

ESTTA Tracking number: **ESTTA387179**

Filing date: **01/07/2011**

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	ARIEL INVESTMENTS, LLC
Granted to Date of previous extension	01/09/2011
Address	200 E. Randolph Drive, Suite 2900 Chicago, IL 60601 UNITED STATES
Attorney information	Luke W. DeMarte Michael Best & Friedrich LLP 180 N. Stetson, Suite 2000 Chicago, IL 60601 UNITED STATES lwdemarte@michaelbest.com, chiipdocket@michaelbest.com Phone:312.222.5795

Applicant Information

Application No	76690467	Publication date	07/13/2010
Opposition Filing Date	01/07/2011	Opposition Period Ends	01/09/2011
International Registration No.	NONE	International Registration Date	NONE
Applicant	Morneau Sobeco Limited Partnership 895 Don Mills Road, No. 700 Toronto, Ontario, M3C 1W3 CANADA		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 2006/12/31 First Use In Commerce: 2006/12/31 All goods and services in the class are opposed, namely: (Based on Use in Commerce) and (Based on 44(e)) SOFTWARE PRE-RECORDED ON CD-ROMS FOR MANAGING AND ADMINISTERING EMPLOYEE BENEFITS, INCLUDING PENSION, SAVINGS, AND BENEFITS PLANS, COMPENSATION AND HUMAN RESOURCES PROGRAMS AND INSTRUCTIONAL MANUALS SOLD AS A UNIT</p>
<p>Class 016. All goods and services in the class are opposed, namely: (Based on 44(e)) PRINTED COMPUTER MANUALS AND INSTRUCTIONAL MATERIALS FOR SOFTWARE WHICH MANAGES AND ADMINISTERS EMPLOYEE BENEFITS, PENSIONS, SAVINGS AND BENEFITS PLANS, COMPENSATION AND HUMAN RESOURCES PROGRAMS</p>
<p>Class 042. First Use: 2006/12/31 First Use In Commerce: 2006/12/31 All goods and services in the class are opposed, namely: (Based on Use in Commerce) and (Based on 44(e)) INSTALLATION, CUSTOMIZATION, MAINTENANCE AND IMPLEMENTATION OF</p>


SOFTWARE FOR MANAGING AND ADMINISTERING EMPLOYEE BENEFITS, INCLUDING PENSION, SAVINGS AND BENEFITS PLANS, COMPENSATION AND HUMAN RESOURCES PROGRAMS; COMPUTER SOFTWARE CONSULTATION AND TECHNICAL SUPPORT SERVICES, NAMELY, TROUBLESHOOTING OF COMPUTER SOFTWARE PROBLEMS IN THE FIELD OF SOFTWARE FOR EMPLOYEE BENEFITS, PENSION, SAVINGS AND BENEFITS PLANS, COMPENSATION AND HUMAN RESOURCES PROGRAMS; PROVIDING TEMPORARY USE OF NON-DOWNLOADABLE COMPUTER SOFTWARE FOR MANAGING AND ADMINISTERING EMPLOYEE BENEFITS, PENSION, SAVINGS AND BENEFITS PLANS, COMPENSATION AND HUMAN RESOURCES PROGRAMS

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. Registration No.	1286420	Application Date	06/20/1983
Registration Date	07/17/1984	Foreign Priority Date	NONE
Word Mark	ARIEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1983/01/10 First Use In Commerce: 1983/03/23 Management of Investments and Investment Funds		

U.S. Registration No.	2772978	Application Date	03/21/2001
Registration Date	10/14/2003	Foreign Priority Date	NONE
Word Mark	ARIEL APPRECIATION FUND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1989/12/01 First Use In Commerce: 1989/12/01 MUTUAL FUND ADVISORY AND MANAGEMENT SERVICES, MUTUAL FUND BROKERAGE SERVICES, AND MUTUAL FUND DISTRIBUTION SERVICES		

U.S. Registration No.	2772980	Application Date	03/21/2001
Registration Date	10/14/2003	Foreign Priority Date	NONE
Word Mark	ARIEL FUND		

Design Mark	ARIEL FUND		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1986/11/06 First Use In Commerce: 1986/11/06 MUTUAL FUND ADVISORY AND MANAGEMENT SERVICES, MUTUAL FUND BROKERAGE SERVICES, AND MUTUAL FUND DISTRIBUTION SERVICES		

U.S. Registration No.	3506141	Application Date	06/19/2007
Registration Date	09/23/2008	Foreign Priority Date	NONE

Word Mark	ARIEL INVESTMENTS		
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Design Mark	ARIEL INVESTMENTS		
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Description of Mark	NONE		
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Goods/Services	Class 016. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Printed publications, namely, reports, educational materials, newsletters, pamphlets and periodicals featuring investment news and commentary Class 036. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Investment advisory services; investment management; mutual fund brokerage, distribution and investment; financial sponsorship of cultural and performing arts events; providing on-line information in the field of investments		
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U.S. Registration No.	3657317	Application Date	12/30/2008
Registration Date	07/21/2009	Foreign Priority Date	NONE

