

ESTTA Tracking number: **ESTTA742365**

Filing date: **04/26/2016**

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	Compassion International, Inc.		
Entity	Corporation	Citizenship	Illinois
Address	12290 Voyager Parkway Colorado Springs, CO 80921 UNITED STATES		

Attorney information	Hope Hamilton Holland & Hart LLP PO Box 8749 Denver, CO 80201 UNITED STATES hihamilton@hollandhart.com, rtlawrence@hollandhart.com, docket@hollandhart.com, mamooore@hollandhart.com
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Applicant Information

Application No	86817585	Publication date	04/19/2016
Opposition Filing Date	04/26/2016	Opposition Period Ends	05/19/2016
Applicant	Florida Baptist Children's Homes, Inc. 1015 Sikes Blvd. Lakeland, FL 33815 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2009/03/03 First Use In Commerce: 2009/03/03 All goods and services in the class are opposed, namely: Association services, namely, promoting the interests of children's homes and orphanages; charitable services, namely, organizing women's groups to undertake projects which benefit orphans and abused, neglected, abandoned, disadvantaged, and displaced children; charitable services, namely, promoting public awareness of orphans and abused, neglected, abandoned, disadvantaged, and displaced children through newsletters and other means
Class 036. First Use: 2009/03/03 First Use In Commerce: 2009/03/03 All goods and services in the class are opposed, namely: Charitable fundraising services; charitable fundraising to support orphans and abused, neglected, abandoned, disadvantaged, and displaced children

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2988651	Application Date	04/26/2004
Registration Date	08/30/2005	Foreign Priority Date	NONE
Word Mark	COMPASSION		
Design Mark	COMPASSION		
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 CHARITABLE FUND RAISING FOR CHILD ADVOCACY, CHILD DEVELOPMENT, AND YOUTH ASSISTANCE PROGRAMS</p> <p>Class 043. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 CHARITABLE SERVICES, NAMELY, PROVIDING FOOD AND TEMPORARY SHELTER TO NEEDY CHILDREN</p> <p>Class 044. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 CHARITABLE SERVICES, NAMELY, PROVIDING MEDICAL CARE TO NEEDY CHILDREN</p> <p>Class 045. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 CHARITABLE SERVICES, NAMELY, PROVIDING CHRISTIAN SPIRITUAL COUNSELING FOR NEEDYCHILDREN</p>		

U.S. Registration No.	1552859	Application Date	12/27/1988
Registration Date	08/22/1989	Foreign Priority Date	NONE
Word Mark	COMPASSION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1959/04/00 First Use In Commerce: 1959/04/00 MAGAZINES DEALING WITH CHRISTIAN CHILD DEVELOPMENT		

U.S. Registration No.	3806533	Application Date	10/28/2009
Registration Date	06/22/2010	Foreign Priority Date	NONE
Word Mark	COMPASSION		

Design Mark	
Description of Mark	The mark consists of a human figure design above the "CO" in the word "COMPASSION", which appears underneath.
Goods/Services	Class 044. First use: First Use: 2001/03/19 First Use In Commerce: 2001/03/19 Charitable services, namely, providing medical care to needy children Class 045. First use: First Use: 2001/03/19 First Use In Commerce: 2001/03/19 Charitable services, namely, providing Christian spiritual counseling for needy children

U.S. Registration No.	2669765	Application Date	06/01/2000
Registration Date	12/31/2002	Foreign Priority Date	NONE

Word Mark COMPASSION RELEASING CHILDREN FROM POVERTY IN JESUS' NAME

Design Mark	
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Description of Mark NONE

Goods/Services	Class 036. First use: First Use: 2001/01/30 First Use In Commerce: 2001/01/30 CHARITABLE FUND RAISING FOR CHILD ADVOCACY, CHILD DEVELOPMENT, AND YOUTH ASSISTANCE PROGRAMS Class 042. First use: First Use: 2001/01/30 First Use In Commerce: 2001/01/30 CHARITABLE SERVICES, NAMELY, PROVIDING FOOD, SHELTER, MEDICAL CARE, EDUCATION ASSISTANCE, AND CHRISTIAN SPIRITUAL COUNSELING FOR CHILDREN
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U.S. Registration No.	3390622	Application Date	07/06/2007
Registration Date	03/04/2008	Foreign Priority Date	NONE

Word Mark COMPASSION AT WORK

Design Mark	COMPASSION AT WORK
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Description of NONE

