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

Proceeding	91238714
Party	Plaintiff Department of Homeland Security
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Date	07/10/2018
Attachments	20180710 FEMA DHS NFIP Opposition Amended Signed.pdf(716720 bytes)

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

IN THE MATTER OF APPLICATION

Serial No.: 87/424,607
Mark: ALLUVION FLOOD INSURANCE POWERED BY LOCKTON and Design



Published: September 5, 2017

_____)	
U.S. Department of Homeland Security,)	
)	
Opposer,)	
)	
v.)	Opposition No.: 91238714
)	
Lockton, Inc.)	
)	
Applicant.)	
_____)	

FIRST AMENDED NOTICE OF OPPOSITION

Pursuant to 15 U.S.C. §1063(a), Section 13(a) of the Lanham Act, Opposer, The United States Department of Homeland Security (“DHS”), an Executive department of the United States of America, having an address of 245 Murray Lane, Washington, DC, 20528, on behalf of the Federal Emergency Management Agency (“FEMA”), the Federal Insurance and Mitigation Administration (FIMA), and the National Flood Insurance Program (“NFIP”), hereby opposes the registration of Application Serial No. 87/424,607 for ALLUVION FLOOD INSURANCE POWERED BY LOCKTON and Design as filed on behalf of Lockton, Inc., (“Applicant”) and as published in the *Official Gazette* on September 5, 2017, at least because DHS believes that it will be damaged by the registration of the mark in the above-identified application.

Pursuant to Federal Rule of Civil Procedure 15(a) and Trademark Trial and Appeal Board Manual of Procedure 507.02, Opposer DHS provides this First Amended Notice of Opposition.

The grounds for opposition are as follows:

1. DHS is a Cabinet department of the executive branch of the United States government. The core DHS missions include preventing terrorism and enhancing security, managing our borders, administering immigration laws, securing cyberspace, and ensuring disaster resilience. FEMA is a component of DHS and works to support our citizens and first responders to ensure that, as a nation, we work together to build, sustain, and improve our capability to prepare for, protect against, respond to, recover from, and mitigate all hazards. FEMA manages the NFIP through FIMA.

2. The NFIP was created in 1968 by the National Flood Insurance Act of 1968, as amended, 42 U.S.C § 4001 *et seq.*, and was administered by the Secretary of Housing and Urban Development. Administration of the NFIP was transferred to FEMA in 1979, and FEMA became part of DHS on March 1, 2003. The NFIP aims to reduce the impact of flooding on private and public structures by providing affordable insurance to property owners, by a program of identifying the nation's flood risks, and by encouraging communities to adopt and enforce minimum floodplain management criteria.

3. Properties located in areas at high risk of flooding with mortgages issued by federal lenders or federally-regulated lenders are statutorily required to have flood insurance. 42 U.S.C. § 4012(a). Federal lending regulators that are responsible for overseeing federally-regulated and insured lenders oversee the mandatory purchase requirement and require regulated lenders to ensure the purchase of flood insurance for properties located within an area having special flood hazards for the term of the loan. *Id.*

4. As of September 30, 2016, the NFIP had over 5 million policies in force throughout all 50 states and United States territories.

5. NFIP policies are sold to the public by over 65 participating Write Your Own (WYO) private insurance providers and also directly from FEMA through licensed property and casualty agents. The WYO Program began in 1983 and is a cooperative undertaking between the private insurance industry and FEMA. The WYO Program allows participating property and casualty insurance companies to write and service the Standard Flood Insurance Policy in their own names, with risk and associated expenses assumed by the National Flood Insurance Fund in the United States Treasury. All Standard Flood Insurance Policies are subject to FEMA's oversight and are issued subject to the National Flood Insurance Act, implementing regulations, and FEMA guidance. The terms of the Standard Flood Insurance Policies are codified in the appendixes to title 44 of the Code of Federal Regulation, Part 61.

