

ESTTA Tracking number: **ESTTA1145964**

Filing date: **07/12/2021**

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	U.S. Department of Homeland Security Office Of The General Counsel
Granted to Date of previous extension	07/11/2021
Address	245 MURRAY LANE MAIL STOP 0205 WASHINGTON, DC 20528 UNITED STATES
Attorney information	ANNE STERBA DHS OFFICE OF THE GENERAL COUNSEL 245 MURRAY LANE MAIL STOP 0205 WASHINGTON, DC 20528 UNITED STATES Primary Email: anne.sterba@hq.dhs.gov Secondary Email(s): megan.smith1@associates.hq.dhs.gov, michelle.mccummings@associates.hq.dhs.gov, mary.klumpp@hq.dhs.gov (202) 254-8918
Docket Number	

Applicant Information

Application No.	90107305	Publication date	01/12/2021
Opposition Filing Date	07/12/2021	Opposition Period Ends	07/11/2021
Applicant	Consova Corporation 143 UNION BLVD STE 800 143 UNION BLVD STE 800 LAKEWOOD, CO 80228 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Corporate identity services; Employmentverification
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Electronic signature verification services using technology to authenticate user identity
Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Verification of personal identity as part of

personal background investigations


Grounds for Opposition

Priority and likelihood of confusion

Trademark Act Section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	5880216	Application Date	05/15/2019
Registration Date	10/08/2019	Foreign Priority Date	NONE
Word Mark	E-VERIFY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/09/25 First Use In Commerce: 2007/09/25 Employment verification Class 045. First use: First Use: 2007/09/25 First Use In Commerce: 2007/09/25 Identification verification services, namely, providing authentication of personal identification information via secure storage and transmitting such information via the Internet		

U.S. Registration No.	3490747	Application Date	03/22/2007
Registration Date	08/19/2008	Foreign Priority Date	NONE
Word Mark	E-VERIFY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/09/25 First Use In Commerce: 2007/09/25 Employment verification		

	Class 045. First use: First Use: 2007/09/25 First Use In Commerce: 2007/09/25 Identification verification services, namely, providing authentication of personal identification information via secure storage and transmitting such information via the Internet		
U.S. Registration No.	3980919	Application Date	10/05/2010
Registration Date	06/21/2011	Foreign Priority Date	NONE
Word Mark	E-VERIFY		
Design Mark			
Description of Mark	The mark consists of the stylized wording "E-Verify", with the "E" appearing in red on a white background, a hyphen in black, and the stylized word "Verify" appearing in blue. There is also a stylized United States Flag in red, white and blue, with wavy, horizontal lines comprising the first letter "E" in the mark.		
Goods/Services	Class 035. First use: First Use: 2007/07/31 First Use In Commerce: 2007/07/31 Employment verification Class 045. First use: First Use: 2007/07/31 First Use In Commerce: 2007/07/31 Identification verification services, namely, providing authentication of personal identification information via secure storage and transmitting such information via the Internet		

Attachments	88431203#TMSN.png(bytes) 77137894#TMSN.png(bytes) 85144974#TMSN.png(bytes) Signed NOO for IVERIFYPRO 07-12-2021.pdf(165855 bytes)
-------------	---

Signature	/Anne M. Sterba/
Name	Anne Sterba
Date	07/12/2021

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

In the matter of Trademark Application: 90/107,305
For the mark: IVERIFYPRO
Filing Date: August 11, 2020
Published in the *Official Gazette* on: January 12, 2021

UNITED STATES DEPARTMENT OF)
HOMELAND SECURITY,)
)
Opposer,)
)
v.)
)
Consova Corporation,)
)
Applicant.)

