

ESTTA Tracking number: **ESTTA733658**

Filing date: **03/15/2016**

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	The Community Preservation Corporation
Granted to Date of previous extension	03/23/2016
Address	28 East 28th Street, 9th Floor New York, NY 10016 UNITED STATES
Attorney information	Jacqueline P. Scheib Robinson & Cole LLP 280 Trumbull Street Hartford, CT 06103 UNITED STATES jscheib@rc.com Phone:8602758285

Applicant Information

Application No	86105213	Publication date	11/24/2015
Opposition Filing Date	03/15/2016	Opposition Period Ends	03/23/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	CPC Group Limited Martello Court, Admiral Park St Peter Port, GY13HB GG		

Goods/Services Affected by Opposition

<p>Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Agency services for the leasing of real estate property; real estate agency services; arranging leases for the rental of real property; arranging of leases for the rental of commercial real property; commercial property investment consulting services; real estate agency services, namely, finding domestic real property for others; real estate management services; arranging of leases relating to real estate property; leasing of real property; leasing of real estate; leasing of real estate property; real estate service, namely, management of rental property; real estate consultancy; provision of information relating to real estate and real property leasing; rental of real property</p>
<p>Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Interior decorating</p>

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
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Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2760535	Application Date	09/02/1998
Registration Date	09/09/2003	Foreign Priority Date	NONE
Word Mark	CPC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1974/07/00 First Use In Commerce: 1974/07/00 Financial services in connection with housing and other development projects for low, moderate and middle income communities, namely, mortgage financing; mortgage servicing, namely, collection of payments, foreclosure with respect to mortgage loans, escrow administration; equity investment services; and real estate asset management and consultation services		

U.S. Registration No.	3817020	Application Date	10/06/2009
Registration Date	07/13/2010	Foreign Priority Date	NONE
Word Mark	CPC GREEN FINANCING INITIATIVE SIMPLE. SENSIBLE. SUSTAINABLE.		
Design Mark			
Description of Mark	The mark consists of the words "CPC Green Financing Initiative Simple Sensible Sustainable" with a design of intersecting houses and a leaf design in the left hand corner replacing a house design placed between the words "CPC" and "Green Financing Initiative" and a period is placed after each of the words "Simple Sensible Sustainable".		
Goods/Services	Class 036. First use: First Use: 2009/09/30 First Use In Commerce: 2009/09/30 Financial services, namely, mortgage financing; mortgage servicing, namely, collection of payments, foreclosure with respect to mortgage loans, escrow administration; equity investment services; and real estate asset management and consultation services in connection with housing and other development projects for low, moderate and middle income communities		

Attachments	77842191#TMSN.png(bytes) NOO CPC GROUP and Design.PDF(1793136 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	/Jacqueline P. Scheib/
Name	Jacqueline P. Scheib
Date	03/15/2016

The Community Preservation Corporation,	:	
Opposer,	:	Opposition No. _____
	:	
v.	:	Serial No.: 86/105,213
	:	Mark: CPC GROUP and Design
CPC Group Limited,	:	Filing Date: October 30, 2013
Applicant.	:	Published: November 24, 2015
	:	

As grounds for opposition, Opposer alleges the following:

1. Opposer is a long-established company which has for more than four decades engaged in providing various financial services, including but not limited to mortgages, equity investment services, real estate asset management, and leasing of real property.
2. Opposer is the owner of U.S. Registration No. 2,760,535 for the mark CPC for “financial services in connection with housing and other development projects for low, moderate and middle income communities, namely, mortgage financing; mortgage servicing, namely, collection of payments, foreclosure with respect to mortgage loans, escrow administration; equity investment services; and real estate asset management and consultation services” and U.S. Registration No. 3,817,020 for the mark CPC GREEN FINANCING INITIATIVE and Design for “financial services, namely, mortgage financing; mortgage servicing, namely, collection of payments, foreclosure with respect to mortgage loans, escrow administration; equity investment services; and real estate asset management and consultation services in connection with housing and other development projects for low, moderate and middle income communities” (the “CPC Marks”).
3. The CPC Marks are valid and subsisting. The U.S. Patent and Trademark Office’s TESS printouts of each of these registrations and Opposer’s application are attached as Exhibit A. The existence of these valid and subsisting federal trademark registrations constitutes *prima facie* evidence of the ownership and validity of the CPC Marks.
4. Since at least as early as 1974, Opposer has provided financial services under the CPC brand.
5. Opposer’s use commenced well before Applicant’s. Specifically, Applicant has not yet claimed use of Applicant’s Mark in the United States and the October 30, 2013 filing date

