



152/00383-1

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

CONSECO SERVICES, LLC)
)
Opposer,)
)
v.)
)
CRYSTAL STAIRS, INC.)
)
Applicant.)
_____)

TTAB

OPPOSITION NO.:

(Serial No. 78/268,072)

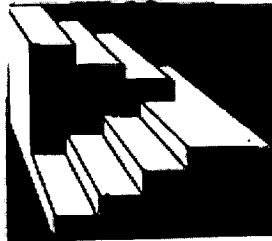
NOTICE OF OPPOSITION

Opposer, Conseco Services, LLC, a limited liability corporation duly organized under the laws of the state of Indiana, having a principal place of business at 11825 N. Pennsylvania Street, Carmel, Indiana 46082, (hereinafter referred to as "Opposer" and "Conseco"), believes that it may be damaged by the registration of Application Serial No. 78/268,072 for a MISCELLANEOUS DESIGN for use in connection with charitable services, namely, providing resource and referral services to help families find childcare providers in their area in Class 35 and charitable services, namely, providing training in the field of childcare and child development in Class 41 as filed on June 27, 2003 in accordance with Section 1(a) of the Lanham Act, as amended, by Crystal Stairs, Inc. a corporation organized under the laws of the state of California having a principal place of business at 650 W. Adams Blvd., #100, Los Angeles, California 90007 (hereinafter referred to as "Applicant"), published in the Trademark Official Gazette on August 16, 2006, time to oppose being extended - hereby opposes the registration of same. Applicant's mark as it appears in the Official Gazette looks like this:

01/08/2007 GTHDHAS2 00000110 78268072

01 FC:6402

600.00 OP



01-03-2007

The grounds for opposition under Sections 2(a) and Section 43(c) of the Lanham Act, as amended, are as follows:

1. Opposer is one of the United States' leading sources of insurance, investment and lending products. Consecos is a Fortune 500 company, with more than \$4 billion in annual revenues. Through its subsidiaries and a nationwide network of insurance agents and financial dealers, Consecos provides financial and insurance services to more than four million customers throughout the United States. Consecos reaches out to more than 50 million potential customer households across America. Consecos provides a range of products and services including but not limited to health and medical insurance, retirement annuities, universal life insurance, administration of employee benefit plans, and consumer and commercial financial products and services, as well as educational conferences, classes, seminars and workshops and the development and dissemination of educational materials of others in the field of annuities and insurance.

2. In an effort to promote the "CONSECO" mark and name as well as the STAIR STEP Design depicted in the registration pleaded herein, Consecos Services, LLC has entered into a number of affiliations and sponsorship arrangements, wherein Opposer has sponsored numerous sporting events and charitable endeavors, including but not limited to the famed Consecos Field House located in Indianapolis, Indiana, (home of the famed Indiana Pacers, an authorized team of the National Basketball Association), as well as its sponsorship of individual participants in Indy Car Racing and in NASCAR Racing.

3. In connection with such sponsorship and affiliations, the "CONSECO" mark and name has been used and promoted in close association with Opposer's famed STAIR STEP Design, and said STAIR STEP Design has been used at common law in connection with a wide variety of collateral products and services, including, but not limited to the following:

- a. educational services, namely, the presentation of seminars, lectures, workshops and classes in the field of life insurance, annuities and financial investments in Class 41;
- b. broadcasting television, radio, cable television, cable radio, subscription television, video, audio programs of field house events; broadcasting programs of fieldhouse events via a global computer network in Class 38;
- c. metal key chains; in Class 6;
- d. jewelry pins for use on hats, ornamental lapel pins, jewelry lapel pins, ornamental pins, pins being jewelry in Class 14;

e. publications and printed matter, namely, postcards, statistical books for sports, guide books and reference books for basketball, printed programs concerning sporting events, journals, and books about fieldhouse sporting events, and media guides in Class 16;

f. umbrellas, golf umbrellas in Class 18;

g. non-metal key chains in Class 20;

h. beverage glassware; drinking glasses, mugs; cups in Class 21;

i. sporting goods, namely basketballs in Class 28;

j. entertainment services, namely providing fieldhouse facilities for sporting events, exhibitions, concerts, shows, informational tours, meetings, seminars, and conventions or other private or public events or gatherings for entertainment, political, charitable, religious, social, and commercial purposes; ushering services; production of television, radio, cable television, cable radio, subscription television, video, audio programs of fieldhouse events and production of programs of fieldhouse events for transmission via a global computer network; arranging and conducting athletic competitions and educational conferences; and arranging for ticket reservations for fieldhouse entertainment events in Class 41.

