

ESTTA Tracking number: **ESTTA630374**

Filing date: **10/01/2014**

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	Brown Brothers Harriman & Co.
Granted to Date of previous extension	10/01/2014
Address	140 Broadway New York, NY 10005 UNITED STATES

Correspondence information	Brown Brothers Harriman & Co. 140 Broadway New York, NY 10005 UNITED STATES abaden@edgelawgroup.com Phone:4088274461
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Applicant Information

Application No	86160577	Publication date	06/03/2014
Opposition Filing Date	10/01/2014	Opposition Period Ends	10/01/2014
Applicant	Berry, Robert 4401 W Slauson Ave. Los Angeles, CA 90043 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2010/06/01 First Use In Commerce: 2010/06/01 All goods and services in the class are opposed, namely: Clothing, namely, tops, bottoms, shirts, shoes, socks, underwear, sleepwear, sweat shirts, sweat pants, hooded sweat shirts, sweat jackets, sweat shorts, gloves, jackets, hats, head wear, and pants
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3660883	Application Date	01/27/2009
Registration Date	07/28/2009	Foreign Priority Date	NONE
Word Mark	BBH		

Design Mark	<h1>BBH</h1>		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 providing temporary use of non-downloadable financial service software for use in analyzing financial data and generating financial reports		

U.S. Registration No.	3594879	Application Date	10/09/2008
Registration Date	03/24/2009	Foreign Priority Date	NONE

Word Mark	BBH		
Design Mark	<h1>BBH</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/01/02 First Use In Commerce: 2000/01/02 Software for banking, trust and investment management, namely, software for asset data management and reporting, foreign exchange services, funds investment and management, investment fund transfers, and brokerage services		

U.S. Registration No.	3594867	Application Date	10/02/2008
Registration Date	03/24/2009	Foreign Priority Date	NONE
Word Mark	BBH		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 036. First use: First Use: 1931/01/02 First Use In Commerce: 1931/01/02 banking and investment services; namely, investment management, investment advice, funds investment, investment brokerage, investment consultation and investment of funds for others; financial analysis and investment advisory services, namely, management and brokerage in the fields of stocks, bonds, options, futures and other securities, and the investment of funds of others; financial research services; investment consultation, funds investment, and investment management; financial exchange services, namely, providing financial information in the nature of rates of exchange; financial information processing; financial information provided by electronic means; financial portfolio management; financial risk management; financial services, namely, assisting others with the completion of financial transactions for stocks, bonds, securities and equities; providing information in the fields of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; investment fund transfer and transaction services; providing on-line stored value accounts in an electronic environment; investment fund transfer and transaction services; providing for the exchange of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; trust and estate administration services, namely, investment management, custody of assets, selection of brokers, collection and valuation of assets, bill paying, recordkeeping and accountings, tax return preparation and filing, incometax planning for trusts, grantors and beneficiaries, review and analysis of will and trust documents; trust company services, namely, institutional trust services, charitable foundation services, client tax services, escrow arrangements, estate planning, financial planning, individual retirement planning, philanthropic planning, retirement trusts, trust and estate administration, donor-advised fund program; wealth management services, namely, alternative investments, asset allocation, risk management for concentrated positions; developing and managing a family of alternative investment funds, investment management services to institutional clients, investment advisory and portfolio management services; banking and advisory services, namely, term loans and revolving lines of credit, acquisition finance, subordinated debt financing, trade letters of credit, standby letters of credit, corporate cash management services, foreign exchange, mergers and acquisitions, advisory, 401k and defined benefit plans, investment management; custody services; equity execution services; equity strategy research services; equity trading services, namely, global custody, accounting, administration, transfer agency, securities lending, performance reporting, financial reporting, compliance, brokerage; providing a suite of fund accounting services, namely, multi-currency portfolio valuation, fund accounting, and reporting services; financial and legal administration services for a comprehensive service suite, namely, fund accounting, financial reporting, expense analysis and payment, assistant treasurer's support, performance measurement, compliance, tax support and regulatory and corporate secretarial assistance, namely, board reporting, regulatory filings and consulting services; consulting and advisory services for both qualified and nonqualified retirement plans;</p>