of Applicant's application to register Applicant's Mark is approximately forty (40) years after the date when Opposer first used Opposer's Marks in U.S. commerce.

6. Opposer has continuously and extensively used the CPC Marks in commerce in connection with the advertising, promotion and sale of its financial and real estate services. Through Opposer's substantial amount of time and effort in advertising, promoting, and offering its services under the CPC Marks, the public and the financial and real estate industries have come to recognize the services offered in conjunction with these marks as signifying Opposer and its services.

7. Opposer has enjoyed substantial market penetration and has spent substantial sums in advertising and promoting its goods and services in connection with its CPC Marks throughout the United States.

8. Opposer's CPC Marks have achieved widespread public recognition and have become commercially strong and well-known.

COUNT ONE

Likelihood of Confusion – 15 U.S.C. §1052(d)

9. Opposer repeats and realleges each and every allegation set forth in Paragraphs 1 through 8.

10. Applicant's Mark imitates and plays off the goodwill of Opposer's CPC Marks. This is done through Applicant's use of the term "CPC" which is the dominant portion of the CPC Marks. While Applicant's Mark contains the addition of the term "Group" this term is not relevant since it is descriptive and Applicant has, in its application, disclaimed any rights to the term. Applicant's Mark claims a stylized format which places the term "Group" below the term "CPC," adds a short line before and after the term "Group," and incorporates mark in a black

box. This stylization is not enough to avoid confusion because both marks still contain the term CPC. Marks are confusingly similar in appearance when there are similar terms, and in this case identical terms, appearing in both marks. In addition, not only is Applicant's Mark identical in appearance to the CPC Marks but most of the services are similar to or overlap with the services covered by the CPC Marks. In particular, the services covered by International Class 36 of Applicant's application are similar to or directly overlap with the services of Opposer's CPC Marks. In view of the similarity between the CPC Marks and Applicant's Mark, and the related nature of the services of the representative parties, Applicant's Mark so resembles the CPC Marks, which were previously used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. §1052(d) and would violate or diminish the prior and superior rights of Opposer in its CPC Marks.

11. For the foregoing reasons, Opposer will be damaged by the registration of Applicant's Mark if International Class 36 is not deleted from the application.

COUNT TWO

False Designation of Origin

12. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 11.

13. Applicant's unauthorized proposed offering of real property leasing services, real estate management services, management of rental property and real estate consultancy services bearing a mark that so resembles Opposer's CPC Marks will constitute a false designation of origin and a false description or representation that Applicant's services are authorized by or otherwise linked to Opposer, and is thereby likely to confuse consumers.

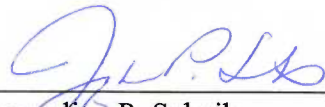
14. Upon information and belief, Applicant intends to use the designation CPC with full knowledge that such designation is likely to cause consumers confusion, mistake or deception as to the origin, sponsorship or association of Applicant's services in relation to Opposer's CPC Marks. Applicant's proposed acts of unfair competition will be willful and deliberate and with intent to reap the benefit of the goodwill and reputation associated with Opposer's CPC Marks.

15. Applicant's proposed services bearing a mark that so resembles Opposer's CPC Marks will violate Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. §1125(a)(1)(A).

