

ESTTA Tracking number: **ESTTA783428**

Filing date: **11/16/2016**

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 Port Authority of New York and New Jersey
Granted to Date of previous extension	11/16/2016
Address	4 World Trade Center 23rd Floor, 150 Greenwich Street New York, NY 10007 UNITED STATES

Attorney information	Michael Geller DLA Piper LLP 203 North LaSalle Street, Suite 1900 Chicago, IL 60601 UNITED STATES michael.geller@dlapiper.com, keith.medansky@dlapiper.com, leon.medzhibovskiy@dlapiper.com, ch.tm@dlapiper.com Phone:3123682152
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Applicant Information

Application No	86568728	Publication date	07/19/2016
Opposition Filing Date	11/16/2016	Opposition Period Ends	11/16/2016
Applicant	World Trade Centers Association, Inc. 120 Broadway, Suite 3350 New York, NY 10271 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Management and leasing of commercial, residential, office, hotel, entertainment, and retail space and property
Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Hotel, bar, café, restaurant, cocktail lounge and catering services; Hotels; Providing a website featuring information in the field of hotels and temporary accommodations for travelers; Providing extended-stay hotels; Providing facilities for fairs and exhibitions; Providing general purpose facilities for conferences, exhibitions and meetings

Grounds for Opposition

Other	The grounds are stated in the pleading for the notice of opposition.
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Attachments	Port Authority - Notice of Opposition - WORLD TRADE CENTER MIAMI - 728.pdf(199952 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 Overnight Courier on this date.

Signature	/Michael Geller/
Name	Michael Geller
Date	11/16/2016

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

In re Serial No. 86/568,728
Mark: WORLD TRADE CENTER MIAMI
Filed: March 18, 2015
Published: July 19, 2016

THE PORT AUTHORITY OF NEW YORK AND)	
NEW JERSEY)	
)	
Opposer,)	
)	Opposition No.:
v.)	
)	
WORLD TRADE CENTERS ASSOCIATION,)	
INC.)	
)	
Applicant.)	

NOTICE OF OPPOSITION

THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY, a body corporate and politic created by a compact between the states of New York and New Jersey with the consent of the United States Congress located at 4 World Trade Center, 150 Greenwich Street, 23rd Floor, New York, New York 10007 (hereinafter "Opposer"), believes that it would be damaged by registration of the mark shown in Application Serial No. 86/568,728 (hereinafter "the Application"), filed March 18, 2015 by World Trade Centers Association, Inc. (hereinafter "Applicant"), published in the Official Gazette of the United States Patent and Trademark Office (hereinafter the "USPTO") on July 19, 2016, and hereby opposes the registration of such mark.

The grounds for the opposition are as follows:

1. Opposer is a body corporate and politic created in 1921 that manages various areas, elements of infrastructure and methods of transportation including, but not limited to, bridges, tunnels, airports and transit in New York City and Northern New Jersey.

2. In 1962, Opposer was granted the statutory right and obligation by the states of New York and New Jersey to develop and manage an area in downtown New York City, which the statutes named the World Trade Center. N.Y. Unconsol. § 6602 (McKinney 2006); N.J. Stat. Ann. § 32:1-35.51 (2006).

3. The World Trade Center was home to the “Twin Towers,” which were destroyed in the September 11, 2001 terrorist attacks, and now features the building named “One World Trade Center,” among other buildings, monuments and transportation facilities (collectively, the “Site”).

4. In or around 1961, Opposer adopted and began using the trademark WORLD TRADE CENTER in connection with its services offered at the Site.

5. In 1986, Opposer allegedly assigned certain, but not all, of its rights in and under the service mark WORLD TRADE CENTER in connection *only* with certain services to Applicant (the “’86 Assignment”). The ’86 Assignment is attached hereto as **Annex A**.

6. The propriety, validity and scope of the ’86 Assignment has recently come into question.

7. Opposer, not Applicant, is the owner of the WORLD TRADE CENTER trademarks in connection with the services claimed in the Application.