	<p>serving as a connectivity point between financial service companies and their external service providers and internal system; providing a hosted communications platform for financial services; institutional fund services, namely, serving as product manager for third party investment funds; serving as a financial advisor to middle market businesses across a broad range of industries with a focus on healthcare services, medical technology, telecommunications and media, and outsourced business services; advisory services to private and closely-held public companies; managing a series of private equity funds; outsourcing services, namely, front, middle and back office outsourced services, namely, restricted securities investigation, restricted securities processing, brokerage services; securities lending services, namely, custodial and third-party lending, auctions, borrower exclusives, and traditional agency lending; financial services, namely, electronic delivery system for financial investment and transaction initiation, trade settlement reporting and trade status tracking; providing an online payment and order authorization system; providing an Internet reporting system for the transmission of financial securities information to others; and managing mutual funds for others, namely, a mutual fund asset allocation program</p>
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U.S. Registration No.	3541186	Application Date	07/25/2007
Registration Date	12/02/2008	Foreign Priority Date	NONE
Word Mark	BBH DIRECT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2007/02/20 First Use In Commerce: 2007/02/20 Financial analysis and consultation; Financial clearing houses; Financial exchange; Financial forecasting; Financial information in the nature of rates of exchange; Financial information processing; Financial information provided by electronic means; Financial portfolio management; Financial research; Financial risk management; Financial services, namely, assisting others with the completion of financial transactions for stocks, bonds, securities and equities; Financial services, namely, providing information in the fields of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; Financial services, namely, investment fund transfer and transaction services; Financial services, namely, providing for the exchange of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; Financial trust operations; Banking; On-line banking services</p>		

U.S. Registration No.	3481476	Application Date	03/15/2007
Registration Date	08/05/2008	Foreign Priority Date	NONE
Word Mark	BBH INFOFX		

Design Mark	BBH INFOFX
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2007/10/00 First Use In Commerce: 2007/10/00 Financial records management

U.S. Registration No.	2515357	Application Date	05/15/2001
Registration Date	12/04/2001	Foreign Priority Date	NONE
Word Mark	BBH COMSET PLUS		
Design Mark	BBH COMSET PLUS 		
Description of Mark	The mark consists of BBH COMSET PLUS INBLACK LETTERS ACCOMPANIED BY A SUPERSCRIPT RED CHEVRON OR FLAG DESIGN ELEMENT APPEARING IMMEDIATELY FOLLOWING THE TERM "PLUS".		
Goods/Services	Class 036. First use: First Use: 2001/02/28 First Use In Commerce: 2001/02/28 Mutual fund brokerage services; mutual fund investment services; investment management services; investment consultation services; investment advisory services; banking services; custody services relating to financial assets		

U.S. Registration No.	2585041	Application Date	05/15/2001
Registration Date	06/25/2002	Foreign Priority Date	NONE
Word Mark	BBH COMSET PLUS		
Design Mark	BBH COMSET PLUS		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2001/02/28 First Use In Commerce: 2001/02/28 Mutual fund brokerage services; mutual fund investment services; investment management services; investment consultation services; investment advisory services; banking services; custody services relating to financial assets		

U.S. Registration No.	2520159	Application Date	05/15/2001
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Registration Date	12/18/2001	Foreign Priority Date	NONE
Word Mark	BBH COMSET		
Design Mark	BBH COMSET		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2000/08/16 First Use In Commerce: 2000/08/16 Mutual fund brokerage services; mutual fund investment services; investment management services; investment consultation services; investment advisory services; banking services; custody services relating to financial assets		

U.S. Registration No.	2628823	Application Date	02/10/2000
Registration Date	10/01/2002	Foreign Priority Date	NONE
Word Mark	BBHCONNECT		
Design Mark	BBHConnect		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1998/10/00 First Use In Commerce: 1998/10/00 FINANCIAL SERVICES OFFERED VIA A GLOBALCOMPUTER NETWORK FOR EXECUTING FINANCIAL TRANSACTIONS AND STOCK TRADES		