6. Opposer DHS is the owner of U.S. Trademark Registration Number 4,940,750 ("the '750 Registration") for NATIONAL FLOOD INSURANCE PROGRAM and Design ("DHS Mark"), registered on April 19, 2016, and used by FEMA in connection with Promotion of only federally backed flood insurance services for property owners in participating communities, on behalf of third parties in International Class 036. The DHS mark as used in commerce is as follows:



7. The DHS Mark is registered on the Principal Register based on actual use in commerce at least as early as May 10, 2008, in International Class 035. Opposer DHS has established exclusive rights in the DHS Mark through continuous use in commerce in the United States.

8. Opposer DHS owns all right, title, and interest to the DHS Mark.

9. The DHS Mark has been used continuously in association with the recited services since before any date that Applicant may have right to claim for priority and is included in all forms of advertising: television, print, online display, direct mail, and out-of-home. As a result, the wording “National Flood Insurance Program” contained in the NFIP Mark has become distinctive of the FEMA program and of being a program operated by the U.S. Government.

10. Copies of the Registration Certificate and Trademark Status & Document Retrieval Status Page are attached as Exhibits 1 and 2, respectively.

11. In addition to the services recited in the ‘750 Registration, NFIP policies are sold directly from FEMA through licensed property and casualty agents in association with the DHS Mark.

12. The opposed U.S. Trademark Application Serial Number 87/424,607 (“the ‘607 Application”) was filed on April 25, 2017, after registration of the ‘750 Registration, as an

intent-to-use application on behalf of Lockton, Inc., a Missouri Corporation having an address of 444 West 47th Street, Suite 900, Kansas City, MO.

13. Applicant seeks to register the applied-for mark for Insurance brokerage services; financial and insurance risk management services; financial and insurance consulting, information and data analysis services in the field of flood insurance in International Class 036. The applied-for mark is shown as follows:



14. The '607 Application does not allege a date of first use or a date of first use in commerce.

15. The '607 Application describes that mark as consisting of “three lines depicting waves under a single home, and to the right the stylized word "ALLUVION" on top of "FLOOD INSURANCE", which is in turn stacked on "POWERED BY LOCKTON". The wording "FLOOD INSURANCE" is contained in a horizontal band spanning the width of the entire mark”.

16. The “three lines depicting waves under a single home” of the Opposed Mark is visually reminiscent of the DHS Mark perhaps to intentionally associate Applicant’s business in the minds of the consuming public with Opposer DHS’s famous and distinctive DHS Mark.

17. The '607 Application makes no claim for color as a feature of the mark.

18. The '607 Application specifically disclaims the words “FLOOD INSURANCE”.

19. The '607 Application was published for opposition on September 5, 2017.

20. Opposer DHS believes it is or will be damaged by registration of the mark of the '607 Application.

LIKELIHOOD OF CONFUSION UNDER §2(d)

21. Paragraphs 1 through 20 are adopted by reference as if fully set forth herein.

22. The mark of the '607 Application so resembles the DHS Mark of the '750 Registration as to be likely, when used on or in connection with the services of the Applicant, to cause confusion, mistake, and deception as to the source or origin of Applicant's goods and services and will injure and damage Opposer DHS and the goodwill and reputation associated with the DHS Mark.

23. The goods and services of the Applicant so resemble the services provided under the DHS Mark that the public is likely to be confused and deceived so as to incorrectly identify the source of the goods and services offered by the Applicant as being offered or endorsed by Opposer DHS, thereby causing irreparable harm to Opposer DHS and the goodwill and reputation associated with the DHS Mark.

24. Likelihood of confusion is substantial in view of the incorporation of portions of the DHS Mark into Applicant's Mark, the similarity of the services provided under the applied-for mark and the DHS mark, the strength and great fame of the DHS Mark, the overlapping geographic areas in which the goods and services of both the Applicant and Opposer DHS are offered, and that individuals who may purchase goods and services of the Applicant are the same as those who may purchase services provided under the DHS Mark, thereby causing irreparable harm to Opposer DHS and the goodwill and reputation associated with the DHS Mark.

25. The DHS Mark has been in continuous use since before the filing of the '607 Application such that Opposer DHS has a clear priority of use in association with the recited services.

