

ESTTA Tracking number: **ESTTA598992**

Filing date: **04/16/2014**

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	Willis North America Inc.
Granted to Date of previous extension	04/16/2014
Address	26 Century Blvd, 7S Nashville, TN 37214 UNITED STATES
Attorney information	Patrick J. Concannon Edwards Wildman Palmer LLP F.D.R. Station, P.O. Box 130 New York, NY 10150 UNITED STATES trademark@edwardswildman.com,pconcannon@edwardswildman.com, kdonahue@edwardswildman.com Phone:617-239-0419

Applicant Information

Application No	85957446	Publication date	12/17/2013
Opposition Filing Date	04/16/2014	Opposition Period Ends	04/16/2014
Applicant	EVOSURE LLC Suite 307 Austin, TX 78704 GERMANY		

Goods/Services Affected by Opposition

Class 009. First Use: 2013/04/24 First Use In Commerce: 2013/04/24

All goods and services in the class are opposed, namely: Computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface

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.	3892687	Application Date	10/06/2009
Registration Date	12/21/2010	Foreign Priority Date	NONE
Word Mark	WILLPLACE		

Design Mark	WILLPLACE
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 0 First Use In Commerce: 0 Data-processing services; business and management advice, database management Class 036. First use: First Use: 0 First Use In Commerce: 0 Insurance and reinsurance brokerage services; insurance brokerage, consultation and information in the fields of accident, fire, life, accident and health, travel, automobile, property, personal property, workers' compensation, fine art, jewelry, specie, kidnap and ransom, bloodstock, livestock, aquaculture, construction, cargo, professional liability, product recall, oil wells; insurance information and consultancy

Attachments	79076290#TMSN.jpeg(bytes) RISKPLACE Notice of Opposition.pdf(334937 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	/PJC/
Name	Patrick J. Concannon
Date	04/16/2014

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

In the Matter of Application Serial No. 85/957446 for the Mark RISKPLACE
Filed on June 12, 2013
Published in the Official Gazette on December 17, 2013

Willis North America Inc.,)	
)	Opposition No.: _____
-v-)	
)	
Evosure LLC,)	
)	
Applicant.)	

BOX TTAB FEE
Assistant Commissioner for
Trademarks P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer Willis North America Inc., a corporation organized and existing under the laws of the state of Delaware, having an address at 26 Century Boulevard, 7S, Nashville, Tennessee, 37214, and a wholly owned subsidiary of Willis Group Limited, a company organized and existing under the laws of the United Kingdom, having an address at The Willis Building, 51 Lime Street, London EC3M 7DQ, United Kingdom, (collectively referred to as “Willis”), believes that it would be damaged by issuance of the proposed registration of the trademark RISKPLACE in Application No. 85/957446 (the “Application”) published in the Official Gazette on December 17, 2013 and filed by Evosure LLC, a limited liability company organized and existing under the laws of the state of Delaware (“Evosure”), and hereby opposes the Application.

As grounds for this Opposition, Willis relies upon the rights developed by it and its predecessors in interest, and alleges upon information and belief as follows:

Willis' Marks

1. Willis Group Limited was founded in 1959 and is organized and existing under the laws of the United Kingdom, with its principal place of business located in London, United Kingdom.

2. Willis North America Inc. is a wholly owned subsidiary of Willis Group Limited (and thus a "related company" to Willis Group Limited under 15 U.S.C. § 1127) and is organized and existing under the laws of Delaware, with its principal place of business located in Nashville, Tennessee. Willis North America Inc. and Willis Group Limited constitute a single source due to the unity of control asserted by Willis Group Limited.

3. Willis is a leading global risk advisor and insurance broker. Willis offers risk advisory, insurance and reinsurance brokerage, employee benefits brokerage and related consulting services to clients in the United States and internationally, covering a wide array of industries. Willis developed and offers an insurance placement platform under its trademark WILLPLACE[®] that processes risk and business data to allow clients to select the most appropriate insurance broker based on price, industry and geography.

4. Prior to Evosure's filing the Application and, upon information and belief, prior to any date of first use or priority date upon which Evosure can rely, Willis obtained a registration for the WILLPLACE[®] mark (Reg. No. 3,892,687) in connection with "data-processing services; business and management advice, database management" in International Class 35 and "insurance and reinsurance brokerage services; insurance brokerage, consultation and information in the fields of accident, fire, life, accident and health, travel, automobile, property, personal property, workers' compensation, fine art, jewelry, specie, kidnap and ransom, bloodstock, livestock, aquaculture, construction, cargo, professional liability, product recall, oil wells; insurance information and consultancy" in International Class 36. Attached as Exhibit A is the TESS record showing status and title of the pleaded registration.

5. Willis' WILLPLACE[®] registration identified above is valid and subsisting, unrevoked and uncanceled, and constitutes *prima facie* evidence of the validity of Willis' exclusive right to use the

mark in the registration in commerce in connection with the services described in the registration, without condition or limitation. Willis' WILLPLACE® registration constitutes constructive notice of Willis' ownership of WILLPLACE® for the services described in the registration, as provided for by §§ 7(b) and 22 of the Lanham Act, 15 U.S.C.A. §§ 1057(b) and 1072.

6. Willis also owns nationwide common law trademark rights in WILLPLACE in connection with the services in the above registration by virtue of its use of WILLPLACE throughout the United States. Upon information and belief, Willis established such common law rights in its WILLPLACE mark prior to any date of first use or priority date upon which Evosure can rely in relation to the mark RISKPLACE.

