

ESTTA Tracking number: **ESTTA990751**

Filing date: **07/26/2019**

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

Proceeding	91237968
Party	Plaintiff KB Home
Correspondence Address	SHELDON H KLEIN GRAY PLANT MOOTY MOOTY & BENNETT PA 600 NEW HAMPSHIRE AVE NW, THE WATERGATE WASHINGTON, DC 20037 UNITED STATES sheldon.klein@gpmlaw.com, trademark@gpmlaw.com, cyn- thia.hefferan@gpmlaw.com, molly.littman@gpmlaw.com 202-295-2200
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Molly R. Littman
Filer's email	molly.littman@gpmlaw.com, sheldon.klein@gpmlaw.com, dean.eyler@gpmlaw.com, trademark@gpmlaw.com, cyn- thia.hefferan@gpmlaw.com, angelina.mejia@gpmlaw.com
Signature	/Molly R. Littman/
Date	07/26/2019
Attachments	Motion for Leave to Amend Notice of Opposition No. 91237968.pdf(104499 bytes )

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

In re Application No. 87035985, filed May 13, 2016, for the mark , UKB, published May 30, 2017

KB HOME,	)	
	)	
Opposer,	)	
	)	Opposition No. 91237968
	)	(Child to Parent Opp. No. 91226921)
v.	)	
	)	
KOOKMIN BANK CO., LTD.,	)	
	)	
	)	
Applicant.	)	
	)	

**MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

Opposer KB Home (“Opposer”) hereby moves the Board to grant Opposer leave to amend its Notice of Opposition in the above-referenced opposition in accordance with 37 C.F.R. § 2.107(a), Fed. R. Civ. P. 15(a), and TBMP §§ 315-316, 507.01-02(a). A copy of the proposed amended pleading is attached hereto as Exhibit A.

**INTRODUCTION**

Opposer seeks to amend its Notice of Opposition to remove Count III for Dilution By Blurring, and to add three common law marks in Opposer’s family of marks in support of its existing § 2(d) and 2(a) claims. Applicant Kookmin Bank (“Applicant”) has advised Opposer that it will not consent to this motion. However, the Trademark Rules and Federal Rules of Civil Procedure encourage the Board to look favorably on motions to amend pleadings. Moreover, Opposer’s amendments are timely and Applicant will not be prejudiced by them.

This case has been suspended for settlement for nearly the entire life of the case. While the parties focused on settlement, virtually no discovery was conducted by either party because

the parties were optimistic that an agreement could be reached without having to engage in costly litigation. Now, however, the parties are moving forward with all of their cases, and anticipate that the individual oppositions Opposer has filed against Applicant's applications will be consolidated, merging the schedules and streamlining the discovery process. Deleting Count III from Opposer's Notice of Opposition is inherently not prejudicial to Applicant. Likewise, Applicant will not be prejudiced by Opposer's addition of three marks, all of which are part of Opposer's family of marks and cited in support of its other oppositions. Applicant will certainly conduct discovery about these marks in the other oppositions, which are likely to be consolidated with this case. Therefore, Applicant will not be prejudiced by the addition of these marks. Opposer's Motion for Leave to Amend should be granted.

### **BACKGROUND**

For more than sixty years Opposer has offered homebuilding services in the United States. Operating originally as Kaufman & Broad, Opposer was founded to build quality new houses for returning Korean War veterans. Since at least 1974, Opposer has used KB as a service mark. In January 2001, Opposer changed its business name and service mark to KB HOME, while continuing to use KB. These marks, in various forms (the "KB Marks") have been used continuously and extensively in connection with Opposer's homebuilding services, and also insurance-related services, mortgage lending services, real-estate services, and more. Opposer owns several trademark registrations and applications for its KB Marks, many of which are incontestable. *See e.g.*, Exhibit A.

Applicant filed an intent-to-use application for the mark UKB, in connection with bank cards, credit cards, debit cards, card readers, banking software, and related goods in Class 9, and

banking, mortgage, insurance, real estate, and related services in Class 36. Opposer subsequently filed its Notice of Opposition, opposing registration of the UKB mark on the grounds that:

1. the UKB mark is confusingly similar to Opposer's KB Marks, in violation 15 U.S.C. § 1052(d),
2. the UKB mark is likely to cause deception as to the source of services offered under the mark, in violation of 15 U.S.C. § 1052(a), and
3. the UKB mark is likely to cause dilution by blurring of Opposer's KB Marks, in violation of 15 U.S.C. § 1125(d).

