

ESTTA Tracking number: **ESTTA758959**

Filing date: **07/18/2016**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	United Country Real Estate, LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	2820 NW Barry Road Kansas City, MO 64154 UNITED STATES		

Attorney information	Daniel A. Crowe Bryan Cave LLP 211 N Broadway, Ste 3600 St. Louis, MO 63102 UNITED STATES bcipdocketing@bryancave.com Phone:314-259-2000		
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Registration Subject to Cancellation

Registration No	4776243	Registration date	07/21/2015
Registrant	UNITED REALTY, INC. 2240-C Gallows Road Vienna, VA 22182 UNITED STATES		

Goods/Services Subject to Cancellation

Class 036. First Use: 1988/00/00 First Use In Commerce: 1988/00/00 All goods and services in the class are cancelled, namely: Real estate agencies; Real estate brokerage

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1109683	Application Date	05/18/1978
Registration Date	12/19/1978	Foreign Priority Date	NONE
Word Mark	UNITED		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1925/00/00 First Use In Commerce: 1925/00/00 REAL ESTATE BROKERAGE SERVICES

Attachments	Petition-Cancellation-UNITED-REALTY-INC.pdf(2171784 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	/Steve G. Trubac/
Name	Steve G. Trubac
Date	07/18/2016

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

In the Matter of Cancellation of
Registration No. 4,776,243
Serial No. 86/452,904
For the Mark: UNITED REALTY, INC.
Registration Date: July 21, 2015

United Country Real Estate, LLC

Petitioner,

vs.

United Realty, Inc.,

Respondent

Cancellation No. _____

CERTIFICATE OF ELECTRONIC MAIL

I hereby certify that this correspondence and related attachments are being sent to the TTAB via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 18th day of July, 2016.

/Steve G. Trubac/
Steven G. Trubac

PETITION FOR CANCELLATION

Petitioner United Country Real Estate, LLC, a Delaware limited liability company having an address of 2820 NW Barry Road, Kansas City, Missouri 64154 (together with its predecessors-in-interest and related companies, “Petitioner” or “United”) believes it has been damaged and will continue to be damaged by the continued registration of the mark UNITED REALTY, INC., shown in U.S. Reg. No. 4,776,243 (the “Registration”), registered on July 21, 2015, by United Realty, Inc., a Virginia corporation (“Respondent”), and hereby petitions to cancel the same pursuant to 15 USC § 1064. As grounds for cancellation, United alleges the following:

United’s Use, Registration, and Rights in its UNITED® Mark

1. United is the owner of the UNITED® service mark in connection with real estate and related services.

2. United’s use of the service mark UNITED® has a long and notable heritage. Beginning in 1925, Roscoe Chamberlain created the United Farm Agency, Incorporated. That

company, and its successors-in-interest, have been identified as “UNITED” for more than ninety years.

3. United has used its UNITED® mark in interstate commerce in connection with real estate services since at least as early as 1925. Since that time, it has continuously used its UNITED® mark in U.S. commerce in connection with those services.

4. United and/or its predecessors-in-interest, since at least as early as 1925, have been engaged in the real estate brokerage services business. Since that time, it has continuously promoted those services in association with numerous service marks, including UNITED®, UNITED COUNTRY®, UNITED NATIONAL REAL ESTATE, UNITED REAL ESTATE, and variations thereof, for use in connection with real estate brokerage services.

5. On May 18, 1978, United filed with the U.S. Patent and Trademark Office trademark application Serial No. 73/170,923 for UNITED® for “real estate brokerage services” in International Class 36, with first use dating back to 1925. The ’923 application registered on December 19, 1978 as U.S. Reg. No. 1,109,683 (the “UNITED® mark”) and is valid, subsisting, and incontestable. *See Exhibit A.*

6. As a result of the prior, longstanding, and continuous use of the UNITED® mark in commerce, United has acquired extremely valuable rights and goodwill in its UNITED® mark. The UNITED® mark has been used and continues to be used in such a way that the public strongly associates the UNITED® mark with United and its real estate and related services.

Respondent’s Registration

7. Notwithstanding the foregoing, on November 13, 2014, Respondent filed with the USPTO an application for registration of UNITED REALTY, INC. for use in connection with “Real estate agencies; Real estate brokerage” in International Class 36. *See Exhibit B.*

8. In the Registration, Respondent asserts that it first used UNITED REALTY, INC. as a trademark for real estate services in 1988. *Id.*

9. Respondent is not entitled to registration of UNITED REALTY, INC. under the Lanham Act, and United will be damaged by the continued registration thereof.

Count I
Priority and Likelihood of Confusion

10. United repeats and incorporates by reference the allegations in the preceding paragraphs of this Petition.

11. United's first use and registration of its UNITED® mark predate the alleged 1988 first use of the mark in the Registration and Respondent's 2014 application to register the same.

