

ESTTA Tracking number: **ESTTA546805**

Filing date: **07/03/2013**

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	BlueBay Asset Management (Services) Limited		
Entity	Limited Company	Citizenship	United Kingdom
Address	77 GROSVENOR STREET LONDON, W1K3JR UNITED KINGDOM		

Attorney information	Brent L. Farese Lerner, David, Littenberg, Krumholz, & Mentlik LLP 600 South Ave. West Westfield, NJ 07090 UNITED STATES BFarese@ldlkm.com, TPalisi@ldlkm.com, Litigation@ldlkm.com Phone:908-654-5000
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### Applicant Information

Application No	85876385	Publication date	06/04/2013
Opposition Filing Date	07/03/2013	Opposition Period Ends	07/04/2013
Applicant	Montpelier Re Holdings Ltd. Montpelier House 94 Pitts Bay Road, PO Box HM2079 Hamilton, HMHX BERMUDA		

### Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Financial advisory and consultancy services
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### Applicant Information

Application No	85806491	Publication date	06/04/2013
Opposition Filing Date	07/03/2013	Opposition Period Ends	07/04/2013
Applicant	Montpelier Re Holdings Ltd. Montpelier House 94 Pitts Bay Road, PO Box HM2079 Hamilton, HMHX BERMUDA		

### Goods/Services Affected by Opposition

Class 036. First Use: 2012/06/00 First Use In Commerce: 2012/06/00 All goods and services in the class are opposed, namely: Financial services, namely, asset and investment management services
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## Applicant Information

Application No	85871053	Publication date	06/04/2013
Opposition Filing Date	07/03/2013	Opposition Period Ends	07/04/2013
Applicant	Montpelier Re Holdings Ltd. Montpelier House 94 Pitts Bay Road, PO Box HM2079 Hamilton, HMHX BERMUDA		

## Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Insurance management and agent services, namely, underwriting services in the field of standard and non-standard property catastrophe insurance and reinsurance products, including claims management and administration services
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## 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. Registration No.	2866499	Application Date	07/19/2001
Registration Date	07/27/2004	Foreign Priority Date	07/18/2001
Word Mark	BLUEBAY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: MONETARY AFFAIRS, NAMELY, ASSET MANAGEMENT SERVICES; INVESTMENT SERVICES, NAMELY, INVESTMENT CONSULTATION AND MANAGEMENT; INVESTMENT FUND SERVICES, NAMELY, FUND MANAGEMENT SERVICES		

U.S. Registration No.	3524369	Application Date	10/02/2007
Registration Date	10/28/2008	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: Financial services, namely, asset management services, dealing in investments, namely, investment of funds for others, financial advice, research and consultancy services, providing information in the form of reports, newsletters, and articles on financial markets, financial investments and financial asset management		

U.S. Registration	4152281	Application Date	05/05/2011
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No.			
Registration Date	06/05/2012	Foreign Priority Date	11/05/2010
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a square design with two overall rectangular shaped sections inside. The outer border of the square is silver, with white shading, the inner border is white, the rectangular section on the right is silver and the section on the left is blue.		
Goods/Services	Class 036. First use: Financial services, namely, asset management services, dealing in investments, namely, investment of funds for others, financial advice, research and consultancy services, providing information in the form of reports, newsletters, and articles on financial markets, financial investments and financial asset management		

U.S. Application No.	79115905	Application Date	03/20/2012
Registration Date	NONE	Foreign Priority Date	03/16/2012
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a square with a wavy blue portion and a wavy grey portion separated by a white band. The blue portion of the mark fades in color from the top to the bottom of the mark, and the grey portion of the mark fades from the bottom to the top of the mark.		
Goods/Services	Class 036. First use: Financial services, namely, asset management services, dealing in investments, namely, investment of funds for others, financial advice, research and consultancy services, providing information in the form of reports, newsletters, and articles on financial markets, financial investments and financial asset management		

Related Proceedings	None.
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Attachments	Notice of Opposition - BlueBay.pdf(77799 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	/Brent L. Farese/
Name	Brent L. Farese
Date	07/03/2013

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

BLUEBAY ASSET MANAGEMENT  
(SERVICES) LTD.,

Opposer,

v.

MONTPELIER RE HOLDINGS, LTD.,

Applicant.

Serial Nos. 85/876,385,  
85/806,491, and  
85/871,053.

Filed: March 14, 2013,  
December 19, 2012, and  
March 8, 2013, respectively.

Published: June 4, 2013

For:



X Opposition No. \_\_\_\_\_

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

**NOTICE OF OPPOSITION**

Opposer, BlueBay Asset Management (Services) Ltd., a corporation having a place of business at 77 Grosvenor Street, London W1K 3JR, United Kingdom, believes that it will be damaged by registration of U.S. Ser. No. 85/876,385 for the mark BLUE CAPITAL ADVISORS

LTD. & Design, U.S. Ser. No. 85/806,491 for the mark BLUE CAPITAL MANAGEMENT LTD. & Design, and U.S. Ser. No. 85/871,053 for the mark BLUE CAPITAL INSURANCE MANAGERS LTD. & Design (collectively, the "Applications"), owned by Montpelier Re Holdings, Ltd. ("Applicant"), which is a corporation having a place of business at 94 Pitts Bay Road, P.O. Box HM2079, Hamilton HMHX, Bermuda. Accordingly, Opposer hereby opposes registration of the Applications as well as alleges the following:

1. On March 14, 2013, Applicant filed for registration of the mark BLUE CAPITAL ADVISORS LTD. & Design. On December 19, 2012, Applicant filed for registration of the mark BLUE CAPITAL MANAGEMENT LTD. & Design. And, on March 8, 2013, Applicant filed for registration of the mark BLUE CAPITAL INSURANCE MANAGERS LTD. & Design.

