

ESTTA Tracking number: **ESTTA469074**

Filing date: **04/25/2012**

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	Discover Financial Services
Granted to Date of previous extension	04/25/2012
Address	2500 Lake Cook Road Riverwoods, IL 60015 UNITED STATES

Attorney information	Michael D. Adams Mayer Brown LLP 71 South Wacker Chicago, IL 60603 UNITED STATES ipdocket@mayerbrown.com, jlwhite@mayerbrown.com, mdadams@mayerbrown.com
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Applicant Information

Application No	85383591	Publication date	12/27/2011
Opposition Filing Date	04/25/2012	Opposition Period Ends	04/25/2012
Applicant	Professional Federal Credit Union 1710 St. Joe River Drive Fort Wayne, IN 46805 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Banking and Credit Union Services including Credit Lines and Checking Accounts with Overdraft Protection

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85192463	Application Date	12/07/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PROTECTBUY		

Design Mark	<h1>PROTECTBUY</h1>
Description of Mark	NONE
Goods/Services	<p>Class 036. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Financial services, namely, banking, credit card services, debit card services and payment processing for point-of-sale transactions; financial advisory services</p> <p>Class 042. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Data encryption services, namely, encryption of payment information</p> <p>Class 045. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Purchaser and merchant authentication services for financial transactions</p>

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PROTECTBUY		
Goods/Services	financial, banking, payment processing, credit card, debit card, security, and fraud prevention products		

Attachments	85192463#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (6 pages)(16095 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 USPS Express Mail Post Office to Addressee on this date.

Signature	/Jason L. White/
Name	Jason L. White
Date	04/25/2012

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

In the matter of trademark application Serial No. 85/383,591
Filed: July 28, 2011
For the mark: PROTECT
Published in the Official Gazette on: **December 27, 2011**

DISCOVER FINANCIAL SERVICES,)	
)	
Opposer,)	
)	
v.)	Opposition No.: Pending
)	
PROFESSIONAL FEDERAL)	
CREDIT UNION,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Discover Financial Services (hereinafter “Discover”), believes that it is being and will be damaged by registration of the PROTECT mark in application 85/383,591 for use in connection with “*Banking and credit union services including credit lines and checking accounts with overdraft protection*” in International Class 36. Discover hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the Lanham Act), 15 U.S.C. § 1063(a).

The Parties and the Marks

1. Discover is a corporation organized under the laws of Delaware, United States, with its principal place of business located at 2500 Lake Cook Road, Riverwoods, Illinois 60015.
2. Discover and its affiliates are a leading global financial services institution which, for purposes relevant to the present Notice of Opposition, offers various financial, banking, payment processing, credit card, debit card, security, and fraud prevention products to customers

under its PROTECTBUY term and various iterations of the same. Discover first used the PROTECTBUY term in U.S. commerce at least as early as January 31, 2011.

3. Discover is the owner of U.S. Ser. No. 85/192,463 for PROTECTBUY for use in connection with “*financial services, namely, banking, credit card services, debit card services and payment processing for point-of-sale transactions; financial advisory services*” in International Class 36, “*data encryption services, namely, encryption of payment information*” in International Class 42, and “*purchaser and merchant authentication services for financial transactions*” in International Class 45 (the “PROTECTBUY Application”). The PROTECTBUY Application was filed on December 7, 2010. A Statement of Use was filed on March 19, 2012 and was accepted by the United States Patent and Trademark Office on April 17, 2012. As such, the PROTECTBUY Application will register in due course and, at which time the PROTECTBUY Application will enjoy a priority date at least as early as December 7, 2010, the date the application was filed.

4. Upon information and belief, applicant Professional Federal Credit Union (“ProFed”) is a federally chartered credit union organized under the laws of Indiana, United States, with its principal place of business located at 1710 St. Joe River Drive, Fort Wayne, Indiana 46805.

5. ProFed’s application Serial No. 85/383,591 for PROTECT (the “PROTECT Application”) largely incorporates, is dominated in sight, sound, and style by, and creates a clear commercial impression with Discover’s PROTECTBUY Application and mark.

