

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

RE: U.S. Trademark Application Serial No. 76/388,618
Published in the Official Gazette on March 4, 2003

ASSOCIATION FOR INVESTMENT)
MANAGEMENT AND RESEARCH (AIMR))

Opposer)

-v-)

CHARITABLE ALLIANCE GROUP, LLC)

Applicant)

Attorney Docket No. 033281-361)

Opposition No. _____

TRADEMARK TRIAL AND APPEAL BOARD
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06-02-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #39

NOTICE OF OPPOSITION

Commissioner for Trademarks
BOX TTAB
2900 Crystal Drive
Arlington, VA 22202-3513

Commissioner:

In the matter of Application Serial No. 76/388,618 filed March 28, 2002 by Charitable Alliance Group, LLC ("Applicant"), to register the mark C.F.C.A. for "providing training in the area of financial planning techniques between donors and charities" in International Class 41 ("Applicant's Services"), which was published in the Official Gazette on March 4, 2003, Association for Investment Management and Research ("Opposer") of Charlottesville, Virginia believes it will be damaged by the registration of the C.F.C.A. mark and opposes same. The grounds for this opposition are as follows:

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1. Applicant is a Limited Liability Corporation of Delaware having a business address of 1100 Cambridge Lane, Newport Beach, California 92660. Applicant filed Application Serial No. 76/388,618 for the mark C.F.C.A. for Applicant's Services identifying

Applicant's alleged use of the mark anywhere as January 5, 2002 and alleged first use in commerce as March 15, 2002.

2. Applicant's filing of Application Serial No. 76/388,618 for **C.F.C.A.** is without license, authorization or permission from Opposer.

3. Commencing long prior to Applicant's date of first use and filing date, Opposer has been continuously engaged and is now engaged in rendering association services, namely, the promotion of interest and professional standards in the field of financial analysts; the certification of individuals in their knowledge of financial analysis services; educational services, namely, arranging, conducting and providing courses of instruction, workshops, seminars and conferences in the field of financial analysis and distributing course materials in connection therewith; and printed materials for use in connection with the foregoing services ("Opposer's Services and related goods").

4. Founded in January 1990, Opposer is the successor in interest to the Institute of Chartered Financial Analysts ("ICFA"). The ICFA was founded in 1959 to examine candidates and award the Chartered Financial Analyst ("CFA") designation. On June 1, 1999, the ICFA and the Financial Analysts Federation ("FAF") was merged into the Association for Investment Management and Research ("Opposer") and all property and good will owned by the ICFA and the FAF was transferred to Opposer.

5. Opposer is the owner of, and relies upon, the following Federal trademark registrations, as well as the common law rights it has obtained through long prior and continuous use of the CFA mark in commerce:

REGISTRATION NO.	MARK	GOODS/SERVICES
935,504	C.F.A.	Association services, namely, the promotion of interest and professional standards in the field of financial analysts

REGISTRATION NO.	MARK	GOODS/SERVICES
2,493,899	CFA	educational services, namely, arranging, conducting and providing courses of instruction, workshops, seminars and conferences in the field of financial analysis and distributing course materials in connection therewith
2,495,459	CFA	printed publications in the field of financial analysis and in support of the interests of financial analysts
2,580,663	CFA THE INSTITUTE OF CHARTERED FINANCIAL ANALYSTS and Design	printed publications in the field of financial analysis and support in the interests of financial analysts
2,661,114	CFA CHARTERED FINANCIAL ANALYST and Design	financial analysis services

Opposer's registrations are not limited by channels of trade or classes of purchasers. Opposer's Registration No. 935,504 is valid, subsisting and incontestable pursuant to 15 U.S.C. § 1065, and is conclusive evidence of the validity of the registered mark, the registration of the mark, Opposer's ownership of the mark, and Opposer's exclusive right to use the C.F.A. Mark in connection with the services specified in the registration. Opposer's Registration Nos. 2,493,899; 2,495,459; 2,580,663; and 2,661,114 are valid and subsisting, and are *prima facie* evidence of the validity of the registered marks, the registration of the marks, Opposer's ownership of the marks, and Opposer's exclusive right to use the registered marks in connection with the goods/services specified in the registrations. The above marks as used and registered are hereinafter referred to as "Opposer's CFA Marks".

6. Commencing long prior to Applicant's filing date and alleged date of first use, Opposer has used, and is now using Opposer's CFA Marks in connection with services pertaining to the field of financial analysis and printed matter related thereto.

7. Since its initial use of Opposer's CFA Marks, Opposer has made a substantial investment in advertising and promoting Opposer's Services and related goods under its CFA Marks. Opposer has extensively used, advertised, promoted, and offered Opposer's Services and related goods to the public through various channels of trade in commerce. Opposer's customers and the public in general know and recognize Opposer's CFA Marks and associate same with Opposer and/or Opposer's Services and related goods. Opposer has built extensive fame and goodwill in connection with the rendering of services under Opposer's CFA Marks.

