

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

IN THE MATTER OF APPLICATION

Mark: CIRRUS CAPITAL & Design
Applicant: Cirrus Capital S.A.
Serial No.: 78/209,795
Filed: February 1, 2003
Published in
the Official Gazette: December 9, 2003


04-09-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

_____ X
CIRRUS SYSTEM, LLC :
Opposer, : Opposition No. ____, __
v. :
CIRRUS CAPITAL S.A., :
Applicant. :
_____ X

NOTICE OF OPPOSITION

Cirrus System, LLC, a Delaware limited liability company, located and doing business at 2000 Purchase Street, New York 10577-2509 (hereinafter referred to as "Opposer"), believes that it will be damaged by the registration of application Serial No. 78/209,795, filed on February 1, 2003, by Cirrus Capital S.A. for the alleged mark CIRRUS CAPITAL & Design ("CIRRUS CAPITAL") for "investment management services, namely, investment funds and separately managed investment accounts" in Class 36 and, having previously been granted extensions of time to oppose, hereby opposes same.

The specific grounds for this opposition are as follows:

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NY02:481239.1

1. Opposer, an indirect, wholly-owned subsidiary of MasterCard International Incorporated ("MasterCard"), is a limited liability company operating within the banking and financial services industry which provides, inter alia, banking services, debit card services, cash disbursement, automatic teller machine ("ATM") services and electronic funds transfer services. Opposer and its corporate affiliates have been in the banking and financial services industry for over twenty years and has become well and favorably known not only among members of that community, but among the public at large.

2. Opposer is the owner of United States Service Mark Registration No. 1259615 for CIRRUS and Reg. No. 1298026 for CIRRUS & Design, both covering "banking services-namely, providing automatic teller services" in Class 36. These registrations are valid and subsisting, uncanceled and unrevoked, and incontestable pursuant to 15 U.S.C. § 1065. Copies of the Certificates of Registration for each are attached hereto. Though the Certificates of Registration identify the owner thereof as Cirrus System, Inc., through a valid transfer of ownership, the registrations are now owned by Opposer.

3. The CIRRUS mark is used by Opposer, its parent corporation MasterCard, and other licensed financial institutions in connection with the world's leading ATM and debit card program. Opposer has used the CIRRUS mark in connection with banking and ATM services since at least as early as March 3, 1982. Use of the CIRRUS mark has been continuous since the date of first use and said mark has not been abandoned. The CIRRUS mark appears on more than one hundred and fifty million debit cards in the United States (nearly five hundred million worldwide), which are accepted at nearly four hundred thousand ATMs in the United States (nearly one million worldwide). In the year 2003, over one million six hundred thousand transactions were conducted in the United States using a debit card bearing the CIRRUS mark

(over ten million transactions worldwide during that same period). Over the years, significant sums have been spent in marketing and promoting the CIRRUS mark. The CIRRUS mark is the subject of trademark registrations and/or applications in virtually every country in the world. As a result of long, extensive and continuous use, the CIRRUS mark has become famous and closely identified with Opposer. Indeed, the CIRRUS mark is an asset of inestimable value to Opposer.

4. By the application opposed herein, Applicant seeks to register the alleged mark CIRRUS CAPITAL as a service mark for "investment management services, namely, investment funds and separately managed investment accounts" in Class 36.

5. Applicant's alleged mark, CIRRUS CAPITAL, is a colorable imitation of Opposer's previously used and registered CIRRUS mark, with "CIRRUS" serving as the dominant portion thereof.

6. Upon information and belief, the services which are to be offered by Applicant under its alleged mark, CIRRUS CAPITAL, are closely related and/or complementary to the goods and services long offered by Opposer under its previously used and registered CIRRUS mark.

7. Upon information and belief, the services which are to be offered by Applicant under its alleged mark, CIRRUS CAPITAL, will be encountered by the same or similar class of customers as those who are interested in or familiar with the services long offered by Opposer under its previously used and registered CIRRUS mark.

8. Applicant's alleged mark, CIRRUS CAPITAL, so resembles Opposer's previously used and registered CIRRUS mark as to be likely to cause confusion, to cause mistake or to deceive, with consequent injury to Opposer and the public.

9. Specifically, and without limitation, the offering of Applicant's aforementioned services under the alleged mark, CIRRUS CAPITAL, is likely to cause consumers to believe that Applicant's services are those of Opposer, or that Applicant's services are connected with those of Opposer, or that Applicant is somehow related or sponsored by Opposer. Accordingly, Applicant's alleged mark is not entitled to registration pursuant to 15 U.S.C. §1052(d).

10. Further, Applicant's alleged mark will lessen the capacity of Opposer's famous and distinctive CIRRUS mark to distinguish and identify Opposer's goods and services from those of others, thereby diluting the distinctive quality of said mark in violation of 15 U.S.C. § 1125(c). Accordingly, Applicant's alleged mark is not entitled to registration under 15 U.S.C. § 1052(f).