16. For the forgoing reasons, Opposer will be damaged if Application Serial No. 86/105,213 is allowed to register without the deletion of International Class 36 from the application because Applicant will obtain statutory rights in the designation CPC in violation and derogation of the established prior rights of Opposer.

WHEREFORE, Opposer respectfully requests that if International Class 36 is not deleted from Applicant's application, that registration of Applicant's Mark be refused in its entirety and that this opposition be sustained.

Respectfully submitted,



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Attorney for Opposer
The Community Preservation Corporation

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on March 15, 2016, upon counsel for Applicant:

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EXHIBIT A



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Typed Drawing

Word Mark CPC

Goods and Services IC 036. US 100 101 102. G & S: Financial services in connection with housing and other development projects for low, moderate and middle income communities, namely, mortgage financing; mortgage servicing, namely, collection of payments, foreclosure with respect to mortgage loans, escrow administration; equity investment services; and real estate asset management and consultation services. FIRST USE: 19740700. FIRST USE IN COMMERCE: 19740700

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75548617

Filing Date September 2, 1998

Current Basis 1A

Original Filing Basis 1A

Published for Opposition June 17, 2003

Change In Registration CHANGE IN REGISTRATION HAS OCCURRED

Registration Number 2760535

Registration Date September 9, 2003

Owner (REGISTRANT) The Community Preservation Corporation NON-PROFIT CORPORATION NEW YORK 28 East 28th Street, 9th Floor New York NEW YORK 10016

Attorney of Record Jacqueline P. Scheib

Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130406.
Renewal 1ST RENEWAL 20130406
Live/Dead Indicator LIVE

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SIMPLE. SENSIBLE. SUSTAINABLE.

Word Mark

CPC GREEN FINANCING INITIATIVE SIMPLE. SENSIBLE. SUSTAINABLE.

Goods and Services

IC 036. US 100 101 102. G & S: Financial services, namely, mortgage financing; mortgage servicing, namely, collection of payments, foreclosure with respect to mortgage loans, escrow administration; equity investment services; and real estate asset management and consultation services in connection with housing and other development projects for low, moderate and middle income communities. FIRST USE: 20090930. FIRST USE IN COMMERCE: 20090930

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code

05.03.25 - Leaf, single; Other leaves
 07.01.04 - Detached house
 07.01.06 - Other houses
 26.09.02 - Plain single line squares; Squares, plain single line
 26.09.21 - Squares that are completely or partially shaded
 26.15.02 - Plain single or multiple line polygons; Polygons (plain, single line)
 26.15.21 - Polygons that are completely or partially shaded

Trademark Search Facility Classification Code

BLDG-AND-SCEN A type of building or a type of scenery
 LETS-2 CPC Two letters or combinations of multiples of two letters
 NOTATION-SYMBOLS Notation Symbols such as Non-Latin characters, punctuation and mathematical signs, zodiac signs, prescription marks
 SHAPES-GEOMETRIC Geometric figures and solids including squares, rectangles, quadrilaterals and polygons
 SHAPES-MISC Miscellaneous shaped designs
 VEG Plant life such as trees, flowers, fruits, grains, nuts, wreaths, and leaves

Serial Number

77842191

Filing Date

October 6, 2009

Current Basis 1A
Original Filing Basis 1A
Published for Opposition April 27, 2010
Registration Number 3817020
Registration Date July 13, 2010
Owner (REGISTRANT) The Community Preservation Corporation non-profit corporation NEW YORK 28 East 28th Street, 9th Floor New York NEW YORK 10016
Attorney of Record Jacqueline P. Scheib
Prior Registrations 2303897;2760535
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GREEN FINANCING INITIATIVE" APART FROM THE MARK AS SHOWN
Description of Mark Color is not claimed as a feature of the mark. The mark consists of the words "CPC Green Financing Initiative Simple Sensible Sustainable" with a design of intersecting houses and a leaf design in the left hand corner replacing a house design placed between the words "CPC" and "Green Financing Initiative" and a period is placed after each of the words "Simple Sensible Sustainable".
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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