

ESTTA Tracking number: **ESTTA420910**

Filing date: **07/20/2011**

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	Lighthouse Capital Group		
Entity	Corporation	Citizenship	California
Address	622 Santiago Ave. Long Beach, CA 90814 UNITED STATES		

Attorney information	David E. Barker Collins Collins Muir + Stewart LLP 1100 El Centro St. South Pasadena, CA 91030 UNITED STATES dbarker@ccmslaw.com Phone:626-243-1100		
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Applicant Information

Application No	85178171	Publication date	07/12/2011
Opposition Filing Date	07/20/2011	Opposition Period Ends	08/11/2011
Applicant	Paramount Equity Mortgage 8781 sierra college blvd roseville, CA 95661 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2009/08/18 First Use In Commerce: 2009/08/18 All goods and services in the class are opposed, namely: Mortgage banking; Mortgage brokerage; Mortgage lending

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. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GO GREEN LENDING		
Goods/Services	IC 036: real estate lending services, financing of real estate developments, mortgage lending, mortgage procurement for others, matching borrowers with potential lenders in the field of mortgage lending		

Attachments	NOTICE OF OPPOSITION.pdf (5 pages)(198083 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	/David E. Barker/
Name	David E. Barker
Date	07/20/2011

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

In the matter of trademark application Serial No. 85178171

For the mark Go Green Refi

Published in the Official Gazette on July 12, 2011

Light House Capital Group

v.

Paramount Equity Mortgage

NOTICE OF OPPOSITION

Lighthouse Capital Group, California

622 Santiago Avenue, Long Beach, California 90814

The above-identified opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

Lighthouse Capital, Inc. dba Go Green Lending opposes the application for federal trademark registration submitted by Paramount Equity Mortgage ("Paramount") under serial number 85178171. The mark at issue is a standard character mark for the words "Go Green Refi". This opposition is made under 15 USC §1052(d).

On February 27, 2011 the examining attorney issued an Office Action refusing registration of the applied for mark under the theory that the mark was only descriptive (Section 2(e)(1) refusal). That refusal to register was ultimately withdrawn on May 25, 2011. However, before the refusal was withdrawn, on April 29, 2011 the applicant (Paramount) replied to the office action. In the reply, Paramount states "others in the industry do not use the term as a descriptive reference for mortgage banking, brokerage

and lending services". This is not the case, and Paramount is aware that there are competing marks in use in the marketplace covered by International Class 36.

1. Go Green Lending has been using the mark for over two years

Lighthouse Capital, Inc.¹ ("Lighthouse") filed a fictitious business name in Los Angeles County California as "Go Green Lending" on March 16, 2009 (filed with Los Angeles County Recorder's office as document number 20090374533). At that time, Lighthouse began using the name Go Green Lending in commerce through extensive advertising, including print and video advertising, Lighthouse has been using the name Go Green Lending continuously since that time to market its services of: real estate lending services, financing of real estate developments, mortgage lending, mortgage procurement for others, matching borrowers with potential lenders in the field of mortgage lending. The use by Lighthouse can be seen at the internet web page of <http://www.gogreenlending.com>.

2. Go Green Lending has California registered mark

California is one of approximately 30 states to adopt the Model State Trademark Law. On May 27, 2009 Lighthouse registered the service mark of Go Green Lending with the California Secretary of state as Service Mark Registration No. 65518. The registration form provided by the California Secretary of State indicates, as substantiated above, that Lighthouse began use of the mark "Go Green Lending" on March 10, 2009. The registration form with the California Secretary of State also states that the Class Number for registration is Class 36. Cal. Bus & Prof. Code §14235 directs that the California Secretary of State is to use the same classification scheme as adopted by the United State Patent and Trademark Office. Further, Cal. Bus. & Prof. Code §14272 states "The intent of this chapter is to provide a system of state trademark registration and protection substantially consistent with the federal system of trademark registration and protection under the Trademark Act of 1946 (15 U.S.C. Sec. 1051 et seq.), as amended. To that end, the construction given the federal act should be examined as nonbinding authority for interpreting and construing this chapter."

3. The Applicant is aware of the competing marks

On December 21, 2010 Lighthouse, through its counsel, wrote to Paramount informing Paramount of the existence of the California registration, and of Lighthouse's extensive use of the deceptively similar "Go Green Lending". On January 13, 2011 Counsel for

¹ Lighthouse operates under Lighthouse Capital, Inc. and its related entities, including but not limited to, Light House Capital Group.

