

ESTTA Tracking number: **ESTTA949992**

Filing date: **01/25/2019**

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	Equis Financial Inc.
Granted to Date of previous extension	01/26/2019
Address	83 S. Tunnel Rd.Suite A-9 Asheville, NC 28805 UNITED STATES

Attorney information	Leesa N. Weiss Jacobson Holman PLLC 400 7th St., N.W. Suite 700 Washington, DC 20004 UNITED STATES trademark@jhip.com, LWeiss@jhip.com, CChapman@jhip.com 202-638-6666
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Applicant Information

Application No	79187966	Publication date	11/27/2018
Opposition Filing Date	01/25/2019	Opposition Period Ends	01/26/2019
International Registration No.	1300089	International Registration Date	02/26/2016
Applicant	Equis Pte. Ltd. 1 George Street, #14-04 One George Street SINGAPORE		

Goods/Services Affected by Opposition


<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business administration services; providing office functions; assistance and consultancy services in the field of business management of companies in the energy sector; import-export agencies in the field of energy; analysis of market research data and statistics; business project management services for construction projects; data management, namely, data management services in the nature of database management for use in the energy sector</p>
<p>Class 040. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Production of energy; consultancy services relating to the generation of electrical power; generation of electricity from solar energy; technical consultancy in the field of production of solar energy; generation of electricity from wave energy; production of hydroelectric power; production of electrical energy from renewable sources; production of</p>

energy by power plants; production and processing of fuels and of other sources of energy, namely, production and treatment and refinement of biofuels

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	87310769	Application Date	01/23/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EQUIS FINANCIAL		
Design Mark			
Description of Mark	<p>The mark consists of the words "EQUIS FINANCIAL" in a black stylized font to the right of an incomplete blue square box having rounded corners inside of which is an abstract arrow-like design shaded from gray to black that is intended to be suggestive of two roads converging to head in the same direction. The color white represents background and is not claimed as a feature of the mark.</p>		
Goods/Services	<p>Class 035. First use: First Use: 2015/10/01 First Use In Commerce: 2015/10/01 independent marketing organization services and insurance marketing organization services, namely, providing business marketing and business technology support services necessary for the independent insurance agent and producer to operate their insurance business; independent marketing organization services and insurance marketing organization services, namely, business and business management consulting, marketing and sales management services for independent insurance agents and producers; providing contracting services in the nature of facilitating contracts between independent insurance agents and producers and insurance carriers, namely, processing insurance carrier contracting paperwork and submission of the paperwork to the insurance carriers, and providing proper documentation to insurance carriers in conjunction with insurance carrier contracts; providing new business application services to independent insurance agents and producers, namely, providing office functions in the nature of administrative processing of insurance applications and forwarding them to insurance carriers; professional business, sales and marketing advisory and consultancy services, namely sales training, business operations training, marketing consultation in the form of training on how to market to clients through direct mail lead and warm market marketing programs; providing sales leads and referrals for independent insurance agents and producers in the field of insurance; insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes to insurance brokers, agents and agencies interested in these requests; promotion of insurance services on behalf of third parties; business development services for independent insurance producers and agents engaged in direct sales of insurance products, namely training in how to structure and operate a successful insurance agency; advertising services; business administration services; arranging and conducting business con-</p>		

	<p>ferences</p> <p>Class 036. First use: First Use: 2015/10/01 First Use In Commerce: 2015/10/01 insurance consultation; insurance consulting in the fields of life insurance, mortgage protection insurance, final expense insurance, disability insurance coverage, critical illness insurance</p> <p>Class 041. First use: First Use: 2015/10/01 First Use In Commerce: 2015/10/01 education services, namely, providing classes, seminars, workshops, mentoring, and coaching in the field of insurance; providing professional business development coaching services to insurance agents and producers in the field of insurance; business education and training services, namely, conducting classes, seminars, conferences and workshops in the field of insurance</p>
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Attachments	87310769#TMSN.png(bytes) Equis Notice of Opposition - final.pdf(111979 bytes)
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Signature	/Leesa N. Weiss/
Name	Leesa N. Weiss
Date	01/25/2019

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

Equis Financial Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
Equis Pte. Ltd.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

In the matter of an application to register a trademark under the Trademark Act of 1946, Serial No. 79/187,966 (“the '966 application”), filed February 26, 2016¹, by Equis Pte. Ltd. (“Applicant”), published for opposition in the *Trademark Official Gazette* of November 27, 2018, for EQUIS (“Applicant’s mark”), the Opposer, Equis Financial Inc. (hereinafter “Opposer” or “Equis Financial”), believes it will be damaged by the registration of said mark and hereby opposes same. The grounds for opposition are as follows:

1. Opposer, Equis Financial, is a corporation duly organized and existing under the laws of the State of North Carolina, having a place of business at Suite A-9, 83 South Tunnel Road, Asheville, North Carolina 28805.
2. Equis Financial provides support to independent insurance agents and insurance agencies so they (the insurance agents and insurance agencies) may, in turn, better service their individual customers with relevant insurance and insurance-related products. Equis Financial works with and through its clients: independent insurance agents and insurance agencies, to

¹This is the filing date of International Registration No. 1300089.

provide a high-quality lead system, industry leading compensation, training systems for independent insurance agents, bonus programs for independent insurance agents and insurance agency managers, access to a portfolio of major insurance companies and products allowing insurance agents to find their customers coverage no matter the situation, top annuity and final expense (funeral/burial) products to compliment life insurance sales, a plug and play system for insurance agency managers to grow successful and sustainable agencies, and support staff to provide assistance with new business, leads, sales support, licensing, underwriting, and marketing. Specific insurance products sold by and sold through Equis Financial's affiliated insurance agents and insurance agencies include mortgage protection, disability coverage, critical illness insurance, term life insurance, equity indexed universal life insurance, insurance-based annuities, and final expense plans (collectively, "Equis Financial's services").