Likelihood of Confusion With Discover’s Prior Application

Section 2(d), 15 U.S.C. § 1052(d)

6. Discover repeats and realleges each and every allegation set forth in Paragraphs 1-5.

7. Discover's rights in its PROTECTBUY Application date back to at least as early as December 7, 2010, and Discover has used its PROTECTBUY Application, and formatives of the same, in U.S. commerce. The filing date of the PROTECT Application is July 28, 2011, and it claims an intent to use the mark in U.S. commerce. As a result, Discover has priority based on its prior use and ownership of the PROTECTBUY Application.

8. The PROTECT Application for the "PROTECT" term largely incorporates, is dominated in sight, sound, and style by, and creates a clear commercial impression with Discover's PROTECTBUY Application.

9. The highly similar, if not identical, nature of the PROTECTBUY Application and the PROTECT Application in sight, sound, and commercial impression is particularly pronounced given the nature of the banking, credit, and overdraft protection services in the PROTECT Application, which are very similar, if not identical, to the products offered by Discover and claimed in the PROTECTBUY Application. As a result, the goods and services, as well as the relevant consumers and channels of trade, of the PROTECTBUY Application and subsequent PROTECT Application are highly similar, if not identical.

10. On information and belief, ProFed adopted its mark after Discover's established ownership of the PROTECTBUY Application, and ProFed modeled its trademark filing after the branding strategy established by Discover for the PROTECTBUY Application.

11. ProFed's junior use of an identical branding strategy and a highly similar, if not identical, trademark for use in connection with highly similar, if not identical, goods and services overlaps and duplicates the PROTECTBUY Application and will inevitably lead consumers to believe that Discover is the source of the products, or that ProFed is affiliated, endorsed, or sponsored by Discover, all in violation of Discover's rights in the PROTECTBUY Application.

12. For the foregoing reasons, Discover believes and alleges that it is being and will be damaged by the registration of the PROTECT Application Serial No. 85/383,591.

Likelihood of Confusion With Discover's Common Law Rights

Section 2(d), 15 U.S.C. § 1052(d)

13. Discover repeats and realleges each and every allegation set forth in Paragraphs 1-12.

14. Based on Discover's continuous use of the PROTECTBUY term in U.S. commerce, the PROTECTBUY mark has become a distinctive source indicator of the various financial, banking, payment processing, credit card, debit card, security, and fraud prevention products offered by Discover, and Discover has not abandoned these common law rights.

15. Discover's common law rights in the PROTECTBUY mark, which date back to at least as early as January 31, 2011, are well prior to the July 28, 2011 filing date of the PROTECT Application, which was filed on an intent to use basis. Discover therefore has priority based on its prior and subsisting use of the PROTECTBUY mark.

16. The PROTECT Application for the "PROTECT" term largely incorporates, is dominated in sight, sound, and style by, and creates a clear commercial impression with Discover's PROTECTBUY mark.

17. The highly similar, if not identical, nature of the PROTECTBUY mark and the PROTECT Application in sight, sound, and commercial impression is particularly pronounced given the nature of the banking, credit, and overdraft protection services in the ProFed Application, which are very similar, if not identical, to the products offered by Discover under the PROTECTBUY mark. As a result, the goods and services, as well as the relevant consumers and channels of trade, of the PROTECTBUY mark and subsequent PROTECT Application are highly similar, if not identical.

18. On information and belief, ProFed adopted its mark after Discover's established use and promotion of the PROTECTBUY mark, and ProFed modeled its trademark filing after the branding strategy established by Discover for the PROTECTBUY mark.

19. ProFed's junior use of an identical branding strategy and a highly similar, if not identical, trademark for use in connection with highly similar, if not identical, goods and services overlaps and duplicates the PROTECTBUY mark and will inevitably lead consumers to believe that Discover is the source of the products, or that ProFed is affiliated, endorsed, or sponsored by Discover, all in violation of Discover's rights in the PROTECTBUY mark.

20. For the foregoing reasons, Discover believes and alleges that it is being and will be damaged by the registration of the PROTECT Application Serial No. 85/383,591.

WHEREFORE, Discover respectfully requests that application Serial No. 85/383,591 be refused registration and judgment in the present opposition be entered in favor of Discover and against ProFed, with prejudice.

Respectfully submitted,

DISCOVER FINANCIAL SERVICES

By: /Jason L. White/

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CERTIFICATE OF MAILING

I hereby certify that, on this 25th day of April, 2012, this Notice of Opposition is being sent via UPS Overnight to:

GEORGE PAPPAS
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919 S HARRISON ST STE 300
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By: /Jason L. White/
Jason L. White