Mark	
Goods/Services	Class 016. First use: First Use: 1999/10/18 First Use In Commerce: 1999/10/18 PUBLICATIONS, NAMELY, NEWSLETTERS ADDRESSING CHILD DEVELOPMENT AND CHILD ADVOCACY

U.S. Registration No.	2826007	Application Date	06/14/2002
Registration Date	03/23/2004	Foreign Priority Date	NONE

Word Mark	SPEAK UP WITH COMPASSION
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Design Mark	SPEAK UP WITH COMPASSION
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 2003/03/03 First Use In Commerce: 2003/03/03 RADIO ENTERTAINMENT SERVICES, namely, RADIO PROGRAMS FEATURING ISSUES DEALING WITH CHILD ADVOCACY AND CHILD DEVELOPMENT; CHARITABLE SERVICES, NAMELY, PROVIDING TRAINING IN THE FIELD OF CHILD ADVOCACY AND CHILD DEVELOPMENT [; CHARITABLE SERVICES, NAMELY, ACADEMIC MENTORING OF SCHOOLS AGE CHILDREN]
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U.S. Registration No.	4579905	Application Date	01/09/2014
Registration Date	08/05/2014	Foreign Priority Date	NONE

Word Mark	COMPASSION INTERNATIONAL
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Design Mark	COMPASSION INTERNATIONAL
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Description of Mark	NONE
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Goods/Services	Class 036. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 Charitable fund raising for child advocacy, child development, and youth assistance programs Class 043. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 Charitable services, namely, providing food and temporary shelter to needy children Class 044. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31 Charitable services, namely, providing medical care to needy children Class 045. First use: First Use: 1966/12/31 First Use In Commerce: 1966/12/31
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	Charitable services, namely, providing Christian spiritual counseling for needy children
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Attachments	76588596#TMSN.png(bytes) 77859428#TMSN.png(bytes) 76059472#TMSN.png(bytes) 76679200#TMSN.png(bytes) 76421461#TMSN.png(bytes) 86161615#TMSN.png(bytes) Comp Intl NOO.pdf(28287 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	/Hope Hamilton/
Name	Hope Hamilton
Date	04/26/2016

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

COMPASSION INTERNATIONAL, INC., Opposer, v. WOMEN OF COMPASSION Applicant.	Opposition No.: Trademark: WOMEN OF COMPASSION Serial No.: 86/817,585
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NOTICE OF OPPOSITION

Opposer Compassion International, Inc., a non-profit corporation of Illinois, having a principal place of business at 12290 Voyager Parkway, Colorado Springs, Colorado 80921, believes that it will be damaged by the registration of the mark WOMEN OF COMPASSION shown in U.S. Trademark Application Serial Nos. 86/817,585 for “Association services, namely, promoting the interests of children’s homes and orphanages; charitable services, namely, organizing women’s groups to undertake projects which benefit orphans and abused, neglected, abandoned, disadvantaged, and displaced children; charitable services, namely, promoting public awareness of orphans and abused, neglected, abandoned, disadvantaged, and displaced children through newsletters and other means,” in International Class 35 and “Charitable fundraising services; charitable fundraising to support orphans and abused, neglected, abandoned, disadvantaged, and displaced children,” in International Class 36 (the “Application”) and hereby opposes it.


As grounds for its opposition, Compassion International, Inc. alleges that, upon actual knowledge with respect to itself and its own actions, and upon information and belief as to other matters:

1. Compassion International, Inc. is a Christian child development organization assisting over 1.2 million children in 26 countries, including the United States, in a variety of charitable, educational, medical, food and spiritual endeavors. Compassion International, Inc. has been providing these services since approximately 1966.

2. Compassion International, Inc. owns the following registered trademarks and service marks for COMPASSION and COMPASSION-formative marks in connection with its various charitable services:


a. COMPASSION, Registration No. 2,988,651, for “charitable fund raising for child advocacy, child development, and youth assistance programs” in Class 36, “charitable services, namely, providing food and temporary shelter to needy children” in Class 43, “charitable services, namely, providing medical care to needy children” in Class 44 and “charitable services, namely, providing Christian spiritual counseling for needy children” in Class 45, in use since December 31, 1966.

b. COMPASSION, Registration No. 1,552,859, for “magazines dealing with Christian child development” in Class 16, in use since April 1959.

c.  , Registration No. 3,806,533, for “charitable services, namely, providing medical care to needy children” in Class 44

and “charitable services, namely, providing Christian spiritual counseling for needy children” in Class 45, in use since March 19, 2001.



