:** ACE Limited**Mark:** SOVEREIGN RISK INSURANCE LTD**Assignment: 1****Reel/Frame:** [3977/0299](#)**Received:** 04/27/2009**Recorded:** 04/27/2009**Pages:** 26**Conveyance:** CHANGE OF INCORPORATION**Assignor:** [ACE LIMITED](#)**Exec Dt:** 12/16/2008**Entity Type:** CORPORATION**Citizenship:** CAYMAN ISLANDS**Assignee:** ACE LIMITED

BARENGASSE 32

ZURICH, SWITZERLAND 8001

Entity Type: CORPORATION**Citizenship:** SWITZERLAND**Correspondent:** ALFRED W. ZAHER

BLANK ROME LLP

ONE LOGAN SQUARE

PHILADELPHIA, PA 19103

Search Results as of: 12/28/2009 03:30 PM

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Web interface last modified: October 18, 2008 v.2.0.2[.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Exhibit B

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-12-28 15:31:09 ET

Serial Number: 77344625 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

ALLIED SOVEREIGN AND EQUITABLE ASSURANCE

(words only): ALLIED SOVEREIGN AND EQUITABLE ASSURANCE

Standard Character claim: Yes

Current Status: A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

Date of Status: 2009-10-06

Filing Date: 2007-12-05

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 109

Attorney Assigned:
MARCY AMY ALFIERI

Current Location: 650 -Publication And Issue Section

Date In Location: 2009-08-05

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Allied Sovereign and Equitable Assurance Company Ltd.

Address:
Allied Sovereign and Equitable Assurance Company Ltd.

Ground Floor Dayrells Ct. Business Centre, Dayrell Rd
Christ Church BB14030
Barbados
Legal Entity Type: Limited Liability Company
State or Country Where Organized: Barbados

GOODS AND/OR SERVICES

International Class: 036

Class Status: Active

Insurance services, namely, administration and management of personal wealth and asset protection in the form of estate planning, succession structure, custodial accounts and investment management

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Disclaimer: "EQUITABLE ASSURANCE"

Foreign Application Number: 1350697

Country: Canada

Foreign Filing Date: 2007-06-07

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-10-06 - Extension Of Time To Oppose Received

2009-09-08 - Published for opposition

2009-08-19 - Notice of publication

2009-08-05 - Law Office Publication Review Completed

2009-07-23 - Approved for Pub - Principal Register (Initial exam)

2009-06-18 - Amendment From Applicant Entered

2009-06-18 - Communication received from applicant

2009-06-16 - PAPER RECEIVED

2009-05-28 - Notification Of Inquiry As To Suspension E-Mailed

2009-05-28 - INQUIRY TO SUSPENSION E-MAILED

2009-05-28 - Suspension Inquiry Written

2009-05-04 - LIE Checked Susp - To Atty For Action

2008-11-04 - Notification Of Letter Of Suspension E-Mailed

2008-11-04 - LETTER OF SUSPENSION E-MAILED

2008-11-04 - Suspension Letter Written

2008-10-06 - Teas/Email Correspondence Entered

2008-10-06 - Communication received from applicant

2008-10-06 - Assigned To LIE

2008-09-23 - TEAS Response to Office Action Received

2008-03-24 - Notification Of Non-Final Action E-Mailed

2008-03-24 - Non-final action e-mailed

2008-03-24 - Non-Final Action Written

2008-03-15 - Assigned To Examiner

2007-12-10 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Jeffrey S. Ellsworth

Correspondent

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Phone Number: 216-642-3342
Fax Number: 216-642-8826



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No assignment has been recorded at the USPTO

For Serial Number: 77344625

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Web interface last modified: October 18, 2008 v.2.0.2

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