NOTICE OF OPPOSITION

The United States Department of Homeland Security (“DHS”) with an address at 245 Murray Lane, Mail Stop 0205, Washington, DC 20528, a federal agency of the United States of America (“Opposer”) believes that it will be damaged by registration of the trademark IVERIFYPRO (the “Opposed Mark”) for use in connection with “[c]orporate identity services; Employment verification” in International Class 35, “[e]lectronic signature verification services using technology to authenticate user identity” in International Class 42, and “[v]erification of personal identity as part of personal background investigations” in International Class 45 (the “Identified Services”), as set forth in Application Serial No. 90/107,305 (the “Application”), filed on August 11, 2020 by Consova Corporation, a corporation organized under the laws of Colorado, and having an address of 143 Union Blvd, Ste. 800, Lakewood, Colorado 80228 (“Applicant”). The Application was published for opposition on January 12, 2021. As grounds for this opposition, Opposer alleges that:

1. Since at least as early as September 25, 2007, Opposer has used the trademark E-VERIFY (the “E-VERIFY Mark”) in connection with, *inter alia*, employment and identification services.

2. In addition to owning common law trademark rights in and to the E-VERIFY Mark, Opposer owns the following trademark registrations at the U.S. Patent and Trademark Office:

- i. Reg. No. 5,880,216 for the trademark E-VERIFY, covering “Employment verification” in Class 35, and “Identification verification services, namely, providing authentication of personal identification information via secure storage and transmitting such information via the Internet” in Class 45, registered on October 8, 2019, asserting a date of first use on September 25, 2007;
- ii. Reg. No. 3,490,747 on the supplemental register for the trademark E-VERIFY, covering “Employment verification” in Class 35, and “Identification verification services, namely, providing authentication of personal identification information via secure storage and transmitting such information via the Internet” in Class 45, registered on August 19, 2008, asserting a date of first use of September 25, 2007; and
- iii. Reg. No. 3,980,919 for the trademark E-VERIFY & Design, covering “Employment verification” in Class 35, and “Identification verification services, namely, providing authentication of personal identification information via secure storage and transmitting such information via the Internet” in Class 45, registered on June 21, 2011, asserting a date of first use of July 31, 2007.

3. By virtue of the uncompromising and prestigious quality of DHS's services provided, advertised and promoted under the E-VERIFY Mark and by virtue of the extensive promotion and advertising of such high-quality services for more than thirteen (13) years, the E-VERIFY Mark has become well-known and has acquired extensive recognition and strength throughout the United States.

4. The Opposed Mark is confusingly similar to Opposer's E-VERIFY Mark in terms of sight, sound, meaning and overall commercial impression.

5. The Application identifies services that are closely related to the services Opposer provides under its E-VERIFY Mark. Upon information and belief, Applicant offers or intends to offer the Identified Services under the Opposed Mark.

6. Upon information and belief, Opposer's date of first use in commerce for the E-VERIFY Mark predates Applicant's earliest available priority date for the Opposed Mark. Applicant filed the Application based on an intent-to-use the Opposed Mark.

7. The Opposed Mark so closely resembles Opposer's E-VERIFY Mark that its use in connection with the Identified Services is likely to cause confusion, or to cause mistake or deceive consumers, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1152(d). Consumers of Applicant's services in the United States likely will assume that Opposer is somehow affiliated with, licenses, or endorses Applicant's use of the Opposed Mark when Opposer is not connected in any way with Applicant.

8. Opposer is not affiliated with Applicant or the Identified Services, nor has Opposer endorsed or sponsored Applicant or its Identified Services. Opposer is not connected to Applicant or the Identified Services in any way whatsoever.

9. Opposer has no control over the nature and quality of Applicant's Identified Services and any deficiency, objection, or fault found in connection with such services marketed under the Opposed Mark would necessarily reflect upon the reputation Opposer has established for the quality of services offered under the E-VERIFY Mark.

10. Registration of the Opposed Mark will be inconsistent with Opposer's rights in the E-VERIFY Mark and will damage Opposer.

WHEREFORE, Opposer prays that the Trademark Trial and Appeal Board will sustain this opposition and refuse registration of the Application.

Respectfully submitted,

By: /Anne M. Sterba/
Anne Sterba
Attorney for Opposer
Attorney Advisor, Intellectual Property
Office of the General Counsel
Department of Homeland Security
245 Murray Lane, Mail Stop 0205
Washington, D.C. 20528
202-924-2863
Anne.Sterba@hq.dhs.gov

Date: 7/12/2021