Applicant denied these claims, and filed counterclaims to cancel Opposer's Registration Nos. 2,774,497 and 2,825,554 on grounds of non-use and abandonment.

Opposer also filed oppositions against applications for three other "KB" marks filed by Applicant, *see* Opposition Nos. 91230708, 91239665, and 91226921, which the Board *sua sponte* consolidated with this Opposition. *See* Parent Opposition No. 91226921. After Applicant filed to register several additional "KB" marks, Opposer filed notices of opposition against those applications as well. *See* Opposition Nos. 91247539, 91247538, and 91249432. At this time, Opposer has opposed the registration of thirteen of Applicant's marks.

The parties have spent the majority of this opposition focusing on settlement. Indeed, during its entire pendency, this opposition has only been "active" (out of suspension) for approximately six months. Settlement discussions have been drawn out for a number of reasons, including the multiplicity of marks and goods/services involved, Applicant's location in Korea, and Applicant's change of counsel late last year. Now, however, the parties are moving forward with the litigation in all of their cases. *See also* Opposition Nos. 91230708, 91239665, 91226921, 91247539, 91247538, and 91249432, and Cancellation No. 92071082. The parties also anticipate that this case will be consolidated, either by motion or *sua sponte* by the Board, and the discovery schedules aligned, so the parties can conduct discovery on the several related

marks and issues in an efficient manner. Opposer has already served written discovery requests in this case.

Opposer seeks to amend its Notice of Opposition in the following ways:

- 1) Remove Count III for Dilution By Blurring; and
- 2) Add three of Opposer's common law marks from its family of marks that Opposer is already relying upon in Opposition Nos. 91239665, 91249432, 91247538, and 91247539.

The common law marks that KB Home seeks to add to its Notice of Opposition are:

- KB – First Use in 2002 for insurance agency, administration, underwriting, and consulting services in the field of homeowner's insurance, property and casualty insurance, and mortgage payment protection insurance.
- KB – First Use in 2002 for mortgage lending in connection with the construction and brokerage of single family and multiple family dwelling units.
- KB HOME INSURANCE AGENCY—First use on March 4, 2002 for insurance agency, administration, underwriting and consulting services in the field of homeowner's insurance, property and casualty insurance, and mortgage payment protection insurance.

(collectively, "Opposer's Common Law Marks").

Both amendments are timely and in the interest of justice, and are not prejudicial to Applicant. Removal of the dilution count simplifies the case and removes a significant claim by Opposer that Applicant no longer needs to defend. Similarly, Applicant has long had knowledge of Opposer's rights in Opposer's family of marks, including Opposer's Common Law Marks, as Opposer relied on these marks in four of the seven oppositions currently pending before the Board. The parties have done virtually no discovery, and are just now engaging in litigation (as opposed to focusing mostly on settlement), and will have ample time to engage in discovery about Opposer's Common Law Marks. Accordingly, Applicant will not be prejudiced or

otherwise injured as a result of Opposer's amendments, and Opposer's Motion for Leave to Amend should be granted.

### **ARGUMENT**

Trademark Rule 2.115 and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend pleadings. *See Embarcadero Technologies v. Delphix Corp.*, 117 U.S.P.Q.2d 1518 (TTAB 2016) (precedential). The Board should freely grant leave to amend a pleading at any stage of a proceeding when justice so requires. *See* Fed. R. Civ. P. 15(a) ("The court should freely give leave when justice so requires."); TBMP § 507.02 ("[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires . . ."). In deciding whether "justice so requires" leave to amend, the Board may consider "undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings." *Embarcadero Techs.*, 117 U.S.P.Q.2d, at 9. When granting leave to amend will not unduly delay trial of the case or prejudice the other party, the Court should grant leave to amend. *See Trendsettah USA, Inc. v. Smoke Inn, LLC, et al.*, Cancellation No. 92062052, 2018 WL 4490972, at 3 (TTAB 2018).

#### **A. Opposer's Amendments Are Neither Untimely Nor Prejudicial.**

The timing of the motion for leave to amend plays a large role in determining whether the other party would be prejudiced by allowance of the proposed amendment. *See Embarcadero Techs.*, 117 U.S.P.Q.2d, at 9. Similarly, the "concept of undue delay is inextricably linked with the concept of prejudice to the moving party, such that the Board may determine that if there is no prejudice to the non-moving party, there is no undue delay." *Trendsettah USA*, 2018 WL 4490972, at 3. At this point in the opposition, there is no undue delay on Opposer's part in seeking to make the proposed amendments. Therefore, there is no prejudice to Applicant.

