

ESTTA Tracking number: **ESTTA246382**

Filing date: **11/03/2008**

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	White Mountains Re Services LLC
Granted to Date of previous extension	11/02/2008
Address	One Liberty Plaza 18th Floor New York, NY 10006 UNITED STATES

Attorney information	Diane Duhaime Jordan Burt LLP 175 Powder Forest Drive, Suite 301 Simsbury, CT 06089 UNITED STATES trademark@jordenusa.com Phone:860-392-5014
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**Applicant Information**

Application No	79044958	Publication date	05/06/2008
Opposition Filing Date	11/03/2008	Opposition Period Ends	11/02/2008
International Registration No.	0940250	International Registration Date	09/14/2007
Applicant	ersol Thin Film GmbH Sonnentor 2 99098 Erfurt GERMANY		

**Goods/Services Affected by Opposition**

Class 036. All goods and services in the class are opposed, namely: financial consultancy, financial consultancy in matters relating to savings and investment, investment consultancy; financing services, financial analysis, financial investment brokerage featuring mutual funds for the financing of solar electricity installations and solar power plants
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Application No.	77415130	Application Date	03/06/2008
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	WHITE MOUNTAINS RE SIRIUS		
Design Mark	WHITE MOUNTAINS RE SIRIUS		
Description of Mark	NONE		
Goods/Services	Class 036. First use: insurance and financial services, namely, insurance underwriting and reinsurance underwriting in the property, casualty, accident, aviation, fire, marine, health, life and medical insurance fields; all of the foregoing provided via the Internet, telephone, facsimile, e-mail or other means		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SIRIUS		
Goods/Services	financial and insurance services		

Attachments	77415130#TMSN.gif ( 1 page )( bytes ) Notice of Opposition.pdf ( 11 pages )(421972 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Diane Duhaime/
Name	Diane Duhaime
Date	11/03/2008

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted via the Electronic System for Trademark Trials and Appeals to the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office on November 3, 2008.

By: *Diane Duhaime*

Print or Type Name: Diane Duhaime

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

**In the matter of trademark application Serial Number:** 79044958  
**For the Mark:** SIRIUS  
**Filed:** September 14, 2007  
**Published in the Trademark  
Official Gazette on:** May 6, 2008

White Mountains Re Services LLC  
Opposer,

v.

ErSol Thin Film GmbH  
Applicant.

Opposition No. \_\_\_\_\_

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

**NOTICE OF OPPOSITION**

Opposer, White Mountains Re Services LLC, is a limited liability company organized under the laws of Delaware, located and doing business at One Liberty Plaza, 18th Floor, New York, NY 10006. Opposer believes that it will be damaged by the registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer has adopted the mark WHITE MOUNTAINS RE SIRIUS in association with insurance and financial services, namely, insurance underwriting and reinsurance underwriting in the property, casualty, accident, aviation, fire, marine, health, life and medical insurance fields. Please see Exhibit A which consists of a copy of the U.S. Patent and Trademark Office (“USPTO”) TESS and TARR record of Opposer’s application.
2. The SIRIUS element of the WHITE MOUNTAINS RE SIRIUS mark is used for, *inter alia*, financial and insurance services, and Opposer, a related company, licensee and/or predecessor in interest, has made continuous and exclusive use of the SIRIUS name and mark since at least as early as 1947.
3. Based on said continuous use of the SIRIUS mark since at least as early as 1947, and the considerable amount of monies spent promoting and using the SIRIUS mark, the SIRIUS mark has achieved widespread recognition and fame, and embodies the considerable goodwill of Opposer.
4. Opposer continues to make use of the SIRIUS element of the WHITE MOUNTAINS RE SIRIUS mark today throughout the United States.
5. The Trademark Act prohibits registration of a mark which so resembles a mark registered in the USPTO as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d); 15 U.S.C. § 1052(d); TMEP § 1207.
6. The issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. TMEP § 1207.01 citing *In re E.I. Du Pont Demours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

7. Applicant's mark, SIRIUS, is identical to the SIRIUS mark which has been in use for financial services since at least as early as 1947, and is similar to the mark WHITE MOUNTAINS RE SIRIUS.

8. Furthermore, there is a relatedness between the services in the application for Applicant's mark and the services provided by Opposer under its mark.

9. Applicant's use of the mark SIRIUS in connection with the subject services so resembles the SIRIUS mark and WHITE MOUNTAINS RE SIRIUS mark as to be likely to cause confusion, or to cause mistake, or to deceive.

10. Accordingly, pursuant to Section 2(d) of the Lanham Act, registration for the mark applied for under U.S. Application Serial No. 79044958 must be refused.

11. Opposer would be damaged by registration of the mark SIRIUS because, *inter alia*, pursuant to Section 2(d) of the Trademark Act, such registration would serve as a potential bar to registration of the WHITE MOUNTAINS RE SIRIUS mark and the SIRIUS mark.

12. Also, such registration would constitute *prima facie* evidence of Applicant's exclusive right to use the mark SIRIUS, which would be inconsistent with and harmful to the prior, established, and superior rights in the SIRIUS mark.