7. Willis has expended substantial amounts of time and effort in advertising and promoting its services under its WILLPLACE® mark. As a result of Willis' advertising and promotional activities and continuous and exclusive use of WILLPLACE®, the relevant public has come to associate and identify WILLPLACE® exclusively with Willis and the mark has attained a high degree of consumer recognition. Willis derives substantial goodwill from such identification by consumers.

Applicant's Mark

8. Willis hereby incorporates by reference the allegations in Paragraphs 1 through 7 hereof as if fully set forth herein.

9. Upon information and belief, Evosure LLC is a Delaware limited liability company with a mailing address of Suite 307, 510 S. Congress Avenue, Austin, Texas, 78704.

10. Evosure filed the Application on June 12, 2013. The Application covers "computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface" in International Class 9.

Count I: Likelihood of Confusion

11. Willis hereby incorporates by reference the allegations in Paragraphs 1 through 10 hereof as if fully set forth herein.

12. The RISKPLACE mark, as set forth in the Application, is highly similar in sight, sound, connotation, and commercial impression to Willis' WILLPLACE[®] Mark. The distinctive suffix element "PLACE" in Applicant's mark is shared with Willis' WILLPLACE[®] mark, causing the respective marks RISKPLACE and WILLPLACE[®] to be confusingly similar on their whole.

13. The goods in the Application and the services in Willis' pleaded registration are either directly overlapping or closely related (and thus must be presumed, absent explicit limitations not applicable here, to be traveling in the same channels of trade), and target the same audiences. Both the services identified by Willis' WILLPLACE[®] mark and the goods in the subject Application are used for purposes of analyzing business and insurance data.

14. Because Evosure's RISKPLACE and Willis' WILLPLACE are confusingly similar, and because the goods and services identified by the respective marks either overlap or are closely related and target the same audience, there is a strong likelihood that the public will believe that Evosure's RISKPLACE mark used in connection with the subject goods emanates from, is associated with, is connected to or is sponsored by Willis. Accordingly, consumer confusion is likely between the WILLPLACE[®] mark and the RISKPLACE mark in the Application.

15. Accordingly, Evosure's RISKPLACE mark in the Application is likely to cause confusion, mistake, or to deceive the public into believing that Evosure's goods emanate from or are somehow affiliated or associated with, connected to or sponsored by Willis, in violation of Section 2(d) of the Lanham Act.

16. If Evosure is permitted to register or use the RISKPLACE mark, there would be a likelihood of confusion as to the source of Evosure's goods, resulting in damage and injury to Willis.

17. Willis will be damaged by Evosure's proposed registration of the RISKPLACE mark because such registration will support and assist Evosure in the confusing and misleading use of RISKPLACE, and will give color of rights to Evosure in violation of Willis' prior and superior statutory and common law rights in its WILLPLACE[®] mark.

WHEREFORE, Willis prays that this Opposition be sustained and that the application for registration of the subject RISKPLACE mark be denied in all respects.

Dated: April 16, 2014

Respectfully submitted,
WILLIS NORTH AMERICA INC.

By its attorneys,
Edwards Wildman Palmer LLP

A handwritten signature in black ink, appearing to read "Patrick J. Concannon", written over a horizontal line. The signature is stylized and extends to the right.

Patrick J. Concannon
Kelly A. Donahue
Edwards Wildman Palmer LLP
F.D.R. Station, P.O. Box 130
New York, NY 10150
Phone: 617-239-0419
Fax: 617-227-4420
Email: trademark@edwardswildman.com

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Notice of Opposition is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this 16th day of April 2014.

A handwritten signature in black ink, appearing to read "Patricia G. Sam", written over a horizontal line.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition is being deposited with the U.S. Postal Service with sufficient postage as first class mail this 16th day of April 2014 in an envelope addressed to Applicant's counsel of record at the following address:

Mr. Michael Williams, Esq.
P.O. Box 340071
Austin, Texas 78734-0002

A handwritten signature in black ink, appearing to read "Patricia G. Sam", written over a horizontal line.

Exhibit A



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WILLPLACE

Word Mark	WILLPLACE
Goods and Services	IC 035. US 100 101 102. G & S: Data-processing services; business and management advice, database management IC 036. US 100 101 102. G & S: Insurance and reinsurance brokerage services; insurance brokerage, consultation and information in the fields of accident, fire, life, accident and health, travel, automobile, property, personal property, workers' compensation, fine art, jewelry, specie, kidnap and ransom, bloodstock, livestock, aquaculture, construction, cargo, professional liability, product recall, oil wells; insurance information and consultancy
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Trademark Search Facility Classification Code	SHAPES-MISC Miscellaneous shaped designs
Serial Number	79076290
Filing Date	October 6, 2009
Current Basis	66A
Original Filing Basis	66A
Published for Opposition	October 5, 2010
Registration Number	3892687
International Registration Number	1021986
Registration Date	December 21, 2010
Owner	(REGISTRANT) Willis Group Limited COMPANY UNITED KINGDOM The Willis Building, 51 Lime Street London EC3M 7DQ UNITED KINGDOM

Priority Date September 22, 2009
Type of Mark SERVICE MARK
Register PRINCIPAL
**Live/Dead
Indicator** LIVE

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Assignments on the Web > Trademark Query

No assignment has been recorded at the USPTO

For Serial Number: 79076290

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3.4
Web interface last modified: Jul 8, 2013 v.2.3.4

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