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

Proceeding	92057574
Party	Plaintiff Transamerica Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TRANSAMERICA CORPORATION,)	
)	
Petitioner/Opposer,)	Opposition No. 91210715 (Parent)
)	Opposition No. 91210753
v.)	Cancellation No. 92057574
)	
TRANSTREND B.V.,)	
)	
)	
Respondent/Applicant.)	

AMENDED PETITION FOR CANCELLATION

Transamerica Corporation, pursuant to Section 14 of the Federal Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1064, hereby petitions the Trademark Trial and Appeal Board to cancel U.S. Registration No. 2,723,185 (hereinafter "the '185 Registration"), currently covering the following composite mark registered for "financial services, namely, capital asset management and consultancy in respect thereof," in International Class 36 (hereinafter "Respondent's Services"):



Petitioner believes that it will be damaged by the continued registration of this mark, on the grounds that this registration, as amended June 5, 2013 pursuant to Section 7 of the Lanham Act, 15 U.S.C. § 1057, is likely to cause confusion with Petitioner's numerous service mark registrations featuring the prefix "TRANS" and used in connection with financial services.

(1) Petitioner is a Delaware corporation principally located at 4333 Edgewood Road NE, Cedar Rapids, IA 52499-0001.

(2) Petitioner is a leading provider of financial services including insurance, investment management and retirement services. These services are provided through Petitioner's network of subsidiaries and operating divisions, which include:

- Transamerica Life Insurance Company and Transamerica Financial Life Insurance Company, a provider of insurance products with approximately \$1.3 trillion of insurance currently in force;
- Transamerica Capital, Inc., a wholesale marketing and sales group that assists financial professionals in providing retirement services, mutual funds, life insurance and annuities;
- Transamerica Financial Advisors, Inc., a full service broker/dealer and financial services provider;
- Transamerica Asset Management, Inc., a provider of investment management services;
- Transamerica Retirement Solutions Corporation, a third-party administrator for employer-sponsored retirement plans; and
- Transamerica Employee Benefits (formerly known as Transamerica Worksite Marketing), a provider of voluntary supplemental insurance products including term life, universal life, cancer, accident, and vision insurance.

(3) Petitioner's subsidiaries and operating divisions offer investment management and other financial services from offices throughout the United States and online through numerous websites including, among others, www.transamerica.com, www.transamericaannuities.com, www.transamericafunds.com, www.ta-retirement.com, www.transamericaseriestrust.com, www.transamericaemployeebenefits.com, and www.transamericainvestments.com.

(4) Petitioner, through its subsidiaries and their predecessors, has used the name "TRANSAMERICA" since 1929 as its principal trade name and service mark for all of its

services, as evidenced by U.S. Service Mark Registration 718,358 for “consultation and advice in respect to investment of monies of others.”

(5) Petitioner owns the following federal registrations duly issued by the PTO and appearing on the Principal Register:

<u>Mark</u>	<u>Reg.</u>	<u>Services</u>
TRANSAMERICA	718358	Consultation and advice in respect to investment of monies of others, in Class 35 (first use 1/1929)
TRANSAMERICA	831626	Underwriting of insurance – namely, life, including accident and health, in Class 36 (first use 7/18/1959)
TRANSAMERICA	978808	Financial services rendered to others – namely, providing loan services to others, providing consumer credit services, insurance underwriting and investment services (first use 1958)
TRANSAMERICA	1635682	Financial consulting services; investment management and counseling services; mutual funds management sales and distribution services; insurance premium financing services; insurance underwriting services for life, disability insurance; life reinsurance services; insurance agency services; underwriting services for variable life insurance and variable annuity products (first use 9/30/1989)

(6) In addition to TRANSAMERICA, Petitioner owns a family of marks with the prefix “TRANS,” used by Petitioner’s subsidiaries and their predecessors since at least 1986, including, but not limited to, the following federally registered marks:

<u>Mark</u>	<u>Reg.</u>	<u>Services</u>
TRANSPLUS	1536748	Annuity underwriting services, in Class 36 (first use 11/1986)
TRANSCARE	1672078	Health insurance underwriting services, in Class 36 (first used 12/3/1990)
TRANSCARE OPTIONS	2672415	Health insurance underwriting services and/or long term care indemnity insurance underwriting providing for nursing and/or nursing home services, physical respiratory and/or speech therapy, audiological services, medical and/or social services, home care services, namely, bathing, dressing, toilet, adult day care services, nursing facility and/or assisted living care facility services, home modification services, therapeutic device rental or purchase, bed reservation services in nursing facilities and/or hospice care services, in Class 36 (first used 6/1/2002)
TRANSULTRA	1731606	Life insurance underwriting services, in Class 36 (first use 11/27/1991)

