

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

UBS AG,)
)
 Opposer,)
)
 v.)
)
 United Security Bank,)
)
 Applicant.)
)
 Our Ref. No. 27578/292840)

Opposition No.
 Ser. No. 78/059,847



09-23-2002

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #11

NOTICE OF OPPOSITION

Commissioner for Trademarks
 BOX TTAB – Fee
 2900 Crystal Drive
 Trademark Trial and Appeal Board
 Arlington, Virginia 22202-3513

10/03/2002 ZCARRITH 00000017 033975 78059847
 01 FC:377 300.00 CH

Sir:

UBS AG (hereinafter Opposer), a corporation organized and existing under the laws of Switzerland, is or will be damaged by the registration of the mark USB E PAY, which is set forth in application Ser. No. 78/059,847 and owned by United Security Bank (hereinafter Applicant), and hereby opposes the same.

As grounds for the opposition, Opposer, by its attorneys, avers as follows:

1. On December 26, 1989, the United States Patent and Trademark Office (hereinafter US PTO) issued a Principal Register registration, Reg. No. 1,573,828, for the mark UBS for “banking, investment banking and securities brokerage services.” This registration was

based on an application, Ser. No. 73/795,596, filed by the Opposer's predecessor in interest with the US PTO on April 21, 1989, which is a date that precedes the date on which the Applicant filed its application.

2. By merger and assignment, Opposer is the owner of Reg. No. 1,573,828. Opposer's registration, Reg. No. 1,573,828, is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use the mark UBS in commerce in connection with the services specified in the registration. Information about this registration is attached hereto as Exhibit 1.

3. On September 30, 1998, Opposer filed application Ser. No. 75/562,333 for the mark UBS & Design for a variety of goods and services including "computer operating software for the financial services industry" and "insurance consultation, brokerage and administration; underwriting retirement, property and casualty risk and life insurance; financing services; banking, stock exchange price quotations and stock brokerage; financial transactions, namely, monetary exchange and financial exchange; real estate brokerage, financial investment in the field of real estate, and fiduciary representative services; stock and insurance brokerage services; financial sponsorship of sports competitions and art exhibits; automated teller machines services; providing financial information via telephonic means; electronic banking services, namely, providing banking via computers on customers' or others third parties' premises including telephone services and videotex services; providing on-line electronic databases on global computer networks in the field of banking." Information about this application is attached hereto as Exhibit 2.

4. On October 10, 2000, Opposer filed application, Ser. No. 76/143,020 for the mark UBS KEYLINK for a variety of goods and services including "computer software" and "insurance, finance, banking, in particular financial analysis and consultancy in connection with

insurance, finance and banking; all these services also provided via computer networks.” Information about this application is attached hereto as Exhibit 3.

5. Opposer is the owner of numerous other applications for marks comprised in whole or in part of the wording UBS.

6. On April 23, 2001, Applicant submitted an application, Ser. No. 78/059,847, with the US PTO to register the mark USB E PAY for “on-line billing bill payment services.”

7. On June 25, 2002, application Ser. No. 78/059,847 was published for opposition.

8. The term USB is the dominant portion of the mark set forth in application Ser. No. 78/059,847.

9. The wording E PAY merely describes a quality, characteristic, function, feature, purpose or use of the services identified in application Ser. No. 78/059,847.

10. The mark set forth in Reg. No. 1,573,828 and the mark set forth in application Ser. No. 78/059,847 are confusingly similar.

11. The services set forth in Reg. No. 1,573,828 and the services set forth in application Ser. No. 78/059,847 are closely related.

12. The conditions surrounding the marketing of the services set forth in Reg. No. 1,573,828 and the services set forth in application Ser. No. 78/059,847 are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the parties’ services come from a common source.

13. The mark set forth in Reg. No. 1,573,828 was first used in commerce prior to any actual use or constructive use of the mark set forth in application Ser. No. 78/059,847.

14. The mark set forth in Reg. No. 1,573,828 has been in continuous use in commerce since 1962 and is still in use in commerce in connection with the services set forth therein.

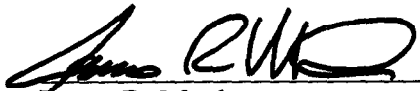
15. By reason of its substantial expenditure of time, effort and resources in advertising and promotion, Opposer has built up extensive and valuable goodwill and consumer recognition in the name and mark UBS for banking, securities brokerage, investment banking and numerous other diverse financial services. Opposer is one of the leading banks in the world and is, in fact, the world's largest global asset manager. Opposer is a top-tier provider of investment banking and securities brokerage services. The name and mark UBS symbolizes the excellent reputation for creditworthiness, safety, and soundness that Opposer has earned over many years as a world-renowned provider of financial services. Opposer's UBS mark is famous and became famous prior to any constructive or actual first use by Applicant of the mark set forth in application Ser. No. 78/059,847.