Word Mark	ARIEL FOCUS FUND		
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Design Mark	ARIEL FOCUS FUND		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2005/06/30 First Use In Commerce: 2005/06/30 mutual fund advisory and management services, mutual fund brokerage services, and mutual fund distribution services		

U.S. Registration No.	3897717	Application Date	03/05/2009
Registration Date	12/28/2010	Foreign Priority Date	NONE
Word Mark	ARIEL'S ABCS OF MONEY		
Design Mark	ARIEL'S ABCS OF MONEY		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2009/04/15 First Use In Commerce: 2009/04/15 online information in the fields of investments and personal financial matters		

U.S. Registration No.	2851056	Application Date	07/31/2003
Registration Date	06/08/2004	Foreign Priority Date	NONE
Word Mark	ARIEL PREMIER GROWTH FUND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/02/01 First Use In Commerce: 2002/02/01 mutual fund advisory and management services, mutual fund brokerage services, and mutual fund distribution services		

Attachments	76228019#TMSN.gif (1 page)(bytes) 76228021#TMSN.gif (1 page)(bytes) 77209986#TMSN.jpeg (1 page)(bytes) 77641499#TMSN.jpeg (1 page)(bytes) 77683963#TMSN.jpeg (1 page)(bytes) Ariel opposition.pdf (14 pages)(328765 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	/Luke W. DeMarte/
Name	Luke W. DeMarte
Date	01/07/2011

CERTIFICATE OF TRANSMISSION

I hereby certify that this Notice of Opposition is being transmitted by the Electronic System for Trademark Trials and Appeals to the United States Patent and Trademark Office on January 7, 2011.



Gina A. Bilotto

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

In the Matter of Trademark Applicant:)
)
Morneau Sobeco Limited Partnership)
)
Serial No. : 76/690467)
)
Filed : June 11, 2006)
)
)
Mark: **ARIEL**)

Published in the Official Gazette dated July 13, 2010

Ariel Investments, LLC,)
)
Opposer,)
)
v.) Opp. No.
)
Morneau Sobeco Limited Partnership,)
)
Applicant.)

NOTICE OF OPPOSITION

Ariel Investments, LLC, a Delaware limited liability company (“Opposer”), believes that it will be damaged by the registration by Morneau Sobeco Limited Partnership (“Applicant”) of the mark ARIEL (stylized), shown in Serial No. 76/690467, for “software pre-recorded on cd-

roms for managing and administering employee benefits, including pension, savings, and benefits plans, compensation and human resources programs and instructional manuals sold as a unit” in International Class 9; “printed computer manuals and instructional materials for software which manages and administers employee benefits, pensions, savings and benefits plans, compensation and human resources programs” in International Class 16; and “installation, customization, maintenance and implementation of software for managing and administering employee benefits, including pension, savings and benefits plans, compensation and human resources programs; computer software consultation and technical support services, namely, troubleshooting of computer software problems in the field of software for employee benefits, pension, savings and benefits plans, compensation and human resources programs; providing temporary use of non-downloadable computer software for managing and administering employee benefits, pension, savings and benefits plans, compensation and human resources programs” in International Class 42 (the “Opposed Application”), and hereby opposes said registration.

The grounds for opposition are as follows:

1. On information and belief, Applicant is a Canadian corporation with an address at 895 Don Mills Road, No. 700, Toronto, Ontario, M3C 1WC, Canada.
2. On July 13, 2010, the Opposed Application was published in the Official Gazette of the United States Patent and Trademark Office. Thereafter, Opposer sought and obtained extensions of time to file this Notice of Opposition.
3. Since at least as early as 1983, Opposer has, at great expense, offered a variety of financial services and related goods and services under the mark ARIEL and other marks which include the term ARIEL (collectively, the “ARIEL Marks”). Opposer has, at great expense,

extensively and continuously offered to the public high quality goods and services under its ARIEL Marks. By reason of its efforts, and the expenditure of considerable sums for extensive promotion, and by virtue of the excellence of its goods and services offered under the ARIEL Marks, the public and trade have come to recognize the ARIEL Marks as signifying Opposer and its goods and services, and Opposer has built up exceedingly valuable goodwill in connection with its goods and services offered under its ARIEL Marks.

