

ESTTA Tracking number: **ESTTA224067**

Filing date: **07/14/2008**

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	FTI Consulting, Inc.
Granted to Date of previous extension	07/13/2008
Address	900 Bestgate Road Suite 100 Annapolis, MD 21401 UNITED STATES

Attorney information	Ann K. Ford DLA Piper US LLP 500 Eighth Street NW Washington, DC 20004 UNITED STATES ann.ford@dlapiper.com, Ryan.Compton@dlapiper.com, David.Huff@dlapiper.com, dctrademarks@dlapiper.com Phone:2027994000
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Applicant Information

Application No	77241109	Publication date	01/15/2008
Opposition Filing Date	07/14/2008	Opposition Period Ends	07/13/2008
Applicant	Porter Novelli, Inc. 450 Lexington Avenue New York, NY 10017 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: PUBLIC RELATION SERVICES, PUBLICITY AGENCY SERVICES, BUSINESS MANAGEMENT CONSULTING, BUSINESS MARKETING CONSULTING, MARKET RESEARCH; PROVIDING INFORMATION IN THE FIELDS OF PUBLIC RELATIONS, BUSINESS MANAGEMENT AND BUSINESS MARKETING BY MEANS OF A GLOBAL COMPUTER NETWORK

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	77309556	Application Date	10/22/2007
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COMPASS LEXECON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: Management, business consulting and economic consulting services Class 036. First use: Financial analysis and consultation; business and security valuations; and economic analysis in connection with acquisitions, mergers and business strategy Class 042. First use: Legal services, namely litigation support, providing public policy studies, and providing expert witness testimony in business and commercial areas		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	COMPASS		
Goods/Services	Management, business consulting and economic consulting services		

Attachments	77309556#TMSN.jpeg (1 page)(bytes) 109.pdf (6 pages)(791030 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Ann K. Ford/
Name	Ann K. Ford
Date	07/14/2008

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

In the matter of Service Mark
Application Serial No. 77/241,109
Filing Date: July 27, 2007
Mark: COMPASSNET and Design
Published for Opposition: January 15, 2008

FTI CONSULTING, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
PORTER NOVELLI, INC.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, FTI Consulting, Inc., (hereinafter "FTI Consulting"), believes that it is or will be damaged by U.S. federal intent-to-use trademark application Serial No. 77/241,109 filed with the U.S. Patent and Trademark Office on July 27, 2007 by Applicant, Porter Novelli, Inc. (hereinafter "Applicant"), for the service mark COMPASSNET and Design in connection with "public relation services, publicity agency services, business management consulting, business marketing consulting, market research; providing information in the fields of public relations, business management and business marketing by means of a global computer network" in International Class 35. FTI Consulting hereby opposes the Application.

As grounds for the Opposition, it is alleged that:

1. FTI Consulting, Inc. is a Maryland corporation with a principal place of business at 900 Bestgate Road, Suite 100, Annapolis, Maryland 21401.

2. FTI Consulting has long-established rights in its COMPASS trademarks, including in its current combined incarnation as COMPASS LEXECON, for which it has filed U.S. federal trademark application Serial No. 77/309,556. FTI uses its COMPASS LEXECON mark in connection with, among other things, management, business consulting and economic consulting services; financial analysis and consultation; business and security valuations; and economic analysis in connection with acquisitions, mergers and business strategy; legal services, namely litigation support, providing public policy studies, and providing expert witness testimony in business and commercial areas and related goods and services.

3. Further, FTI Consulting (and its predecessors-in-interest) have used the COMPASS mark in the United States extensively and continuously, since at least as early as January 2003. A mark or trade name previously used in the United States by another and not abandoned can serve as the basis for the refusal of registration of a junior user's mark even if mark has not been registered by the senior user. *See* Trademark Manual of Examining Procedure (TMEP) § 1207.03. Therefore, FTI Consulting's extensive and continuous prior use of the COMPASS mark should bar Applicant's registration of a mark identical or confusingly similar to the COMPASS mark.

4. Despite FTI Consulting's use of the COMPASS mark prior to Applicant's filing date of July 27, 2007, Applicant filed an intent-to-use Application for registration of the service mark COMPASSNET and Design. Said application was assigned Serial No. 77/241,109.

