

ESTTA Tracking number: **ESTTA147231**

Filing date: **06/21/2007**

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	Thrivent Financial for Lutherans
Granted to Date of previous extension	07/01/2007
Address	4321 North Ballard Road Appleton, WI 54919 UNITED STATES

Attorney information	Joseph T. Nabor Fitch, Even, Tabin & Flannery 120 S. LaSalle Street Suite 1600 Chicago, IL 60603 UNITED STATES trademark@fitcheven.com Phone:312 577-7000
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Applicant Information

Application No	78885951	Publication date	01/02/2007
Opposition Filing Date	06/21/2007	Opposition Period Ends	07/01/2007
Applicant	Credit Union National Association, Inc. 5710 Mineral Point Road Madison, WI 53705 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2005/03/29 First Use In Commerce: 2005/03/29 All goods and services in the class are opposed, namely: Financial information provided by electronic means for use by young credit union members; Financial information provided by electronic means for use by parents to teach their children about money matters
Class 041. First Use: 2005/03/29 First Use In Commerce: 2005/03/29 All goods and services in the class are opposed, namely: Education services, namely, providing tutorial sessions and workshops featuring educational information in the field of finance for use young credit union members; Education services, namely, providing tutorial sessions and workshops featuring educational information for use by parents to educate their children about money matters

Applicant Information

Application No	78885984	Publication date	05/22/2007
Opposition Filing Date	06/21/2007	Opposition Period Ends	06/21/2007
Applicant	Credit Union National Association, Inc. 5710 Mineral Point Road		

Madison, WI 53705 UNITED STATES

Goods/Services Affected by Opposition

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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2815440	Application Date	10/12/2001
Registration Date	02/17/2004	Foreign Priority Date	NONE
Word Mark	THRIVENT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Computer software for personal financial planning and estate planning</p> <p>Class 016. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Print publications, namely, brochures, information sheets, printed educational and teaching materials, books, and membership magazines for a fraternal benefits society, all in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters</p> <p>Class 036. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations</p> <p>Class 041. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars, and video tapes</p>		
U.S. Registration No.	2798598	Application Date	11/15/2001

Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	THRIVENT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional items made of metal, namely, metal key holders</p> <p>Class 009. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional computer accessory items, namely, tape measures, decorative magnets</p> <p>Class 011. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional items, namely, flashlights</p> <p>Class 014. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional jewelry items, namely, jewelry, watches, clocks, ornamental pins</p> <p>Class 016. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional printed and [stationary] * stationery * items, namely, pens, pencils, high-lighting markers, letter openers, paperweights, note pads, decals and stickers, calendars, paper napkins</p> <p>Class 018. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional items, namely attache cases, billfolds, business card cases, traveling bags, canvas tote bags, carry-all bags, umbrellas</p> <p>Class 020. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional items, namely, non-metal key holders</p> <p>Class 021. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional housewares and glass items, namely, mugs, beverage glassware, travel mugs, portable coolers, insulated can and bottle holder, plastic sports bottles sold empty, paper plates, paper cups</p> <p>Class 024. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional textile items, namely, golf towels</p> <p>Class 025. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional clothing items, namely, jackets, shirts, t-shirts, hats, sweatshirts, [, hats] and visors</p> <p>Class 028. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional toys and games, namely, golf balls, flying discs</p> <p>Class 030. First use: First Use: 2002/05/21 First Use In Commerce: 2002/05/21 Promotional food items, namely, candy</p>		

U.S. Registration No.	3006446	Application Date	07/09/2003
Registration Date	10/11/2005	Foreign Priority Date	NONE
Word Mark	WHERE VALUES THRIVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2003/12/00 First Use In Commerce: 2003/12/00 Insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and</p>		

	<p>consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations</p> <p>Class 041. First use: First Use: 2003/12/00 First Use In Commerce: 2003/12/00</p> <p>Education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars and videotapes</p>
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U.S. Registration No.	2995822	Application Date	07/09/2003
Registration Date	09/13/2005	Foreign Priority Date	NONE
Word Mark	HELPING YOU THRIVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00</p> <p>Insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations</p> <p>Class 041. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00</p> <p>Education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars and videotapes</p>		