k. paper flags, paper banners, paper signs, collectible cardboard trading discs, postcards, paper placemats, plastic placemats, note cards, memo pads, ballpoint pens, pencils, other writing instruments, ring binders, stationery folders, wirebound notebooks, portfolio notebooks, writing pads, tablets, unmounted and mounted photographs, posters, calendars, bumper stickers, book covers, wrapping paper, children's activity books, brochures, newsletters, journals, magazines, books bulletins about fieldhouse sporting events, coloring books, three dimensional educational models or replicas, paper bath mats, and paper mats in Class 16;

l. athletic bags, shoe bags for travel, overnight bags, backpacks, baby backpacks, duffel bags, tote bags, luggage tags, patio umbrellas, valises, attache cases, billfolds, wallets, briefcases, canes, business card cases, book bags, all-purpose sport bags, gym bags, purses, fanny packs, waist packs, cosmetic cases sold empty, garment bags for travel, handbags, key cases, knapsacks, suitcases, toiletry cases sold empty, trunks for traveling and rucksacks in Class 18;

m. clothing, namely, hosiery, footwear, athletic shoes, t-shirts, sweatshirts, sweatpants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, polo shirts, fleece gloves, fleece mittens, fleece hats, fleece scarves, fleece socks, fleece pants, fleece shirts, fleece jackets, fleece

coats, fleeced headbands, sweaters, belts, ties, nightshirts, hats, warm-up suits, jackets, parkas, coats, cloth bibs, headbands, wristbands, aprons, boxer shorts, slacks, caps, ear muffs, gloves, skirts, socks, infant and toddler sets, scarves, and infant clothing, namely, undershirts, T-shirts, overalls, shirts, pants, cloth diapers, socks, cap and hats in Class 25.

n. pre-recorded computer discs, computer programs, compact discs, CD-ROMS, laser discs, audio and video tapes, featuring games, musical sound recording and sports information for entertainment purposes; computer accessories, namely computer software in the nature of screen savers, computer mouse, computer mouse pads; calculators; interactive video and computer games of virtual reality comprised of computer hardware and software.

o. computer services for others, namely, software design and software maintenance, data conversion of computer and network data or information and system testing; technical support services, namely, diagnosis, analysis, troubleshooting, maintenance and repair of computer software and network via telephone, e-mail, and over a global computer network; computer consultation; management of computer systems and network systems for others, namely analysis and monitoring of computer and network systems; computer services, namely creating and maintaining web sites for others; database development services, namely consultation, design, analysis and maintenance of computerized database for others.

4. Since long prior to Applicant's filing date and alleged date of first use, Opposer has been, and is now using its STAIR STEP Design mark in commerce in connection with the following:

a. business acquisition and merger consultations; cost management for health care benefit plans of others in Class 35.

b. insurance actuarial services; insurance administration; administration of employee benefit plans and pension plans; administration of prepaid healthcare plans; financial analysis and consultation; annuity underwriting; insurance brokerage; claims adjustment in field of insurance; insurance claims administration; insurance claims processing; insurance consultation; electronic processing of insurance claims and payment data; financial planning and portfolio management; underwriting insurance for prepaid healthcare; organizing prepaid healthcare plans; life insurance underwriting; medical insurance underwriting; re-insurance underwriting, debit card services, and credit card services in Class 36.

c. educational services, namely, arranging and conducting educational conferences; entertainment services in the nature of automobile races; development and dissemination of educational materials in the fields of insurance, annuities, banking, investments for others; educational services, namely, conducting classes; seminars; conferences and workshops in field of insurance, annuities, investments and banking; entertainment in nature of golf tournaments in Class 41.

d. charitable services in class 41.

5. Since long prior to Applicant's filing date and alleged date of first use, Opposer has been, and is now using its STAIR STEP Design mark in commerce in connection with its charitable giving and sponsorships. Opposer has used this mark in connection with supporting the YWCA Women of Achievement, Easter Seals Crossroads, United Way of Central Indiana, The Susan B. Komen Breast Cancer Foundation, and other charitable endeavors.

6. Opposer, Consecro Services, LLC, by reason of an Assignment dated May 15, 2000, is the owner and relies upon the following incontestable registration which is valid, subsisting and unrevoked: Registration No. 2,472,633 for the following MISCELLANEOUS DESIGN registered July 31, 2001 in Class 41.



(Referred to as Opposer's STAIR STEP Design mark). Certified status and title copies of the above registration will be provided at a later date. The above registration is conclusive evidence of Opposer's exclusive right to use the mark in commerce in connection with the goods and services listed in the registration and for services related thereto.

7. Applicant filed a use based application to register Application Serial No. 78/268,072 for a MISCELLANEOUS DESIGN alleging a date of first use of January 26, 1980 in connection with the services contained within the application.

8. Upon information and belief, Applicant had not made a bona fide commercial use of the MISCELLANEOUS DESIGN mark in connection with the services contained within the application as of its alleged date of first use.

Count I - Section 43(c) Likelihood of Dilution

9. The Opposer continuously and in good faith used the STAIR STEP Design mark as described herein in paragraphs 1, 2, 4 and 5 and has also from time to time used the STAIR STEP Design mark as described in paragraph 3.

10. As a consequence of Opposer's extensive use of its STAIR STEP Design mark, Opposer's STAIR STEP Design mark has become famous as well as distinctive in the minds of the trade, business community, and the public of the quality of goods and services offered by Opposer.

