

ESTTA Tracking number: **ESTTA704127**

Filing date: **10/23/2015**

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	Touro College
Granted to Date of previous extension	11/01/2015
Address	500 Seventh Avenue, 4th Floor New York, NY 10018 UNITED STATES

Attorney information	Wendy E. Miller Cooper & Dunham LLP 30 Rockefeller Plaza New York, NY 10112 UNITED STATES wmiller@cooperdunham.com, wendyemiller@hotmail.com Phone:212-278-0400
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Applicant Information

Application No	86275759	Publication date	05/05/2015
Opposition Filing Date	10/23/2015	Opposition Period Ends	11/01/2015
Applicant	TORO TAX FRANCHISING LLC 1800 E SAHARA AVE LAS VEGAS, NV 89104 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 2014/03/14 First Use In Commerce: 2014/03/14 All goods and services in the class are opposed, namely: Legal consultation services; Legal consulting services in the field of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets; Legal document preparation services; Legal services; Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of immigration law; Providing legal services in the field of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets
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Applicant Information

Application No	86276066	Publication date	05/05/2015
Opposition Filing Date	10/23/2015	Opposition Period Ends	
Applicant	TORO TAX FRANCHISING LLC 1800 E SAHARA AVE LAS VEGAS, NV 89104		

	UNITED STATES
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Applicant Information

Application No	86366056	Publication date	05/05/2015
Opposition Filing Date	10/23/2015	Opposition Period Ends	
Applicant	TORO TAX FRANCHISING LLC 1800 E SAHARA AVE LAS VEGAS, NV 89104 UNITED STATES		

Goods/Services Affected by Opposition

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 All goods and services in the class are opposed, namely: Legal consultation services; Legal consulting services in the field of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets; Legal document preparation services; Legal services; Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of employment and labor law for both employees and employers; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of immigration law; Litigation services; Providing customized legal information, counseling, and advice, and litigation services in the field of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets; Providing legal services in the field of personal injury, family, criminal, bankruptcy, immigration, workers compensation and traffic tickets

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	TOURO LAW		
Goods/Services	legal education services, legal aid services and related goods and services		

Attachments	Notice Of Opposition.pdf(96336 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	/Wendy E. Miller/
Name	Wendy E. Miller
Date	10/23/2015

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

TOURO COLLEGE,	X	
	:	
Opposer,	:	Opposition Nos.:
	:	
v.	:	Serial No.: 86/275,759
	:	Filed: May 8, 2014
TORO TAX FRANCHISING LLC,	:	Mark: TOROLAW T
	:	
Applicant.	:	Serial No.: 86/276,066
	:	Filed: May 8, 2014
	X	Mark: TOROLAW

Serial No.: 86/366,056
Filed: August 13, 2014
Mark: TOROLAW

NOTICE OF OPPOSITION

Touro College, a corporation of New York, having a place of business at 500 Seventh Avenue, 4th Floor, New York, NY 10018 (hereinafter “Opposer”), believes that it will be damaged by the issuance of registrations to Toro Tax Franchising LLC, a Nevada limited liability company having a place of business at 1800 E. Sahara Ave., Ste. 106, Las Vegas, NV 89104 (hereinafter “Applicant”), for the marks which are the subject of this opposition and hereby opposes issuance of such registrations.

As grounds for the opposition, Opposer states as follows:

1. Opposer has been using the designation TOURO LAW as a trademark and as a tradename in interstate commerce since at least 1980 and is currently using the designation in connection with legal education, legal aid and other related goods and services.
2. On May 8, 2014 and August 13, 2014, many years after the Opposer’s first use of the mark TOURO LAW, Applicant filed applications Nos. 86/275,759, 86/276,066 and

86/366,056 to register the designation TORO LAW in word and logo forms for “legal services, namely, providing customized information, counseling, advice and litigation services in all areas of immigration law” and “providing legal services in the field of personal injury, family criminal, bankruptcy, immigration, workers compensation and traffic tickets” in Class 45, based on 1(a) of the Lanham Act (collectively “Applicant’s Marks”). Applicant claims a date of first use of March 14, 2014 for all three marks. Because Opposer’s first use is earlier than Applicant’s filing dates and Applicant’s claimed date of first use, Opposer has rights superior to any rights of Applicant.

3. Applicant's Marks are confusingly similar to Opposer’s famous mark TOURO LAW, and Applicant’s services are related to Opposer’s goods and services such that Applicant’s registration of Applicant’s Marks in association with the services for which registration is sought is likely to cause confusion, or to cause mistake or to deceive and dilutes the distinctiveness of Opposer’s mark.

4. The registration to Applicant of Applicant’s Marks on the Principal Register will interfere with Opposer’s enjoyment of its rights in the mark TOURO LAW, to Opposer’s substantial detriment.

WHEREFORE, Opposer requests that its opposition be sustained and that the registration sought by Applicant be refused.

Respectfully submitted,

COOPER & DUNHAM LLP

Dated: October 23, 2015

By: /s/ Wendy E. Miller
Wendy E. Miller
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New York, New York 10112
Tel: (212) 278-0400
Fax: (212) 278-0525

Attorney for Opposer
Tuoro College

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served on Applicant by e-mail and by first class mail, postage prepaid, this 23rd day of October, 2015, addressed to the attorney of record as follows:

C. Michael Rasmussen, Esq.
8485 W. Sunset Rd., Ste. 208
Las Vegas, NV 89113
mrmussen@grrlawfirm.com

/s/ Wendy E. Miller

Wendy E. Miller