**FIRST GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - COMMON LAW)**

8. Opposer realleges the allegations contained in paragraphs 1 through 7 of this Notice of Opposition.

9. Applicant's C.F.C.A. mark is a simulation and colorable imitation of, and so resembles Opposer's CFA Marks as to be likely, when applied to the services of Applicant, to cause confusion or mistake or to deceive customers resulting in damage and detriment to Opposer and its reputation.

10. Applicant's date of first use anywhere claimed in Application Serial No. 76/388,618, January 5, 2002, is subsequent to Opposer's date of first use of the CFA Marks, September 15, 1963. As such, priority is not an issue in this proceeding.

11. Opposer's and Applicant's services and goods related thereto are closely related and overlapping, will be offered and rendered through the same channels of trade and purchased and consumed by the same class of purchasers.

12. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation and sponsorship of Applicant's services rendered and marketed under Applicant's C.F.C.A. mark and misled into believing that such

services are rendered by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

13. Opposer will be damaged by the registration by Applicant of the C.F.C.A. mark as set forth in Application Serial No. 76/388,618, in that the mark is substantially similar to Opposer's CFA Marks and Opposer's common law rights to the CFA Marks, and that the C.F.C.A. mark is being used in connection with services identical and/or similar to Opposer's services and goods.

14. Applicant's registration of the C.F.C.A. mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer in Opposer's CFA Marks.

**SECOND GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - FEDERAL)**

15. Opposer realleges the allegations contained in paragraphs 1 through 14 of this Notice of Opposition.

16. Applicant's C.F.C.A. mark is a simulation and colorable imitation of, and so resembles Opposer's CFA Marks as registered as to be likely, when applied to the services of Applicant, to cause confusion or mistake or to deceive customers resulting in damage and detriment to Opposer and its reputation.

17. Applicant's date of first use anywhere claimed in Application Serial No. 76/388,618, January 5, 2002, is subsequent to the registration date of U.S. Reg. No. 935,504, June 6, 1972; and Opposer's date of first use of the CFA Mark, September 15, 1963. Applicant's date of first use is also subsequent to the filing dates of all of Opposer's pleaded registrations. As such, priority is not an issue in this proceeding.

18. Opposer's and Applicant's services and goods related thereto are closely related and overlapping, will be offered and rendered through the same channels of trade and purchased and consumed by the same class of purchasers.

19. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation and sponsorship of Applicant's services rendered and marketed under Applicant's C.F.C.A. mark and misled into believing that such services are rendered by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

20. Opposer will be damaged by the registration by Applicant of the C.F.C.A. mark as set forth in Application Serial No. 76/388,618, in that the mark is substantially similar to Opposer's CFA Marks and Opposer's Federal rights to the CFA Marks, and that the C.F.C.A. mark is being used in connection with services identical and/or similar to Opposer's services.

21. Applicant's registration of the C.F.C.A. mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer in Opposer's CFA Marks.

THIRD GROUND FOR OPPOSITION (DILUTION)

22. Opposer realleges the allegations contained in paragraphs 1 through 21 of this Notice of Opposition.

23. Opposer's CFA Marks, as aforesaid, are distinctive and famous, and are inherently distinctive, or in the alternative had acquired distinctiveness, and had acquired fame, prior to the filing date of Application Serial No. 76/388,618, and prior to any date of first use of the C.F.C.A. mark that could be claimed by Applicant.

24. Opposer, upon information and belief, avers it will be damaged by Applicant's registration of the C.F.C.A. mark as set forth in Application Serial No. 76/388,618, in that the mark causes dilution of the distinctive quality of Opposer's CFA Marks as a unique indicator of source in connection with the services offered to the public by Opposer.

25. Opposer would be damaged if Application Serial No. 76/388,618 is granted because Applicant will obtain statutory rights in the C.F.C.A. mark in violation and derogation of the established prior rights of Opposer in Opposer's CFA Marks.

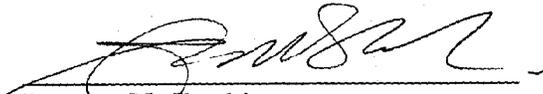
WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 76/388,618 be rejected and that the registration of C.F.C.A. as a service mark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

ASSOCIATION FOR INVESTMENT
MANAGEMENT AND RESEARCH (AIMR)

Date:

6/02/2003


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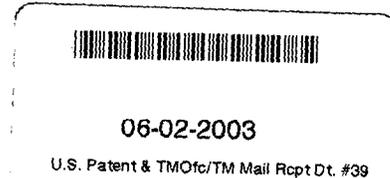
-v-)

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Attorney Docket No. 033281-361)

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COMMUNICATION

Commissioner for Trademarks
BOX TTAB
2900 Crystal Drive
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Dear Commissioner:

Enclosed for filing is an original and two copies of the Notice of Opposition and a check in the amount of \$300.00 to cover the government filing fee. The Commissioner is hereby authorized to credit any overpayment or charge any deficiencies in payment to Deposit Account No. 02-4800 referencing Attorney Docket No. 010752-047.

Respectfully submitted

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Date: 6/02/2003