ESTTA Tracking number: **ESTTA583472**

Filing date: **01/23/2014**

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	Transamerica Corporation		
Entity	Corporation	Citizenship	Delaware
Address	4333 Edgewood Road NE Cedar Rapids, IA 52499 UNITED STATES		

Attorney information	Bruce A. McDonald Buchanan Ingersoll & Rooney PC 1700 K Street NW, Suite 300 Washington, DC 20006 UNITED STATES bruce.mcdonald@bipc.com, holly.lance@bipc.com

Applicant Information

Application No	85889202	Publication date	12/24/2013
Opposition Filing Date	01/23/2014	Opposition Period Ends	01/23/2014
Applicant	Charles Schwab & Co., Inc. 211 Main Street San Francisco, CA 94105 CANADA		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Downloadable electronic publications, namely, brochures, newsletters, and reports in the fields of investment, finance,business, financial planning, portfoliomanagement, retirement planning, money management, investment strategy and asset allocation; downloadable electronic instructional and teaching materials in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation
Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Print publications, namely, brochures, newsletters, and reports in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation; printed instructional and teaching materialsin the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation
Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Banking services; financial research; providing financial and investment advice, analysis and consultation services; financial and investment services, namely,securities brokerage and trading of securities, stocks, bonds, mutual funds, money market funds, exchange traded funds,commodities, futures, options, and indices of any

of the forgoing; financial and investment services, namely, management of mutual funds, money market funds, exchange traded funds, index funds and managed accounts; financial and investmentservices, namely, financial trust services for employee benefit plans; financial and investment services, namely, custody services maintaining possession of financial assets of others for employee benefit plans; financial and investment services, namely, cash management account services; financial and investment services, namely, distribution of annuities; financial and investment advisory services featuring custody, trading and support; financial administration of retirement plans; providing a website containing financial and investment information foruse by investors
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Educational services, namely, workshops, seminars, and conferences in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation; educational services, namely, providing webcasts in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy andasset allocation; educational services,namely, providing online training sessions in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, moneymanagement, investment strategy and asset allocation

Grounds for Opposition

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

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4325690	Application Date	03/14/2012
Registration Date	04/23/2013	Foreign Priority Date	NONE
Word Mark	TRANSFORM YOUR TOMORROW		
Design Mark	TRANSFORM YOUR TOMORROW		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2013/01/14 First Use In Commerce: 2013/01/14 Financial services, namely, underwriting and distribution of life and health insurance and annuity products; investmentmanagement and advisory services; mutual fund management, brokerage, and distribution services; retail stock brokerage services; financial retirement planning;administration of retirement and pension plans; and insurance agency and brokerage services		

Attachments	85568872#TMSN.jpeg(bytes) Notice_of_Opposition_-_OWN_YOUR_TOMORROW.pdf(344138 bytes)

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	/ Holly B. Lance /
Name	Holly B. Lance
Date	01/23/2014

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

TRANSAMERICA CORPORATION,	)	
	)	Opposition No. _____
Opposer,	)	
	)	Adverse U.S. Applic. Serial No.
v.	)	85/889,202, in Int'l Classes 9, 16,
.	)	36 and 41
CHARLES SCHWAB & CO., INC.,	)	
	)	
Applicant.	)	

NOTICE OF OPPOSITION

Transamerica Corporation (hereinafter "Opposer") believes that it will be damaged by the registration of the mark identified in U.S. Application Serial No. 85/889,202, **OWN YOUR TOMORROW**, and hereby opposes said application in all classes, namely:

> "Downloadable electronic publications, namely, brochures, newsletters, and reports in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation; downloadable electronic instructional and teaching materials in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation," in International Class 9;
>
> "Print publications, namely, brochures, newsletters, and reports in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation; printed instructional and teaching materials in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation," in International Class 16;
>
> "Banking services; financial research; providing financial and investment advice, analysis and consultation services; financial and investment services, namely, securities brokerage and trading of securities, stocks, bonds, mutual funds, money market funds, exchange traded funds, commodities, futures, options, and indices of any of the forgoing; financial and investment services, namely, management of mutual funds, money market funds, exchange traded funds, index funds and managed accounts; financial and investment services, namely, financial trust services for employee benefit plans; financial and investment services, namely, custody services maintaining possession of financial assets of others for employee benefit plans; financial and investment services, namely, cash management account services; financial and investment services, namely, distribution of annuities; financial and investment advisory services featuring custody, trading and

support; financial administration of retirement plans; providing a website containing financial and investment information for use by investors," in International Class 36; and

"Educational services, namely, workshops, seminars, and conferences in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation; educational services, namely, providing webcasts in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation; educational services, namely, providing online training sessions in the fields of investment, finance, business, financial planning, portfolio management, retirement planning, money management, investment strategy and asset allocation," in International Class 41.

As grounds for this opposition, it is submitted that the opposed mark is likely to be confused with Opposer's prior registration**, TRANSFORM YOUR TOMORROW**, for materially identical, similar and related services, as depicted in United States Service Mark Registration 4,325,690, registered April 23, 2013 ("Opposer's Mark"). A copy of the registration certificate for Opposer's Mark is appended hereto as Exhibit A. In support of this Opposition, Opposer states as follows.