DILUTION BY BLURRING UNDER §43(c)

26. Paragraphs 1 through 25 are adopted by reference as if fully set forth herein.

27. The NFIP was introduced to the American public in 1968 and has been widely using the DHS Mark in commerce in the United States such that the DHS Marks are well-known and famous as distinctive symbols of Opposer DHS's goodwill and services since before any use by Applicant.

28. The mark of the '607 Application and the DHS Mark are nearly identical in at least the representation of a house and three lines depicting waves with the exception of the distinctiveness of and the goodwill associated with the DHS Mark.

29. Opposer DHS is engaging in substantially exclusive use of the DHS Mark, and the DHS Mark is widely recognized.

30. There is no association or relationship between Applicant and Opposer DHS relevant to the mark of the '607 Application and the DHS Mark.

31. Any use by the Applicant of the mark of the '607 Application would be after the registration of the DHS Mark and long after the DHS Mark was distinctive and famous. Thus, any use by the Applicant of the mark of the '607 Application would dilute the distinctive value of the DHS Mark and associated goodwill and diminish the capacity of the famous DHS Mark to identify Opposer DHS as the source of the provided services.

32. Any such use by the Applicant of the mark of the '607 Application is not a fair use, or a nominative or descriptive fair use or facilitation of such fair use, of a famous mark and

is not use in connection with advertising or promotion that permits consumers to compare goods or services or identifying and parodying, criticizing, or commenting upon DHS or the goods or services of DHS.

DECEPTION/FALSE SUGGESTION OF CONNECTION UNDER §2(a)

33. Paragraphs 1 through 32 are adopted by reference as if fully set forth again.

34. The mark of the ‘607 Application so resembles the DHS Mark of the ‘750 Registration as to be likely to deceive as to the affiliation, connection, and association of Applicant with DHS so as to cause deception as to the approval and endorsement of Applicant’s goods and services by DHS. The ‘607 Application falsely suggests that the source or origin of its services is Opposer DHS, and consumers will assume that Opposer DHS approves and endorses Applicant’s services, resulting in injury and damage to Opposer DHS and the goodwill and reputation associated with the DHS Mark.

35. The goods and services offered by the Applicant are of such type and character that the public would be misled by the use of the mark of the ‘607 Application into believing that Opposer DHS has approved, endorsed, or sponsored the goods and services.

36. The mark of the ‘607 Application, by its very nature, falsely suggests a connection with Opposer DHS at least through the use of the house and three lines depicting waves adjacent to the ALLUVION FLOOD INSURANCE POWERED BY LOCKTON such that the specific consuming public will be misled into believing Opposer DHS endorses the goods and services provided by Applicant.

37. Use and registration of the mark of the ‘607 Application will deprive Opposer DHS of the ability to protect its reputation, persona, and goodwill.

MERELY DESCRIPTIVE UNDER §2(e)(1)

38. Paragraphs 1 through 37 are adopted by reference as if fully set forth again.

39. The mark of the ‘607 Application, when used on or in connection with the services of the Applicant, is merely descriptive of such applied-for services, and no showing of acquired distinctiveness has been made or can be made because the ‘607 Application is an intent-to-use application filed under §1(b).

40. The mark of the ‘607 Application includes the visual representation of a house and three lines depicting waves adjacent to the word “ALLUVION”, which is defined as “flood”¹ and which extends over the words “FLOOD INSURANCE” and “POWERED BY LOCKTON”.

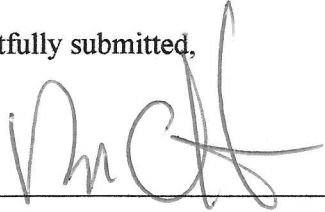
41. Each aspect of the mark of the ‘607 Application is merely descriptive of a characteristic, function, feature, purpose, or use of the applied-for services, without need for thought or imagination.

¹ Alluvion is defined as “overflow; flood”. <http://www.dictionary.com/browse/alluvion> (accessed July 10, 2018).

WHEREFORE, Opposer DHS believes that it has been, is, and/or will be damaged by registration of the mark of '607 Application and requests that the mark of '607 Application be denied registration.

Respectfully submitted,

By: _____



Date: July 10, 2018

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