

ESTTA Tracking number: **ESTTA607533**

Filing date: **06/02/2014**

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	Buckingham Asset Management, LLC
Granted to Date of previous extension	06/01/2014
Address	8182 Maryland Ave., Suite 500 St. Louis, MO 63105 UNITED STATES

Attorney information	Michelle Alvey Husch Blackwell LLP 190 Carondelet Plaza, Suite 600 St. Louis, MO 63105 UNITED STATES pto-sl@huschblackwell.com, michelle.alvey@huschblackwell.com,Arkadia.Olson@huschblackwell.com, Michelle.Cotton@huschblackwell.com Phone:314-480-1500
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**Applicant Information**

Application No	86005534	Publication date	12/03/2013
Opposition Filing Date	06/02/2014	Opposition Period Ends	06/01/2014
Applicant	The Buckingham Research Group, Incorporated 750 Third Avenue New York, NY 10017 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 036. First Use: 1983/02/08 First Use In Commerce: 1983/02/08 Opposed goods and services in the class: Securities broker- dealer
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**Applicant Information**

Application No	86005612	Publication date	12/10/2013
Opposition Filing Date	06/02/2014	Opposition Period Ends	
Applicant	The Buckingham Research Group, Incorporated 750 Third Avenue New York, NY 10017 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 036. First Use: 1985/12/00 First Use In Commerce: 1985/12/00
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All goods and services in the class are opposed, namely: advisory services in the fields of investments, private funds, and financial asset and capital management; investment services, namely, funds investment, investment management; and financial asset management services

### Applicant Information

Application No	86005628	Publication date	12/17/2013
Opposition Filing Date	06/02/2014	Opposition Period Ends	
Applicant	The Buckingham Research Group, Incorporated 750 Third Avenue New York, NY 10017 UNITED STATES		

### Goods/Services Affected by Opposition

Class 036. First Use: 2011/11/00 First Use In Commerce: 2011/11/00  
All goods and services in the class are opposed, namely: advisory services in the fields of investments, private funds, and financial asset and capital management; investment services, namely, funds investment, investment management; and financial asset management services

### Applicant Information

Application No	86005577	Publication date	12/24/2013
Opposition Filing Date	06/02/2014	Opposition Period Ends	
Applicant	The Buckingham Research Group, Incorporated 750 Third Avenue New York, NY 10017 UNITED STATES		

### Goods/Services Affected by Opposition

Class 036. First Use: 2013/06/00 First Use In Commerce: 2013/06/00  
Opposed goods and services in the class: securities broker- dealer

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	The applications are void ab initio with respect to the defined "Opposed Services" due to failure to use the marks at the time of the filing dates of the applications

### Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BUCKINGHAM		
Goods/Services	financial advising and wealth management services; investment advice; financial retirement plan consulting services and retirement plan administration; estate planning; tax management services; financial services and related services		

Attachments	Consolidated Notice of Opposition.PDF(382756 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	/Michelle Alvey/
Name	Michelle Alvey
Date	06/02/2014

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals on June 2, 2014.

/Michelle Alvey/

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

In the matter of Application Serial Nos. 86/005,628, 86/005,577, 86/005,612, and 86/005,534

BUCKINGHAM ASSET	)	
MANAGEMENT, LLC	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.
	)	
THE BUCKINGHAM RESEARCH GROUP,	)	
INCORPORATED	)	
	)	
Applicant.	)	

**CONSOLIDATED NOTICE OF OPPOSITION**

Buckingham Asset Management, LLC (“Opposer”), a Delaware limited liability company, with a place of business at 8182 Maryland Avenue, Suite 500, St. Louis, Missouri, 63105, believes it will be damaged by the use and/or registration of the marks as shown in Serial Nos. 86/005,628, 86/005,577, 86/005,612 and 86/005,534 and hereby opposes the same.

As grounds for opposition, Opposer states:

1. Applicant, in Application No. 86/005,628, applied for registration of the mark BCM BUCKINGHAM CAPITAL MANAGEMENT and Design for advisory services in the fields of investments, private funds, and financial asset and capital management; investment services, namely, funds investment, investment management; and financial asset management services in International Class 36. The application was filed July 9, 2013 and alleges a date of first use of November, 2011.

2. Applicant, in Application No. 86/005,577, applied for registration of the mark BRG THE BUCKINGHAM RESEARCH GROUP and Design for securities broker-dealer; underwriter of corporate securities; and institutional investment research in International Class 36. This application was filed on July 9, 2013 and alleges a date of first use of June, 2013.

