

ESTTA Tracking number: **ESTTA511916**

Filing date: **12/19/2012**

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

Proceeding	91207936
Party	Defendant Mun, Johnathan C.
Correspondence Address	JAMES MICHAEL SMEDLEY, ESQ. JAMES M SMEDLEY LLC 50 CHRISTY DR WARREN, NJ 07059-6833 james.smedley@sigmalawgroup.com
Submission	Answer
Filer's Name	James Michael Smedley, Esq.
Filer's e-mail	info@sigmalawgroup.com
Signature	/James M Smedley/
Date	12/19/2012
Attachments	Answer.pdf (5 pages)(46694 bytes)

3. Applicant is the owner of all rights, title and interest in the following trademark registrations:

Mark	Reg. No.	Goods & Services
Certified in Risk Management	3705182 Issued: 11-3-2009	Educational services, namely, providing classes, workshops and seminars in the field of risk management
CRM-IIPER	3698578 Issued: 10-20-2009	Educational services, namely, providing classes, workshops and seminars in the field of risk management

4. With respect to US Reg. No. 2,303,193 and US. Reg. No. 2,203,657, both owned by Opposer, Applicant notes that these are both Collective Membership Marks, denoting marks that indicate membership in an association of certified risk managers.
5. With respect to US. Appl. Serial No. 85/269,504, owned by Opposer , Applicant notes that this mark is associated with “providing risk advice in the fields of **insurance** and risk management; consulting services in the fields of **insurance** and risk management; providing **insurance** and risk management services” (Emphasis added).
6. With respect to the Application, Applicant has made widespread use of the mark applied for throughout the entire US in connection with the goods and services identified in the Application. Applicant, and its respective marks, including the mark identified in the Application are widely known in the industry of the Applicant. The Applicant’s industry is generally related to analyzing risk in capital budgeting decisions with respect to real options valuations and risks related to equities and securities.
7. Applicant is the founder and CEO of Real Options Valuation, Inc., and is responsible for the development of analytical software products, consulting, and training services in the field of real options valuations and analyzing risk with respect for equities, options and securities markets. He was formerly the VP of Analytics at Decisioneering, Inc., and was a Consulting Manager in KPMG’s Global Financial Strategies. Dr. Mun is also a full professor at the U.S. Naval Postgraduate School and a professor at the University of Applied Sciences (Zurich and Frankfurt). Applicant is renowned for his expertise in his respective field and those consumers in his field identify his registered marks and the mark of the Application with him and his company, Real Options Valuation, Inc.
8. Upon information and belief, Opposer’s marks are used exclusively in the field of analyzing risk in the insurance industry and for the purpose of analyzing risk for as it relates to the provision of

insurance. More specifically, Opposer's marks are used to identify professionals in the insurance industry that have received a certification from the Opposer or its related entities.

9. Applicant's mark, as identified in the Application, is used in the field of real options valuations, specialized corporate finance and related options and equities risk analysis. This is a highly specialized field, with participants being extremely well educated and trained professionals.
10. The relevant industry and public of Opposer is vastly different from that of the relevant industry and public of the Applicant. Both Opposer's industry (i.e., insurance professionals) and Applicant's industry (i.e., real options valuations, specialized corporate finance and related options and equities risk analysis) are highly specialized fields, being occupied by extremely well educated and trained professionals. There is no significant overlap between the industry of the Opposer and the industry of the Applicant.
11. The services provided by the Opposer and the Applicant are both very expensive. Upon information and belief, Opposer's services are generally provided at a cost of several hundreds of dollars for an individual class/training session. Applicant's services, classes and software are generally in the range of several thousand dollars. These are not the types of goods or services consumed by the uninformed public or purchased without significant research and aforethought.
12. Applicant's mark, as identified in the Application, is distinguishable in appearance, sound, connotation and commercial impression from the marks of the Opposer, and there would be no likelihood of confusion between the mark of the Application and the marks of the Opposer. Applicant's mark consists of both graphical and textual differences that are not insignificant in nature.
13. Applicant's mark, as identified in the Application, is so distinguishable from the marks of the Opposer, and the industries so disparate, that there would be no likelihood of confusion between the marks, nor would the usage of the Applicant's mark cause and dilution of the marks of the Opposer.
14. Applicant's mark would cause no significant risk of confusion and would cause no harm to the Opposer as the marks in question and the industries and consuming public involved are so disparate as to not provide any concern of these risks.

WHEREFORE, Applicant has shown that there is no likelihood of confusion between the mark of the Application and the marks of the Opposer and requests the denial of this opposition and the allowance of the mark identified in the Application.

Please direct all communications regarding this matter to the undersigned attorney for the Applicant.

This Answer is being filed by the undersigned attorney, duly authorized to represent the Applicant in this proceeding.

Please charge any additional fees due in connection with this document to Deposit Account No. 50-5761.

Correspondence Address

Docket Administrator
James M. Smedley LLC
776 Mountain Blvd. STE 105
Watchung, NJ 07069

Respectfully submitted,

/James M. Smedley/

James Michael Smedley, Esq.
Attorney for Applicant
Reg. No.: 66,083
Dated: 2012-12-18

CERTIFICATE OF SERVICE

This is to certify that on December 18, 2012, a true and correct copy of the above referenced Answer was served on Opposer, via Opposer's authorized attorney, H. Dale Langley, Jr., via express mail to:

H. Dale Langley, Jr.
610 West Lynn
Austin, TX 78703

Respectfully submitted,

/James M. Smedley/_____

James Michael Smedley, Esq.