U.S. Registration No.	1492559	Application Date	07/13/1987
Registration Date	06/14/1988	Foreign Priority Date	NONE
Word Mark	BBH & CO.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1958/05/10 First Use In Commerce: 1958/05/10 BANKING SERVICES		

U.S. Registration No.	1575488	Application Date	01/23/1989
Registration Date	01/02/1990	Foreign Priority Date	NONE
Word Mark	BBH & CO.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1931/01/02 First Use In Commerce: 1931/01/02 BANKING SERVICES		

U.S. Registration No.	1561346	Application Date	01/23/1989
Registration Date	10/17/1989	Foreign Priority Date	NONE
Word Mark	BBH & CO.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1931/01/02 First Use In Commerce: 1931/01/02 BANKING SERVICES		

Attachments	77657894#TMSN.png(bytes) 77589814#TMSN.png(bytes) 77584243#TMSN.png(bytes) 77238602#TMSN.png(bytes) 77132361#TMSN.png(bytes) 76257657#TMSN.png(bytes) 76257658#TMSN.png(bytes) 76257656#TMSN.png(bytes) 75914764#TMSN.png(bytes) 73775589#TMSN.png(bytes) 73775653#TMSN.png(bytes) Notice of Opposition bbh black beverly hills.pdf(341960 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	/Allen J Baden/
Name	Brown Brothers Harriman & Co.
Date	10/01/2014

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

In re Application of: Robert Berry dba Black Beverley Hills

Serial No.: 86160577

Filed: January 8, 2014

For the Mark: BBH in International Class 25

Date of Publication: June 3, 2014
Page TM 882

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

NOTICE OF OPPOSITION

Brown Brothers Harriman & Co., a limited partnership organized under the laws of New York having its principal place of business at 140 Broadway, New York, New York 10005 ("Opposer"), believing that it will be damaged by registration of the alleged "BBH" word mark claimed in U.S. Trademark Application Serial No. 86160577 (the "Challenged Application"), hereby opposes the same.

As grounds for its opposition, Opposer alleges as follows, with knowledge concerning its own acts, and on information and belief as to all other matters:

1. Applicant, Robert Berry, having an address at 4401 West Slauon Avenue, Los Angeles, California 90043 ("Applicant"), owns and is the applicant of record of the Challenged Application.
2. By the application herein opposed, Applicant is seeking to obtain registration for "BBH" for the following goods in International Class 25: Clothing, namely, tops, bottoms, shirts, shoes, socks, underwear, sleepwear, sweat shirts, sweat pants, hooded sweat shirts, sweat jackets, sweat shorts, gloves, jackets, hats, head wear, and pants.
3. Opposer attaches a copy of page TM 882 from the Official Gazette of June 3, 2014, in which the U.S. Patent and Trademark Office published this application, as Exhibit A to this paper.
4. The Applicant filed for the instant application under Section 1A of the Trademark Act on January 8, 2014.
5. Opposer, Brown Brothers Harriman & Co., which commonly refers to itself and is known as "BBH," and operates the website <bbh.com>, is the oldest and largest partnership bank in the United States. Opposer operates in six domestic and eight overseas locations with approximately 4,000 employees. In addition to providing commercial banking services, Opposer is among the leading providers of global custody, fund administration, transfer agency, foreign exchange, private equity, merger and acquisition services, investment management for individuals and institutions, personal

trust and estate administration and securities brokerage services, and provides a myriad of products, including promotional items, in conjunction with those services.

6. Opposer is the owner of 25 active registrations and 3 pending applications for the BBH mark and variants thereof for a wide variety of goods and services, including the U.S. Registrations identified in the below table. Opposer attaches and makes of record a copy of the electronic record for each of the U.S. Registrations identified below, prepared and issued by the Office showing both the status of and title to the registrations, as Exhibit B to this paper.