3. Applicant, in Application No. 86/005,612, applied for registration of the mark BUCKINGHAM CAPITAL MANAGEMENT for advisory services in the fields of investments, private funds, and financial asset and capital management; investment services, namely, funds investment, investment management; and financial asset management services in International Class 36. This application was filed on July 9, 2013 and initially alleged a first use date of 2011. Applicant subsequently filed a post-publication amendment and alleged a date of first use of December, 1985.

4. Applicant, in Application No. 86/005,534, applied for registration of the mark BUCKINGHAM RESEARCH GROUP for securities broker- dealer; underwriter of corporate securities; and institutional investment research in International Class 36. This application was filed on July 9, 2013 and initially alleged a first use date of June 2013. Applicant subsequently filed a post-publication amendment and alleged a date of first use of February 8, 1983.

The above-referenced applications are hereinafter collectively referred to as the “Applicant’s Marks.” Opposer herein opposes Applicant’s Marks with respect to the following services:

- “advisory services in the fields of investments, private funds, and financial asset and capital management; investment services, namely, funds investment, investment management; and financial asset management services” under App. Nos. 86/005,628 and 86/005,612, and
- “securities broker-dealer” under App. Nos. 86/005,577 and 86/005,534

(collectively, the “Opposed Services” or “Applicant’s Services”).

5. Opposer is the owner of extensive common law rights in and to the service marks and names BUCKINGHAM and BUCKINGHAM ASSET MANAGEMENT in connection with financial advising and wealth management services, investment advice, financial retirement plan consulting services and retirement plan administration, estate planning, tax management services, and related services (“Opposer’s Services”), and Opposer owns a recently filed application for the mark BUCKINGHAM, the Serial number for which has not yet been assigned. For purposes of this Notice, all of the marks and names of Opposer, including its pending U.S. application, will be referred to as the “Opposer’s Marks”.

6. Since long prior to Applicant's filing date for Applicant’s Marks, and prior to Applicant’s claimed date of first use for Application Nos. 86/005,577 and 86/005,628, Opposer (and its predecessors in interest) have used Opposer’s Marks in commerce on or in connection with Opposer’s Services. Upon information and belief, Applicant has also used Opposer’s marks prior to Applicant’s first use of the marks under 86/005,612 and 86/005,534, in all or part of the U.S.

7. Opposer has and continues to promote Opposer’s Marks in interstate commerce within the United States for identifying Opposer's Services.

8. Opposer's Marks are distinctive, and are uniquely associated with Opposer in connection with Opposer's services, by reason of Opposer's continuous use and promotion of its marks and family of marks through extensive advertising, promotion and use. Such advertising, promotion, and use occurred prior to the filing date of the applications for Applicant’s Marks.

9. The Applicant’s Marks as they relate to Applicant’s Services so resemble Opposer's Marks as to be likely to cause confusion, and mistake, and to deceive consumers; and

the Applicant's Marks are confusingly and deceptively similar to Opposer's Marks when used in connection with Applicant's Services.

10. Applicant's Services may be directed to the same or related class of consumers as those for Opposer's Services and may be sold in the same channels of trade. Accordingly, Applicant's Services and Opposer's Services are so commercially related that the marks sought to be registered and Opposer's Marks are confusingly similar.

11. Applicant's use of Applicant's Marks with the Applicant's Services, which so resemble and are colorably imitative of Opposer's Marks, is likely to cause confusion, mistake, or deception of purchasers as to the source of Applicant's Services and will inevitably falsely suggest a trade connection between Opposer and Applicant.

12. In addition, upon information and belief, Applicant's above-referenced Applications are void ab initio with respect to Applicant's Services as defined herein, as a result of Applicant's failure to use the mark that is the subject of each Application at the time of the filing date of each such Application.

WHEREFORE, Opposer believes that it would be damaged by the registrations applied for and prays that said applications be refused registration.

In the event that the fees are not otherwise charged when this notice is filed, Opposer requests that the statutory filing fee be debited from our Deposit Account no. 11-0160.

Respectfully submitted,

Date: June 2, 2014

By: /Michelle Alvey/  
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Arkadia D. Olson  
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing Consolidated Notice of Opposition was served by First Class Mail, postage prepaid on this 2 ND day of June, 2014 upon the following:

*Applicant:*

The Buckingham Research Group, Incorporated  
750 Third Avenue  
New York, New York 10017

and

*Attorney of Record*

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*/Michelle Alvey/*