U.S. Registration No.	3006447	Application Date	07/09/2003
Registration Date	10/11/2005	Foreign Priority Date	NONE
Word Mark	HELPING OTHERS THRIVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00</p> <p>Insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations</p> <p>Class 041. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00</p> <p>Education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars and videotapes</p>		

Attachments	76324049#TMSN.gif (1 page)(bytes) 76338285#TMSN.gif (1 page)(bytes) 8567-58331 Thrivent v. Credit Union.pdf (10 pages)(402604 bytes)
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Signature	/John E. Lyhus/
Name	John E. Lyhus
Date	06/21/2007

8567-58331

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

Thrivent Financial for Lutherans,)
)
 Opposer,)
 v.)
)
 Credit Union National Association, Inc.,)
)
 Applicant.)
)
 _____)
 Marks: THRIVE BY FIVE, Application No. 78/885,951)
 THRIVE BY 5, Application No. 78/885,984)

NOTICE OF OPPOSITION

Thrivent Financial for Lutherans, a Wisconsin Fraternal Benefit Society, located and doing business at 4321 North Ballard Road, Appleton, WI 54919 (hereinafter referred to as “Thrivent”) believes that it will be damaged by registration of the trademarks THRIVE BY FIVE, Application Serial No. 78/885,951, and THRIVE BY 5, Application Serial No. 78/885,984, by Credit Union National Association, Inc. and hereby opposes the same upon the following grounds:

COUNT I - LIKELIHOOD OF CONFUSION

1. In its Application Serial No. 78/885,951, Applicant is seeking registration on the Principal Register of the mark THRIVE BY FIVE for use in connection with “financial information provided by electronic means for use by young credit union members; financial information provided by electronic means for use by parents to teach their children about money matters” in International Class 36 and “education services, namely providing tutorial sessions and workshops featuring educational information in

the field of finance for use young credit union members; education service, namely, providing tutorial sessions and workshops featuring educational information for use by parents to educate their children about money matters” in International Class 41 which was published in the Official Gazette of January 2, 2007.

2. In its Application Serial No. 78/885,984, Applicant is seeking registration on the Principal Register of the mark THRIVE BY 5 for use in connection with “financial information provided by electronic means for use by young credit union members; financial information provided by electronic means for use by parents to teach their children about money matters” in International Class 36 and “education services, namely providing tutorial sessions and workshops featuring educational information in the field of finance for use young credit union members; education service, namely, providing tutorial sessions and workshops featuring educational information for use by parents to educate their children about money matters” in International Class 41 which was published in the Official Gazette of May 22, 2007.

3. Thrivent has used the trade name and mark THRIVENT in connection with a full range of financial, investment, money management, banking, insurance and estate planning goods and services beginning at least as early as May 21, 2002, and over the course of time, and long before the filing date of Applicant’s Application Nos. 78/885,951 and 78/884,984, has extensively used and expanded its use of the mark THRIVENT in commerce, of which as a result Thrivent owns Federal Trademark Registration No. 2815440 for its mark THRIVENT specifying “education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars,

and video tapes” in International Class 41; “computer software for personal financial planning and estate planning” in International Class 9; “insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations.” in International Class 36; and “information sheets, printed educational and teaching materials, books, and membership magazines for a fraternal benefits society, all in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters” in International Class 16.

4. Thrivent has used the trademark THRIVENT on and in connection with promotional items to promote its service and other offerings in the field of financial, investment, money management, banking, insurance and estate planning goods and services beginning at least as early as May 21, 2002, and over the course of time, and long before the filing date of Applicant’s Application Nos. 78/885,951 and 78/884,984, has extensively used and expanded the recognition and use of the mark THRIVENT, of which as a result Thrivent owns Federal Trademark Registration No. 2798598 for its mark THRIVENT specifying “promotional computer accessory items, namely, tape measures, decorative magnets” in International Class 9; “promotional items made of metal, namely, metal key holders” in International Class 6; “promotional items, namely, flashlights” in International Class 11; “promotional jewelry items, namely, jewelry,

