

ESTTA Tracking number: **ESTTA1021620**

Filing date: **12/10/2019**

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	Expeditors International of Washington, Inc.
Granted to Date of previous extension	12/11/2019
Address	1015 THIRD AVE., 12TH FLOOR SEATTLE, WA 98104 UNITED STATES
Correspondence information	ERIN S. HENNESSY BRACEWELL LLP 701 FIFTH AVE. STE. 6200 SEATTLE, WA 98104 UNITED STATES docketing@bracewell.com, erin.hennessy@bracewell.com, an-nie.allison@bracewell.com, heather.fox@bracewell.com 206-204-6200

Applicant Information

Application No	88391312	Publication date	08/13/2019
Opposition Filing Date	12/10/2019	Opposition Period Ends	12/11/2019
Applicant	Tradeflo LLC 5th Floor 1177 Ave. Of The Americas New York, NY 10036 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2018/06/08 First Use In Commerce: 2018/06/25 All goods and services in the class are opposed, namely: Trade finance advisory, consulting and broker services

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. Registration No.	2875646	Application Date	12/27/2002
Registration Date	08/17/2004	Foreign Priority	NONE

		Date	
Word Mark	TRADE FLOW		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2003/06/13 First Use In Commerce: 2003/06/13 business consultation in the field of freight management, importing and exporting, and consolidation</p> <p>Class 039. First use: First Use: 2003/06/13 First Use In Commerce: 2003/06/13 international freight forwarding, importing and exporting, and consolidation</p> <p>Class 042. First use: First Use: 2003/06/13 First Use In Commerce: 2003/06/13 providing temporary use of on-line non-downloadable software for use in management of freight forwarding, importing and exporting, and consolidation</p>		

Attachments	TRADEFLO Opposition 12 10 19.pdf(269837 bytes)
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Signature	/Erin S. Hennessy/
Name	ERIN S. HENNESSY
Date	12/10/2019

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

EXPEDITORS INTERNATIONAL OF
WASHINGTON, INC.,

Opposer,

v.

TRADEFLO LLC,

Applicant.

Opposition No. _____

Mark: TRADEFLO

Application Serial No. 88/391,312

Filed: April 18, 2019

Published: August 13, 2019

NOTICE OF OPPOSITION

Expeditors International of Washington, Inc. (“Opposer”) believes that it will be damaged by the issuance of a registration for the mark TRADEFLO (“Applicant’s Mark”), as applied for in Application Serial No. 88/391,312, filed on April 18, 2019 (the “Application”) by Tradeflo LLC (“Applicant”). Opposer hereby opposes same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1063(a).

THE PARTIES AND PLEADING HISTORY

1. Opposer is a Washington corporation with a place of business at 1015 Third Ave., 12th Floor, Seattle, Washington, 98104.
2. Applicant is a Delaware limited liability company with a place of business at 1177 Ave. of the Americas, 5th floor, New York, New York 10036.
3. Opposer took two timely extensions of time to oppose, on September 6, 2019, and October 11, 2019, and timely files this Notice of Opposition

OPPOSER AND ITS MARKS

4. Opposer is a Fortune 500 service-based logistics company. Opposer has been in operation since 1979 and presently operates globally out of 322 locations in 103 countries on six continents. For more information, visit www.Expeditors.com (the "Expeditors Site").

5. Opposer is the owner of valid and subsisting United States Trademark Registration No. 2,875,646 on the Principal Register in the United States Patent and Trademark Office for the trademark TRADE FLOW (hereinafter the "TRADE FLOW Mark"). Registration for the TRADE FLOW Mark was issued on August 17, 2004. A chart of the services covered under the TRADE FLOW Mark ("Opposer's Services") are attached hereto as Exhibit 1 (including the corresponding TSDR records).

6. Opposer has used the TRADE FLOW Mark in interstate commerce in the United States in connection with Opposer's Services continuously since at least as early as June 13, 2003.

7. As a result of its widespread, continuous, and exclusive use of the TRADE FLOW Mark to identify Opposer's Services, and Opposer as their source, Opposer owns valid and subsisting federal statutory and common law rights to the TRADE FLOW Mark.

8. Opposer's TRADE FLOW Mark is distinctive to both the consuming public and Opposer's trade.

9. Opposer has expended substantial time, money, and resources marketing, advertising, and promoting the services offered under the TRADE FLOW Mark.

10. Due to Opposer's extensive use and promotion of the TRADE FLOW Mark, Opposer has established valuable goodwill and name recognition in the TRADE FLOW Mark. Because of these efforts, the general public associates the TRADE FLOW Mark with Opposer and recognizes the same as an indication of high quality services that originate from Opposer.