Paramount, Mr. Richard Kirkpatrick, responded to counsel for Lighthouse. The December 21, 2010 letter from counsel for Lighthouse, among other things, pointed out the potential confusion that could arise to consumers through the terms “Refi” as in the application and “Lending” as used by Lighthouse. Particularly important in this consideration is the fact that both the Applicant and Lighthouse use the respective marks in the same class. Conspicuously missing from the January 13, 2011 response by Paramount is any actual recognition that these two businesses compete in the same Class and for consumers searching for the same services. As attachments 3 and 4 to the examining attorney’s February 27, 2011 office action recognize, the term “refi” refers to mortgage lending. That is the exact class that Lighthouse has registered under for its California registration and is the class being sought by Applicant here.

4. Confusion is likely to occur

The standard to apply is whether confusion is likely to occur. 15 USCA §1052(d). “[I]t is not the possibility or even the ease of distinguishing the marks which governs. The statute prohibits the registration of a mark (Sec. 2(d), 1946 Act) which, when applied to the goods of the applicant, is likely to cause confusion, mistake or deception of purchasers. It is not a question of whether people will confuse the marks but of whether the marks will confuse people.” Columbian Steel Tank Co. v. Union Tank & Supply Co., 47 C.C.P.A. 898 , 903; 277 F.2d 192, 196 (1960). When evaluating the potential for confusion, the considerations include: the nature of the potential purchasers, the nature of the services offered, and the means of marketing or selling those services. Each of these issues are addressed below.

a. The Nature of the Purchasers

Among the elements to be considered in evaluating the potential for confusion is the type of persons who will be making the purchase. Durox Co. v. Duron Paint Mfg. Co., 320 F.2d 882 (1963). Whereas connoisseurs of fine cigars may be able to distinguish between companies manufacturing cigars (General Cigar CO. v. Allied Cigar Corp., 48 C.C.P.A. 1032; 289 F.2d 958 (1961)); individuals searching for services to assist them with refinancing their homes, or to assist them in obtain loans related to environmentally sound construction practices tend to be focused on issues such as principal, interest rates, term, and fees – not the particular name of the company that is providing the service of putting the purchaser together with the financial institution.

b. The nature of the services offered

Lighthouse, through Go Green Lending, and Paramount, through Go Green Refi offer the exact same services. Both marks are intended to lead purchasers to a service designed to pair individuals seeking environmentally conscientious financing options to lenders offering such financial products. In W.B. Roddenberg Co. v. Kalich, 34 C.C.P.A. 745; 158 F.2d 289 (1946) the Court held that lettuce on the one hand was similar enough to pickles, cane syrup and peanut butter on the other hand to refuse a registration. There the Court said “there must ‘be enough disparity in character between the goods of the first and second users as to insure against confusion’” (citing to California Packing Corporation v. Tillman & Bendel, Inc., 17 C.C.P.A. 1048, 40 F.3d 108). There is NO disparity between the services of Paramount and those of Lighthouse here. The class of both services is the same – matching individuals who want lending with a particular emphasis (environmental concerns) to those lending institutions that provide such financial products. The average consumer would undoubtedly run a high probability of confusion between Go Green Lending and Go Green Refi.

c. Both Services are sold through the same channels

In today’s day and age consumers turn to the internet to find the services they are looking for. Unlike decades past when financial matters were all handled through trusted professionals at banks; today the internet abounds with services to match financial institutions with customers. Both Lighthouse and Paramount offer their services on the internet. Even for those consumers that may go to a bank to discuss the delicate matters of personal finances; the banker will turn to the internet to find the information they need.

5. Go Green Refi should be rejected

Lighthouse has been using the Go Green Lending mark for over two years. Paramount began its marketing efforts in the last 10 months. Lighthouse took the step of registering its use of the mark with the State of California (where both companies are based and sell their services). Lighthouse contacted Paramount to express the concern over Paramount’s use of the deceptively similar name. Paramount refuses to see the potential for confusion. This opposition lays out all of the elements to show that Paramount is attempting to edge in on what Lighthouse has already done. Paramount’s efforts are clearly aimed not only at the same services, but the same customers, that Lighthouse is already serving. The marks are confusingly similar when considered, as they must, in their totality and in light of the elements set forth above.

For the reasons stated herein, Lighthouse respectfully requests that the application be rejected for registration.

By:  _____

David E. Barker
Collins Collins Muir + Stewart
Attorneys for Lighthouse Capital

Date 7/20/11 _____