3. Since prior to the June 30, 2016 filing date of the '966 application in the U.S. Patent & Trademark Office, and since prior to the February 26, 2016 filing date of International Registration No. 1300089, Equis Financial continuously has used in commerce the service marks **EQUIS** and **EQUIS FINANCIAL** in a variety of forms and formats (hereinafter collectively referred to as Equis Financial's "**EQUIS Marks**") to identify the Equis Financial services.

4. On January 23, 2017, Opposer filed an application to register:



("EQUIS FINANCIAL & Design mark"), service mark application Serial No. 87/310,769 (the "769 application"), pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Opposer's continuous use in commerce of same since at least as early as October 1, 2015, for:

independent marketing organization services and insurance marketing organization services, namely, providing business marketing and business technology support services necessary for the independent insurance agent and producer to operate their insurance business; independent marketing organization services and insurance marketing organization services, namely, business and business management consulting, marketing and sales management services for independent insurance agents and producers; providing contracting services in the nature of facilitating contracts between independent insurance agents and producers and insurance carriers, namely, processing insurance carrier contracting paperwork and submission of the paperwork to the insurance carriers, and providing proper documentation to insurance carriers in conjunction with insurance carrier contracts; providing new business application services to independent insurance agents and producers, namely, providing office functions in the nature of administrative processing of insurance applications and forwarding them to insurance carriers; professional business, sales and marketing advisory and consultancy services, namely sales training, business operations training, marketing consultation in the form of training on how to market to clients through direct mail lead and warm market marketing programs; providing sales leads and referrals for independent insurance agents and producers in the field of insurance; insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes to insurance brokers, agents and agencies interested in these requests; promotion of insurance services on behalf of third parties; business development services for independent insurance producers and agents engaged in direct sales of insurance products, namely training in how to structure and operate a successful insurance agency; advertising services; business administration services; arranging and conducting business conferences, in Class 35;

insurance consultation; insurance consulting in the fields of life insurance, mortgage protection insurance, final expense insurance, disability insurance coverage, critical illness insurance, in Class 36; and

education services, namely, providing classes, seminars, workshops, mentoring, and coaching in the field of insurance; providing professional business development coaching services to insurance agents and producers in the field of insurance; business education and training services, namely, conducting classes, seminars, conferences and workshops in the field of insurance, in Class 41.

5. On February 26, 2016, an application which resulted in International Registration No. 1300089 was filed by Applicant. Subsequently, on June 30, 2016, the '966 application to

register Applicant's mark was filed in the U.S. Patent & Trademark Office pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f) for the following services (as amended):

business administration services; providing office functions; assistance and consultancy services in the field of business management of companies in the energy sector; import-export agencies in the field of energy; analysis of market research data and statistics; business project management services for construction projects; data management, namely, data management services in the nature of database management for use in the energy sector, in Class 35; and

production of energy; consultancy services relating to the generation of electrical power; generation of electricity from solar energy; technical consultancy in the field of production of solar energy; generation of electricity from wave energy; production of hydroelectric power; production of electrical energy from renewable sources; production of energy by power plants; production and processing of fuels and of other sources of energy, namely, production and treatment and refinement of biofuels, in Class 40.

6. On April 19, 2017, the Examining Attorney assigned to Opposer's '769 application issued an Office Action citing the '966 application, and advising that its (Opposer's) application for the **EQUIS FINANCIAL** & Design service mark may be refused if a registration issues for Applicant's mark from the '966 application because of a likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

7. In a Response dated May 10, 2017, Opposer presented significant arguments supporting its '769 application, and distinguishing its mark and services from the mark and services of the '966 application. However, the Examining Attorney did not withdraw his citation to the '966 application and, instead, on May 12, 2017, suspended prosecution of Opposer's '769 application pending the ultimate disposition of the '966 application opposed herein.

8. The '966 application was published for opposition in the *Official Gazette* of November 27, 2018.

9 On November 27, 2018, Opposer filed a Request for extension of time to file a Notice of Opposition to the '966 application; said Request was granted by the Trademark Trial & Appeal Board (“Board”) on November 27, 2018.

10. By virtue of the foregoing, and notwithstanding Opposer’s priority, if Applicant is granted a registration from the '966 application opposed herein, and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, said registration is likely to be cited as a basis for refusing registration of Opposer’s **EQUIS FINANCIAL & Design** mark which is the subject of its '769 application, to the detriment and damage of Opposer in that Opposer will be unable to register its **EQUIS FINANCIAL & Design** mark.

WHEREFORE, this Opposer believes and alleges that it will be damaged by registration of the mark of application Serial No. 79/187,966, as aforesaid, and prays that:

- A. judgment in the present opposition be entered in favor of Opposer;
- B. the present opposition be sustained; and
- C. registration of application Serial No. 79/187,966 be rejected and refused.

Should the payment accompanying this Notice of Opposition be insufficient, the Board is hereby authorized to charge the undersigned counsel’s Deposit Account No. 06-1358.

Respectfully submitted,

EQUIS FINANCIAL INC.

By: /Leesa N. Weiss/
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Date: January 25, 2019