12. The mark in the Registration is confusingly similar in appearance, pronunciation, and commercial impression to United's UNITED® mark.

13. The sole difference between United's UNITED® mark and Respondent's mark is the addition of the generic or highly descriptive wording "REALTY, INC." which wording is disclaimed in the Registration. *Id.*

14. The real estate services recited in the Registration are identical and/or highly similar or related to United's real estate services provided in connection with its UNITED® mark. Such real estate services are customarily offered through similar channels of trade, to similar classes of customers, and under circumstances that are likely to cause confusion with United's UNITED® mark.

15. Accordingly, when used in connection with the services recited in the Registration, the mark in the Registration so resembles United's UNITED® mark as to cause confusion, to cause mistake, and/or to deceive within the meaning of Section 2(d) of the Lanham Act.

16. The Registration must be cancelled under Section 2(d) of the Lanham Act in view of United's prior, continuous, and ongoing use of its UNITED® mark in U.S. commerce.

Count II
Fraud in the Procurement of a Trademark Registration

17. United repeats and incorporates by reference the allegations in the preceding paragraphs of this Petition.

18. Respondent has committed fraud on the USPTO in the procurement of the Registration.

19. On or about August 14, 2014, United sent a cease-and-desist letter to Respondent, advising it that Respondent's unauthorized use of UNITED in connection with real estate services infringed upon United's exclusive rights in the UNITED® mark, and that United had already experienced instances of actual confusion in the Virginia market. *See Exhibit C.*

20. On or about September 15, 2014, Respondent sent a response to United in which it: (a) acknowledged receipt of United's letter; (b) disputed the fact that United used and registered the UNITED® mark; (c) requested proof of United's exclusive rights in the UNITED® mark in connection with real estate services; and (d) refused to cease use thereof. *See Exhibit D.*

21. On or about October 7, 2014, United replied to Respondent, providing the requested proof of United's prior and superior use of, registration of, and exclusive rights in the UNITED® mark. *See Exhibit E.* United reiterated that Respondent's unauthorized use of UNITED had already caused instances of actual confusion, and was likely to continue to cause confusion in the Virginia market, in violation of United's rights. *Id.*

22. On November 13, 2014, approximately one month after United's reply, Respondent filed with the USPTO an application for registration of UNITED REALTY, INC. for

use in connection with “Real estate agencies; Real estate brokerage” in International Class 36.
See Exhibit B.

23. In that application, Tony Yeh, in his capacity as President of Respondent, falsely represented to the USPTO that to the best of his knowledge and belief, “no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely” to cause confusion when used in connection with the goods or services of another. *See Exhibit B.*

24. Respondent had knowledge at least as early as August 2014 that United had the prior, superior, and exclusive right to use the UNITED® mark in connection with real estate services. *See Exhibit C.*

25. While Respondent indicated doubts regarding United’s rights in its September 15, 2014 letter (**Exhibit D**), United provided the specific evidence and proof that Respondent requested to resolve any such doubt, at least as early as October 2014 (**Exhibit E**).

26. Respondent claims to have been using UNITED REALTY, INC. since 1988, and yet elected not to file a federal trademark application until shortly after United explicitly informed it of its prior, superior, and exclusive right to use the UNITED® mark, and the likelihood of confusion and actual confusion in the marketplace.

27. United’s August and October letters apprised Respondent of the likelihood of confusion and actual confusion resulting from Respondent’s unauthorized use of the UNITED® mark, and Respondent had no basis for a good faith belief otherwise.

28. Respondent made the false representation with the intent to deceive the USPTO and obtain a registration to which it is not entitled.

29. Accordingly, Respondent knowingly made a false, material representation in its application with the intent to deceive the USPTO. But for the false representation, the Registration would not have been granted.

30. The Registration must be cancelled under Section 14(3) of the Lanham Act in view of the damage to United resulting from the fraudulent obtainment of the Registration.

WHEREFORE, United Country Real Estate, LLC hereby respectfully requests that the Trademark Trial and Appeal Board grant this Petition for Cancellation and that:

(1) U.S. Trademark Registration Number 4,776,243 be cancelled pursuant to 15 U.S.C. § 1064; and

(2) For a judgment in favor of United Country Real Estate, LLC for such other and further relief as this Board deems just and proper under the circumstances.