Similarly, Opposer's amendments are not prejudicial to Applicant and, therefore, there is no undue delay.

1. Opposer's Amendments Are Timely.

Opposer's amendments are timely because the parties have jointly and repeatedly extended or suspended the proceedings in order to focus on settlement. Indeed, this case has been out of suspension for only 6 of the 20 months it has been pending. According to the Board, an amendment will not be considered untimely where the proceedings were largely suspended until the motion was filed. *See e.g., Embarcadero Techs.*, 117 U.S.P.Q.2d , at 9, 12 (precedential) (holding that the plaintiff did not unnecessarily delay in seeking to add a new claim where the proceedings were largely suspended until the instant motion was filed). For example, in *Jive Software, Inc. v. Jive Communications, Inc., et al*, precedential, the Board explicitly "declin[ed] to penalize a party for taking no action while proceedings were suspended by the Board for settlement discussions upon agreement of the parties." 125 U.S.P.Q.2d 1175, at 15, 2017 WL 6527147, at \*8 (TTAB 2017). The Board found that the other party was not prejudiced by the timing of the amendment, and granted the motion to amend. *Id.*

Here, the parties have jointly extended the schedule or suspended the several times, all for the purpose of allowing the parties to focus on settlement. It is not untimely now, less than two weeks after the parties' latest suspension ended, that Opposer is moving to amend its pleadings. Applicant will not be prejudiced by the timing of Opposer's amendments, since any alleged delay is justified as a result of the ongoing suspensions agreed to by both parties.

2. Opposer's Amendments Will Not Prejudice Applicant.

Likewise, Opposer's amendments are not prejudicial to Applicant. It is inherently not prejudicial to Applicant for Opposer to delete a claim that it no longer wishes to pursue as

Applicant will no longer have to defend itself against the claim. Courts have permitted parties to delete claims with little or no discussion as to the purported prejudice of the deletion. *See generally, e.g., Pick v. City of Remsen*, 298 F.R.D. 408 (N.D. Iowa 2014) (the only sentence mentioning the motion to amend to delete a claim states: “If [movant] no longer wishes to pursue his existing Claim VII, then he may delete that claim from the fourth amended complaint and renumber his existing Count VIII as Count VII”). Similarly, deleting a claim cannot prejudice the opposing party because it does not present new facts or legal theories. *See Young v. St. Luke’s Hosp.*, Civ. Action No. 09-cv-03460, 2010 WL 1348468 (E.D. Penn. Mar. 30, 2010) (granting motion to amend to delete claim). The same principle applies here. Applicant will not be prejudiced if the Board allows Opposer to delete Claim III.

Furthermore, it is not prejudicial for Opposer to add Opposer’s Common Law Marks. Indeed, the Board has permitted adding allegations of ownership of common law rights in similar circumstances. *See e.g., Narrative Capital Partners, LLC v. Sammann*, Opposition No. 91225578, 2018 WL 2331714, at \*3 (TTAB 2018) (allowing opposer to amend its pleading to add a claim of ownership of another mark). In *Narrative Capital Partners*, the applicant alleged that it would be prejudiced by opposer’s amendment seeking to add a common law mark it knew it was using at the time it filed its original notice of opposition. *Id.* The Board disagreed, holding that applicant would not be prejudiced because the parties had already incorporated the mark into discovery and because the motion was filed before the close of discovery. *Id.* at \*3.

Here, the proceedings were out of suspension for only a limited period of time, and the parties only just recently began to engage in discovery. To date, Applicant has not served any discovery requests. Moreover, if the Board consolidates all of the pending oppositions between

the parties, as it should, Opposer's Common Law Marks will certainly be incorporated into discovery and the case.

Further, Applicant is not prejudiced by Opposer's amendments because Applicant will be allowed ample time to file an Amended Answer.

All of the forgoing factors weigh in favor of granting Opposer's Motion for Leave to Amend.

**B. Opposer's Amendments Are Not Futile.**

Opposer's amendments are also not futile. Deleting Claim III of Opposer's Notice of Opposition will streamline the issues in this opposition as the parties' focus will be on the core claims of likelihood of confusion and likelihood of deception. Moreover, by allowing Opposer to delete the claim, this opposition will be made consistent with the more recent oppositions Opposer filed that the parties anticipate will be consolidated with this action.