4. Opposer is the owner of the U.S. trademark registrations set forth below, copies of which are attached as Exhibit A:

<u>Mark</u>	<u>Registration No.</u>	<u>Goods and Services</u>
ARIEL	1286420	Management of investments and investment funds (Class 36)
ARIEL APPRECIATION FUND	2772978	Mutual fund advisory and management services, mutual fund brokerage services, and mutual fund distribution services (Class 36)
ARIEL FUND	2772980	Mutual fund advisory and management services, mutual fund brokerage services, and mutual fund distribution services (Class 36)
ARIEL INVESTMENTS	3506141	Printed publications, namely, reports, educational materials, newsletters, pamphlets and periodicals featuring investment news and commentary (Class 16) Investment advisory services; investment management; mutual fund brokerage, distribution and investment; financial sponsorship of cultural and performing arts events; providing on-line information in the field of investments (Class 36)
ARIEL FOCUS FUND	3657317	Mutual fund advisory and management services, mutual fund brokerage services, and mutual fund distribution services (Class 36)
ARIEL'S ABCS OF MONEY	3897717	Online information in the fields of investments and personal financial matters (Class 36)

<u>Mark</u>	<u>Registration No.</u>	<u>Goods and Services</u>
ARIEL PREMIER GROWTH FUND	2851056	Mutual fund advisory and management services, mutual fund brokerage services, and mutual fund distribution services (Class 36)

5. The mark set forth in the Opposed Application is confusingly similar to Opposer's ARIEL Marks.

6. The goods set forth in the Opposed Application are highly related to the goods and services provided by Opposer under its ARIEL Marks.

7. Opposer's use of the ARIEL Marks predates the filing date of the Opposed Application.

8. The filing dates of Opposer's Registration Nos. 1286420, 2772978, 2772980, 3506141, 2851056 predate the filing date of the Opposed Application.

9. Opposer's rights in the ARIEL Marks predate Applicant's use (if any) in United States commerce of the mark shown in the Opposed Application.

10. If Applicant is permitted to use and register the mark set forth in the Opposed Application, such registration and use by Applicant are likely to cause confusion, deception and mistake, and will seriously damage Opposer. Persons familiar with the ARIEL Marks would be likely to buy Applicant's goods and services as and for goods and services made and sold by Opposer. Any such confusion would result in loss of sales to Opposer. Furthermore, any defect or fault found with Applicant's goods or services marketed under the ARIEL mark shown in the Opposed Application would reflect upon and seriously injure the reputation which has been established for the goods and services provided under Opposer's ARIEL Marks.


11. If Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use the mark set forth in the Opposed Application. Such registration by Applicant would be a source of irreparable damage and injury to Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Applicant's application, Serial No. 76/690467, be denied and refused.

Dated: January 7, 2011

Respectfully submitted,

Ariel Investments, LLC

By: 
One of its Attorneys

Luke W. DeMarte
Jeffrey H. Brown
Michael Best & Friedrich LLP
Two Prudential Plaza
180 N. Stetson Ave., Suite 2000
Chicago, Illinois 60601
(312) 222-0800

Attorneys for Ariel Investments, LLC

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EXHIBIT A

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,286,420

Registered Jul. 17, 1984

SERVICE MARK
Principal Register

ARIEL

Ariel Capital Management, Inc. (Illinois corporation)
Suite 2014
307 N. Michigan Ave.
Chicago, Ill. 60601

For: **MANAGEMENT OF INVESTMENTS
AND INVESTMENT FUNDS**, in **CLASS 36 (U.S.
Cl. 102)**.

First use Jan. 10, 1983; in commerce Mar. 23, 1983.

Ser. No. 431,218, filed Jun. 20, 1983.

RUSS HERMAN, Examining Attorney

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,772,978

Registered Oct. 14, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

ARIEL APPRECIATION FUND

ARIEL CAPITAL MANAGEMENT, INC. (ILLINOIS CORPORATION)
200 E. RANDOLPH DRIVE
SUITE 2900
CHICAGO, IL 60601 , BY ASSIGNMENT ARIEL
GROWTH FUND (MASSACHUSETTS BUSINESS
TRUST), DBA ARIEL INVESTMENT TRUST CHI-
CAGO, IL 60601

FOR: MUTUAL FUND ADVISORY AND MAN-
AGEMENT SERVICES, MUTUAL FUND BROKER-
AGE SERVICES, AND MUTUAL FUND
DISTRIBUTION SERVICES, IN CLASS 36 (U.S. CLS.
100, 101 AND 102).

FIRST USE 12-1-1989; IN COMMERCE 12-1-1989.

OWNER OF U.S. REG. NO. 1,286,420.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "APPRECIATION FUND", APART
FROM THE MARK AS SHOWN.

SER. NO. 76-228,019, FILED 3-21-2001.