Date: July 18, 2016

Respectfully Submitted,

By: /Steven G. Trubac/
Daniel Crowe
Matthew G. Minder
Steven G. Trubac
BRYAN CAVE LLP
One Metropolitan Square
211 North Broadway, Suite 3600
St. Louis, Missouri 63021
(314) 259-2000 (phone)
(314) 250-2020 (fax)
BCIPDocketing@bryancave.com

ATTORNEYS FOR PETITIONER, UNITED
COUNTRY REAL ESTATE, LLC

Certificate of Service

Pursuant to Trademark Rule of Practice § 2.119, I hereby certify that on July 18, 2016, I served a true and correct copy of the foregoing document and its exhibits by First Class U.S. Mail, postage prepaid, on United Realty, Inc., and its known counsel of record, as follows:

United Realty, Inc.
2240-C Gallows Road
Vienna, Virginia 22182

Erik M. Pelton
Erik M. Pelton & Associates PLLC
PO Box 100637
Arlington, VA 22210-3637

Dated: July 18, 2016

/Steven G. Trubac/
Steven G. Trubac

EXHIBIT A

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Mark: UNITED

US Serial Number: 73170923

Application Filing Date: May 18, 1978

US Registration Number: 1109683

Registration Date: Dec. 19, 1978

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Feb. 02, 2009

Mark Information

Mark Literal Elements: UNITED

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 1009034

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: REAL ESTATE BROKERAGE SERVICES

International Class(es): 036 - Primary Class

U.S Class(es): 101

Class Status: ACTIVE

Basis: 1(a)

First Use: 1925

Use in Commerce: 1925

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: UNITED COUNTRY REAL ESTATE, LLC

Owner Address: 2820 NW BARRY ROAD
KANSAS CITY, MISSOURI 64154
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Matthew G. Minder

Docket Number: 0386233

Attorney Primary Email Address: BCIPDocketing@bryancave.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Matthew G. Minder
Bryan Cave LLP
211 North Broadway, Suite 3600
Saint Louis, MISSOURI 63102
UNITED STATES

Phone: 314-259-2000

Fax: 314-259-2020

Correspondent e-mail: BCIPDocketing@bryancave.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 14, 2015	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Oct. 07, 2015	ATTORNEY REVOKED AND/OR APPOINTED	
Oct. 07, 2015	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Aug. 11, 2011	NOTICE OF SUIT	
May 14, 2010	NOTICE OF SUIT	
Feb. 02, 2009	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	68502
Feb. 02, 2009	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Feb. 02, 2009	ASSIGNED TO PARALEGAL	68502
Nov. 24, 2008	ASSIGNED TO PARALEGAL	76293
Nov. 12, 2008	TEAS SECTION 8 & 9 RECEIVED	
Jul. 22, 2008	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Jul. 22, 2008	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
May 20, 2008	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 10, 2008	CASE FILE IN TICRS	
Sep. 30, 1998	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Aug. 20, 1998	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Mar. 26, 1984	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Dec. 19, 2008

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Feb. 02, 2009

Assignment Abstract Of Title Information**Summary**

Total Assignments: 4

Registrant: UNITED FARM AGENCY, INCORPORATED

Assignment 1 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL AS OF JUNE 1, 1987

Reel/Frame: [0592/0454](#)

Pages: 1

Date Recorded: Feb. 12, 1988

Supporting Documents: No Supporting Documents Available

AssignorName: [UNITED FARM AGENCY, INCORPORATED](#)

Execution Date: Jan. 12, 1988

Legal Entity Type: CORPORATION

State or Country MISSOURI
Where Organized:**Assignee**Name: [UNITED NATIONAL REAL ESTATE, INC.](#)

Legal Entity Type: CORPORATION

State or Country MISSOURI
Where Organized:

Address: KANSAS CITY, MISSOURI

Correspondent

Correspondent Name: HOVEY, WILLIAMS, ET AL.

Correspondent Address: 1400 MERCANTILE BANK TOWER
1101 WALNUT STREET
KANSAS CITY, MO 64106-2165**Domestic Representative - Not Found****Assignment 2 of 4**

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0711/0840](#)

Pages: 0

Date Recorded: May 21, 1990

Supporting Documents: No Supporting Documents Available

AssignorName: [UNITED NATIONAL REAL ESTATE, INC.](#)

Execution Date: May 11, 1990

Legal Entity Type: CORPORATION

State or Country MISSOURI
Where Organized:**Assignee**Name: [FIRST HORIZON CORPORATION](#)

Legal Entity Type: CORPORATION

State or Country MISSOURI
Where Organized:

Address: KANSAS CITY, MISSOURI

Correspondent

Correspondent Name: HOVEY, WILLIAMS, TIMMONS & COLLINS

Correspondent Address: THOMAS H. VAN HOOZER
1400 MERCANTILE BANK TOWER
1101 WALNUT STREET
KANSAS CITY, MO 64106-2165**Domestic Representative - Not Found****Assignment 3 of 4**

Conveyance: CHANGE OF NAME

Reel/Frame: [2791/0719](#)

Pages: 6

Date Recorded: Feb. 11, 2004

Supporting Documents: [assignment-tm-2791-0719.pdf](#)

Assignor

Name: [FIRST HORIZON CORPORATION](#)
Legal Entity Type: CORPORATION
Execution Date: Nov. 26, 2003
State or Country Where Organized: MISSOURI

