

ESTTA Tracking number: **ESTTA562477**

Filing date: **10/01/2013**

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	Thrivent Financial for Lutherans
Granted to Date of previous extension	10/02/2013
Address	625 4th Avenue South Minneapolis, MN 55415 UNITED STATES

Attorney information	Heather Kliebenstein Merchant & Gould P.C. Suite 320080 South Eighth Street Minneapolis, MN 55402 UNITED STATES hkliebenstein@merchantgould.com, aries@merchantgould.com, dockmpls@merchantgould.com Phone:612-332-5300
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Applicant Information

Application No	85886732	Publication date	06/04/2013
Opposition Filing Date	10/01/2013	Opposition Period Ends	10/02/2013
Applicant	Ameriprise Financial, Inc. 5226 Ameriprise Financial Center Minneapolis, MN 55474 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Life insurance underwriting and administration, namely for life insurance policies with one or more riders providing for additional policy benefits or options

Grounds for Opposition

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

U.S. Registration No.	3534688	Application Date	02/26/2007
Registration Date	11/18/2008	Foreign Priority Date	NONE
Word Mark	TRIO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2007/02/23 First Use In Commerce: 2007/02/23 Providing online non-downloadable software for making calculations in the field of retirement planning, analysis and strategy

Related Proceedings	Federal lawsuit 13cv2360 in the U.S. District Court for the District of Minnesota
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Attachments	2013 10 01 Notice of Opposition.pdf(232784 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	/Heather Kliebenstein/
Name	Heather Kliebenstein
Date	10/01/2013

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

Thrivent Financial for Lutherans)	
)	Opposition No. _____
Opposer,)	
)	Mark: TRIO
v.)	
)	Application Ser. No. 85-886,732
Ameriprise Financial, Inc.)	
)	Filed: March 26, 2013
Applicant.)	
)	Published: June 4, 2013
)	

NOTICE OF OPPOSITION

Thrivent Financial for Lutherans (“Thrivent”), a Wisconsin Fraternal Benefit Society, having a principal place of business at 625 Forth Avenue South, Minneapolis, Minnesota 55414, believes it will be damaged by registration of TRIO as a trademark for a variety of insurance products in International Class 36 as set forth in Application Ser. No. 85-886,732, by Ameriprise Financial, Inc. (hereinafter referred to as “Applicant”), and hereby opposes the same upon the following grounds.

1. Thrivent is the owner of the registered trademark TRIO. At least as early as 2007, and long prior to Applicant’s filing date of March 26, 2013, Thrivent adopted and began using the mark TRIO for use on or in connection with numerous services relating to the financial field, which are and have been continuously used and marketed in interstate commerce by Thrivent.

2. Since at least as early as February 23, 2007, Thrivent adopted and began using the mark TRIO for use with “providing online non-downloadable software for making calculations in the field of retirement planning, analysis and strategy,” which is and has been marketed in commerce throughout the United States. On November 18, 2008, the United States Patent and Trademark Office registered on the Principal Register and issued to Thrivent Registration No.

3,534,688 for the mark TRIO. Registration No. 3,534,688 is presently valid and subsisting and is now owned by Thrivent and is prima facie evidence of Thrivent's exclusive right to use the TRIO mark in commerce with "providing online non-downloadable software for making calculations in the field of retirement planning, analysis and strategy."

3. Thrivent has also used the TRIO mark since 2007 to identify and promote its strategic retirement income and wealth management planning service. Based on the output from the TRIO software product, Thrivent representatives provide advice to members and potential members regarding retirement planning and what financial products are available to meet those goals.

4. Since 2007, Thrivent has continuously used the TRIO mark in commerce nationwide, including in Minnesota and all other states of the United States, to designate the source of Thrivent's TRIO branded software tool, strategic retirement income and strategic income and wealth management planning services, and marketing of various financial products.

5. Thrivent has expended substantial amounts of money in marketing, advertising and promoting the TRIO mark on or in connection with financial services and related products in the United States.

6. Thrivent has enjoyed substantial sales of services in the United States in connection with the use of the TRIO mark.

7. By reason of the extensive marketing, advertising and promotion of goods and services in connection with the TRIO mark and the high quality of those goods and services, these marks have extremely valuable goodwill that inures to the benefit of Thrivent.

8. Applicant is a Delaware corporation with a mailing address at 5226 Ameriprise Financial Center, Minneapolis, Minnesota 55474.

9. Applicant is seeking to obtain registration on the Principal Register of the mark TRIO, Application Serial No. 85-886,732, for use on or in connection with “life insurance underwriting and administration, namely for life insurance policies with one or more riders providing for additional policy benefits or options” in International Class 36.

