

ESTTA Tracking number: **ESTTA535400**

Filing date: **05/01/2013**

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	GregoryALewis
Granted to Date of previous extension	05/01/2013
Address	189 Bridge StreetApt. 10B Brooklyn, NY 11201 UNITED STATES

Attorney information	Jeffrey Sonnabend SonnabendLaw 600 Prospect Avenue Brooklyn, NY 11215 UNITED STATES jsonnabend@sonnabendlaw.com Phone:718-832-8810
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Applicant Information

Application No	85730110	Publication date	01/01/2013
Opposition Filing Date	05/01/2013	Opposition Period Ends	05/01/2013
Applicant	Kingsley Ventures Corporation 309 N Huber Dr Casper, WY 82609 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2004/06/01 First Use In Commerce: 2004/06/01 All goods and services in the class are opposed, namely: Financial analysis and research services; Financial consultancy; Financial forecasting; Financial information; Financial risk management; Global investment research services
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Lack of use in commerce; Lack of Use in Commerce # Specimen Not in Agreement with Drawing

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85680188	Application Date	07/18/2012
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BRITANNICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2011/12/19 First Use In Commerce: 2011/12/19 Investment Services for Domestic and International Exchange Traded Funds; Electronically Traded Funds Analysis and Services; Financial Asset Management Assistance and Advising Services; Junk Bond and Private Equity Investment Procurement Services; Raising Seed and Development Capital for Accredited Investors and Entities; Advising on Securities Hedging and Insurance; Futures and Currency Indexing Services; Debt Security Services; Financial Services, namely Operation and Management of Individual Retirement Accounts, Hedge Funds, Options, Investment Pools and other Investment Vehicles; Corporate Equity Advising and Services; Advising on Real Estate Investment Trusts; Advising on Networking Opportunities Amongst Investor Groups; Capital Investment Services; Providing Sourced Macro Updates on Social, Geo-Political and Economic Trends and Indicators; Exempt Investment Procurement; Master Limited Partnership and High-Dividend Yield Procurement and Advice; Venture Capital and Angel Investment Facilitation in		

Related Proceedings	91/207552 91/209887 91/210104 91/210136
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Attachments	Lewis Notice of Opposition (BRITANNICA with logo) [2013-05-01].pdf (11 pages)(125446 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	/JS/
Name	Jeffrey Sonnabend
Date	05/01/2013

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

In the matter of trademark application Serial No. 85/730110
For the mark BRITANNICA and illustration

Gregory A. Lewis,

Opposer,

Opposition No.:

v.

Kingsley Ventures Corporation,

Applicant.

NOTICE OF OPPOSITION

Opposer believes that he will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same on the following grounds.

1. Opposer provides investment consulting and management services.
2. No later than December, 2011, Opposer began licensing and other preparatory actions necessary for providing such services under the mark BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL.
3. Among other preparation, Opposer contacted the Financial Industry Regulatory Authority (“FINRA”), the largest independent regulator for all securities firms doing business in the United States. As part of the registration process with FINRA, Opposer requested on January 24, 2012, that FINRA check the availability of and if available reserve the name BRITANNICA CAPITAL PARTNERS LLC.

4. On February 9, 2012, FINRA Registration & Disclosure Manager Damian Williams wrote to Opposer confirming that the name BRITANNICA CAPITAL PARTNERS LLC was available for registration with FINRA (i.e., no other firm was registered with FINRA having a confusingly similar name), and the name would be reserved for 120 days by FINRA.

5. Opposer understands that FINRA has responsibility for certifying and registering every financial services firm in the United States, and therefore has record of the name if every such firm. As a result, by confirming the availability of the name BRITANNICA CAPITAL PARTNERS LLC, FINRA was necessarily confirming that Applicant was not operating under that name in the United States at that time.

6. In the December, 2011 and early 2012 time period, Opposer had conversations with prior clients (i.e., clients of Opposer from previous engagements) in which Opposer informed the clients that Opposer would be providing investment related services under the mark BRITANNICA in the near future, once all regulatory compliance had been completed.