Assignee

Name: [UNITED COUNTRY REAL ESTATE, INC.](#)
Legal Entity Type: CORPORATION
State or Country Where Organized: MISSOURI
Address: 1600 N. CORRINGTON AVENUE
KANSAS CITY, MISSOURI 64120

Correspondent

Correspondent Name: THOMAS H. VAN HOOZER
Correspondent Address: 2405 GRAND BLVD., SUITE 400
KANSAS CITY, MO 64108

Domestic Representative - Not Found

Assignment 4 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST
Reel/Frame: [5640/0517](#) **Pages:** 6
Date Recorded: Oct. 07, 2015
Supporting Documents: [assignment-tm-5640-0517.pdf](#)

Assignor

Name: [UNITED COUNTRY REAL ESTATE, INC.](#)
Legal Entity Type: CORPORATION
Execution Date: May 28, 2015
State or Country Where Organized: MISSOURI

Assignee

Name: [UNITED COUNTRY REAL ESTATE, LLC](#)
Legal Entity Type: LIMITED LIABILITY COMPANY
State or Country Where Organized: DELAWARE
Address: 2820 NW BARRY ROAD
KANSAS CITY, MISSOURI 64154

Correspondent

Correspondent Name: MATTHEW G. MINDER
Correspondent Address: 211 NORTH BROADWAY, SUITE 3600
SAINT LOUIS, MO 63102

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 4

Type of Proceeding: Opposition

Proceeding Number: [91158548](#) **Filing Date:** Nov 12, 2003
Status: Terminated **Status Date:** Nov 13, 2006
Interlocutory Attorney: DAVID M MERMELSTEIN

Defendant

Name: Christopher B. Colwell
Correspondent Address: Christopher B. Colwell
Realty United, LLC
1290 Horsham Way
Apex NC , 27502

UNITED STATES

Associated marks			
Mark	Application Status	Serial Number	Registration Number
REALTY UNITED	Abandoned - After Inter-Partes Decision	78181779	

Plaintiff(s)

Name: First Horizon Corporation

Correspondent Address: Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City MO , 64108
UNITED STATES

Associated marks			
Mark	Application Status	Serial Number	Registration Number
UNITED	Renewed	73170923	1109683

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 12, 2003	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 24, 2003	Jan 03, 2004
3	PENDING, INSTITUTED	Nov 24, 2003	
4	ANSWER	Dec 30, 2003	
5	D'S MOTION FOR SUMMARY JUDGMENT	Mar 01, 2004	
6	PLS BRIEF IN OPP TO DEF'S MOT FOR SJ	Apr 05, 2004	
7	PLS MOT TO CHANGE TITLE OF PROC AND BRIEF AND SUPP	Apr 05, 2004	
8	SUSPENDED	Apr 15, 2004	
9	PLS REPLY TO OPP TO DFS MOTION FOR SUMMARY JUDG	Apr 16, 2004	
10	PLS MOTION STRIKE	May 03, 2004	
11	STIPULATED PROTECTIVE ORDER	Aug 09, 2004	
12	DELETE ENTRY	Aug 26, 2004	
13	DELETE ENTRY	Aug 26, 2004	
14	DEF'S MOTION FOR SUMMARY JUDGMENT DENIED	Aug 27, 2004	
15	PL'S MOTION TO COMPEL	Jan 10, 2005	
16	P'S MOTION FOR SUMMARY JUDGMENT	Dec 30, 2004	
17	BRIEF IN SUPPORT OF P'S MOTION FOR SUMMARY JUDGEMENT	Dec 30, 2004	
18	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	Feb 08, 2005	
19	D'S MOTION FOR AN EXTENSION OF TIME	Jan 24, 2005	
20	PLS BRIEF IN OPP TO PLS MOTFOR SUMMARY JUDG	Jan 24, 2005	
21	PL'S MOT. FOR SUMM. JUDGMENT DENIED	May 10, 2005	
22	UNDELIVERABLE MAIL RETURNED	May 26, 2005	
23	OTHER FILING	Jul 12, 2005	
24	APPL'S CHANGE OF ADDRESS	Jul 12, 2005	
25	PLN NOTICE OF RELIANCE 2 OF 7	Oct 20, 2005	
26	PLN NOTICE OF RELIANCE 1 OF 7	Oct 20, 2005	
27	PLN NOTICE OF RELIANCE 3 of 7	Oct 20, 2005	
28	PLN NOTICE OF RELIANCE 4 of 7	Oct 20, 2005	
29	PLN NOTICE OF RELIANCE 5 of 7	Oct 20, 2005	
30	PLN NOTICE OF RELIANCE 6 of 7	Oct 20, 2005	
31	PLN NOTICE OF RELIANCE 7 OF 7	Oct 20, 2005	
32	BRIEF ON MERITS FOR PLAINTIFF	Mar 27, 2006	
33	SUBMITTED ON BRIEF	Aug 02, 2006	
34	BOARD'S DECISION: SUSTAINED	Aug 30, 2006	
35	TERMINATED	Nov 13, 2006	

