

ESTTA Tracking number: **ESTTA731609**

Filing date: **03/07/2016**

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	Utopia Management, Inc.		
Entity	Corporation	Citizenship	California
Address	4617 Ruffner Street San Diego, CA 92111-2285 UNITED STATES		

Attorney information	Rob G. Leach Charmasson, Buchaca & Leach, LLP 2635 Camino Del Rio South, Suite 102 San Diego, CA 92108 UNITED STATES rob@charmasson.com, adri@charmasson.com Phone: 619-294-2922		
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Applicant Information

Application No	86711972	Publication date	02/16/2016
Opposition Filing Date	03/07/2016	Opposition Period Ends	03/17/2016
Applicant	Jonathan Hursh 809 Pinon Avenue Millbrae, CA 94030 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Design, development, and consulting services in the fields city and slums design, urbanization, architecture, and urbanplanning for humanitarian purposes
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Grounds for Opposition

Disparaging	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)
Dilution by tarnishment	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3215579	Application Date	05/02/2006
Registration Date	03/06/2007	Foreign Priority	NONE

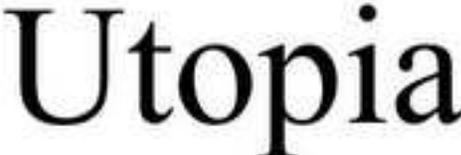
		Date	
Word Mark	UTOPIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1992/08/00 First Use In Commerce: 1992/08/00 Real estate property management services; real estate brokerage services; leasing of real estate; and mortgage brokerage Class 037. First use: First Use: 1992/08/00 First Use In Commerce: 1992/08/00 Building maintenance and repair of commercial and residential property		

U.S. Registration No.	4789464	Application Date	12/11/2014
Registration Date	08/11/2015	Foreign Priority Date	NONE
Word Mark	UTOPIA MANAGEMENT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2014/06/01 First Use In Commerce: 2014/06/01 Administrative hotel management; Business management of hotels for others; Hotel management for others		

U.S. Registration No.	2205587	Application Date	10/03/1997
Registration Date	11/24/1998	Foreign Priority Date	NONE
Word Mark	UTOPIA MANAGEMENT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1992/08/00 First Use In Commerce: 1992/08/00		

	real estate management, brokerage, acquisition, leasing and financing services		
U.S. Registration No.	4378693	Application Date	06/18/2012
Registration Date	08/06/2013	Foreign Priority Date	NONE
Word Mark	UTOPIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 2008/02/01 First Use In Commerce: 2008/02/01 Conducting boat charters; Conducting fishing charters; Pleasure boat cruises		

U.S. Registration No.	3215578	Application Date	05/02/2006
Registration Date	03/06/2007	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a stylized silhouette of a city skyline and setting sun.		
Goods/Services	Class 036. First use: First Use: 1994/11/00 First Use In Commerce: 1994/11/00 Real estate property management services; real estate brokerage services; leasing of real estate; and mortgage brokerage		

	Class 037. First use: First Use: 1994/11/00 First Use In Commerce: 1994/11/00 Building maintenance and repair of commercial and residential property		
U.S. Application No.	86920041	Application Date	02/25/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	UTOPIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 0 First Use In Commerce: 0 Financing of real estate development projects Class 037. First use: First Use: 0 First Use In Commerce: 0 Real estate development		

Attachments	78874492#TMSN.png(bytes) 86478030#TMSN.png(bytes) 85654391#TMSN.png(bytes) 78874470#TMSN.png(bytes) 86920041#TMSN.png(bytes) 160025rglclopp.pdf(282738 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	/Rob G. Leach/
Name	Rob G. Leach
Date	03/07/2016

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

Utopia Management, Inc.,)	
)	Opposition No. _____
Opposer)	Serial No.: 86711972
)	
v.)	OPPOSER’S NOTICE OF OPPOSITION
)	
Jonathan Hursh,)	
)	
Applicant)	
_____)	

Opposer, Utopia Management, Inc. (“Utopia”), respectfully submits this Notice of Opposition based on the grounds set forth below.

1. Applicant, Jonathan Hursh, (referred to as “Applicant”), an individual whose address is believed to be 809 Pinon Avenue, Millbrae, California, U.S.A., 94030, is the owner of a federal trademark intent-to-use registration application with the USPTO for the standard character mark “Utopia”, Serial No. 86711972. The Applicant’s registration application is for the following goods and services in international class 42: “Design, development, and consulting services in the fields city and slums design, urbanization, architecture, and urban planning for humanitarian purposes”.

