

ESTTA Tracking number: **ESTTA121799**

Filing date: **01/26/2007**

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	F & C Management Limited
Granted to Date of previous extension	01/28/2007
Address	Exchange House, Primrose Street London, EC2A 2NY UNITED KINGDOM
Attorney information	Terrence J. McAllister Ohlandt, Greeley, Ruggiero & Perle, L.L.P. One Landmark Square, 10th Floor Stamford, CT 06901 UNITED STATES trademark@ogrp.com, tmcallister@ogrp.com, jscepanski@ogrp.com Phone:203-327-4500

Applicant Information

Application No	76566561	Publication date	08/01/2006
Opposition Filing Date	01/26/2007	Opposition Period Ends	01/28/2007
Applicant	RBC Dain Rauscher Inc. 60 South Sixth Street Minneapolis, MN 554024422 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. All goods and services in the class are opposed, namely: PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE WEB-BASED SOFTWARE THAT PERMITS REGISTERED SECURITIES REPRESENTATIVES TO ACCESS CLIENT ACCOUNT INFORMATION, ENTER ORDERS FOR EQUITIES, MUTUAL FUNDS, AND OPTIONS, ACCESS DELAYED AND REAL TIME QUOTES, ACCESS ON-LINE REPORTS, AND PROVIDE ADMINISTRATIVE SUPPORT IN THE NATURE OF OVERSIGHT OF THE ORDERS BEING ENTERED THROUGH A REVIEW AND RELEASE PROGRAM
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Attachments	Notice of Opposition - FC WebLink.pdf (10 pages)(465445 bytes)
Signature	/OGRP-CNR-TJM-JJS/
Name	Terrence J. McAllister
Date	01/26/2007

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

In the matter of Application Serial No. 76/566,561, FC WebLink
Published in the *Official Gazette* on August 1, 2006

F&C Management Limited,

Opposer,

Opposition No.:

vs.

RBC Dain Rauscher Inc.,

Applicant.

NOTICE OF OPPOSITION

F&C Management Limited (“Opposer”), a private limited company formed under the laws of the United Kingdom, having an office at Exchange House, Primrose Street, London EC2A 2NY, United Kingdom, believes it will be damaged by the issuance of a registration to RBC Dain Rauscher Inc. (“Applicant”), a corporation formed under the laws of Minnesota, U.S.A., having an office at 60 South Sixth Street, Minneapolis, Minnesota 55402-4422, U.S.A., for Application Serial No. 76/566,561 for the claimed mark FC WebLink. Accordingly, Opposer hereby opposes said mark under provisions of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. §1063.

As grounds for opposition, it is alleged that:

1. Opposer is one of the leading investment firms in Europe, as well as one of the largest investment firms quoted on the London Stock Exchange. Opposer has managed money for individuals and institutions for more than 130 years and currently manages approximately £131 billion (approximately 228,228,641,294 USD) in investment funds.

2. Opposer has been using the Mark F&C since 1889 and in commerce in the U.S. since at least December 30, 1982 in association with a wide variety of financial services. Opposer is the owner of the trademark F&C, the United States Trademark registrations and applications thereof (collectively referred to as the “F&C Marks”), and the goodwill symbolized by the trademarks and the registrations and applications thereof, as follows:

- a) Registration No. 2,706,152, registered April 15, 2003, for F&C in International Class 36 for “Financial services, namely financial management, loan financing; financial and fiscal appraisal services; financial investment and investment services, namely investment fund management, unit trust services and investment trust services; pension fund services; pension management; banking; capital investment services; mutual fund investment; providing derivative funds for others; providing and managing individual savings accounts (ISAs), personal equity plans (PEPs); venture capital investment; providing emerging markets equity portfolios, emerging markets investments; providing equity investments, fixed income investments, composite bonds, overseas equity investments, bond investments, cash funds, unit trusts, mutual trusts, pension schemes, institutional investment portfolios, private investor portfolios; providing private investor plans, PEP transfer plans; private equity funds, hedge funds, off-shore funds, emerging debt investments, government bonds investments, corporate bonds investments, high yield bond investments, risk altered fund products and institutional pension schemes; providing investment advice and investment funds for charities; providing information, opinions, estimates and forecasts all relating to investments, investment vehicles, equities, world markets, currencies, company performances; reports and update reports relating to portfolio performances; forecasts relating to corporate profits and price/earnings ratio; providing investment strategies; providing financial market data; providing asset allocation and stock selection; providing liquidity screening and pension management; asset management, namely asset management relating to property, equities, bonds, and structured products, namely products designed to give increased income and protection, providing money management, tailoring of funds for investors; providing closed-end fund investment services, market analysis services, property project management and redevelopment services, cash management services, administration of investments, namely stocks, securities, mutual funds and bonds, savings plans and closed-end fund vehicles in the nature of investment trusts the value of which is driven by supply and demand in the financial markets; providing information and advisory services for independent financial advisors; providing data relating to investment fund performances; providing research relating to money markets, world currencies, corporate profits, price/earnings ratio, company information and performances and market sectors; and stock

exchange quotation services” (hereinafter “the aforementioned Class 36 services”);

- b) Registration No. 2,755,004, registered August 26, 2003, for F&C (Design) in International Class 36 for the aforementioned Class 36 services;
- c) Registration No. 2,757,933, registered September 2, 2003, for F&C @ YOURSERVICE in International Class 35 for “business administration services, namely business appraisals; business management; business research, all relating to finance and investments” and International Class 36 for the aforementioned Class 36 services;
- d) Registration No. 2,954,182, registered May 24, 2005, for F&C AMETHYST FUND in International Class 36 for the aforementioned Class 36 services;
- e) Registration No. 3,008,180, registered October 25, 2005, for F&C CITRINE FUND in International Class 36 for the aforementioned Class 36 services;
- f) Registration No. 2,947,310, registered May 10, 2005, for F&C RUBY FUND in International Class 36 for the aforementioned Class 36 services;
- g) Registration No. 2,749,472, registered August 12, 2003, for FandC in International Class 9 for “downloadable electronic publications in the nature of books, manuals, periodical publications, magazines, brochures, pamphlets, prospectuses, fact sheets, informational flyers, and instructional and teaching material, all relating to finance, investments, investment trusts, investment projections, investment and equity portfolios, investment fund and equity performances, global markets, emerging markets, bonds, global currencies, property project management and redevelopment; printed publications, namely publications relating to investment trusts and financial investments; printed reports and reviews featuring investment and equity portfolios, investment fund and equity performances, investments, investment projections, global markets, emerging markets, bonds, global currencies;” International Class 16 for “printed matter, namely, books, manuals, periodical publications, magazines, brochures, pamphlets, prospectuses, fact sheets, informational flyers, and instructional and teaching material, all relating to finance, investments, investment trusts, investment projections, investment and equity portfolios, investment fund and equity performances, global markets, emerging markets, bonds, global currencies, property project management and redevelopment; printed publications, namely publications relating to investment trusts and financial investments; printed reports and reviews featuring investment and equity portfolios, investment fund and equity performances, investments, investment projections, global markets, emerging markets, bonds, global currencies; photographs, pictures, posters, stationery, and calendars;” International Class 35 for “business administration services, namely business appraisals, business management; business

research, all relating to finance and investments;" International Class 36 for the aforementioned Class 36 services; International Class 38 for "providing on-line chat rooms for transmission of messages among computer users concerning finance and investments."