Type of Proceeding: Extension of Time

Proceeding Number: [78181779](#)

Filing Date: Nov 03, 2003

Status: Terminated

Status Date: Nov 14, 2003

Interlocutory
Attorney:

Defendant

Name: Christopher B. Colwell

Correspondent Christopher B. Colwell

Address: 1290 Horsham Way
Apex NC U SA , 27502

Associated marks

Mark	Application Status	Serial Number	Registration Number
REALTY UNITED	Abandoned - After Inter-Partes Decision	78181779	

Potential Opposer(s)

Name: First Horizon Corporation

Correspondent Thomas H. Van Hoozer

Address: Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City MO , 64108
UNITED STATES

Associated marks

Mark	Application Status	Serial Number	Registration Number
UNITED	Renewed	73170923	1109683

Prosecution History

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Nov 03, 2003	
2	EXTENSION OF TIME GRANTED	Nov 14, 2003	

Type of Proceeding: Opposition

Proceeding Number: [91124988](#)

Filing Date: Jan 14, 2002

Status: Terminated

Status Date: Aug 09, 2002

Interlocutory
Attorney: CHERYL A BUTLER

Defendant

Name: MATIONAL HOUSING DEVELOPMENT CORPORATION

Correspondent SUSAN L. SMITH

Address: ORRICK HERRINGTON & SUTCLIFFE, LLP
1000 MARSH ROAD
MENLO PARK CA , 94025
UNITED STATES

Associated marks

Mark	Application Status	Serial Number	Registration Number
UNITED NATIONAL PRESERVATION TRUST	Cancelled - Section 8	76143035	2641793

Plaintiff(s)

Name: FIRST HORIZON COPORATION

Correspondent THOMAS H. VAN HOOZER

Address: HOVEY WILLIAMS, LLP
2405 GRAND BOULEVARD SUITE 400
KANSAS CITY MO , 64108
UNITED STATES

Associated marks

Mark	Application Status	Serial Number	Registration Number
UNITED	Renewed	73170923	1109683

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 14, 2002	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 25, 2002	Mar 06, 2002

3	PENDING, INSTITUTED	Jan 25, 2002
4	STIPULATED REQUEST FOR EXTENSION OF TIME	Mar 05, 2002
5	D'S MOT FOR EXTEN. OF TIME W/ CONSENT	Apr 04, 2002
6	D'S MOTION FOR AN EXTENSION OF TIME	May 03, 2002
7	STIP TO AMEND AND W/D OPP W/O PREJ AND CONSENT	May 23, 2002
8	AMDT APPR.; DSMSD W/O PREJUDICE	Aug 09, 2002
9	TERMINATED	Aug 09, 2002

Type of Proceeding: Cancellation

Proceeding Number: [92032737](#) **Filing Date:** Jan 14, 2002
Status: Terminated **Status Date:** Nov 08, 2002
Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: NATIONAL HOUSING DEVELOPMENT CORPORATION
Correspondent Address: SUSAN L. MASETTI
ORRICK, HERRINGTON & SUTCLIFFE, LLP
1000 MARSH ROAD MENLO PARK, CA 94025

Associated marks

Mark	Application Status	Serial Number	Registration Number
UNITED NATIONAL PRESERVATION TRUST	Cancelled - Section 8	75908028	2432408

Plaintiff(s)

Name: FIRST HORIZON CORPORATION
Correspondent Address: THOMAS H. VAN HOOZER
HOVEY WILLIAMS LLP
SUITE 400, 2405 GRAND BOULEVARD
KANSAS CITY MO , 64108-2519
UNITED STATES

Associated marks

Mark	Application Status	Serial Number	Registration Number
UNITED	Renewed	73170923	1109683

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 14, 2002	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 25, 2002	Mar 06, 2002
3	PENDING, INSTITUTED	Jan 25, 2002	
4	D'S MOT FOR EXTEN. OF TIME W/ CONSENT	Mar 05, 2002	
5	D'S MOT FOR EXTEN. OF TIME W/ CONSENT	Apr 04, 2002	
6	SUSPENDED	Apr 23, 2002	
7	STIPULATED MOTION TO AMEND REGISTRATION AND CONDITIONAL WITHDRAWAL OF CANCELLATI	May 23, 2002	
8	AMDT DENIED; PARTIES ALLOWED 30 DAYS TO FILE ACCEPTABLE AMDT; PROC SUSP	Aug 14, 2002	
9	D'S AMENDMENT AND PARTIES CONDITIONAL W/ D W/O PREJ W/CON	Sep 16, 2002	
10	AMENDMENT APPROVE; BD DECISION: DSMS W/O PREJUDICE	Nov 08, 2002	
11	TERMINATED	Nov 08, 2002	

EXHIBIT B

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Mark: UNITED REALTY, INC.