APPLICANT AND THE APPLICATION

11. Applicant seeks to register the mark TRADEFLO in connection with the services set forth in Exhibit 2 (including the corresponding TSDR application details) (“Applicant’s Services”).

12. Applicant filed the Application on April 18, 2019 (“Applicant’s Filing Date”).

13. Applicant allegedly began using the proposed mark on June 25, 2018, fifteen (15) years after Opposer began using Opposer's Mark.

14. On information and belief, Applicant has not used Applicant’s Mark for Applicant’s Goods and Services in the U.S. prior to June 13, 2003.

15. The Application was published for opposition in the Official Gazette on August 13, 2019.

PRIORITY

16. There is no issue as to priority. Upon information and belief the TRADE FLOW Mark was in use in commerce prior to when Applicant filed the Application.

FIRST GROUND FOR OPPOSITION – LIKELIHOOD OF CONFUSION

17. The TRADE FLOW Mark is an inherently distinctive and protectable mark that has become exclusively associated with Opposer through continuous, extensive, and widespread use in U.S. commerce through the advertising, promoting, and marketing by Opposer of Opposer’s Services since at least as early as June 13, 2003. As a result, the TRADE FLOW Mark exclusively identifies Opposer’s services.

18. Applicant's proposed mark TRADEFLO is confusingly similar in appearance, sound, and commercial impression to Opposer's TRADE FLOW Mark. Namely, Applicant’s Mark contains Opposer’s TRADE FLOW Mark in its entirety.

19. Applicant’s Services are similar and related to Opposer’s Services.

20. On information and belief, the Application covers services which are likely to flow through the same channels of trade and to the same class of consumers as the services covered by the TRADE FLOW Mark.

21. As a result of the public's association of the TRADE FLOW Mark with Opposer, Opposer's senior rights in the TRADE FLOW Mark, and the confusingly similar nature of the TRADE FLOW Mark and Applicant's Mark, registration of the Application will injure Opposer because Applicant's Mark, when used on or in connection with Applicant's Services, is likely to cause confusion, mistake, or deception as to the source, origin, or affiliation of Applicant's Goods and Services, in that consumers are likely to be confused that Applicant's Goods and Services originate with or are otherwise endorsed, sponsored or approved by Opposer.

22. Accordingly, Applicant's Mark should be barred from registration because it consists of or comprises a mark which so resembles Opposer's previously used and registered TRADE FLOW Mark as to be likely, when used in connection with Applicant's Services, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

WHEREFORE, Opposer respectfully prays that the Application be refused registration and that this Opposition be sustained in its favor.

DATED: December 10, 2019

Respectfully Submitted,

BRACEWELL LLP

Signed: /Erin S. Hennessy/

Erin S. Hennessy
Bracewell LLP
701 Fifth Ave., Ste. 6200
Seattle, WA 98104-7043
206-204-6200

CERTIFICATE OF SERVICE

I hereby certify that a copy of this NOTICE OF OPPOSITION was served upon Applicant, Tradeflo LLC, on December 10, 2019 by email directed to:

Daniel Kokhba
dk@kokhbalaw.com

/Erin S. Hennessy/
Erin S. Hennessy

EXHIBIT 1

OPPOSER'S TRADE FLOW MARK

Mark	Goods/Services	Application Number	Registration Number
TRADE FLOW	<u>Class 35</u> : business consultation in the field of freight management, importing and exporting, and consolidation. <u>Class 39</u> : international freight forwarding, importing and exporting, and consolidation. <u>Class 42</u> : providing temporary use of on-line non-downloadable software for use in management of freight forwarding, importing and exporting, and consolidation.	78/198,299	2,875,646

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Mark: TRADE FLOW

US Serial Number: 78198299

Application Filing Date: Dec. 27, 2002

US Registration Number: 2875646

Registration Date: Aug. 17, 2004

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Aug. 13, 2014

Publication Date: Aug. 05, 2003

Notice of Allowance Date: Oct. 28, 2003

Mark Information

Mark Literal Elements: TRADE FLOW

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: providing temporary use of on-line non-downloadable software for use in management of freight forwarding, importing and exporting, and consolidation

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 13, 2003

Use in Commerce: Jun. 13, 2003

For: international freight forwarding, importing and exporting, and consolidation

International Class(es): 039 - Primary Class

U.S Class(es): 100, 105

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 13, 2003

Use in Commerce: Jun. 13, 2003

For: business consultation in the field of freight management, importing and exporting, and consolidation

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 13, 2003

Use in Commerce: Jun. 13, 2003

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Expeditors International of Washington Inc.