Please charge all applicable fees to Jordan Burt LLP Deposit Account Number 502252.

WHEREFORE, Opposer requests that no registration be issued in the matter of U.S. Serial No. 79044958, and that this opposition be sustained in favor of Opposer. Opposer requests that it be granted all such further relief as the Trademark Trial and Appeal Board deems just and appropriate.

Respectfully submitted,

White Mountains Re Services LLC

Dated: November 3, 2008



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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served upon the Opposer's counsel of record, Ullrich & Naumann, by mailing said copy on November 3, 2008, via First Class Mail International, postage prepaid to:

Patent- und Rechtsanwälte  
ULLRICH & NAUMANN  
Luisenstr. 14  
69115 Heidelberg  
FED REP GERMANY

A handwritten signature in cursive script, appearing to read "Diane Duhaime".

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Diane Duhaime, Esq.

## **Exhibit A**





United States Patent and Trademark Office

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Trademarks > Trademark Electronic Search System (TESS)

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Record 1 out of 1

TARR Status ASSIGN Status TDR TTAB Status ( Use the "Back" button of the Internet

Browser to return to TESS)

WHITE MOUNTAINS RE SIRIUS

**Word Mark** WHITE MOUNTAINS RE SIRIUS

**Goods and Services** IC 036. US 100 101 102. G & S: insurance and financial services, namely, insurance underwriting and reinsurance underwriting in the property, casualty, accident, aviation, fire, marine, health, life and medical insurance fields; all of the foregoing provided via the Internet, telephone, facsimile, e-mail or other means. USED IN ANOTHER FORM The mark was first used anywhere in a different form other than that sought to be registered on 03/06/1997.

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 77415130

**Filing Date** March 6, 2008

**Current Filing Basis** 1B

**Original Filing Basis** 1B

**Published for Opposition** August 26, 2008

**International Registration Number** 0959471

**Owner** (APPLICANT) White Mountains Re Services LLC LIMITED LIABILITY COMPANY DELAWARE 18th Floor One Liberty Plaza New York NEW YORK 10006

**Attorney of Record** Diane Duhaime

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "RE" APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG TOP HELP



Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-11-03 09:16:23 ET

Serial Number: 77415130 Assignment Information      Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

**WHITE MOUNTAINS RE SIRIUS**

(words only): WHITE MOUNTAINS RE SIRIUS

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2008-08-26

Filing Date: 2008-03-06

The Information will be/was published in the Official Gazette on 2008-08-26

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 108

Attorney Assigned:  
HACK ANDREA R

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-07-23

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. White Mountains Re Services LLC

**Address:**

White Mountains Re Services LLC  
18th Floor One Liberty Plaza  
New York, NY 10006  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** Delaware

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**GOODS AND/OR SERVICES**

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**International Class:** 036

**Class Status:** Active

insurance and financial services, namely, insurance underwriting and reinsurance underwriting in the property, casualty, accident, aviation, fire, marine, health, life and medical insurance fields; all of the foregoing provided via the Internet, telephone, facsimile, e-mail or other means

**Basis:** 1(b)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**Used Anywhere in Another Form:** The mark was first used anywhere in a different form other than that sought to be registered on 03/06/1997.

**Used in Commerce in Another Form:** The mark was first used in commerce in a different form other than that sought to be registered on 03/06/1997.

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### ADDITIONAL INFORMATION

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**Disclaimer:** "RE"

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### MADRID PROTOCOL INFORMATION

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**USPTO Reference Number:** A0011952

**International Registration Number:** 0959471

**International Registration Date:** 2008-04-03

**Original Filing Date with USPTO:** 2008-04-03

**International Registration Status:** Application For IR Registered By IB

**Date of International Registration Status:** 2008-05-08

**International Registration Renewal Date:** 2018-04-03

**Irregularity Reply by Date:** (DATE NOT AVAILABLE)

**Madrid History:**

05-08-2008 - 14:48:11 - Application For IR Registered By IB

04-04-2008 - 21:00:44 - IR Certified And Sent To IB

04-04-2008 - 09:02:36 - Manually Certified

04-03-2008 - 14:47:00 - New Application For IR Received

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### PROSECUTION HISTORY

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-08-26 - Published for opposition

2008-08-13 - FAX RECEIVED

2008-08-13 - FAX RECEIVED

2008-08-06 - Notice of publication

2008-07-23 - Law Office Publication Review Completed

2008-07-23 - Approved for Pub - Principal Register (Initial exam)  
2008-07-16 - Amendment From Applicant Entered  
2008-07-16 - Communication received from applicant  
2008-07-16 - Assigned To LIE  
2008-07-14 - PAPER RECEIVED  
2008-05-28 - Notification Of Non-Final Action E-Mailed  
2008-05-28 - Non-final action e-mailed  
2008-05-28 - Non-Final Action Written  
2008-05-27 - Assigned To Examiner  
2008-03-11 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Diane Duhaime

**Correspondent**

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