

ESTTA Tracking number: **ESTTA981808**

Filing date: **06/19/2019**

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	American Association for Justice a/k/a Association of Trial Lawyers of America		
Entity	Corporation	Citizenship	District of Columbia
Address	777 6th Street NW, Suite 200 Washington, DC 20001 UNITED STATES		

Attorney information	Christopher K. Larus Robins Kaplan LLP 800 LaSalle Avenue, Ste 2800 Minneapolis, MN 55402 UNITED STATES clarus@robinskaplan.com, tmoore-willis@robinskaplan.com, cmay@robinskaplan.com 612-349-8500		
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Applicant Information

Application No	88224064	Publication date	05/21/2019
Opposition Filing Date	06/19/2019	Opposition Period Ends	06/20/2019
Applicant	Association of American Trial Lawyers (AOATL) P.O. Box 15864 Sacramento, CA 958520864 UNITED STATES		


Goods/Services Affected by Opposition

Class 035. First Use: 2018/06/02 First Use In Commerce: 2018/06/02 All goods and services in the class are opposed, namely: Advertising agencies specializing in law and the legal profession.; Advertising and business services, namely, securing airtime on all forms of media communications stations, systems, networks, and services for the purpose of promoting the goods and services of others; Advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes; Preparation of custom or non-custom advertising for businesses for dissemination via the web, CD or DVD for optional upload or download to a computer; Promoting, advertising and marketing of the brands, products, services and online websites of individuals, businesses and nonprofit organizations; Providing on-line business information of others, namely, advertisements or solicitations
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1035037	Application Date	03/26/1975
Registration Date	03/02/1976	Foreign Priority Date	NONE
Word Mark	ATLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1974/10/31 First Use In Commerce: 1974/10/31 PROVIDING SEMINARS AND MEETINGS FOR ATTORNEYS		

Attachments	73047782#TMSN.png(bytes) 2019.06.19 AAJ Notice of Opposition.pdf(62389 bytes)
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Signature	/Christopher K. Larus/
Name	Christopher K. Larus
Date	06/19/2019

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

American Association for Justice a/k/a
Association of Trial Lawyers of America,

Opposer,

v.

Association of American Trial Lawyers
(AOATL), LLC

Applicant.

Trademark Application

Mark: ASSOCIATION OF AMERICAN
TRIAL LAWYERS (AOATL)

Serial No. 88224064

Filed: December 11, 2018

Published: May 21, 2019

Opposition No. _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

The American Association for Justice a/k/a Association of Trial Lawyers of America (“Opposer”), a nonprofit corporation organized under the laws of the District of Columbia, located and doing business at 777 6th St., NW, Suite 200, Washington, DC, believes that it will be damaged by registration by the Association of American Trial Lawyers, LLC of the mark THE ASSOCIATION OF AMERICAN TRIAL LAWYERS (AOATL) shown in Application Serial No. 88224064 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. The Association of American Trial Lawyers (AOATL), LLC filed a trademark application assigned Application Serial No. 88224064 in the United States Patent and Trademark Office (“USPTO”) on December 11, 2018 (“the Application”) to register the mark ASSOCIATION OF AMERICAN TRIAL LAWYERS (AOATL) (hereinafter “Applicant’s Mark”) for use in connection with “Advertising agencies specializing in law and the legal

profession; Advertising and business services, namely, securing airtime on all forms of media communications stations, systems, networks, and services for the purpose of promoting the goods and services of others; Advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes; Preparation of custom or non-custom advertising for businesses for dissemination via the web, CD or DVD for optional upload or download to a computer; Promoting, advertising and marketing of the brands, products, services and online websites of individuals, businesses and nonprofit organizations; [and] Providing on-line business information of others, namely, advertisements or solicitations” in International Class 035.

2. The Application for the Applicant’s Mark was published for opposition in the Official Gazette on May 21, 2019.

I. OPPOSER AND OPPOSER’S MARKS

3. Opposer is the world’s largest trial bar. As detailed below, Opposer owns the marks ATLA®, and ASSOCIATION OF TRIAL LAWYERS OF AMERICA (collectively, “Opposer’s Marks”).

4. Since at least 1974, Opposer has continuously used the mark ATLA® in interstate commerce in connection with the advertisement, promotion, and sale of its legal association services, educational seminars, conferences, and publications in the legal field.