7. In the December 2011 and early 2012, Opposer enlisted the services of Luxor Financial Group (“Luxor”) to assist Opposer in meeting Opposer’s regulatory compliance requirements. In connection with this effort, Opposer disclosed to Luxor Opposer’s intention to use the mark BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL in connection with Opposer’s services. Luxor undertook to provide services to Opposer to establish Opposer’s business under that name.

8. On or about March 28, 2012, Opposer established BRITANNICA CAPITAL PARTNERS, LLC and BRITANNICA HOLDINGS, LLC as New York State limited liability companies.

9. Shortly after forming the above mentioned LLC's, Opposer entered into a lease for office space under the name BRITANNICA CAPITAL PARTNERS, LLC.

10. Opposer has applied for registration of the mark BRITANNICA in application serial no. 85/680188.

11. The registration process through FINRA (and accordingly through the SEC) under the name BRITANNICA CAPITAL PARTNERS, LLC and/or BRITANNICA CAPITAL, has continued to date, and Opposer anticipates final approval and registration by late October or early November of this year.

12. Based in part upon Opposer's review of the FINRA registration process and the timing and nature of Applicant's activities detailed below, Opposer understands that Applicant learned of Opposer's 2011 and early 2012 efforts to establish a financial services business under the marks BRITANNICA, BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL and has undertaken to frustrate Opposer's ability to use and register those marks.

13. Applicant filed the present application for registration of the mark BRITANNICA with illustration on July 8, 2012. The application alleged a date of first use in commerce no later than June 1, 2004.

14. Applicant is owner of copending application 85/540559 for the mark BRITANNICA.

15. Both the present application and application 85/540559 include the literal BRITANNICA and no other literal element. Both the present application and application 85/540559 are for financial and investment related services.

16. Application filed application 85/540559 on February 12, 2012, claiming a date of first use of February 12, 2012, the same day as that application's filing.

17. The entirety of the mark of application 85/540559 is contained in the present application; that is, the literal element of the present application is identical to and co-extensive with the entire mark applied-for in application 85/540559. Thus, based on this identity of literal elements and substantive identity of the claimed services of each application, the date of first use of application 85/540559, the date of first use of the instant application and application 85/540559 must be the same.

18. According to whois records, Applicant obtained the domain <britannicapital.com> on February 24, 2012. At some time thereafter, Applicant began operating a website at <britannicapital.com> advertising and promoting investment related services.

19. Applicant's website states that "Britannica is an investment advisory firm founded in 2012." Applicant's website bears a copyright notice of 2012.

20. On September 7, 2012, an attorney for Applicant wrote to Opposer demanding that Opposer cease use of the mark BRITANNICA and that Opposer abandon his pending application for registration of that mark. In that letter, the attorney for Applicant represented that

Applicant “began using the trademark BRITANNICA at least as early as 2004 in the United States.”

21. Subsequent to the September 7, 2012 letter, Opposer’s attorney responded to the Opposer’s attorney requesting (a) explanation for the discrepancy between the date of first use stated in the letter and the claims made on Applicant’s website regarding date of formation; (b) explanation for the discrepancy between the date of first use stated in the letter and the date of registration of the domain <britannicapital.com>; (c) explanation for the discrepancy between the date of first use stated in the letter and the date of first use stated in the instant application; and (d) documentation of Opposer’s alleged use dating to 2004.

22. Applicant’s counsel did not provide any explanation for foregoing requests (a), (b) and (c), supporting the aforementioned allegations concerning Applicant’s knowledge and intent underlying its activities.

23. Applicant’s counsel provided purported documentation of Opposer’s use dating to 2004, such documentation appearing to be fabricated, supporting the aforementioned allegations concerning Applicant’s knowledge and intent underlying its activities.

24. Applicant was aware of Opposer’s activities surrounding Opposer’s adoption of the mark BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL at all relevant times, including as of the filing date of Applicant’s instant application.

25. Applicant believed that its use of the applied-for mark would likely cause confusion with Opposer’s use of the mark BRITANNICA, as evidenced by the aforementioned correspondence from Applicant’s attorney to Opposer.

Priority of Use

26. Opposer's aforementioned activities constitute analogous use of the marks BRITANNICA, BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL by Opposer. As a result of the analogous use, Opposer has priority to the applied-for mark over Applicant.