8. The grant of a registration to Applicant for the WORLD TRADE CENTER mark as sought in the Application (hereinafter “Applicant’s Mark”) should be denied because Opposer

is the owner of the WORLD TRADE CENTER trademarks in connection with the services claimed in the Application. Applicant's Mark fully incorporates Opposer's WORLD TRADE CENTER trademark as well as the geographically descriptive term MIAMI and covers identical services as Opposer's WORLD TRADE CENTER trademark. Granting registration to Applicant for Applicant's Mark will disrupt Opposer's statutory right to exclusive use and control of the WORLD TRADE CENTER trademark, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

9. Alternatively, Opposer asserts that the grant of registration to Applicant for Applicant's Mark should be denied in light of Opposer's prior common law rights.

10. Alternatively, Opposer asserts that the '86 Assignment was improper, invalid and/or otherwise incomplete based on, without limitation, Applicant and its representatives' self-dealing and conflicts of interest.

11. Alternatively, Opposer asserts that granting registration to Applicant for Applicant's Mark will deprive Opposer the right to use the WORLD TRADE CENTER mark in connection with the services claimed in the Application, in derogation of the statutory mandate obligating Opposer to manage and operate the World Trade Center site.

12. Applicant filed a federal complaint against Opposer regarding Opposer's use of the WORLD TRADE CENTER trademarks (the "Litigation"). The Litigation will determine the outcome of, and substantially bears on, this opposition and, therefore, Opposer, in a separate filing, requests a suspension of this opposition.

WHEREFORE, Opposer files this Notice of Opposition and prays that the aforesaid application of World Trade Centers Association, Inc., herein opposed, be rejected; that no

registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

The Deposit Account No. 18-2284 should be charged the amount of \$300.00 to cover the filing fees of this notice of opposition against the Application. Please charge any additional fees to Deposit Account No. 18-2284, and address all correspondence regarding this opposition to:

Dated: November 16, 2016

Respectfully submitted,

**THE PORT AUTHORITY OF NEW YORK
AND NEW JERSEY**

By: /s/ Michael A. Geller

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of this correspondence is being sent via overnight courier to the correspondent of record:

Lindsay Kassof
120 Broadway
Suite 3350
New York, New York 10271-0024

/s/ Michael A. Geller
Signature

Michael A. Geller
Name

November 16, 2016
Date of Signature

EXHIBIT A

CONFIRMATORY ASSIGNMENT

WHEREAS, THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY, a body corporate and politic created by the States of New York and New Jersey with the consent of the Congress of the United States, having a place of business at One World Trade Center, New York, New York (hereinafter called "PORT AUTHORITY"), has adopted and used the service mark WORLD TRADE CENTER, for which it has obtained Argentine Service Mark Registrations 927594 and 937721 and the following New York State service mark registrations:

<u>Registration No.</u>	<u>Class</u>
S-9095	Advertising and Business Class 101
S-9096	Insurance and Financial Class 102
S-9097	Construction and Repair Class 103
S-9098	Communication Class 104
S-9099	Transportation & Storage Class 105
S-9100	Education & Entertainment Class 107

WHEREAS, the PORT AUTHORITY has sold and agreed to sell, transfer and convey to THE WORLD TRADE CENTERS ASSOCIATION, a Delaware corporation, having a place of business at One World Trade Center, New York, New York (hereinafter called "WTCA"), the entire right, title and interest in and to said service mark and said service mark registrations, together with the good will of its business in the services in respect of which the mark is used;


NOW, THEREFORE, for ten dollars (\$10.00) and other good and valuable consideration paid to PORT AUTHORITY by WTCA, the receipt and adequacy of which is hereby acknowledged:

PORT AUTHORITY has sold and does hereby sell, transfer and convey to WTCA, its successors, assigns and legal representatives, the entire right, title and interest in and to said service mark WORLD TRADE CENTER, said service mark registrations and the good will of PORT AUTHORITY's business in the services in respect of which the mark is used, together with all rights to apply for, obtain and hold registrations of the same and renewals and extensions thereof, and together with all right to bring suit for any past and future infringement of said mark. PORT AUTHORITY reserves to itself the right and license to use said service mark for the existing and future services.

This Assignment shall enure to the benefit of and be binding upon the parties hereto and their successors, assigns and legal representatives.

IN WITNESS WHEREOF, PORT AUTHORITY has caused this instrument to be executed as of this 18th day of February , 1986.

THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY

By 
Doris E. Landre, Secretary

Sworn and subscribed to
before me this 19th day of
February , 1986.


Notary Public

HERBERT S. SOMERWITZ
Notary Public, State of New York
No. 310597
Qualified in New York County
Commission Expires March 30, 1986