BRENDAN REGAN, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,772,980

Registered Oct. 14, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

ARIEL FUND

ARIEL CAPITAL MANAGEMENT, INC. (ILLINOIS CORPORATION)
200 E. RANDOLPH DRIVE
SUITE 2900
CHICAGO, IL 60601 , BY ASSIGNMENT ARIEL GROWTH FUND (MASSACHUSETTS BUSINESS TRUST), DBA ARIEL INVESTMENT TRUST CHICAGO, IL 60601

FOR: MUTUAL FUND ADVISORY AND MANAGEMENT SERVICES, MUTUAL FUND BROKERAGE SERVICES, AND MUTUAL FUND DISTRIBUTION SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 11-6-1986; IN COMMERCE 11-6-1986.

OWNER OF U.S. REG. NO. 1,286,420.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FUND", APART FROM THE MARK AS SHOWN.

SER. NO. 76-228,021, FILED 3-21-2001.

BRENDAN REGAN, EXAMINING ATTORNEY

Int. Cls.: 16 and 36

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 50, 100, 101, and 102

Reg. No. 3,506,141

United States Patent and Trademark Office

Registered Sep. 23, 2008

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

ARIEL INVESTMENTS

ARIEL INVESTMENTS, LLC (DELAWARE LIMITED LIABILITY COMPANY)
200 E. RANDOLPH DRIVE
SUITE 2900
CHICAGO, IL 60601

FOR: PRINTED PUBLICATIONS, NAMELY, REPORTS, EDUCATIONAL MATERIALS, NEWSLETTERS, PAMPHLETS AND PERIODICALS FEATURING INVESTMENT NEWS AND COMMENTARY, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 4-30-2008; IN COMMERCE 4-30-2008.

FOR: INVESTMENT ADVISORY SERVICES; INVESTMENT MANAGEMENT; MUTUAL FUND BROKERAGE, DISTRIBUTION AND INVESTMENT; FINANCIAL SPONSORSHIP OF CULTURAL AND PERFORMING ARTS EVENTS; PROVIDING ON-LINE INFORMATION IN THE FIELD OF IN-

VESTMENTS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 4-30-2008; IN COMMERCE 4-30-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,286,420, 2,772,980, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INVESTMENTS", APART FROM THE MARK AS SHOWN.

SN 77-209,986, FILED 6-19-2007.

IRA J. GOODSaid, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,657,317

Registered July 21, 2009

**SERVICE MARK
PRINCIPAL REGISTER**

ARIEL FOCUS FUND

ARIEL INVESTMENTS, LLC (DELAWARE LIMITED LIABILITY COMPANY)

200 E. RANDOLPH DRIVE, SUITE 2900

CHICAGO, IL 60601

FOR: MUTUAL FUND ADVISORY AND MANAGEMENT SERVICES, MUTUAL FUND BROKERAGE SERVICES, AND MUTUAL FUND DISTRIBUTION SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 6-30-2005; IN COMMERCE 6-30-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,772,978, 2,851,056 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FOCUS FUND", APART FROM THE MARK AS SHOWN.

SER. NO. 77-641,499, FILED 12-30-2008.

DAVID HOFFMAN, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

ARIEL'S ABCS OF MONEY

Reg. No. 3,897,717

ARIEL INVESTMENTS, LLC (DELAWARE LIMITED LIABILITY COMPANY)
200 E. RANDOLPH STREET, SUITE 2900
CHICAGO, IL 60601

Registered Dec. 28, 2010

Int. Cl.: 36

FOR: ONLINE INFORMATION IN THE FIELDS OF INVESTMENTS AND PERSONAL FINANCIAL MATTERS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK

FIRST USE 4-15-2009; IN COMMERCE 4-15-2009.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,286,420, 3,506,141, AND OTHERS.

SN 77-683,963, FILED 3-5-2009.

BRIDGETT SMITH, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,851,056

Registered June 8, 2004

**SERVICE MARK
PRINCIPAL REGISTER**

ARIEL PREMIER GROWTH FUND

ARIEL CAPITAL MANAGEMENT, INC. (ILLINOIS CORPORATION)
200 E. RANDOLPH DRIVE, STE. 2900
CHICAGO, IL 60601

FOR: MUTUAL FUND ADVISORY AND MANAGEMENT SERVICES, MUTUAL FUND BROKERAGE SERVICES, AND MUTUAL FUND DISTRIBUTION SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-1-2002; IN COMMERCE 2-1-2002.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PREMIER GROWTH FUND", APART FROM THE MARK AS SHOWN.

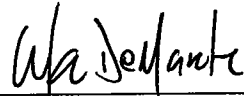
SER. NO. 78-281,643, FILED 7-31-2003.

BRETT J. GOLDEN, EXAMINING ATTORNEY

CERTIFICATE OF SERVICE

The undersigned certifies that a true and complete copy of the foregoing Notice of Opposition has been served upon Applicant by mailing said copy on January 7, 2011 via first class mail, postage prepaid, to:

Carl S. Clark
Price Heneveld Cooper Dewitt & Litton
PO BOX 2567
Grand Rapids, MI 49501-2567



Luke W. DeMarte