2. Utopia, a California corporation with its principal place of business at 4617 Ruffner Street, San Diego, California, 92111, U.S.A., has for many years used, continues to use, has federally registered, and seeks additional registration for the standard character marks

“Utopia” and “Utopia Management” for the following classes, goods and services (referred to collectively in this Opposition as “Utopia’s Marks”):

- a. “Utopia”, registered on 8/06/2013, Registration No. 4378693 in Class 039 for “Conducting boat charters; Conducting fishing charters; Pleasure boat cruises” with a first use date at least as early as 2/01/2008.
 - b. “Utopia”, registered on 3/06/2007, Registration No. 3215579, in class 036 for “Real estate property management services; real estate brokerage services; leasing of real estate; and mortgage brokerage”, and in class 037 for “Building maintenance and repair of commercial and residential property”, with a first use date at least as early as 8/01/1992.
 - c. “Utopia Management”, registered on 8/11/2015, Registration No. 4789464, in class 035 for “Administrative hotel management; Business management of hotels for others; Hotel management for others”, with a first use date at least as early as 6/01/2014.
 - d. “Utopia Management”, registered on 11/24/1998, Registration No. 2205587, in class 036 for “Real estate management, brokerage, acquisition, leasing and financing services” with a first use date at least as early as 8/01/1992.
3. Utopia also has an international registration with the World Intellectual Property Organization (“WIPO”) for the mark “Utopia”, registered on 7/09/2012, Registration No. 1127783, in class 036 for “Real estate property management services; real estate brokerage services; leasing of real estate; and mortgage brokerage”, and in class 037 for

“Maintenance and repair of commercial and residential property”. That international trademark registration has been recognized in the United Kingdom, Australia, and the European Community.

4. Utopia has also registered in the United States a design logo depicting a city skyline “UTOPIA & Design”, registered on 3/06/2007, Registration No. 3215578, for class 036 for “Real estate property management services; real estate brokerage services; leasing of real estate; and mortgage brokerage”, and class 037 for “Maintenance and repair of commercial and residential property” with a first use date at least as early as 11/01/1994.
5. Utopia has continuously and extensively used the Utopia Marks since their first uses described above.
6. Utopia has also applied to the United States Patent and Trademark Office for registration with an intent to use the standard character mark “Utopia” in class 036 for “Financing of real estate development projects”, and in class 037 for “Real estate development, Serial No. 86920041. That application is pending.

COUNT 1
DAMAGE THROUGH LIKELIHOOD OF CONFUSION
WITH REGISTERED MARK

7. Utopia incorporates by reference, as if fully set forth, paragraphs 1 through 6.
8. Utopia’s “Utopia” mark and Applicant’s “Utopia” mark are identical in appearance and sound. Utopia’s “Utopia Management” mark is nearly identical and/or confusingly similar in appearance and sound.

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9. Applicant's intended use of its "Utopia" mark is highly and confusingly similar to the use made by Utopia of its "Utopia Marks", and the same or substantially similar groups of persons will be exposed to both marks.
10. Persons familiar with Utopia's "Utopia Marks", and/or with the extensive efforts by Utopia to associate the "Utopia" mark with Utopia, upon seeing Applicant's "Utopia" mark would likely believe, and would be justified in believing, that Applicant, Applicant's services, Applicant's products and/or Applicant's "Utopia" mark is associated with, affiliated with, sponsored by, or used with the authorization of Utopia.
11. For the reasons stated above, if Applicant is permitted to maintain its registration of "Utopia", there will be a likelihood of confusion amongst the relevant public resulting in damage and injury to Utopia (15 U.S.C § 1052(d) and §1063).

COUNT 2
DAMAGE THROUGH TRADEMARK DILUTION

12. Utopia incorporates by reference, as if fully set forth, paragraphs 1 through 11.
13. Utopia's use of the Utopia Marks has been so continuous, extensive, and exclusive such that one or more of the Utopia Marks is famous, as defined by law, including without limitation that one or more of the Utopia Marks is widely recognized by the general consuming public of the United States as a designation of Utopia's services.
14. Utopia's mark(s) and associated rights will be wrongfully diluted by Applicant's registration of its mark.

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15. Any objection, fault, adverse publicity, or negative connotations in connection with Applicant's mark, services and/or products will necessarily reflect on and seriously injure the reputation that Utopia has established with its "Utopia" mark, including without limitation dilution by tarnishment. (15 U.S.C § 1125(c) and §1063)
16. This dilution by tarnishment includes, without limitation, Applicant's intended use of the mark in association with "slums", including providing design, urbanization, architecture, and urban planning services for "slums.". To associate Utopia and/or Utopia Marks with "slums" would damage Utopia and/or the Utopia Marks. Utopia has spent many years and enormous resources developing the Utopia Marks to stand for and convey a reputation in the marketplace for delivering high quality, clean, safe, well-maintained and well-organized residences, residential property, and commercial property. "Slums" is directly contrary and damaging to such favorable qualities in Utopia's reputation and the Utopia Marks.
17. If Applicant is allowed to maintain its registration for its "Utopia" mark for the purposes identified, Applicant could arguably obtain at least a *prima facie* exclusive right to use that mark for the stated services, and arguably for related services, and arguably for fields of natural expansion, further damaging Utopia by limiting or potentially preventing Utopia's use of its Utopia Marks, including without limitation use in fields of natural expansion, damaging Utopia, and including without limitation through dilution by blurring (15 U.S.C § 1052(d); § 1125(c); and §1063).