(1) Opposer is a Delaware corporation located at 4333 Edgewood Road NE, Cedar Rapids, IA 54299.

(2) On information and belief, Applicant is a California corporation location at 211 Main Street, San Francisco, CA 94105.

(3) Opposer's **TRANSFORM YOUR TOMORROW** registration is based on use in commerce since January 14, 2013, and covers "financial services, namely, underwriting and distribution of life and health insurance and annuity products; investment management and advisory services; mutual fund management, brokerage, and distribution services; retail stock brokerage services; financial retirement planning; administration of retirement and pension

plans; and insurance agency and brokerage services" in International Class 36 ("Opposer's Services").

(4) Opposer is a leading provider of financial services, namely, insurance, investment and retirement services. The **TRANSFORM YOUR TOMORROW** mark has appeared on the homepage of Opposer's flagship website, http://www.transamerica.com, since at least as early as January 15, 2013. An archived version of Opposer's website from the WayBack Machine showing use of the **TRANSFORM YOUR TOMORROW** mark on this date is attached as Exhibit B.

(4) Applicant filed the opposed application on March 28, 2013 based on an intent to use.

Likelihood of Confusion

(5) Applicant's Mark is similar to Opposer's pleaded mark in appearance, sound, and commercial impression.

(6) Grammatically and conceptually, the marks are similar because both consist of three words, beginning with the imperative form of a verb that conveys ownership, and an acknowledgement and assertion of responsibility, followed by the exact phrase "YOUR TOMORROW."

(7) The goods and services identified in the opposed Application ("Applicant's Goods and Services") are similar, related or materially identical to Opposer's Services.

(8) Based on the absence of any limitation in the class of purchasers or channels of trade appearing in the opposed Application or the pleaded registration, it follows as a matter of law that Applicant's Goods and Services are offered and sold to classes of consumers that are

similar or materially identical to Opposer's classes of consumers, through channels of trade that are similar or materially identical to those of Opposer.

(9) Applicant's Mark so resembles Opposer's previously used and registered Mark as to be likely, when applied to Applicant's Goods and Services, to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that Applicant's Goods and Services originate from or are associated with Opposer, or that Applicant's Goods and Services are authorized, endorsed or sponsored by Opposer.

(10) Applicant's filing of the opposed application was without license, authorization or permission from Opposer.

(11) Opposer will be damaged if the opposed application is allowed to register because Applicant will obtain statutory rights in the opposed mark in violation and derogation of the established prior rights of Opposer in its pleaded registration.

WHEREFORE, Opposer opposes U.S. Application Serial No. 85/889,202 on the grounds that registration of Applicant's mark is prohibited by Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Respectfully submitted,

TRANSAMERICA CORPORATION

By:

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Fax: (703) 836-2021
E-mail: holly.lance@bipc.com

Attorneys for Opposer

Date: January 23, 2014

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 23, 2014, a copy of the foregoing NOTICE OF OPPOSITION was served by U.S. mail, postage prepaid, on Applicant at the following address:

Charles Schwab & Co., Inc.
211 Main Street
San Francisco, California 94105

Bruce A. McDonald
Attorney
BUCHANAN INGERSOLL & ROONEY PC

EXHIBIT A

United States of America
United States Patent and Trademark Office

TRANSFORM YOUR TOMORROW

Reg. No. 4,325,690

Registered Apr. 23, 2013

Int. Cl.: 36

SERVICE MARK

PRINCIPAL REGISTER

TRANSAMERICA CORPORATION (DELAWARE CORPORATION)
4333 EDGEWOOD ROAD NE
CEDAR RAPIDS, IA 52499

FOR: FINANCIAL SERVICES, NAMELY, UNDERWRITING AND DISTRIBUTION OF LIFE AND HEALTH INSURANCE AND ANNUITY PRODUCTS; INVESTMENT MANAGEMENT AND ADVISORY SERVICES; MUTUAL FUND MANAGEMENT, BROKERAGE, AND DISTRIBUTION SERVICES; RETAIL STOCK BROKERAGE SERVICES; FINANCIAL RETIREMENT PLANNING; ADMINISTRATION OF RETIREMENT AND PENSION PLANS; AND INSURANCE AGENCY AND BROKERAGE SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-14-2013; IN COMMERCE 1-14-2013.

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

SN 85-568,872, FILED 3-14-2012.

KARANENDRA S. CHHINA, EXAMINING ATTORNEY

Acting Director of the United States Patent and Trademark Office

EXHIBIT B

INTERNET ARCHIVE Wayback Machine
http://www.transamerica.com/ Go
605 captures
18 Oct 96 - 18 Jan 14
DEC JAN MAR
2012 15 2013 2014
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Help

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Learn more about retirement

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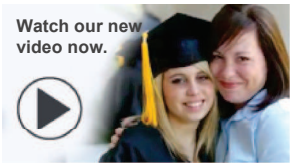

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