Mark	Reg. No.	Recitation of Goods or Services
BBH	3660883	(INT. CL. 42) providing temporary use of non-downloadable financial service software for use in analyzing financial data and generating financial reports
BBH	3594879	(INT. CL. 9) software for banking, trust and investment management, namely, software for asset data management and reporting, foreign exchange services, funds investment and management, investment fund transfers, and brokerage services
BBH	3594867	(INT. CL. 36) banking and investment services; namely, investment management, investment advice, funds investment, investment brokerage, investment consultation and investment of funds for others; financial analysis and investment advisory services, namely, management and brokerage in the fields of stocks, bonds, options, futures and other securities, and the investment of funds of others; financial research services; investment consultation, funds investment, and investment management; financial exchange services, namely, providing financial information in the nature of rates of exchange; financial information processing; financial information provided by electronic means; financial portfolio management; financial risk management; financial services, namely, assisting others with the completion of financial transactions for stocks, bonds, securities and equities; providing information in the fields of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; investment fund transfer and transaction services; providing on-line stored value accounts in an electronic environment; investment fund transfer and transaction services; providing for the exchange of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; trust and estate administration services, namely, investment management, custody of assets, selection of brokers, collection and valuation of assets, bill paying, recordkeeping and accountings, tax return preparation and filing, income tax planning for trusts, grantors and beneficiaries, review and analysis of will and trust documents; trust company services, namely, institutional trust services, charitable foundation services, client tax services, escrow arrangements, estate planning, financial planning, individual retirement planning, philanthropic planning, retirement trusts, trust and estate administration, donor-advised fund program; wealth management services, namely, alternative investments, asset allocation, risk management for concentrated positions; developing and managing a family of alternative investment funds, investment management services to institutional clients, investment advisory and portfolio management services; banking and advisory services, namely, term loans and revolving lines of credit, acquisition finance, subordinated debt financing, trade letters of credit, standby letters of credit, corporate cash management services, foreign exchange, mergers and acquisitions, advisory, 401k and defined benefit plans, investment management; custody services; equity execution services; equity strategy research services; equity trading services, namely, global custody, accounting, administration, transfer agency, securities lending, performance reporting, financial reporting, compliance, brokerage; providing a suite of fund accounting services, namely, multi-currency portfolio valuation, fund accounting, and reporting services; financial and legal administration services for a comprehensive service suite, namely, fund accounting, financial reporting, expense analysis and payment, assistant treasurer's support, performance measurement, compliance, tax support and regulatory and corporate secretarial assistance, namely, board reporting, regulatory filings and consulting services; consulting and advisory services for both qualified and nonqualified retirement plans; serving as a connectivity point between financial service companies and their external service providers and internal system; providing a hosted communications platform for financial services; institutional fund services, namely, serving as product manager for third party investment funds; serving as a financial advisor to middle market businesses across a broad range of industries with a focus on healthcare services, medical technology, telecommunications and media, and outsourced business services; advisory ...

Mark	Reg. No.	Recitation of Goods or Services
BBH DIRECT	3541186	(INT. CL. 36) financial analysis and consultation; financial clearing houses; financial exchange; financial forecasting; financial information in the nature of rates of exchange; financial information processing; financial information provided by electronic means; financial portfolio management; financial research; financial risk management; financial services, namely, assisting others with the completion of financial transactions for stocks, bonds, securities and equities; financial services, namely, providing information in the fields of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; financial services, namely, investment fund transfer and transaction services; financial services, namely, providing for the exchange of foreign currency, commodities, financial derivatives, interest rate products, and equities via the internet and intranet systems; financial trust operations; banking; on-line banking services
BBH INFOFX	3481476	(INT. CL. 35) financial records management
BBH COMSET PLUS	2515357	(INT. CL. 36) mutual fund brokerage services; mutual fund investment services; investment management services; investment consultation services; investment advisory services; banking services; custody services relating to financial assets
BBH COMSET PLUS	2585041	(INT. CL. 36) mutual fund brokerage services; mutual fund investment services; investment management services; investment consultation services; investment advisory services; banking services; custody services relating to financial assets
BBH COMSET	2520159	(INT. CL. 36) mutual fund brokerage services; mutual fund investment services; investment management services; investment consultation services; investment advisory services; banking services; custody services relating to financial assets
BBHCONNECT	2628823	(INT. CL. 36) financial services offered via a global computer network for executing financial transactions and stock trades
BBH & CO.	1492559	(INT. CL. 36) banking services
BBH & CO.	1575488	(INT. CL. 36) banking services
BBH & CO.	1561346	(INT. CL. 36) banking services