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COUNT 3
DAMAGE THROUGH DISPARAGEMENT

18. Utopia incorporates by reference, as if fully set forth, paragraphs 1 through 17.
19. Applicant's mark consists of or comprises a matter which will disparage Utopia, and/or bring Utopia contempt, or disrepute, or falsely suggest a connection with Utopia, as a "person" and/or "institution" under the law. (15 U.S.C § 1052(a) and §1063).
20. This disparagement of Utopia, and/or the Utopia Marks, includes without limitation Applicant's intended use of the mark in association with "slums", including providing design, urbanization, architecture, and urban planning services for "slums."
21. To associate Utopia and/or Utopia Marks with "slums" would damage Utopia and/or the Utopia Marks. Utopia has spent many years and enormous resources developing the Utopia Marks to stand for and convey a reputation in the marketplace for delivering high quality, clean, safe, well-maintained and well-organized residences, residential property, and commercial property. "Slums" is directly contrary and damaging to such favorable qualities in Utopia's reputation and the Utopia Marks.

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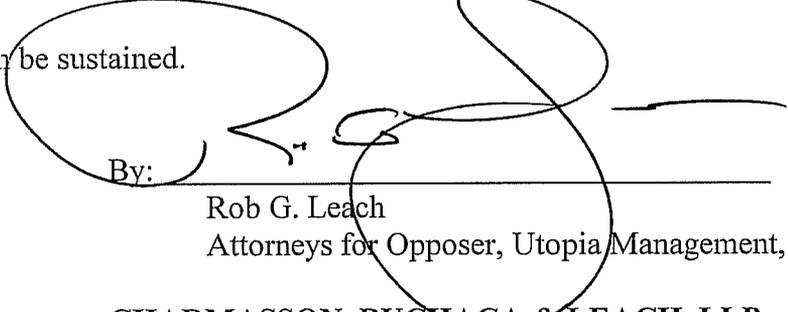
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PRAYER

22. WHEREFORE, Utopia prays that Applicant's trademark registration application, Serial No. 86711972, be rejected, that registration of the mark sought be denied and refused, and that this opposition be sustained.

Dated: March 7, 2016

By: 

Rob G. Leach
Attorneys for Opposer, Utopia Management, Inc.

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Utopia Management v. Hursh, Opposition No.

United States Patent and Trademark Office, Trademark Trial and Appeals Board
CB&L Matter No. 160025

PROOF OF SERVICE

I am employed in the County of San Diego, State of California. I am over the age of 18 and not a party to the within action; my business address is 2635 Camino Del Rio South, Suite 102, San Diego, CA 92108. On March 7, 2016, I served the following document(s) on the interested parties in this action by sending a true and correct copy thereof as follows:

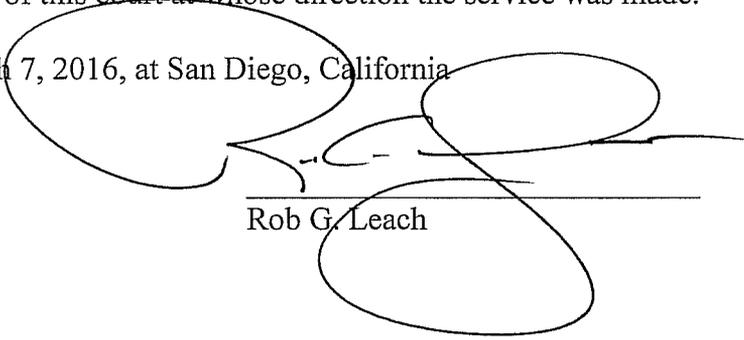
1. OPPOSER'S NOTICE OF OPPOSITION

Paul A. McLean
Greenberg Traurig Llp
1900 University Ave Fl 5
East Palo Alto CA 94303-2283
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Attorney for Applicant, Jonathan Hursh

XX (BY MAIL) I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with U.S. postal service on that same day with postage thereon fully prepaid at San Diego, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct. I declare that I am a member of the bar of California, or employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on March 7, 2016, at San Diego, California



Rob G. Leach