Owner Address: 1015 Third Avenue, 12th Floor
Seattle, WASHINGTON UNITED STATES 981041190

Legal Entity Type: CORPORATION

State or Country Where Organized: WASHINGTON

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Erin S. Hennessy

Attorney Primary Email Address: docketing@bgllp.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Erin S. Hennessy
Attorney of Record, WA state bar member
701 Fifth Avenue, Suite 6200
Seattle, WASHINGTON UNITED STATES 98104

Phone: 206-204-6200

Fax: 206-24-6262

Correspondent e-mail: docketing@bgllp.com erin.hennessy@bgllp.com ennifer.ashton@bgllp.com lily.hadley@bgllp.com edgar.cantu@bgllp.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 13, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Aug. 13, 2014	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68502
Aug. 13, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	68502
Aug. 13, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68502
Jul. 25, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 25, 2014	TEAS SECTION 8 & 9 RECEIVED	
Oct. 30, 2013	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Oct. 30, 2013	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Oct. 23, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76293
Oct. 23, 2009	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76293
Oct. 08, 2009	TEAS SECTION 8 & 15 RECEIVED	
Aug. 17, 2004	REGISTERED-PRINCIPAL REGISTER	
Jun. 13, 2004	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	

May 18, 2004	ASSIGNED TO EXAMINER	76745
May 17, 2004	STATEMENT OF USE PROCESSING COMPLETE	
May 06, 2004	USE AMENDMENT FILED	
May 06, 2004	TEAS STATEMENT OF USE RECEIVED	
Apr. 27, 2004	EXTENSION 1 GRANTED	
Apr. 27, 2004	EXTENSION 1 FILED	
Apr. 27, 2004	TEAS EXTENSION RECEIVED	
Oct. 28, 2003	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Aug. 05, 2003	PUBLISHED FOR OPPOSITION	
Jul. 16, 2003	NOTICE OF PUBLICATION	
Jun. 01, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 15, 2003	ASSIGNED TO EXAMINER	76745

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Aug. 13, 2014

EXHIBIT 2

APPLICANT'S MARK

Mark	Goods/Services	Application Number
TRADEFLO	<u>Class 36</u> : Trade finance advisory, consulting and broker services.	88/391,312

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Mark: TRADEFLO

Tradeflo

US Serial Number: 88391312

Application Filing Date: Apr. 18, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Published for Opposition

A pending trademark application has been examined by the Office and has been published in a way that provides an opportunity for the public to oppose its registration.

Status: A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Sep. 06, 2019

Publication Date: Aug. 13, 2019

Mark Information

Mark Literal Elements: TRADEFLO

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Trade finance advisory, consulting and broker services

International Class(es): 036 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 08, 2018

Use in Commerce: Jun. 25, 2018

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Tradeflo LLC

Owner Address: 5th Floor
1177 Ave. Of The Americas
New York, NEW YORK UNITED STATES 10036

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record - None Correspondent

Correspondent Name/Address: TRADEFLO LLC
1177 AVE. OF THE AMERICAS
5TH FLOOR
NEW YORK, NEW YORK UNITED STATES 10036

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 06, 2019	EXTENSION OF TIME TO OPPOSE RECEIVED	
Aug. 13, 2019	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 13, 2019	PUBLISHED FOR OPPOSITION	
Jul. 24, 2019	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 08, 2019	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 27, 2019	ASSIGNED TO EXAMINER	90330
May 04, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: BROOKSHIRE, DAVID AARO

Law Office Assigned: LAW OFFICE 114

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 11, 2019

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Extension of Time

Proceeding Number: [88391312](#)

Filing Date: Sep 06, 2019

Status: Extension of Time to Oppose Filed

Status Date: Sep 06, 2019

Interlocutory Attorney:

Defendant

Name: Tradeflo LLC

Correspondent Address: TRADEFLO LLC
1177 AVE. OF THE AMERICAS
5TH FLOOR
NEW YORK NY , 10036

Correspondent e-mail: abueno@trade-flo.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
TRADEFLO	Request For Extension of Time to File Opposition	88391312	
	Potential Opposer(s)		

Name: Expeditors International of Washington, Inc.

Correspondent ERIN S. HENNESSY

Address: BRACEWELL LLP
701 FIFTH AVE. STE. 6200
SEATTLE WA UNITED STATES , 98104

Correspondent e-mail: docketing@bracewell.com , erin.hennessy@bracewell.com , annie.allison@bracewell.com , heather.fox@bracewell.com

Prosecution History

Entry Number	History Text	Date	Due Date
1	FIRST 30-DAY REQUEST TO EXT TIME TO OPPOSE	Sep 06, 2019	
2	EXT GRANTED	Sep 06, 2019	
3	ADD'L 60-DAY REQUEST TO EXT TIME TO OPPOSE	Oct 11, 2019	
4	EXT GRANTED	Oct 11, 2019	