10. There is no issue of priority concerning Application Serial No. 85-886,732 because Thrivent used and registered of its TRIO mark prior to March 26, 2013, Applicant’s filing date of its intent-to-use application.

11. The TRIO trademark for which Applicant seeks registration is confusingly similar to Thrivent’s TRIO mark.

12. Applicant’s TRIO is so confusingly similar to Thrivent’s TRIO mark as to be likely, when applied to Applicant’s services, to cause confusion, mistake, or deception as to the source of origin of Applicant’s services by creating the erroneous impression that Applicant’s services originate with, are sponsored by, approved or endorsed by, licensed by, affiliated or associated with, or in some other way legitimately connected to Thrivent.

13. The services for which Applicant seeks registration of the TRIO trademark, namely, “life insurance underwriting and administration, namely for life insurance policies with one or more riders providing for additional policy benefits or options” are sufficiently related to, and overlap with, the services marketed under Thrivent’s TRIO mark, and are likely to cause confusion among purchasers and potential customers of Applicant’s services.

14. For example, Thrivent uses the TRIO mark in connection with its retirement financial planning services. As part of these services, Thrivent markets and offers its customers insurance products. These services, and co-marketed products, overlap directly with Applicant’s life insurance products.

15. The services for which Applicant seeks registration of the TRIO trademark are likely to be sold or offered to, or used by, the same customers to whom Thrivent offers and provides its services under the TRIO mark. The services of Thrivent and Applicant will travel in the same channels of trade.

16. Applicant's TRIO mark is confusingly similar to Thrivent's TRIO mark and use thereof by the Applicant on the services specified in Application No. 85-886,732 is likely to cause confusion, mistake, or deception that Applicant's services are those of Thrivent or are otherwise endorsed, sponsored, or approved by Thrivent, whereby Thrivent will be damaged by registration of Applicant's TRIO mark on the Principal Register of the United States Patent and Trademark Office.

17. Thrivent enjoys substantial and exclusive goodwill and good reputation in connection with its TRIO trademark. This goodwill and reputation will be harmed by the use and registration of the mark TRIO by Applicant.

18. Applicant's intended adoption and use of its TRIO mark has been with actual or constructive knowledge of Thrivent's prior use of and registration of its TRIO mark.

19. Applicant's intended adoption and use of the TRIO trademark has been without Thrivent's consent or permission.

20. Granting a federal trademark registration to Applicant for its claimed TRIO mark as shown in Application Serial No. 85-886,732 would be contrary to 15 U.S.C. § 1052 (d) and would violate or diminish the prior and superior rights of Thrivent in its TRIO trademark, causing irreparable damage and injury to Thrivent.

PRAYER FOR RELIEF

WHEREFORE, Thrivent asks that its opposition to Application No. 85-886,732 be sustained and that the registration of the term TRIO set forth therein be refused. Please direct all correspondence to the attention of Heather J. Kliebenstein:

Merchant & Gould P.C.
PO Box 2910
Minneapolis, MN 55402
612-332-5300

Thrivent hereby appoints Allen W. Hinderaker, William D. Schultz, Heather J. Kliebenstein, Ian McFarland, John A. Clifford, Scott W. Johnston, Gregory C. Golla , Andy Ehard and other attorneys of the firm of Merchant & Gould P.C. as attorneys with the full power to represent Thrivent, to receive all correspondence related thereto and to represent it in all proceedings affecting the potential opposition of the mark.

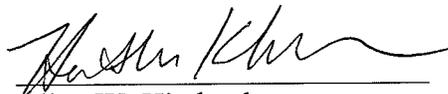
Accompanying the duplicate signed copies of this Notice of Opposition is the required fee of \$300.00. Please charge any fees or credit any overpayment to Deposit Account No. 13-2725 of Thrivent's counsel noted above.

Respectfully submitted,

Dated: October 1, 2013

THRIVENT FINANCIAL FOR LUTHERANS

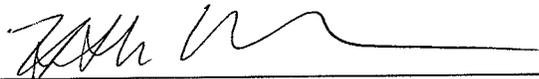
By its attorneys,



Allen W. Hinderaker
Heather Kliebenstein
Merchant & Gould P.C.
PO Box 2910
Minneapolis, MN 55402
(612) 332-5300

CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was filed electronically with the Electronic System for Trademark Trials and Appeals this 1st day of October, 2013.



Heather Kliebenstein

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION has been served by First Class Mail this 1st day of October, 2013 upon the following:

Ameriprise Financial, Inc.
5226 Ameriprise Financial Center
Minneapolis, Minnesota 55474



Heather Kliebenstein