- d.  , Registration No. 2,669,765, for “charitable fund raising for child advocacy, child development, and youth assistance programs” in Class 36 and “charitable services, namely, providing food, shelter, medical care, education assistance, and Christian spiritual counseling for children” in Class 42, in use since January 30, 2001.
- e. COMPASSION AT WORK, Registration No. 3,390,622, for “publications, namely, newsletters addressing child development and child advocacy” in Class 16, in use since October 18, 1999.
- f. SPEAK UP WITH COMPASSION, Registration No. 2,826,007, for “radio entertainment services, namely, radio programs featuring issues dealing with child advocacy and child development; charitable services, namely, providing training in the field of child advocacy and child development” in Class 41, in use since March 3, 2003.
- g. COMPASSION INTERNATIONAL, Registration No. 4,579,905, for “charitable fund raising for child advocacy, child development, and youth assistance programs” in Class 36, “charitable services, namely, providing food and temporary shelter to needy children” in Class 43, “charitable services, namely, providing medical care to needy children” in Class 44,

and “charitable services, namely, providing Christian spiritual counseling for needy children” in Class 45, in use since 1966.

3. The foregoing registrations are valid and subsisting and constitute prima facie evidence of the validity of the marks and registrations, of Compassion International, Inc.’s ownership of and exclusive right to use the marks in commerce, and provide constructive notice of Compassion International, Inc.’s rights.

4. Since approximately 1966, Compassion International, Inc. has used the marks COMPASSION and COMPASSION INTERNATIONAL in commerce in connection with its various charitable, evangelical, and ministerial services. Since approximately 2010, Compassion International, Inc. has also used the mark WOMEN OF COMPASSION to denote its community of women workers and volunteers from around the world. Compassion International, Inc. owns common law rights in the COMPASSION, COMPASSION INTERNATIONAL, and WOMEN OF COMPASSION marks for such services. The common law COMPASSION, COMPASSION INTERNATIONAL, and WOMEN OF COMPASSION marks, together with the registered marks listed in Paragraphs 2(a) – (g), are hereinafter collectively referred to the “Compassion Marks.”

5. Compassion International, Inc. has expended considerable time, money, and effort marketing and advertising its charitable services under the Compassion Marks. As a result of these expenditures and Compassion International Inc.’s many years of service to millions of impoverished people around the world, the Compassion Marks have become famous.

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

6. Compassion International, Inc. realleges and incorporates by reference the preceding allegations of its Notice of Opposition.

7. Since well prior to the filing date of the Application, Applicant's first use of the WOMEN OF COMPASSION mark, or any priority date upon which Applicant may rely, Compassion International, Inc. has used one or more of the Compassion Marks.

8. Applicant's WOMEN OF COMPASSION trademark so resembles Compassion International, Inc.'s prior used and registered Compassion Marks as to be likely, when used in connection with the goods set forth in the Application, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT II
Likelihood of Dilution
15 U.S.C. § 1125(c)

9. Compassion International, Inc. realleges and incorporates by reference the preceding allegations of its Notice of Opposition.

10. The Compassion Marks are famous and well known and became famous under 15 U.S.C. § 1125(c) well prior to the filing date of the Application, Applicant's first use of the WOMEN OF COMPASSION mark, or any priority date upon which Applicant could rely.

11. Applicant's Women of Compassion trademark so resembles Compassion International, Inc.'s prior used and registered Compassion Marks as to dilute or to be likely to cause dilution of the distinctive quality of the Compassion Marks by blurring under section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, Compassion International, Inc. believes that it will be damaged by registration of the mark shown in the Application, Compassion International, Inc. respectfully requests that the opposition be sustained, and that registration to Applicant be refused.

The filing fee in the amount of \$600 is being transmitted electronically with this submission. Any deficiency in the fee should be charged to Deposit Account No. 08-2623.

Dated this 26th day of April, 2016.

Respectfully submitted,

/Hope Hamilton/
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**Attorneys for Opposer
Compassion International, Inc.**

CERTIFICATE OF SERVICE

I certify that on April 26, 2016, I served a true and complete copy of the above NOTICE OF OPPOSITION to the following by:

- U.S. Mail, postage prepaid
- Hand Delivery
- Fax

Florida Baptist Children's Homes, Inc.
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Orlando, FL 32801-4961

/Barbara A. Adams/
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