27. There is a likelihood of confusion between the marks BRITANNICA, BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL as used and owned by Opposer and the applied-for mark as allegedly used and applied-for by Applicant.

28. As a result, Applicant is not entitled to registration of the applied-for mark.

Fraudulent Declaration

29. In connection with the instant application, Applicant made the following declaration:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

30. As evidenced in part by the foregoing specifically alleged facts, Applicant knew that, at the time of filing, Applicant was not the owner of the trademark/service mark sought to be registered.

31. As evidenced in part by the foregoing specifically alleged facts, Applicant knew that, at the time of filing, Opposer was using the mark BRITANNICA at the time Applicant filed the aforementioned oath with the Trademark Office in the manner described herein, such use creating in Opposer rights to the mark that were superior to Applicant's rights to the applied-for mark.

32. As evidenced in part by the foregoing specifically alleged facts, Applicant knew that, at the time of filing that its use of the applied-for mark was likely to cause confusion with Opposer's BRITANNICA mark.

33. As a result of the foregoing, Applicant knew at the time of filing the falsity of the statement that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

34. As evidenced in part by the foregoing specifically alleged facts, Applicant made the aforementioned statement with the intent to deceive the Trademark Office and procure registration of the applied-for mark, to which Applicant was not entitled.

35. Applicant therefore fraudulently executed the declaration submitted with the filing of the present application.

Fraudulent Specimen

36. In connection with the instant application, Applicant has submitted specimen which is or are fabrications.

37. In connection with the instant application, the submission of the fabricated specimen to the Trademark Office was material because the application would not be allowed without such submission.

38. In connection with the instant application, Applicant made the foregoing submission to the Trademark Office knowing of its falsity.

39. In connection with the instant application, Applicant made the foregoing submission to the Trademark Office with the specific intent to deceive the Trademark Office and obtain registration of the applied-for mark.

40. For the foregoing reasons, Applicant has committed fraud in connection with the present application.

Lack of Use in Commerce

41. Applicant is not and has not actually used in commerce the applied-for mark.

42. Applicant was not using the applied-for mark in commerce as of the filing date of the application.

43. Applicant is therefore not entitled to registration of the applied-for mark.

Lack of Use in Commerce – Specimen Not in Agreement with Drawing

44. The mark of the instant application is:



45. The mark of the instant application is described as:

The mark consists of the wording "BRITANNICA", and to the left of the wording is the design of a lion-like animal with a spear-shaped tail with a flame coming from its mouth.

46. The specimen shows the mark:



47. The mark of the instant application as shown in the drawing and described in the application differs substantially from the mark appearing in the specimen.

48. The mark on the drawing of the present application is not a substantially exact representation of the mark on the specimen, and is thus not proper to show use pursuant to 37 C.F.R. §2.51(a).

49. Applicant has provided no specimen showing the applied-for mark.

50. Applicant is not and has not actually used in commerce the applied-for mark as shown and described in the application.

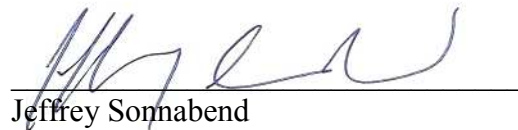
51. Applicant is therefore not entitled to registration of the applied-for mark.

As a result of the instant application and any registration that may result from it, Opposer has been, is and will be harmed, such harm including *inter alia* the inability to register and/or use the mark BRITANNICA, BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL.

WHEREFORE, for the foregoing reasons, Opposer requests that the above-identified application be denied registration.

Dated: May 1, 2013

Respectfully submitted,



Jeffrey Sonnabend
SonnabendLaw
600 Prospect Avenue
Brooklyn, NY 11215

Attorney for Opposer
Gregory A. Lewis

CERTIFICATE OF SERVICE

I certify that on the date indicated below, a copy of the foregoing papers were served by
United States postal mail on the following:

Malgorzata Madej
Kingsley Ventures Corporation
Suite 94
22 Notting Hill Gate
London
UNITED KINGDOM
W113JE

Dated: May 1, 2013


Jeffrey Sonnabend