2. Opposer is the owner of Registration No. 2,866,499 for the mark BLUEBAY, which mark has been registered for the following services in International Class 36:

Monetary affairs, namely, asset management services; investment services, namely, investment consultation and management; investment fund services, namely, fund management services.

3. Opposer is the owner of Registration No. 3,524,369 for the following design mark:



4. Registration No. 3,524,369 has been registered for the following services in International Class 36:

Financial services, namely, asset management services, dealing in investments, namely, investment of funds for others, financial advice, research and consultancy services, providing information in the form of reports, newsletters, and articles on financial markets, financial investments and financial asset management.

5. Opposer is the owner of Registration No. 4,152,281 for the following design mark:



6. Registration No. 4,152,281 has been registered for the following services in International Class 36:

Financial services, namely, asset management services, dealing in investments, namely, investment of funds for others, financial advice, research and consultancy services, providing information in the form of reports, newsletters, and articles on financial markets, financial investments and financial asset management.

7. Opposer is the owner of Application Serial No. 79/115,905 for the following design mark:



8. Application Serial No. 79/115,905 has been granted protection and will be registered for the following services in International Class 36:

Financial services, namely, asset management services, dealing in investments, namely, investment of funds for others, financial advice, research and consultancy services, providing information in the form of reports, newsletters, and articles on financial markets, financial investments and financial asset management.

9. Opposer, during the time period extending from approximately October 2005 to November 2010,<sup>1</sup> used its BLUEBAY word mark, apart from and also in connection with the below-excerpted design, to promote its financial, investment, consultancy, and other business services.



10. Around approximately November 2010, Opposer continued use of its BLUEBAY word mark, apart from and also in connection with the below-excerpted design, to promote its financial, investment, consultancy, and other business services.



11. In or around approximately April 2012, Opposer continued use of its BLUEBAY word mark, apart from and also in connection with the below-excerpted design, to promote its financial, investment, consultancy, and other business services.

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<sup>1</sup> Although certain dates are detailed herein, Opposer notes that such dates are only approximate, and are not intended to represent the earliest or exact date upon which Opposer began or ceased using a particular iteration of its BLUEBAY and design marks. Further information may cause Opposer to modify the dates noted herein.



12. Opposer, or its predecessor(s) in interest, has been using the BLUEBAY word and design marks long before Applicant filed the Applications and/or adopted the BLUE CAPITAL ADVISORS LTD. & Design, BLUE CAPITAL MANAGEMENT LTD. & Design, and BLUE CAPITAL INSURANCE MANAGERS LTD. & Design marks.

13. As a result of the extensive promotion of its services, as set forth above and otherwise, Opposer has built up highly valuable goodwill in its BLUEBAY and design marks. Such goodwill has become closely and uniquely identified and associated with Opposer prior to the filing of the Applications by Applicant.

14. The Application for the BLUE CAPITAL ADVISORS LTD. & Design mark by Applicant is for services in International Class 36, including:

Financial advisory and consultancy services.

15. The Application for the BLUE CAPITAL MANAGEMENT LTD. & Design mark by Applicant is for services in International Class 36, including:

Financial services, namely, asset and investment management services.

16. The Application for the BLUE CAPITAL INSURANCE MANAGERS LTD. & Design mark by Applicant is for services in International Class 36, including:

Insurance management and agent services, namely, underwriting services in the field of standard and non-standard property catastrophe insurance and reinsurance products, including claims management and administration services.

17. The services covered by the Applications are similar to or closely related to the services offered by Opposer in connection with Opposer's BLUEBAY and design marks.

18. Applicant's BLUE CAPITAL ADVISORS LTD. & Design and its BLUE CAPITAL INSURANCE MANAGERS LTD. & Design marks were filed on an intent to use basis, pursuant to § 1(b), while Applicant's BLUE CAPITAL MANAGEMENT LTD. & Design mark was filed on a use basis, pursuant to § 1(a). Opposer has superior rights in and to its BLUEBAY and design marks because its common-law and registered uses predate the dates Applicant filed its Applications for registration of the BLUE CAPITAL ADVISORS LTD. & Design and BLUE CAPITAL INSURANCE MANAGERS LTD. & Design marks on, respectively, March 14, 2013 and March 8, 2013, and Opposer's common-law and registered uses predate the date of first use alleged by Applicant in its Application for the BLUE CAPITAL MANAGEMENT LTD. & Design mark, June 2012.

19. Opposer's BLUEBAY and design marks are substantially similar to Applicant's marks, and Opposer will suffer harm as a result of the confusion likely to arise from registration of the Applications, and from Opposer's ongoing use of its BLUEBAY and design marks for the same or similar services.

20. Accordingly, Applicant's marks should be denied registration under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)).

21. This opposition is timely given the filing deadline therefor of July 4, 2013.

22. Please charge a fee of \$900.00 for this Notice of Opposition to our Deposit Account No. 12-1095, \$300.00 for one class for each of the three (3) above-noted Applications.

If any other fees are believed due, the Board is authorized to charge our Deposit Account No. 12-1095 therefor. The undersigned is authorized to make charges to said deposit account.

WHEREFORE, Opposer requests that the Board refuse registration of Application Serial Nos. 85/876,385, 85/806,491, and 85/871,053, and that this Opposition be sustained.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP  
*Attorneys for Opposer BlueBay Asset  
Management (Services) Ltd.*  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000

Dated: July 3, 2013

By:           /Brent L. Farese/            
BRENT L. FARESE

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