

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

ING USA HOLDING CORPORATION

Opposer,

v.

ORANGE PERSONAL COMMUNICATIONS)
SERVICES LIMITED)

Applicant.)



Opposition No. _____

Attorney's Reference: 32870-199793



06-28-2004

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

NOTICE OF OPPOSITION

In the matter of the application for registration of the trademark ORANGE PAGES filed by Orange Personal Communications Services Limited ("Applicant"), as shown in Application Serial No. 76/309,149 September 4, 2001 based upon a corresponding application filed in the United Kingdom on July 5, 2001 and published for opposition in the *Official Gazette* of December 30, 2003.

ING USA Holding Corporation ("Opposer"), a Delaware corporation with its address at 1 South Orange Street, Wilmington, Delaware, 19801 believes that it will be damaged by registration of the mark shown in said Application Serial No.76/309,149, and hereby opposes the same:

As grounds for opposition it is alleged that:

1. Opposer is the owner of a number of U.S. trademark applications for marks comprised in part of the term ORANGE and covering various financial, banking and insurance services in Class 36. These include:

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- a. Application Serial No. 76/036,367 filed April 27, 2000 for the mark ORANGE MINUS as intended to be used to identify various banking and financial services in Class 36.
- b. Application Serial No. 76/036,368 filed April 27, 2000 for the mark ORANGE SAVINGS ACCOUNT as intended to be used to identify various banking and financial services in Class 36.
- c. Application Serial No. 76/036,370 filed April 27, 2000 for the mark ORANGE ACCOUNT as intended to be used to identify various banking and financial services in Class 36.
- d. Application Serial No. 76/036,371 filed April 27, 2000 for the mark ORANGE PLUS as intended to be used to identify various banking and financial services in Class 36.
- e. Application Serial No. 76/066,841 filed June 9, 2000 for the mark ORANGE CARD as intended to be used to identify various banking and financial services in Class 36.
- f. Application Serial No. 76/066,849 filed June 9, 2000 for the mark ORANGE+ as intended to be used to identify various banking and financial services in Class 36.
- g. Application Serial No. 76/071,824 filed June 16, 2000 for the mark SIMPLY ORANGE as intended to be used to identify various banking and financial services in Class 36.
- h. Application Serial No. 76/085,478 filed July 6, 2000 for the mark ORANGE LOAN ACCOUNT as intended to be used to identify various banking and financial services in Class 36.

i. Application Serial No. 76/089,023 filed July 14, 2000 for the mark ORANGE CD as intended to be used to identify various banking and financial services in Class 36.

j. Application Serial No. 76/096,577 filed July 26, 2000 for the mark ORANGE LOAN as intended to be used to identify various banking and financial services in Class 36.

k. Application Serial No. 76/096,578 filed July 26, 2000 for the mark ORANGE MORTGAGES as intended to be used to identify various banking and financial services in Class 36.

l. Application Serial No. 76/096,579 filed July 26, 2000 for the mark ORANGE MORTGAGE as intended to be used to identify various banking and financial services in Class 36.

m. Application Serial No. 76/096,580 filed July 26, 2000 for the mark ORANGE CDS as intended to be used to identify various banking and financial services in Class 36.

n. Application Serial No. 76/096,581 filed July 26, 2000 for the mark ORANGE SAVINGS as intended to be used to identify various banking and financial services in Class 36.

2. Each of the applications referenced in Paragraph 1, subparagraphs a-n, has a filing date that is prior to the filing date of Application Serial No. 76/309,149.
3. Each of the applications referenced in Paragraph 1, subparagraphs a-n, has a filing date that is prior to the priority filing date of Application Serial No. 76/309,149.

4. Each of the applications referenced in Paragraph 1, subparagraphs a-n, has a filing date that is prior to any date of first use of the mark ORANGE PAGES in the United States that may be alleged by the Applicant for the services listed in Class 36 in Application Serial No. 76/309,149.
5. Each of the applications referenced in Paragraph 1, subparagraphs a-n, has a filing date that is prior to any date of first use of the mark ORANGE PAGES in the United States that may be alleged by the Applicant for the goods and services listed in each Class in Application Serial No. 76/309,149.
6. The mark ORANGE PAGES is substantially similar to the marks shown in the applications referenced in Paragraph 1, subparagraphs a-n of this Opposition.
7. The applicant has not used the trademark ORANGE PAGES in the United States on or in connection with the services listed in Class 36 in its application.
8. The applicant has not used the trademark ORANGE PAGES in the United States on or in connection with any of the goods and services listed in its application.
9. The services in Class 36 for which applicant seeks to register the mark ORANGE PAGES are related to services covered by the marks shown in the applications referenced in Paragraph 1, subparagraphs a-n of this Opposition.
10. Consumers are likely to be confused and to mistakenly believe that Applicant's goods and services offered under its ORANGE PAGES mark either emanate from or are licensed by, sponsored by, or associated with Opposer, or that they incorporate Opposer's services.
11. If the Applicant were permitted to use and register its mark for its goods and services as specified in its application, confusion among consumers resulting in damage and injury to Opposer would be caused by virtue of the similarity between

Applicant's trademark and Opposer's trademark, and the related nature of the goods and services covered by those marks. Any defect, objection or fault found with Applicant's goods or services would reflect upon, seriously injure, and dilute the reputation and value that Opposer has established under its trademarks.

12. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 9 at the time the application was filed.
13. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 16 at the time the application was filed.
14. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 18 at the time the application was filed.
15. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 25 at the time the application was filed.
16. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 28 at the time the application was filed.
17. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 35 at the time the application was filed.

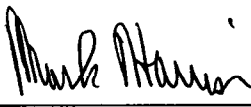
18. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 36 at the time the application was filed.
19. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 37 at the time the application was filed.
20. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 38 at the time the application was filed.
21. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 39 at the time the application was filed.
22. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 41 at the time the application was filed.
23. Upon information and belief, Application Serial No. 76/309,149 is void because Applicant did not have a bona fide intent to use the mark in commerce for the each of the goods in Class 42 at the time the application was filed.
24. The bona fides of Applicant's intent to use its mark in connection with each product and service listed in each Class in its application are not apparent from the materials of record in the subject application, and Opposer therefore challenges the same and leaves the Applicant to its proof with regard to the nature and sufficiency of its intent to use at the time of filing.

WHEREFORE, Opposer prays that Application Serial No. 76/309,149 be rejected, that no registration be issued thereon to applicant, and that this opposition be sustained in favor of the Opposer.

This Notice of Opposition is submitted in duplicate, together with the statutory filing fee of \$3,600.00 (12 Classes). Should any additional fee be required, please charge the same to our Account No. 22-0261 and notify the undersigned accordingly.

Opposer appoints Mark B. Harrison, Andrew Price, Janet Satterthwaite, and Jacqueline Patt, along with the law firm of Venable LLP, P.O. Box 34385, Washington, D.C. 20043-9998 to transact all business on its behalf in connection with this Opposition.

Respectfully submitted,

By:  _____

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