UNITED REALTY, INC.

US Serial Number: 86452904

Application Filing Date: Nov. 13, 2014

US Registration Number: 4776243

Registration Date: Jul. 21, 2015

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jul. 21, 2015

Publication Date: May 05, 2015

Mark Information

Mark Literal Elements: UNITED REALTY, INC.

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "REALTY, INC."

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Real estate agencies; Real estate brokerage

International Class(es): 036 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: 1988

Use in Commerce: 1988

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: UNITED REALTY, INC.

Owner Address: 2240-C Gallows Road
Vienna, VIRGINIA 22182
UNITED STATES

Legal Entity Type: CORPORATION

State or Country: VIRGINIA

Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Erik M. Pelton

Attorney Primary Email Address: uspto@tm4smallbiz.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: ERIK M. PELTON
Erik M Pelton & Associates Pllc
PO Box 100637
Arlington, VIRGINIA 22210-3637
UNITED STATES

Phone: 703-525-8009

Correspondent e-mail: uspto@tm4smallbiz.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 21, 2015	REGISTERED-PRINCIPAL REGISTER	
May 05, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 05, 2015	PUBLISHED FOR OPPOSITION	
Apr. 15, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 30, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Mar. 30, 2015	ASSIGNED TO LIE	66213
Mar. 10, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 10, 2015	EXAMINER'S AMENDMENT ENTERED	88888
Mar. 10, 2015	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Mar. 10, 2015	EXAMINERS AMENDMENT E-MAILED	6328
Mar. 10, 2015	EXAMINERS AMENDMENT -WRITTEN	77986
Mar. 05, 2015	ASSIGNED TO EXAMINER	77986
Nov. 20, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 17, 2014	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 21, 2015

Trademark/Service Mark Application, Principal Register

Serial Number: 86452904

Filing Date: 11/13/2014

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86452904
MARK INFORMATION	
*MARK	UNITED REALTY, INC.
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	UNITED REALTY, INC.
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	UNITED REALTY, INC.
*STREET	2240-C Gallows Road
*CITY	Vienna
*STATE (Required for U.S. applicants)	Virginia
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	22182
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Virginia
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	036
*IDENTIFICATION	Real estate agencies; Real estate brokerage
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 00/00/1988
FIRST USE IN COMMERCE DATE	At least as early as 00/00/1988
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\864\529\86452904\xml1\ APP0003.JPG
SPECIMEN DESCRIPTION	business card
ATTORNEY INFORMATION	
NAME	Erik M. Pelton

FIRM NAME	Erik M. Pelton & Associates, PLLC
STREET	PO Box 100637
CITY	Arlington
STATE	Virginia
COUNTRY	United States
ZIP/POSTAL CODE	22210
PHONE	703-525-8009
EMAIL ADDRESS	uspto@tm4smallbiz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Nicholas T. Santucci
CORRESPONDENCE INFORMATION	
NAME	Erik M. Pelton
FIRM NAME	Erik M. Pelton & Associates, PLLC
STREET	PO Box 100637
CITY	Arlington
STATE	Virginia
COUNTRY	United States
ZIP/POSTAL CODE	22210
PHONE	703-525-8009
EMAIL ADDRESS	uspto@tm4smallbiz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/Tony yeh/
SIGNATORY'S NAME	Tony Yeh
SIGNATORY'S POSITION	President
DATE SIGNED	11/13/2014

Trademark/Service Mark Application, Principal Register

Serial Number: 86452904

Filing Date: 11/13/2014

To the Commissioner for Trademarks:

MARK: UNITED REALTY, INC. (Standard Characters, see [mark](#))

The literal element of the mark consists of UNITED REALTY, INC..

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, UNITED REALTY, INC., a corporation of Virginia, having an address of
2240-C Gallows Road
Vienna, Virginia 22182
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 036: Real estate agencies; Real estate brokerage

In International Class 036, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 00/00/1988, and first used in commerce at least as early as 00/00/1988, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) business card.

[Specimen File1](#)

The applicant's current Attorney Information:

Erik M. Pelton and Nicholas T. Santucci of Erik M. Pelton & Associates, PLLC
PO Box 100637
Arlington, Virginia 22210
United States

The applicant's current Correspondence Information:

Erik M. Pelton
Erik M. Pelton & Associates, PLLC
PO Box 100637
Arlington, Virginia 22210
703-525-8009(phone)
uspto@tm4smallbiz.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the

goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /Tony yeh/ Date: 11/13/2014

Signatory's Name: Tony Yeh

Signatory's Position: President

RAM Sale Number: 86452904

RAM Accounting Date: 11/13/2014

Serial Number: 86452904

Internet Transmission Date: Thu Nov 13 09:22:09 EST 2014

TEAS Stamp: USPTO/BAS-XXX.XXX.XXX.XX-201411130922095

71417-86452904-500937c198de63197d812cd18

7f42b88b11ad261a771d7e517838d4f27aa0b51-

ET-6811-20141107152832349791

UNITED REALTY, INC.