11. Opposer has more than four million customers who hold an insurance policy with the STAIR STEP Design mark and there are countless others who have been exposed to the STAIR STEP Design through Opposer's various sponsorships and affiliations and Opposer's charitable giving programs.

12. Upon information and belief, Opposer's STAIR STEP Design mark became famous prior to Applicant's actual date of first use for its MISCELLANEOUS DESIGN.

13. Applicant's registration of the MISCELLANEOUS DESIGN mark is likely to cause dilution by blurring and dilution by tarnishment of the distinctive quality of Opposer's STAIR STEP Design mark and is likely to cause injury to the business, goodwill and business reputation of Opposer since Opposer's customers and purchasers of Opposer's goods and services may

erroneously believe that Applicant is in some way associated with Opposer, all to Opposer's injury and detriment.

14. Applicant's actual and subsequent adoption, use and registration of the MISCELLANEOUS DESIGN mark in connection with the services described in its application is likely to dilute the distinctive quality of Opposer's STAIR STEP Design mark, and is likely to cause injury to the business, goodwill and business reputation of the goods and services being offered by Opposer in connection with its STAIR STEP Design mark by blurring, tarnishing and/or otherwise by reducing the distinctiveness of the Conseco STAIR STEP Design mark.

15. Opposer has expended considerable time, effort and money in advertising and otherwise promoting its services and products and in encouraging the public and trade to recognize its STAIR STEP Design mark, that unless refused, Applicant's registration for its MISCELLANEOUS DESIGN will enable Applicant to reap the benefits of such goodwill attached to Opposer's STAIR STEP Design mark, and Opposer will suffer irreparable damage and injury as a result of the dilution that is likely to arise from its inability to control its reputation.

16. Opposer is not connected in any way with the business or affairs of the Applicant, with the services offered, sponsored or endorsed by Applicant, nor does it have any control over the nature or quality of the services sold thereunder by Applicant.

Count II - Section 2(a)

17. The Applicant's MISCELLANEOUS DESIGN mark shown in Application Serial No. 78/268,072 falsely suggests a connection with Opposer under the provisions of Section 2(a) of the U.S. Trademark Act, 15 U.S.C. § 1052(a), pursuant to the allegations stated above since the Applicant's mark.

18. The mark is the same as, or a close approximation of, the Opposer's corporate identity which has been previously used by the Opposer.

19. The public would believe that the Applicant's mark suggests a connection with the Opposer since Applicant's MISCELLANEOUS DESIGN points uniquely and unmistakably to the Opposer.

20. Opposer is not connected with the activities performed by the Applicant under its MISCELLANEOUS DESIGN.

21. Since the Opposer and its STAIR STEP Design mark are famous and Opposer's reputation so widespread that a connection with the Opposer would be presumed when the Applicant's MISCELLANEOUS DESIGN is used on Applicant's services.

Count III - Fraud

22. Upon further information and belief, the statements made by Applicant regarding its first use of the MISCELLANEOUS DESIGN in commerce were false and were made knowingly with the intent to deceive the Trademark Office.

23. When Opposer spoke with one of Applicant's representatives and requested information demonstrating the Applicant's date of first use for of the MISCELLANEOUS DESIGN in commerce, Opposer's request was refused

24. Upon information and belief, Applicant has committed fraud on the Patent and Trademark Office by asserting incorrectly in its application that it had first used his trademark in commerce on January 26, 1980 in order to procure a registration to which it was not entitled.

25. Upon information and belief, Applicant has committed fraud in its application by making materially false statements in order to obtain registration of its MISCELLANEOUS DESIGN mark.

26. The information concerning the date of first use for the Applicant's MISCELLANEOUS DESIGN is solely within the possession of the Applicant.

27. Unless Applicant's registration for the for the MISCELLANEOUS DESIGN mark is denied by the Trademark Trial and Appeal Board, Opposer will suffer irreparable harm.

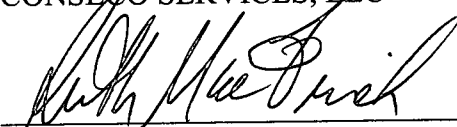
WHEREFORE, Opposer respectfully prays that Applicant's registration for the MISCELLANEOUS DESIGN mark be denied by the Trademark Trial and Appeal Board and that the opposition be sustained in favor of Opposer.

Please recognize Barth X. deRosa and the firm of Stevens Davis Miller Mosher LLP consisting of Barth X. deRosa, James E. Ledbetter, Thomas P. Pavelko, Anthony P. Venturino, and Peter N. Lalos, all members of a bar, 1615 L Street, N.W., Suite 850, Washington, D.C. 20036 as the attorneys for Opposer.

A check for \$600.00 for the government fee for two (2) classes is attached hereto together with two copies of the Notice of Opposition.

Respectfully submitted,

CONSEGO SERVICES, LLC



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