

ESTTA Tracking number: **ESTTA1044735**

Filing date: **03/25/2020**

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

Proceeding	91253508
Party	Defendant Figure Technologies, Inc.
Correspondence Address	JOHN L SLAFSKY WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050 UNITED STATES trademarks@wsgr.com 650-493-9300
Submission	Answer and Counterclaim
Filer's Name	John L. Slafsky
Filer's email	trademarks@wsgr.com
Signature	/John L. Slafsky/
Date	03/25/2020
Attachments	2020-03-25 Answer and Counterclaim.pdf(141139 bytes)

Registration Subject to the filing

Registration No.	2808868	Registration date	01/27/2004
Registrant	Provenance Wealth Advisors, LLC 200 Biscayne Boulevard,, 6th Floor Miami, FL 33131 UNITED STATES Email: trademark@patentmiami.com		

Goods/Services Subject to the filing

Class 036. First Use: 2003/02/07 First Use In Commerce: 2003/02/07

All goods and services in the class are requested, namely: financial and insurance consultation in the fields of investments and financial planning, [tax,] life insurance, investment annuities, mutual funds, deferred compensation, estate planning, business planning, charitable planning, retirement planning and registered investor advisory services and financial research, financial management and financial analysis in connection therewith

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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PROVENANCE WEALTH ADVISORS, LLC,)	
)	
Opposer,)	Opposition No. 91253508
v.)	
FIGURE TECHNOLOGIES, INC.,)	
)	
Applicant.)	
_____)	
FIGURE TECHNOLOGIES, INC.,)	
)	
Counterclaimant,)	
v.)	
PROVENANCE WEALTH ADVISORS, LLC,)	
)	
Registrant.)	
_____)	

ANSWER AND COUNTERCLAIM

Figure Technologies, Inc. (“Applicant” or “Counterclaimant”), through its undersigned attorneys, hereby submits this Answer and Counterclaim to the Notice of Opposition filed by Provenance Wealth Advisors, LLC (“Opposer” or “Registrant”) in Opposition No. 91253508 against U.S. Application Serial No. 88132410. Unless expressly admitted herein, each allegation contained in the Notice of Opposition is denied.

1. The allegations in Paragraph 1 of the Notice of Opposition call for a legal conclusion and therefore do not require a response.
2. Applicant denies the allegations of Paragraph 2 of the Notice of Opposition.
3. Applicant denies the allegations of Paragraph 3 of the Notice of Opposition.
4. Applicant denies the allegations of Paragraph 4 of the Notice of Opposition.

5. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 5 of the Notice of Opposition, and therefore denies the allegations.
6. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 6 of the Notice of Opposition, and therefore denies the allegations.
7. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 7 of the Notice of Opposition, and therefore denies the allegations.
8. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 8 of the Notice of Opposition, and therefore denies the allegations.
9. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 9 of the Notice of Opposition, and therefore denies the allegations.
10. The allegations in Paragraph 10 of the Notice of Opposition call for a legal conclusion and therefore do not require a response.
11. Applicant acknowledges Opposer has attached documents to its pleading as Exhibits A and B. Those documents speak for themselves.
12. Applicant acknowledges Opposer has attached documents to its pleading as Exhibits C-1-4. Those documents speak for themselves.
13. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 13 of the Notice of Opposition, and therefore denies the allegations.
14. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 14 of the Notice of Opposition, and therefore denies the allegations.
15. Applicant admits the allegations of Paragraph 15 of the Notice of Opposition.
16. Applicant admits the allegations of Paragraph 16 of the Notice of Opposition.
17. Applicant denies the allegations of Paragraph 17 of the Notice of Opposition.

18. Applicant admits information on its products and services is available on its website at <provenance.io> (“Applicant’s Website”). Applicant otherwise denies the allegations of Paragraph 18 of the Notice of Opposition.

19. Applicant admits it provides a platform based on blockchain technology in order to, among other things, originate, finance, and sell HELOCs (Home Equity Line of Credit) to banks, asset managers, and credit funds. Applicant otherwise denies the allegations of Paragraph 19 of the Notice of Opposition.

20. Applicant admits the whitepaper titled “Provenance: creating the future of finance” posted on Applicant’s Website includes the following statement: “Figure will expand its product set to include services such as banking and asset management, all of which will also exclusively use Provenance as ledger and registry.” Applicant otherwise denies the allegations of Paragraph 20 of the Notice of Opposition.

21. Applicant admits the whitepaper titled “Investment fund services on Provenance” posted on Applicant’s Website includes the following statement: “Our vision is to use Provenance to build an integrated ecosystem where issuers of securities, fund managers and investors all utilize a common blockchain ledger, registry and exchange to create unparalleled value.” Applicant otherwise denies the allegations of Paragraph 21 of the Notice of Opposition.