- h) Registration No. 2,864,049, registered July 20, 2004, for FandC in International Class 9 for "downloadable electronic publications in the nature of books, manuals, periodical publications, magazines, brochures, pamphlets, prospectuses, fact sheets, informational flyers, and instructional and teaching material, all relating to finance, investments, investment trusts, investment projections, investment and equity portfolios, investment fund and equity performances, global markets, emerging markets, bonds, global currencies, property project management and redevelopment; printed publications, namely publications relating to investment trusts and financial investments; printed reports and reviews featuring investment and equity portfolios, investment fund and equity performances, investments, investment projections, global markets, emerging markets, bonds, global currencies;" International Class 16 for "printed matter, namely, books, manuals, periodical publications, magazines, brochures, pamphlets, prospectuses, fact sheets, informational flyers, and instructional and teaching material, all relating to finance, investments, investment trusts, investment projections, investment and equity portfolios, investment fund and equity performances, global markets, emerging markets, bonds, global currencies, property project management and redevelopment; printed publications, namely publications relating to investment trusts and financial investments; printed reports and reviews featuring investment and equity portfolios, investment fund and equity performances, investments, investment projections, global markets, emerging markets, bonds, global currencies; photographs, pictures, posters, stationery, and calendars;" International Class 35 for "business administration services, namely business appraisals, business management; business research, all relating to finance and investments;" International Class 36 for the aforementioned Class 36 services; International Class 38 for "providing on-line chat rooms for transmission of messages among computer users concerning finance and investments."
- i) Registration No. 3,047,451, registered January 24, 2006, for F&C GARNET FUND in International Class 9 for "downloadable publications in electronic form provided on-line via the Internet and other interactive electronic platforms, all relating to funds, fund charting and provision of fund prices;" International Class 36 for "provision of hedge funds; mutual funds; investment funds; cash funds; private equity funds; off-shore funds; provision of derivative funds; pension fund services; investment fund managers; risk altered fund products; investment funds for charities; tailoring of funds for investors; closed-end fund investment services; closed-end fund vehicles; provision of data relating to investment fund performances; information provided on-line via the Internet and other interactive electronic platforms in

relation to all of the aforesaid funds, funds charting and provision of fund prices;" International Class 42 for "hosting of web-sites and other interactive electronic platforms for others in relation to hedge funds, mutual funds, investment funds, cash funds, private equity funds, off-shore funds, provision of derivative funds, pension fund services, investment fund managers, risk altered fund products, investment funds for charities, tailoring of funds for investors, closed-end fund investment services, closed-end fund vehicles, provision of data relating to investment fund performances, information provided on-line via the Internet and other interactive electronic platforms all relating to all of the aforesaid funds, funds charting and provision of fund prices."

- j) Application No. 76/555,071, filed October 15, 2003, for F&C SAPPHIRE FUND in International Class 9 for "downloadable publications in electronic form provided on-line via the Internet and other interactive electronic platforms, all relating to funds, fund charting and provision of fund prices;" International Class 36 for "provision of hedge funds; mutual funds; investment funds; cash funds; private equity funds; off-shore funds; provision of derivative funds; pension fund services; investment fund managers; risk altered fund products; investment funds for charities; tailoring of funds for investors; closed-end fund investment services; closed-end fund vehicles; provision of data relating to investment fund performances; information provided on-line via the Internet and other interactive electronic platforms in relation to all of the aforesaid funds, funds charting and provision of fund prices;" International Class 42 for "hosting of web-sites and other interactive electronic platforms for others in relation to hedge funds, mutual funds, investment funds, cash funds, private equity funds, off-shore funds, provision of derivative funds, pension fund services, investment fund managers, risk altered fund products, investment funds for charities, tailoring of funds for investors, closed-end fund investment services, closed-end fund vehicles, provision of data relating to investment fund performances, information provided on-line via the Internet and other interactive electronic platforms all relating to all of the aforesaid funds, funds charting and provision of fund prices."

3. Applicant applied on December 23, 2003 to register the mark FC WebLink ("Applicant's Mark") for "providing temporary use of on-line non-downloadable web-based software that permits registered securities representatives to access client account information, enter orders for equities, mutual funds, and options, access delayed and real time quotes, access on-line reports, and provide administrative support in the nature of

oversight of the orders being entered through a review and release program” in International Class 42.

4. Opposer claims priority for the mark F&C over Applicant’s FC WebLink mark by virtue of having used its F&C Mark in commerce in the U.S. since at least December 30, 1982, before Applicant filed its intent-to-use U.S. trademark application for FC WebLink in International Class 42 on December 23, 2003. Opposer also has long prior to Applicant’s filing date, used F&C as a trade name, corporate name, trademark, and house mark in association with a wide variety of financial services and in the promotion of such services.

