

ESTTA Tracking number: **ESTTA408467**

Filing date: **05/11/2011**

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	Content Guru Limited
Granted to Date of previous extension	05/11/2011
Address	The Redwood Building, Broad Lane Bracknell Berkshire, RG12 9GU UNITED KINGDOM

Attorney information	Sean Ploen Ploen Law Firm, PC 100 SOUTH FIFTH STREET, STE. 1900 Minneapolis, MN 55402 UNITED STATES sploen@ploen.com Phone:651-894-6803
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Applicant Information

Application No	85094265	Publication date	01/11/2011
Opposition Filing Date	05/11/2011	Opposition Period Ends	05/11/2011
Applicant	Banks III, Joseph 181 Green Bridge Ct. Lawrenceville, GA 30046 UNITED STATES		

Goods/Services Affected by Opposition


Class 009. All goods and services in the class are opposed, namely: Computer programs and computer software for electronically trading securities
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77544841	Application Date	08/12/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	STORM		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: Computer hardware, middleware and software to enable the hosting and management of telecommunications services; computer software for telecommunications hosting and management systems; multiple caller processing and management software and systems, namely, computer software and hardware for managing and controlling call centre operations; customer relations management software and systems, namely, computer software and hardware for managing and controlling call centre operations; interactive voice response systems comprising computer hardware and operating and applications software for fixed and mobile communications; computerised telephony software; computer software and telecommunications apparatus to enable connection to databases and the Internet, namely, telecommunications exchange software and hardware</p> <p>Class 038. First use: Telecommunications services, namely, transmission of webcasts and TV broadcasts; telecommunications gateway services, namely, provision of telecommunication links to TV and media entertainment broadcasts and internet broadcasts; network communication services, namely, transmission of voice, audio, and visual images and data by telecommunications networks, the Internet, information services networks and data networks; providing telecommunications and communications connections to multiple caller processing software and systems, multiple caller management software and systems, and customer relations management software and systems; hosting and management of telecommunications services, namely, call forwarding services; provision of unified electronic messaging services, audio conferencing and facsimile transmission</p>

Attachments	77544841#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (6 pages)(24993 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	/Sean Ploen/
Name	Sean Ploen
Date	05/11/2011

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

In the Matter of Application Serial No.: 85/094,265
Mark: THE PERFECT STORM
Published for Opposition in the *Official Gazette*: January 11, 2011

CONTENT GURU LIMITED)	
)	
Opposer)	
)	
v.)	OPPOSITION NO. _____
)	
JOSEPH BANKS III,)	
)	
Applicant)	
)	

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

NOTICE OF OPPOSITION

Content Guru Limited (“Opposer”) is a corporation duly organized and existing under the laws of the United Kingdom, having a principal place of business at The Redwood Building, Broad Lane, Bracknell, Berkshire, RG12 9GU, United Kingdom.

Opposer believes it will be damaged by registration of the trademark THE PERFECT STORM as shown in application serial number 85/094,265 (the “Opposed Application”) filed in the U.S. Patent and Trademark Office by Joseph Banks III (“Applicant”) on July 27, 2010, and Opposer hereby opposes registration of that trademark.

The grounds of opposition are as follows:

1. Opposer possesses broad, substantial and longstanding rights in the trademark STORM, which it has protected, used, and continues to use in connection with a variety of goods and services.

2. Opposer owns all right, title and interest to U.S. trademark application serial no. 77/544,841 for the mark STORM (“Opposer’s Application”), filed August 12, 2008 for use in connection with the following goods and services:

- *In Int’l. Class 9:* Computer hardware, middleware and software to enable the hosting and management of telecommunications services; computer software for telecommunications hosting and management systems; multiple caller processing and management software and systems, namely, computer software and hardware for managing and controlling call centre operations; customer relations management software and systems, namely, computer software and hardware for managing and controlling call centre operations; interactive voice response systems comprising computer hardware and operating and applications software for fixed and mobile communications; computerised telephony software; computer software and telecommunications apparatus to enable connection to databases and the Internet, namely, telecommunications exchange software and hardware; *and*
- *In Int’l. Class 38:* Telecommunications services, namely, transmission of webcasts and TV broadcasts; telecommunications gateway services, namely, provision of telecommunication links to TV and media entertainment broadcasts and internet broadcasts; network communication services, namely, transmission of voice, audio, and visual images and data by telecommunications networks, the Internet, information services networks and data networks; providing telecommunications and communications

connections to multiple caller processing software and systems, multiple caller management software and systems, and customer relations management software and systems; hosting and management of telecommunications services, namely, call forwarding services; provision of unified electronic messaging services, audio conferencing and facsimile transmission.

3. Opposer's Application bestows upon Opposer a constructive date of first use in commerce in the United States which is nearly two years earlier than Applicant's own constructive date of first use arising out of the Opposed Application.

4. Opposer also possesses trademark rights in the STORM mark in other jurisdictions; for instance, Opposer owns all right, title and interest in European Community trademark registration no. 5,675,236 issued on July 14, 2009 by the Office for Harmonization in the Internal Market for the mark STORM for use in connection with goods and services similar to those claimed in Opposer's U.S. application.

5. Opposer uses its STORM trademark in connection with the goods and services listed above, which have several financial components, including a secure hosted automated payment system, payment collection and processing services, invoice processing and reconciliation services, and cost-allocation and financial reporting features.

6. As a result of its extensive use of the STORM trademark, Opposer has built up valuable goodwill in that mark, and said goodwill has become closely and uniquely identified and associated with Opposer.

7. On July 27, 2010, Applicant filed the Opposed Application based upon an intent to use, claiming protection for "Computer programs and computer software for electronically trading securities," in International Class 9.

8. Upon information and belief, Applicant did not use the THE PERFECT STORM trademark in United States commerce for the goods covered in the Opposed Application prior to its filing date of July 27, 2010.

9. The goods claimed in the Opposed Application are identical and/or closely related to the goods offered and the services provided in connection with Opposer's STORM trademark.

10. Applicant's THE PERFECT STORM mark so resembles Opposer's STORM mark as to be likely, when used in connection with Applicant's claimed goods, to cause confusion, to cause mistake, and to deceive the trade and public, members of whom are likely to believe that Applicant's goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer therefore would be injured by the granting to Applicant of a certificate of registration for Applicant's mark.

11. Opposer would be further injured by the granting of a certificate of registration to Applicant because Applicant's THE PERFECT STORM mark, which is a close approximation of Opposer's STORM mark, when used in connection with Applicant's applied-for goods would falsely suggest a connection between Applicant and Opposer, which has granted no authorization to Applicant and which has no connection with Applicant.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's trademark and requests that this opposition be sustained and said registration be denied.

Respectfully submitted,

PLOEN LAW FIRM, PC
Attorneys for Opposer

Date: May 11, 2011

By: /Sean Ploen/
Sean Ploen

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Certificate of Service

The undersigned hereby certifies that he has this day served a true and correct copy of this Notice of Opposition, along with any exhibits thereto, upon the Applicant (who is listed as the correspondent for the opposed application), by mailing the same via First Class mail, postage paid, to:

Joseph Banks III
181 Green Bridge Ct.
Lawrenceville, GA 30046-9473

SIGNED under the pains and penalties of perjury.

Dated: May 11, 2011

/Sean Ploen/
Sean Ploen