7. Opposer also owns broad common law trademark rights in the BBH mark by virtue of its lengthy and continuous use of BBH as a trade name and its provision of goods and services under the BBH mark throughout the United States and around the world.
8. Consumers and the trade use Opposer's BBH mark to identify a myriad of goods and services provided by Opposer, including goods in Classes 25. Many of these goods are related to and provided to the same channels of trade and to the same customers as are many of the goods and services for which applicant now seeks registration of the subject alleged trademark.
9. By virtue of Opposer's efforts and the expenditure of considerable sums for promotional activities, and by virtue of the excellence of its goods and services, Opposer has gained for its BBH mark a most valuable reputation and exceedingly valuable goodwill.
10. The alleged trademark proposed for registration by the Applicant, namely, the letters BBH, is identical and confusingly similar to Opposer's BBH trademark.
11. The alleged mark in the Challenged Application "so resembles a mark registered in the Patent and Trademark Office or a mark previously used in the United States by another and not abandoned,"

namely Opposer's BBH trademark, "as to be likely when applied to the [goods and] services of Applicant, to cause confusion, or to cause mistake, or to deceive."

12. Moreover, the applied for trademark is not a "trademark by which the [goods and] services of the Applicant may be distinguished from the [goods and] services of others," namely the goods and services offered by Opposer under its BBH mark, which Opposer has used since well prior to the filing date of Applicant's application, and Opposer has never abandoned its trademark.
13. If the Applicant were permitted to use and register the BBH mark for its goods, as specified in the application herein opposed, confusion in the trade resulting in damage and injury to the Opposer would be caused and would result by reason of the substantial similarity between Applicant's mark and Opposer's mark.
14. Persons familiar with Opposer's goods and services may well confuse Applicant's goods and services as and for goods and services offered by Opposer. Furthermore, any defect, objection or fault found with Applicant's goods or services marketed under its alleged trademark would necessarily reflect upon and seriously injure the reputation that Opposer has established for the goods and services sold or provided under its trademark.
15. If the USPTO were to grant Applicant a registration for the alleged trademark herein opposed, it would obtain thereby at least the *prima facie* exclusive right to use said mark. Such registration would be inconsistent with Opposer's right to use its trademark BBH to identify the source of and describe Opposer's goods and services.
16. Accordingly, the Board should refuse and deny registration of Applicant's alleged trademark in accordance with Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).
17. Additionally, Opposer believes that Applicant has not used the BBH Mark on or in connection with all of the goods as claimed in the instant Challenged Application. If true, such act constitutes fraud on the USPTO and another ground upon which registration of the Challenged Application should be denied.
18. WHEREFORE, the Opposer prays that the Trademark Trial and Appeals Board reject application Serial No. 86160577, and that the registration of the mark therein sought for the goods and services therein specified be denied and refused, and that the Board sustain this Opposition.

Please address all future communications regarding this opposition to the following attorney of record for Opposer:

Allen J. Baden
Edge Law Group
236 N Santa Cruz Ave Ste 228
Los Gatos CA 95030-7279
Email: abaden@edgelawgroup.com

Applicant files this Notice of Opposition electronically, pursuant to 37 C.F.R. § 2.1 04(a).

Respectfully submitted,

Dated: October 1, 2014

By: /Allen J. Baden/

Allen J. Baden
Edge Law Group
236 N Santa Cruz Ave Ste 228
Los Gatos CA 95030-7279
Telephone: (408) 827-4461
Email: abaden@edgelawgroup.com

Exhibit A

Except from the Official Gazette

Exhibit B

Printouts from USPTO Website

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Notice of Opposition was mailed to:

Robert Berry
4401 West Slauson Avenue
Los Angeles, California 90043

by the following indicated method:

By mailing full, true, and correct copies thereof in a sealed, first-class postage-prepaid envelope deposited with the United States Postal Service at Los Gatos, California, on the date set forth below.

DATED: this 1st day of October 2014.

/Allen J. Baden/

4832-3605-2766, v. 1