<u>Mark</u>	<u>Reg.</u>	<u>Services</u>
TransAdvantage	1902999	Life insurance underwriting services, in Class 36 (first use 4/12/1994)
TRANSEQUITY	1934916	Life insurance underwriting services containing investment options for policy holders, in Class 36 (first use 4/25/1994)
TRANSSAVERS	1982523	Life insurance underwriting services, in Class 36 (first use 5/1/1995)
TRANSVALUE	2218549	Life insurance underwriting services, in Class 36 (first use 7/2/1997)
TRANSDIRECT	2125499	Providing information on-line via computer to customers regarding pension accounts, in Class 36 (first use 10/31/1996)
TRANSLIFE	2223978	Life insurance underwriting services, in Class 36 (first use 9/13/1989)
TRANSCENDER	1424244	Life insurance underwriting services, in Class 36 (first use 11/1/1985)
TRANSEQUITY	1487796	Life insurance underwriting services, in Class 36 (first use 4/7/1987)
TRANSMAX	1364880	Insurance underwriting services, in Class 36 (first use 2/15/1985)
TRANSMILLENIUM	2277415	Life insurance underwriting services, in Class 36 (first use 11/17/1997)
TRANSFREEDOM	2514570	Annuity underwriting services, in Class 36 (first use 2/1/2000)
TRANSACT	2648195	Providing marketing information to insurance brokers, agents and consumers for purposes of marketing insurance products, in Class 35 (first use 9/11/1998) Providing insurance information to insurance brokers, agents and consumers for purposes of marketing insurance products, in Class 36 (first use 9/11/1998)
TRANSACE	2717097	Life insurance underwriting services, in Class 36 (first use 5/31/2001)
TRANSACE SURVIVOR	2720613	Life insurance underwriting services, in Class 36 (first use 5/31/2001)
TRANSSMILE	2761407	Dental insurance underwriting services, in Class 36 (first used 6/1/2002)
TRANSCONNECT	2836281	Health insurance underwriting services, in Class 36 (first used 5/15/2003)
TRANSSECURE	3000511	Life insurance underwriting, in Class 36 (first use 9/15/2003)
TRANSACCUMULATOR	3003173	Life insurance and annuity underwriting services, in Class 36 (first use 2/4/2002)
TRANSCHOICE	3022835	Health insurance underwriting services, in Class 36 (first use 3/1/2004)
TRANSEXPRESS	3117788	Life insurance underwriting services, in Class 36 (first use 8/1/2005)

<u>Mark</u>	<u>Reg.</u>	<u>Services</u>
TRANSULTRA PLUS	3131783	Life insurance underwriting services, in Class 36 (first use 8/3/2005)
TRANSWARE	3170495	Computer software for use in estimating the appropriate amount of life insurance coverage and calculating premiums and future value of life insurance policies, in Class 9 (first use 9/12/2005)
TRANS-\$AVER	3204909	Life insurance underwriting, in Class 36 (first use 3/15/2006)
TRANSLINK	3209503	Health insurance underwriting featuring online enrollment, in Class 36 (first use 7/2005)
TRANSPROTECTOR	3238738	Life insurance underwriting, in Class 36 (first use 8/1/2006)
TRANSDI	3342536	Disability insurance underwriting services, in Class 36 (first use 2/1/2007)
TRANSQUOTE	3679130	Long term care insurance underwriting services, in Class 36 (first use 10/2008)
TRANSABILITY	3765109	Financial planning and investment advisory services; providing information and advice to financial planners and life insurance professionals with clients who have children or relatives with special needs, in Class 36 (first use 10/12/2009)
TRANSSECURITY	3935547	Financial planning and life insurance underwriting; providing information and advice to financial planners and life insurance professionals relating to the establishment of trusts funded by or otherwise using life insurance, in Class 36 (first use 1/31/2010)
TRANSTERM	3989732	Insurance services, namely, underwriting, issuing and administration of life insurance, in Class 36 (first use 2/1/2011)
TRANSLINK	4104530	Providing referrals in the field of life insurance premium financing, in Class 35 (first use 12/31/2010) Facilitating and arranging for life insurance premium financing; consultancy services in the field of life insurance premium financing (first use 12/31/2010)
TRANS SELECT	4251049	Life insurance underwriting, in Class 36 (first use 5/31/2012)
TRANSCENTRAL	4347935	Providing temporary use of non-downloadable computer software for administration of a company intranet, in Class 36 (first use 5/16/2012)
TRANSAPP	4384632	Life and health insurance services featuring online enrollment, namely, underwriting, issuing and administration of life and health insurance, in Class 36 (first use 12/1/2011)
TRANSAPP	4397305	Business services, namely, administration of a program for enabling participants to engage in online enrollment for pre-paid legal services and identity theft protection services, in Class 36 (first use 12/1/2011)