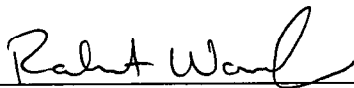
11. Opposer will be damaged by the registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading and dilutive use of Applicant's alleged mark, CIRRUS CAPITAL, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that the registration sought by Applicant be denied.

Respectfully submitted,
BAKER BOTTS L.L.P.

Dated: April 7, 2004

By:



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Attorneys for Opposer

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Applicant. :
_____ X

CERTIFICATE OF MAILING

I hereby certify that on the date set forth below that this paper is being deposited with the United States Postal Service (in duplicate) as First-Class Mail in an envelope with sufficient postage addressed to: BOX TTAB FEE, Commissioner For Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

April 7, 2004
Date of Deposit

Robert M. Wasnofski, Jr.
Robert M. Wasnofski, Jr.

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,259,615

Registered Nov. 29, 1983

SERVICE MARK
Principal Register

CIRRUS

Cirrus System, Inc. (Texas corporation)
1900 Spring Rd.
Oak Brook, Ill. 60521, assignee of
First Interstate Bancorp (Delaware corporation)
Los Angeles, Calif.

For: BANKING SERVICES—NAMELY, PRO-
VIDING AUTOMATIC TELLER SERVICES, in
CLASS 36 (U.S. Cl. 102).

First use Feb. 12, 1982; in commerce Feb. 12,
1982.

Ser. No. 352,494, filed Mar. 3, 1982.

G. MAYERSCHOFF, Examining Attorney

REGISTERED FOR A TERM OF 20 YEARS FROM Nov. 29, 1983

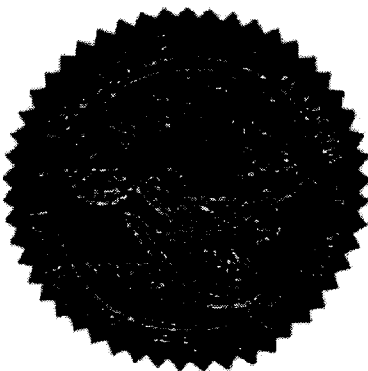
COMB. AFF. SEC 8 & 15...

CERTIFIED TO BE A TRUE COPY OF THE ADMINISTRATION
WHICH IS IN FULL FORCE AND EFFECT, WITH NOTATION
OF ALL STATUTORY ACTIONS TAKEN THEREON, AS DIS-
CLOSED BY THE RECORDS OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE. SAID RECORDS SHOW TITLE
TO BE IN: Registrant

Attest

JUN 27 1989
D. C. Taylor
Attesting Officer

Donald R. Ziegler
COMMISSIONER OF PATENTS
AND TRADEMARKS



Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,298,026

Registered Sep. 25, 1984

SERVICE MARK
Principal Register



Cirrus System, Inc. (Texas corporation)
1900 Spring Rd.
Oak Brook, Ill. 60521

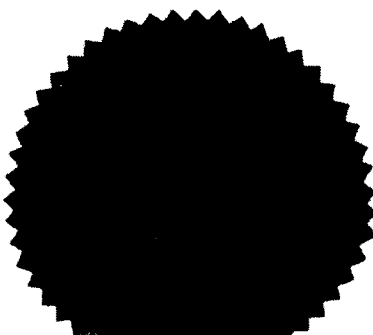
For: **BANKING SERVICES—NAMELY, PROVIDING AUTOMATIC TELLER SERVICES**, in CLASS 36 (U.S. Cl. 102).

First use Aug. 4, 1982; in commerce Aug. 4, 1982.
Owner of U.S. Reg. No. 1,259,615.

Ser. No. 404,146, filed Nov. 29, 1982.

DOMINICK J. SALEMI, Examiner

REGISTERED FOR A TERM OF 20 YEARS FROM Sept. 25, 1984



Certified to be a true copy of the registration issued by the United States Patent & Trademark Office, which registration is in full force and effect. Record title is in Registrant

Attest

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COMMISSIONER OF PATENTS

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04-09-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

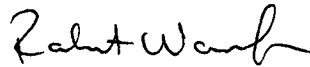
Re: Cirrus System, LLC v. Cirrus Capital S.A.
Mark : CIRRUS CAPITAL & Design
Serial No. : 78/209,795

Dear Sir or Madam:

I enclose for filing on behalf of Opposer, Cirrus System, LLC, a Notice of Opposition to the above-captioned mark and a duplicate copy thereof. A check in the amount of \$300.00 is enclosed to cover the filing fee.

If the fee enclosed is found to be inadequate, please draw the additional amount from our Deposit Account No. 02-4377.

Very truly yours,



Robert M. Wasnofski, Jr.

Enclosures