22. Applicant denies the allegations of Paragraph 22 of the Notice of Opposition.

23. Applicant denies the allegations of Paragraph 23 of the Notice of Opposition.

24. Applicant denies the allegations of Paragraph 24 of the Notice of Opposition.

25. Applicant admits that it has raised funding for its business. Applicant otherwise denies the allegations of Paragraph 25 of the Notice of Opposition.

26. Applicant lacks sufficient knowledge regarding Opposer's beliefs to admit or deny the allegations of Paragraph 26 of the Notice of Opposition, and therefore denies the allegations.

27. Applicant admits its goods and services may rely on blockchain technology. Applicant otherwise denies the allegations of Paragraph 27 of the Notice of Opposition.

28. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 28 of the Notice of Opposition, and therefore denies the allegations.

29. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 29 of the Notice of Opposition, and therefore denies the allegations.

30. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 30 of the Notice of Opposition, and therefore denies the allegations.

31. Applicant lacks information sufficient to admit or deny the allegations of Paragraph 31 of the Notice of Opposition, and therefore denies the allegations.

32. Applicant denies the allegations of Paragraph 32 of the Notice of Opposition.

FIRST COUNT – LIKELIHOOD OF CONFUSION

33. Applicant repeats its answers to Paragraphs 1 through 32 of the Notice of Opposition.

34. Applicant denies the allegations of Paragraph 34 of the Notice of Opposition.

35. Applicant denies the allegations of Paragraph 35 of the Notice of Opposition.

36. Applicant denies the allegations of Paragraph 36 of the Notice of Opposition.

37. Applicant denies the allegations of Paragraph 37 of the Notice of Opposition.

38. Applicant denies the allegations of Paragraph 38 of the Notice of Opposition.

SECOND COUNT – MARK IS MERELY DESCRIPTIVE

39. Applicant repeats its answers to Paragraphs 1 through 38 of the Notice of Opposition.

40. Applicant denies the allegations of Paragraph 40 of the Notice of Opposition.


First Affirmative Defense


41. The Notice of Opposition fails to set forth facts sufficient to entitle Opposer to the relief sought.

COUNTERCLAIM

42. Counterclaimant is Figure Technologies, Inc., a Delaware corporation in the business of providing digital asset management, transaction, and investment services to financial institutions.

43. Registrant is Provenance Wealth Advisors, LLC, a Florida limited liability company in the business of providing financial planning, estate planning, investment planning, retirement planning, and business succession planning services to business professionals and retirees.

44. Counterclaimant is informed and believes, and therefore alleges, that Registrant owns Registration No. 2,808,868 for the mark  PROVENANCE (the “Registration”). According to public records of the United States Patent and Trademark Office (“USPTO”), the current information regarding the Registration is as follows:

Registrant:	Provenance Wealth Advisors, LLC 
Mark:	<u>PROVENANCE</u> WEALTH ADVISORS
Last listed address:	200 Biscayne Boulevard, 6th Floor Miami, FLORIDA 33131
Registration date:	January 27, 2004

Correspondence
Information:

Robert M. Schwartz
ROBERT M. SCHWARTZ, P.A.
P.O. Box 221470
Hollywood, FLORIDA 33020

Services:

[F]inancial and insurance consultation in the fields of investments and financial planning, [tax,] life insurance, investment annuities, mutual funds, deferred compensation, estate planning, business planning, charitable planning, retirement planning and registered investor advisory services and financial research, financial management and financial analysis in connection therewith, in International Class 36.

45. Upon information and belief, Registrant has stopped using the mark in the Registration in connection with some or all of the listed services.

46. Upon information and belief, Registrant does not intend to resume use of the mark in the Registration in connection with some or all of the listed services.

47. Upon information and belief, the mark in the Registration has been abandoned.


48. Counterclaimant has been and will be damaged by the Registration because, among other reasons, Registrant has pled the Registration as a basis in the Notice of Opposition.

WHEREFORE, Counterclaimant prays that Registration No. 2,808,868 be cancelled and that this Counterclaim be sustained in favor of Counterclaimant.

Dated: March 25, 2020

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
A Professional Corporation

By: 
John L. Slafsky
Christine K. Au-Yeung

Attorneys for Applicant and Counterclaimant
FIGURE TECHNOLOGIES, INC.

Please address all communications concerning this proceeding to:

John L. Slafsky
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trademarks@wsgr.com

CERTIFICATE OF SERVICE

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050. I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action.

On this date, I served **ANSWER AND COUNTERCLAIM** on each person listed below, by forwarding the document(s) by electronic transmission on this date to the Internet email address listed below:

Robert M. Schwartz
Robert M Schwartz PA
litigation@patentmiami.com

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of documents for delivery according to instructions indicated above. In the ordinary course of business, documents would be handled accordingly.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on March 25, 2020.


Elvira Minjarez