16. Opposer will be damaged by the issuance of this registration. Specifically, the mark set forth in application Ser. No. 78/059,847 so resembles the mark set forth in Reg. No. 1,573,828 as to be likely to cause confusion, or to cause mistake, or to deceive, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In addition, the mark set forth in application Ser. No. 78/059,847 will cause the dilution of the distinctive quality of the famous mark set forth in Reg. No. 1,573,828.

WHEREFORE, Opposer requests that application Ser. No. 78/059,847 be refused registration.

Please charge any fees due in connection with this document to Deposit Account No. 03-3975, 27578/292840.

Respectfully submitted,
UBS AG

By: 
James R. Menker
Paul W. Kruse

Opposer's Attorneys
Pillsbury Winthrop LLP
P.O. Box 10500
McLean, Virginia 22102
(703) 905-2000

EXHIBIT 1



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Sat Sep 21 04:10:50 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	UBS
Goods and Services	IC 036. US 101 102. G & S: BANKING, INVESTMENT BANKING, AND SECURITIES BROKERAGE SERVICES. FIRST USE: 19620101. FIRST USE IN COMMERCE: 19620101
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73795596
Filing Date	April 21, 1989
Published for Opposition	October 3, 1989
Registration Number	1573828
Registration Date	December 26, 1989
Owner	(REGISTRANT) UNION BANK OF SWITZERLAND CORPORATION SWITZERLAND 45 BAHNHOFSTRASSE ZURICH SWITZERLAND (LAST LISTED OWNER) UBS AG CORPORATION BY MERGER SWITZERLAND BAHNHOFSTRASSE 45 8021 ZURICH SWITZERLAND
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	TIMOTHY E. SHEIL
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20001223.

Renewal 1ST RENEWAL 20001223
Live/Dead
Indicator LIVE

[PTO HOME](#) [TRADEMARK](#) [TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [TOP](#) [HELP](#)

EXHIBIT 2



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Sat Sep 21 04:10:50 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



UBS

Word Mark UBS

Goods and Services

IC 036. US 100 101 102. G & S: insurance consultation, brokerage and administration; underwriting retirement, property and casualty risk and life insurance; financing services; banking, stock exchange price quotations and stock brokerage; financial transactions, namely, monetary exchange and financial exchange; real estate brokerage, financial investment in the field of real estate, and fiduciary representative services; stock and insurance brokerage services; financial sponsorship of sports competitions and art exhibits; automated teller machines services; providing financial information via telephonic means; electronic banking services, namely, providing banking via computers on customers' or others third parties' premises including telephone services and videotex services; providing on-line electronic databases on global computer networks in the field of banking

IC 014. US 002 027 028 050. G & S: precious metals and their alloys sold in bulk; bars of precious metal; jewelry; non-monetary coins

IC 038. US 100 101 104. G & S: telecommunications services, namely, electronic transmission of data via computer terminals

IC 009. US 021 023 026 036 038. G & S: apparatus for recording, transmitting, and reproducing data, sound and images, namely, photographic cameras, video cameras, motion picture cameras, stereo receivers and amplifiers, computer hardware telephones; magnetic or optical data carriers; data processing apparatus and installations, namely,

computer hardware, computer operating software for the financial services industry

IC 042. US 100 101. G & S: legal services; scientific research; leasing of computer hardware and software, compact discs, optical discs, and magnetic computer tapes; licensing of intellectual property

IC 035. US 100 101 102. G & S: data processing services and tax consultation services

Mark
Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 141101 141105
Serial Number 75562333
Filing Date September 30, 1998
Filed ITU FILED AS ITU
Published for Opposition July 9, 2002
Owner (APPLICANT) UBS AG CORPORATION SWITZERLAND Bahnhofstrasse 45 CH-8001 Zurich SWITZERLAND
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record TIMOTHY E SHEIL
Section 44 Indicator SECT44
Priority Date April 1, 1998
Prior Registrations 1573829
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

[PTO HOME](#) [TRADEMARK](#) [TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [TOP](#) [HELP](#)

EXHIBIT 3



UNITED STATES PATENT AND TRADEMARK OFFICE

Trade mark Electronic Search System (TESS)

TESS was last updated on Sat Sep 21 04:10:50 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark UBS KEYLINK

Goods and Services IC 009. US 021 023 026 036 038. G & S: Computer software; magnetic or optical data carriers

IC 035. US 100 101 102. G & S: Collecting and processing of data, information, images and sound in computer databases

IC 036. US 100 101 102. G & S: Insurance, finance, banking, in particular financial analysis and consultancy in connection with insurance, finance and banking; all these services also provided via computer networks

IC 038. US 100 101 104. G & S: Telecommunications services, including remote on-line data transmission; provision and transmission of data, information, images and sound via telecommunication means and Internet

IC 042. US 100 101. G & S: Scientific research in connection with insurance, finance and banking

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76143020

Filing Date October 10, 2000

Filed ITU FILED AS ITU

Owner (APPLICANT) UBS AG CORPORATION SWITZERLAND Bahnhofstrasse 45 CH-8001 Zurich SWITZERLAND

Attorney of

Record Timothy E Sheil
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

[FTO HOME](#) [TRADEMARK](#) [TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [TOP](#) [HELP](#)