5. Applicant's COMPASSNET and Design service mark, as shown in the Application, is confusingly similar to FTI Consulting's COMPASS and COMPASS LEXECON service marks, and the respective services of the parties are identical and/or substantially related, and are or would normally be marketed within the same or similar channels of trade, and to the

same class of consumers, with the result that FTI Consulting's consumers, the trade and the public in general, are likely to be confused, mistaken or deceived as to the origin and/or sponsorship of Applicant's services under the COMPASSNET and Design service mark, and misled into believing that such services are marketed by, or are in some way directly or indirectly associated with the services offered by FTI Consulting, thus resulting in damage and detriment to FTI Consulting and its reputation and goodwill.

6. In view of the similarity of the respective marks and the similar or related nature of the services of the respective parties, Applicant's mark so resembles FTI Consulting's service mark, as to be likely to cause confusion and mistake, deceive the public, injure and damage FTI Consulting and the goodwill and reputation symbolized by FTI Consulting's COMPASS service mark, and raise a considerable risk of consumer confusion as to the affiliation of FTI Consulting and Applicant. Applicant's mark and the Application are also diluting or will dilute the distinctiveness of FTI Consulting's service mark and the goodwill associated therewith in violation of 15 U.S.C. 1125(c).

7. Further, upon information and belief, Applicant solely uses the term COMPASSNET and Design to refer to a proprietary tool used internally on behalf of its clients. The COMPASSNET and Design mark is not used or intended to be used in association with a product or service offered to its clients. As Applicant's use of the COMPASSNET and Design mark is not a *bona fide* trademark use, FTI Consulting contends that Applicant does not have a bona fide intent to use the COMPASSNET and Design mark in interstate commerce and thus, the COMPASSNET and Design mark should not be entitled to registration. *See* TMEP § 1202.06(b) ("If the...applicant uses the mark only on items incidental to conducting its own business, as

opposed to items intended to be used by others, the examining attorney should refuse registration on the Principal Register...”).

8. If Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, it will obtain at least a *prima facie* exclusive right to use its alleged mark, and FTI Consulting will be subjected to great and irreparable damage, and Applicant will enjoy unlawful gain, and advantage to which it is not entitled under the Trademark Act of 1946.

WHEREFORE, FTI Consulting believes and avers that it is being, and will continue to be, damaged by registration of the COMPASSNET and Design service mark, and prays that said U.S. Application Serial No. 77/241,109 be rejected, that no registration be issued thereon to Applicant, and that the Opposition be sustained in favor of FTI Consulting.

FTI Consulting hereby appoints Ann K. Ford, Esq., a member of the Bar of the District of Columbia, Thomas E. Zatic, a member of the Bar of the District of Columbia, Ryan C. Compton, a member of the Bar of the District of Columbia, and Jennifer A. Zador, a member of the Bar of Columbia and all of the law firm of DLA Piper US LLP, 500 8th Street N.W., Washington, D.C. 20004, telephone number (202) 799-4000, to transact all business in the Patent and Trademark Office in connection with the above opposition proceeding and hereby revokes all previous powers of attorney herein.

Please address all correspondence to:

Ann K. Ford, Esq.
DLA Piper US LLP
500 8th Street N.W.
Washington, DC 20004
dctrademarks@dlapiper.com

The filing fee for this opposition, in the amount of \$300.00, is hereby electronically transferred with the submission of the Notice of Opposition.

FTI CONSULTING, INC.

By: 

Ann K. Ford
Thomas E. Zutic
Ryan C. Compton
DLA Piper US LLP
500 8th Street N.W.
Washington, DC 20004
(202) 799-4000

Attorneys for Opposer

Dated: 7/14/08

CERTIFICATE OF SERVICE

I, RYAN C. COMPTON, do hereby certify that I have, this 14th day of July, 2008, served a copy of the foregoing NOTICE OF OPPOSITION against Porter Novelli, Inc. via U.S. First Class Mail, postage prepaid, and addressed to:

David A. Weems, Esq.
Davis & Gilbert, LLP
1740 Broadway, Floor 3
New York, New York 10019-4379


Ryan C. Compton
Attorney for Opposer