UNITED REALTY, INC.

Tony Yeh

Broker • NVAR Top Producer
Licensed in VA, MD & DC

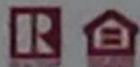
Res.: (703) 753-3648

Cell: (202) 257-0830

Office: (703) 204-1188

Fax: (703) 204-9005

email: tonyyehusa@gmail.com



2240-C Gallows Road, Vienna, VA 22182

EXHIBIT C



Jessica V. Barnard
Compliance and Legal Analyst
2820 NW Barry Road
Kansas City, MO 64154

Office: 816.420.6250
Fax: 816.420.6219

jbarnard@unitedcountry.com

Offices Independently Owned And Operated

August 14, 2014

CERTIFIED MAIL 7009 0960 0000 9899 5199
RETURN RECEIPT REQUESTED

United Realty, Inc.
2240 Gallows Road
Vienna, VA 22182

Re: UNITED® Trademark

Dear Sir or Ma'am:

It has been brought to our attention that your business, United Realty, Inc. has been using a name confusingly similar our trademark name of UNITED® in association with the marketing or sale of your real estate services. It is possible that you were unaware of this conflict, so we believe that it is in our mutual interest to bring this matter to your attention.

UNITED® is a registered trademark (U.S. Reg. Nos. 1109683 and 3063245) of our business, United Real Estate, Inc., and is used in conjunction with our real estate services. Our UNITED® federal registration has been in full effect since 1978. Proof of the federal trademark registration is attached for your reference.

Our federal registration of this trademark provides us with certain proprietary rights. This includes the right to restrict the use of the trademark, or a confusingly similar trademark, in association with confusingly similar products or services. The Lanham Act (the U.S. Trademark Act) also provides numerous remedies for trademark infringement and dilution, including, but not limited to, preliminary and permanent injunctive relief, monetary damages, a defendant's profits, provisions for the destruction or confiscation of infringing products and promotional materials, and where intentional infringement is shown, attorneys' fees and possible treble money damages.

United Real Estate, Inc. offers franchises for real estate brokerage services under the UNITED® family of trademarks. A number of these registrations have achieved incontestability status. United Real Estate, Inc. recently discovered that your company has adopted and is using the trademark UNITED® for directly competitive services. Of course, our company offers identical and overlapping services to that of your company.

Find Your Freedom®

State and federal laws support our position that confusingly similar trademarks may cause confusion among customers. This confusion may cause substantial harm to the trademark by facilitating the loss of its effectiveness in establishing a distinct association between it and our products and services. It is important that we exercise our right to protect our trademark. It serves as an important and distinctive representation of the origin of our products as well as the goodwill of our company.

Use of the UNITED® trademark is likely to cause confusion among consumers as to whether it is affiliated, associated, or sponsored by United Real Estate. In this case, United Real Estate is particularly concerned because of the overlapping geographical territory of our two companies. In fact, we have experienced instances of actual confusion in Virginia and your use does negatively affect our ability to franchise our brand in the marketplace.

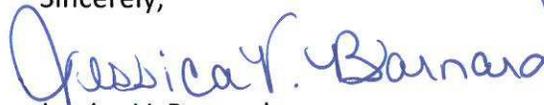
Due to these concerns, and because unauthorized use of our federally registered trademark amounts to an infringement of our trademark rights, we respectfully request that you cease and desist in any further use of the UNITED® trademark in association with the sale, marketing, distribution, promotion or other identification of your products or services, to include its use on your website, in Internet domain names, meta tags, keyword advertising, and on any other promotional or advertising material.

Please respond by letter or e-mail within thirty (30) calendar days, indicating your intention to cease and desist the use of the UNITED® trademark, or any confusingly similar trademark.

This letter is sent without prejudice to United Real Estate, Inc.'s rights and claims, all of which are expressly reserved.

We hope that this issue may be resolved this way so we can avoid any further legal remedies as provided by state law and under federal law pursuant to the Lanham Act.

Sincerely,



Jessica V. Barnard

Compliance and Legal Analyst

EXHIBIT D



United Realty

2240-C Gallows Rd, Vienna, VA 22182

Tel: 703-204-1188

Fax: 703-204-9005

September 15, 2014

Jessica Barnard
Compliance and Legal Analyst
United Country Real Estate, Inc.
2820 NW Barry Road
Kansas City, MO 64154

Re: Response letter regarding UNITED* trademark

Dear Ms. Barnard,

My company, United Realty, Inc., has been using this name in the Commonwealth of Virginia since 1988. I have reviewed your August 14 letter and based on both the letter itself as well as a review of your presence online, I respectfully disagree with your claims. On your website, unitedcountry.com, your company appears to be consistently referred to as "United Country Real Estate", which I do not believe would be easily confused with United Realty, Inc. Further, the word "United" in and of itself should not be able to be restricted to one single trademark owner. Please provide case law supporting your assertion that the term "United" could be used alone as a trademark for a real estate company, as well as case law supporting the assertion that always using the trademarked word within a larger name of the company doesn't dilute the validity of the trademarked word itself when used by itself.