5. The mark FC WebLink, which Applicant seeks to register, is so similar to Opposer’s F&C Mark, trade name, corporate name, and house mark, in sight, sound, overall appearance, and commercial impression, as to be likely, when used on or in connection with the services covered under Applicant’s FC WebLink Mark, to cause confusion, or to cause mistake, or to deceive consumers and members of the industry into believing that the services covered under Applicant’s FC WebLink Mark originate from, are sponsored by, or are otherwise authorized by Opposer, when, in fact, they are not.

6. The services covered under Applicant’s FC WebLink Mark, namely, “providing temporary use of on-line non-downloadable web-based software that permits registered securities representatives to access client account information, enter orders for equities, mutual funds, and options, access delayed and real time quotes, access on-line reports, and provide administrative support in the nature of oversight of the orders being entered through a review and release program” are similar to those covered in Opposer’s F&C Marks and associated with Opposer’s trade name, corporate name, and house mark.

7. Upon information and belief, the services associated with Applicant's FC WebLink Mark will be advertised, marketed, promoted, and provided through the same channels of trade and will be advertised in the same types of publications as Opposer's F&C Marks, trade name, corporate name, and house mark, and sold to the same classes of the purchasing public for use by or on the same consumers as Opposer's services.
8. Upon information and belief, the services associated with Applicant's FC WebLink Mark would be offered to and used by some of the same customers and consumers who would also be in the market for and use the services associated with Opposer's F&C Marks, trade name, corporate name, and house mark.
9. Opposer's F&C Marks, trade name, corporate name, and house mark have been extensively marketed and publicized and have become famous throughout the United States in the financial services field.
10. Opposer, since long prior to Applicant's filing of its intent-to-use application for its FC WebLink Mark, has spent, and continues to spend, large sums of money in the advertisement, marketing, promotion, and sale of its services identified and distinguished by its F&C Marks, trade name, corporate name, and house mark. And, by reason of such advertising, promotion, marketing and high quality of its products and services carrying the F&C Marks, trade name, corporate name, and house mark, Opposer now enjoys a valuable goodwill and enviable reputation with respect to its F&C Marks, trade name, corporate name, and house mark.
11. Upon information and belief, Opposer's F&C Marks are famous within the

meaning of the Anti-Dilution Act, 15 U.S.C. § 1125(c), and was famous long prior to Applicant's December 23, 2003 filing of its intent-to-use based trademark application for FC WebLink.

12. Applicant's use of FC WebLink will result in the dilution of the distinctive qualities and exclusive rights that Opposer has enjoyed in connection with its F&C Marks in violation of 15 U.S.C. § 1125(c).

13. Registration of Applicant's FC WebLink Mark would be a source of damage to Opposer because consumers and members of the industry are likely to attribute the source or sponsorship of Applicant's services to Opposer.

14. Registration of Applicant's FC WebLink Mark would be a source of damage to Opposer because registration would confer upon Applicant statutory presumptions to which Applicant is not entitled in view of Opposer's priority in regard to its use in commerce of the mark F&C in the U.S. and the registration of its F&C Marks with the USPTO.

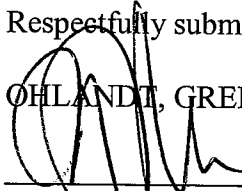
15. Applicant's Mark is merely descriptive.

WHEREFORE, Opposer prays that registration of Application No. 76/566,561 be denied and that this opposition be sustained in favor of Opposer on the merits, with prejudice, and without leave to refile.

Please direct all correspondence to the undersigned at the address listed below.

Respectfully submitted,

OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.



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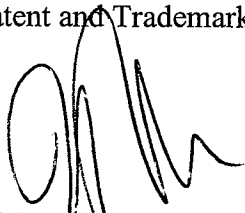
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ATTORNEYS FOR OPPOSER

Date: January 26, 2007

CERTIFICATE OF FILING

The undersigned hereby certifies that a copy of the foregoing "Notice of Opposition" was filed electronically through the Electronic System for Trademark Trial and Appeals ("ESTTA") located on the U.S. Patent and Trademark Office's website at <uspto.gov> on this 26th day of January, 2007.



Terrence J. McAllister
ATTORNEY FOR OPPOSER