watches, clocks, ornamental pins” in International Class 14; “promotional printed and stationery items, namely, pens, pencils, high-lighting markers, letter openers, paperweights, note pads, decals and stickers, calendars, paper napkins”; in International Class 16; “promotional items, namely attache cases, billfolds, business card cases, traveling bags, canvas tote bags, carry-all bags, umbrellas” in International Class 18; “promotional housewares and glass items, namely, mugs, beverage glassware, travel mugs, portable coolers, insulated can and bottle holder, plastic sports bottles sold empty, paper plates, paper cups” in International Class 21; “promotional textile items, namely, golf towels” in International Class 24; “promotional clothing items, namely, jackets, shirts, t-shirts, hats, sweatshirts, hats and visors” in International Class 25; “promotional toys and games, namely, golf balls, flying discs” in International Class 28; “promotional food items, namely, candy” in International Class 30; and “promotional items, namely, non-metal key holders” in International Class 20.

5. Thrivent has used the mark WHERE VALUES THRIVE in connection with a full range of financial, investment, money management, banking, insurance and estate planning goods and services beginning at least as early as December 2003, and over the course of time, and long before the filing date of Applicant’s Application Nos. 78/885,951 and 78/884,984, has extensively used and expanded its use of the mark WHERE VALUES THRIVE, of which as a result Thrivent owns Federal Trademark Registration No. 3006446 for its mark WHERE VALUES THRIVE specifying “insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary

grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations” in International Class 36; and “education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars and videotapes” in International Class 41.

6. Thrivent has used the mark HELPING YOU THRIVE in connection with a full range of financial, investment, money management, banking, insurance and estate planning goods and services beginning at least as early as January 2004, and over the course of time, and long before the filing date of Applicant’s Application Nos. 78/885,951 and 78/884,984, has extensively used and expanded its use of the mark HELPING YOU THRIVE, of which as a result Thrivent owns Federal Trademark Registration No. 2995822 for its mark HELPING YOU THRIVE specifying “insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations” in International Class 36; and “education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars and videotapes” in International Class 41.

7. Thrivent has used the mark HELPING OTHERS THRIVE in connection with a full range of financial, investment, money management, banking, insurance and estate planning goods and services beginning at least as early as January 2004, and over the course of time, and long before the filing date of Applicant's Application Nos. 78/885,951 and 78/884,984, has extensively used and expanded its use of the mark HELPING OTHERS THRIVE, of which as a result Thrivent owns Federal Trademark Registration No. 3006447 for its mark HELPING OTHERS THRIVE, wherein the services are specified as "insurance underwriting in the field of life, medical, long-term care, disability and annuities; insurance brokerage services; financial analysis and consultation services; insurance consultation services; investment management and consultation services; mutual fund investment services; banking services; providing educational scholarships and monetary grants to individuals; charitable fundraising services and providing grants to other organizations, institutions, communities, and church congregations" in International Class 36; and "education and training in the field of financial planning and management, investment planning, estate planning, insurance planning, tax planning, charitable planning, life and retirement planning, long-term care, fundraising, faith and family matters, offered through workshops, seminars and videotapes" in International Class 41.

8. Thrivent has incorporated the term "THRIVE" as a source identifying mark and prominent element of marks in connection with advertising, marketing and promotion for its full range of financial, investment, money management, banking, insurance and estate planning goods and services long before the filing date of Applicant's Application Nos. 78/885,951 and 78/884,984.

9. Thrivent has expended substantial monies in marketing, advertising, and promoting its aforesaid marks and building the goodwill of the aforesaid marks, including the term “THRIVE” as a source identifying mark, in connection with its specified goods and services in interstate commerce throughout the United States, and as a result of such efforts and expenditures, as well as the quality of its goods and services, Thrivent has enjoyed substantial revenue from the sale of its goods and services associated with these aforesaid marks.

10. Thrivent’s use of its aforesaid marks began long before Applicant can claim first use of its THRIVE BY FIVE or THRIVE BY 5 marks or can otherwise claim priority in the marks or its related Application Serial Nos. 78,995,951 and 78/885,984.