(7) Collectively, the registrations referenced above are hereinafter referred to as “Petitioner’s Marks” and the services identified therein as “Petitioner’s Services.”

(8) Of the registrations pleaded above by Petitioner in support of this Petition, all those over five years old are “incontestable” under Section 15 of the Lanham Act, 15 U.S.C. § 1065, constituting thereby conclusive evidence of (i) the registration of the marks, (ii) the validity of the registered marks, (iii) Petitioner’s ownership of the marks, and (iv) Petitioner’s exclusive right to use the marks in commerce in connection with the identified goods and services, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

(9) Petitioner and its subsidiaries have spent substantial sums of money since 1929 to advertise and promote the name TRANSAMERICA in connection with financial services. For at least 25 years, such advertising and promotion has been further directed to Petitioner’s family of “TRANS”-prefix service marks. These marks have acquired distinctiveness and are recognized by the public as a designation of source that identifies Petitioner as the origin of financial services offered under these marks.

Likelihood of Confusion between Petitioner’s Marks and Respondent’s Amended Mark

(10) The ‘185 Registration, at the time of registration on June 10, 2003, appeared as follows:



(11) On June 5, 2013, Respondent filed a Section 7 request to amend the ‘185 Registration, stating that the design below “updates the design of the stylized letter ‘T’, does not

alter materially the character of the mark as all the essence of the mark as registered and the mark, as amended, creates essentially the same impression as the original mark.”



(12) Respondent’s amended registration represents an enlargement of the rights conferred by the original certificate of registration, and there is a likelihood of confusion between the mark currently depicted in the ‘185 Registration (“Respondent’s Mark”) and Petitioner’s Marks.

(13) Petitioner used its “TRANS”-prefix Marks prior to first use of Respondent’s Mark.

(14) Respondent’s Mark is similar in commercial impression to Petitioner’s Marks because the salient feature of the mark is the term “TRANSTREND,” which employs the prefix “TRANS” as part of a non-descriptive, composite term.

(15) Respondent’s Services are similar, overlapping and/or materially identical to Petitioner’s Services.

(16) On information and belief, the services described in the Respondent’s registration are offered, likely to be offered, or capable of being offered and sold to classes of consumers that are similar, overlapping or materially identical to those of Petitioner, through channels of trade that are similar, overlapping or materially identical to those of Petitioner. With or without such similarities, Respondent’s Mark bears such a similar commercial impression to Petitioner’s prior-registered “TRANS”-prefix marks, that when applied to Respondent’s Services, it is likely to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that

Respondent's Services originate from or are associated with Petitioner, or that Respondent's Services are authorized, endorsed or sponsored by Petitioner.

(17) Respondent's ownership and use of the amended '185 Registration is without license, authorization or permission from Petitioner.

(18) Petitioner will be damaged if the '185 Registration is allowed to remain registered because the recent amendment represents an enlargement of statutory rights in violation and derogation of the established rights of Petitioner in its prior-registered Marks.

(19) Respondent's Mark is subject to cancellation pursuant to TBMP § 307.02. *See Stanspec Co. v. Am. Chain & Cable Co., Inc.*, 189 USPQ 420, 423 (CCPA 1976) and *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 824-25 (TTAB 1984)).

WHEREFORE, the '185 Registration should be cancelled on the grounds of likelihood of confusion with Petitioner's prior-registered family of "TRANS"-prefix marks.

Respectfully submitted,

TRANSAMERICA CORPORATION

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Date: April 1, 2014

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing AMENDED PETITION FOR CANCELLATION was served this 1st day of April, 2014, by electronic mail and first-class mail, postage prepaid, on Applicant's counsel of record:

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