Sincerely Yours,

Elizabeth Zeng
Vice President
United Realty, Inc.

Cc: Tony Yeh

EXHIBIT E

October 7, 2014

2820 NW Barry Rd
Kansas City, MO 64154

Elizabeth Zeng
United Realty, Inc.
2240-C Gallows Road
Vienna, VA 22182

Phone: 816.420.6250
jbarnard@unitedcountry.com

RE: INFRINGING USE OF UNITED® TRADEMARK

Dear Ms. Zeng,

Thank you for your letter of September 15th. We respectfully disagree with your position that use of our UNITED® trademark is not confusing and that despite our federal registration of the mark we would somehow have no right to preclude others from using it. Perhaps you are unaware that we have been using the UNITED® mark since 1925. For your reference, I have enclosed evidence of the same. In addition, please find below a list of our federally registered marks incorporating use of our UNITED® mark:

Trademark	First Use	Class	Registration Date	Registration No.
UNITED	1925	IC 36 US 101	12/19/1978	1109683
UNITED COUNTRY	03/15/1992	IC 16 US 38	5/11/1993	1770019
UNITED COUNTRY	01/00/1997	IC 36 US 100 101 102	9/1/1998	2186596
UNITED COUNTRY AND DESIGN	01/00/1997	IC 36 US 100 101 102	9/8/1998	2188368
UNITED	1925	IC 35 US 100 101 102	2/28/2006	3063245
UNITED COUNTRY	01/31/1997	IC 35 US 100 101 102	5/16/2006	3092646

UNITED COUNTRY HOME MORTGAGE	12/07/2007	IC 36 US 100 101 102	9/23/2008	3506275
UNITED COUNTRY	12/00/2006	IC 35 US 100 101 102	12/16/2008	3546632
UNITED REAL ESTATE	07/14/2011	IC 35, 36 US 100 101 102	03/25/2014	4502863

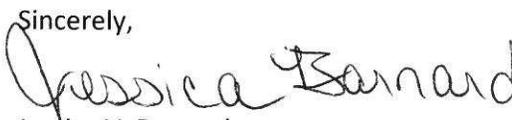
As you can see from these records, for nearly 90 years, United® has offered its real estate brokerage services under the UNITED family of trademarks. We not only offer franchises for real estate brokerage under our United Country® brand, but also under our United Real Estate® brand.

Your continued unauthorized use of the UNITED® trademark causes and will continue to cause significant consumer confusion in the marketplace as to whether it is affiliated, associated, or sponsored by United under either of the United Country® or United Real Estate® brands. In this case, United is particularly concerned because it is located in the same and overlapping geographic region, we have experienced instances of actual confusion in Virginia, and your use is affecting our brand in the market. Your unauthorized use of our mark is in direct violation of the Lanham Act, federal and state common law, state unfair competition laws, and other laws barring unfair trade practices. Such infringement may be redressed by injunctive relief, damages, and an award of attorneys' fees.

United prefers to settle this matter quickly and amicably, but aggressively protects and enforces its intellectual property rights. We again request that you promptly phase out all use of UNITED® as part of or consisting of trade name or trademarks, and any other confusingly similar trademark on your website, Internet domain name, e-mail addresses, meta tags and keyword advertising, and on any other promotional or advertising material, including but not limited to telephone directory listings, signage, business cards, and/or stationary.

We need written assurances no later than **November 1, 2014**, that you will comply with the terms of this letter and will begin phasing out your use of the UNITED® mark.

The foregoing is without prejudice to or waiver of any additional claims that United Real Estate, Inc. may have or which may hereafter arise.

Sincerely,

 Jessica V. Barnard

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,063,245

Registered Feb. 28, 2006

SERVICE MARK
PRINCIPAL REGISTER

UNITED

UNITED COUNTRY REAL ESTATE, INC. (MISSOURI CORPORATION)
2820 NW BARRY ROAD
KANSAS CITY, MO 641880250

FOR: FRANCHISE SERVICES, NAMELY, OFFERING TECHNICAL ASSISTANCE IN THE ESTABLISHMENT AND/OR OPERATION OF REAL ESTATE BROKERAGES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1925; IN COMMERCE 0-0-1925.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,109,683, 2,188,368 AND OTHERS.

SER. NO. 78-577,812, FILED 3-1-2005.

YSA DEJESUS, EXAMINING ATTORNEY