5. On March 2, 1976, the USPTO granted Opposer’s application to register the ATLA® mark on the Principal Register for “providing seminars and meetings for attorneys.” A true and correct copy of Opposer’s certificate of registration for United States Trademark Registration No. 1,035,037 is attached as Exhibit A.

6. Opposer's registration for the ATLA® mark is incontestable, valid, subsisting, and in full force and effect.

7. Since at least 1972, Opposer has continuously used the distinctive mark ASSOCIATION OF TRIAL LAWYERS OF AMERICA in interstate commerce throughout the United States in connection with the advertisement, promotion, and sale of its legal association services, educational seminars, conferences, and publications in the legal field.

8. Opposer's longstanding use of Opposer's Marks includes use of these marks in connection with the identification of membership to Opposer's association, which is widely recognized and highly regarded by members of the legal community.

9. Opposer has expended substantial effort and expense advertising and promoting, *inter alia*, its association, products and services under the Opposer's Marks.

10. As a result of Opposer's efforts, the purchasing public throughout the United States has come to know, rely upon, and recognize the products, and services sold by Opposer under the Opposer's Marks.

11. Through their longstanding and continuous use by Opposer, Opposer's Marks have become famous among members of the legal community in which Opposer sells its goods and services.

12. Opposer's filing date and Opposer's first use date for the ATLA® mark are substantially earlier than the filing date for the Application at issue.

13. Opposer's first use date for the mark ASSOCIATION OF TRIAL LAWYERS OF AMERICA is earlier than the filing date for the Application at issue.

II. APPLICANT AND APPLICANT'S MARK

14. Applicant, the Association of American Trial Lawyers (AOATL), LLC claims to be a corporation organized under the laws of the State of California, with its principal place of business located at 3104 O Street, Suite 127, Sacramento, California 95816. Upon information and belief, Applicant purports to be an organization of lawyers that conducts a variety of commercial activities related to the legal industry.

15. Upon information and belief the Association of American Trial Lawyers (AOATL), LLC was formed in 2018 to trade upon the substantial goodwill established by Opposer in Opposer's Marks.

III. LIKELIHOOD OF CONFUSION REGARDING APPLICANT'S MARK

16. Applicant's Mark is confusingly similar to Opposer's Marks, including the mere rearrangement and singularization of Opposer's mark ASSOCIATION OF TRIAL LAWYERS OF AMERICA.

17. The goods and services described in Applicant's Mark include those identical or similar to the goods and services sold by Opposer in association with Opposer's Marks.

18. Applicant did not ask or obtain Opposer's permission to use the Applicant's Mark in conjunction with Applicant's services and activities.

19. On information and belief, Applicant adopted the Applicant's Mark in an effort to trade on the goodwill existing in connection with Opposer's Marks, or to otherwise lead consumers to believe that there was some connection or affiliation between Applicant's goods and/or services and those of Opposer.

20. Applicant's Mark consists of or comprises a mark which so resembles Opposer's Mark that when used on or in connection with the goods and services of the applicant, will cause confusion, mistake, or deception.

21. Applicant's Mark would likely cause dilution of Opposer's Marks by blurring or tarnishment under Section 43(c) of the Lanham Act.

22. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged.

23. WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 8224064 be refused and that this Opposition be sustained in favor of Opposer.

Date: June 19, 2019

ROBINS KAPLAN LLP

/s/ Christopher K. Larus

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**ATTORNEYS FOR OPPOSER
AMERICAN ASSOCIATION FOR
JUSTICE a/k/a ASSOCIATION OF
TRIAL LAWYERS OF AMERICA**

Exhibit A

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent and Trademark Office

10 Year Renewal

Reg. No. 1,035,037

Registered Mar. 2, 1976

Renewal Term Begins Mar. 2, 1996

**SERVICE MARK
PRINCIPAL REGISTER**

ATLA

ASSOCIATION OF TRIAL LAWYERS
OF AMERICA, THE (D.C. CORPORATION)

1050 31ST STREET, N.W.

WASHINGTON, DC 200074499, ASSIGNEE OF ASSOCIATION OF TRIAL LAWYERS OF AMERICA, THE (MASSACHUSETTS UNINC. ASSOCIATION)
CAMBRIDGE, MA

FOR: PROVIDING SEMINARS AND MEETINGS FOR ATTORNEYS, IN CLASS 41 (U.S. CL. 107).

FIRST USE 10-31-1974; IN COMMERCE 10-31-1974.

SER. NO. 73-047,782, FILED 3-26-1975.

In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on Sep. 17, 1996.