11. Applicant’s filing for registrations of the THRIVE BY FIVE and THRIVE BY 5 marks have been without the consent or permission of Thrivent.

12. On information and belief, Applicant’s intended adoption of its marks has been with actual or constructive knowledge of Thrivent’s prior use and registration of the aforesaid marks of Thrivent in connection with its goods and services.

13. On information and belief, the services for which Applicant seeks registration of its THRIVE BY FIVE and THRIVE BY 5 marks are identical, similar and related to the goods and services Thrivent provides in connection with its aforesaid marks and specified in Thrivent’s trademark registrations.

14. On information and belief, the Applicant’s services in connection with its marks are promoted to the same customers and in the same channels of trade as Thrivent in connection with the aforesaid marks of Thrivent.

15. Applicant’s THRIVE BY FIVE and THRIVE BY 5 marks are confusingly similar to the aforesaid marks of Thrivent in connection with the services as specified in

Application Serial Nos. 78/885,951 and 78,885,984 and are likely to cause confusion, mistake, or deception that Applicant's services are those of Thrivent or are otherwise endorsed, sponsored, or approved by Thrivent, whereby Thrivent will be damaged by the registration of Applicant's marks.

COUNT II - DILUTION

16. Paragraph nos. 1-15 are incorporated by reference herein.

17. As a result of long-standing use and continuous nationwide use, marketing, publicity, advertising, and promotion of its goods and services in connection with the aforesaid marks of Thrivent and the high quality of those goods and services, Thrivent possesses extremely valuable goodwill associated with its aforesaid marks.

18. The aforesaid marks of Thrivent are famous and distinctive within the meaning of the Lanham Act, and are entitled to the protection of the anti-dilution provisions of the Lanham Act, including 15 U.S.C. § 1125 (c).

19. The aforesaid marks of Thrivent are inherently distinctive.

20. The aforesaid marks of Thrivent are widely used and promoted by Thrivent and were so widely used and promoted before May 17, 2006 when Applicant filed applications for its THRIVE BY FIVE and THRIVE BY 5 marks.

21. On information and belief, the aforesaid marks of Thrivent are widely recognized by the public and among relevant consumers.

22. On information and belief, Applicant cannot claim use of or other priority in the marks THRIVE BY FIVE or THRIVE BY 5 until after the aforesaid marks of Thrivent became famous and distinctive.

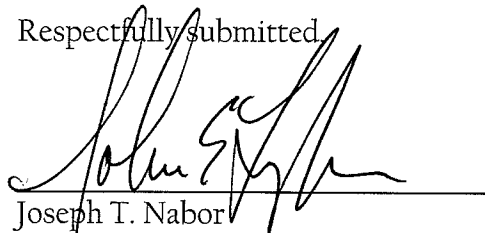
23. If Applicant is granted registration of its marks as shown in Application Serial Nos. 78/885,951 and 78/885,984, Applicant will thereby obtain the *prima facie* exclusive right to use such marks, and such registration will impair, diminish, and dilute

Thrivent's goodwill and rights in its aforesaid marks, causing irreparable injury to Thrivent.

REQUEST FOR RELIEF

WHEREFORE, Thrivent respectfully requests that Application Serial Nos. 78/885,951 and 78/885,984 be rejected and that registration of the mark THRIVE BY FIVE and THRIVE BY 5 for the services specified therein be refused.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John E. Lyhus", is written over a horizontal line.

Joseph T. Nabor
John E. Lyhus
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120 South LaSalle Street, Suite 1600
Chicago, IL 60603-3406
Telephone: 312.577.7000
Facsimile: 312.577.7007

Attorney for Opposer

June 21, 2007

CERTIFICATE OF OPPOSER'S ATTORNEYS

We hereby certify that we are trademark attorneys for Thrivent Financial for Lutherans herein, and that we have been instructed to file the foregoing Opposition. We are, therefore, filing this Opposition under Section 13 of the Trademark Act of 1946 and under Trademark Rule 2.101.

FITCH, EVEN, TABIN & FLANNERY

June 21, 2007

By: 

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Attorney for Opposer