Likewise, adding Opposer's Common Law Marks, which serve as a basis for priority and likelihood of confusion, is not futile. The application at issue in this case is for the mark UKB for use in connection with services that include mortgage lending and insurance-related services. Opposer's Common Law Marks have "KB" as their most distinctive element and cover mortgage lending and insurance-related services. None of Opposer's previously plead marks cover insurance services. The important relevance of these marks to this proceeding is self-evident. This factor weighs heavily in favor of granting Opposer's Motion for Leave to Amend.

**C. Opposer's Amendments Are Not Made in Bad Faith or With a Dilatory Motive, and Opposer Has Not Previously Sought to Amend Its Notice of Opposition.**

Lastly, Opposer's amendments are not made in bad faith or with a dilatory motive, and Opposer has not previously sought to amend its Notice of Opposition. These factors weigh in favor of granting Opposer's Motion for Leave to Amend.

**CONCLUSION**

In light of the rules encouraging the Board to liberally allow motions to amend pleadings, and the fact that all of the factors considered on a motion to amend weigh in favor of granting leave, Opposer's Motion for Leave to Amend should be granted. Opposer should be permitted to delete Count III (Dilution) and add Opposer's Common Law Marks in its Notice of Opposition.

Respectfully submitted,

Dated: July 26, 2019

**GRAY, PLANT, MOOTY,  
MOOTY & BENNETT, P.A.**

By/Dean C. Eyler/  
Dean C. Eyler  
Molly R. Littman  
80 South 8th Street  
500 IDS Center  
Minneapolis, MN 55402  
Telephone: (612) 632-3000  
[dean.eyler@gpmlaw.com](mailto:dean.eyler@gpmlaw.com)  
[molly.littman@gpmlaw.com](mailto:molly.littman@gpmlaw.com)

Sheldon H. Klein  
The Watergate—Suite 700  
600 New Hampshire Avenue, NW  
Washington, DC 20037  
Tel: (202) 295-2200  
Fax: (202) 295-2265  
Email: [sheldon.klein@gpmlaw.com](mailto:sheldon.klein@gpmlaw.com)

**Attorneys for Opposer KB Home**

**CERTIFICATE OF SERVICE**

I hereby certify that on July 26, 2019, a true and correct copy of the foregoing  
OPPOSER'S FIRST SET OF DOCUMENT REQUESTS was served via email upon Applicant's  
counsel at the following:

Catherine Holland  
Mincheol Kim  
Bitia Kianin  
Knobbe Martens Olsen & Bear LLP  
2040 Main Street, 14<sup>th</sup> Floor  
Irvine, CA 92614  
[catherine.holland@knobbe.com](mailto:catherine.holland@knobbe.com)  
[mincheol.kim@knobbe.com](mailto:mincheol.kim@knobbe.com)  
[bita.kianin@knobbe.com](mailto:bita.kianin@knobbe.com)  
[efiling@knobbe.com](mailto:efiling@knobbe.com)

Dated: July 26, 2019

/Dean C. Eyler/  
Dean C. Eyler

# EXHIBIT A

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

In re Application No. 87035985, filed May 13, 2016, for the mark UKB, published May 30, 2017

KB HOME,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91237968
	)	(Child to Parent Opp. No. 91226921)
KOOKMIN BANK CO., LTD.,	)	
	)	
Applicant.	)	
	)	

**FIRST AMENDED NOTICE OF OPPOSITION**

Opposer KB Home, a Delaware corporation, having an address of 10990 Wilshire Boulevard, Los Angeles, California 90024, United States, believes that it will be damaged by the registration of the above-identified mark and hereby opposes the same pursuant to the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063(a), as amended.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the service marks KB, KB HOME, KB HOME & Design, and KB HOME MORTGAGE, and registrations therefor on the Principal Register of the United States Patent and Trademark Office (hereinafter the "KB Marks"), as follows:

(a) Reg. No. 2,706,002 - KB - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development. Although not listed in the registration, Opposer also owns and uses this mark in interstate commerce in connection with mortgage lending

services in connection with the construction of, and to assist in the purchase of, single family and multiple family dwelling units, and homeowner's insurance brokerage services.

(b) Reg. No. 2,749,283 -  - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development.

(c) Reg. No. 2,768,634 -  - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development. Although not listed in the registration, Opposer also owns and uses this mark in interstate commerce in connection with mortgage lending services in connection with the construction of, and to assist in the purchase of, single family and multiple family dwelling units, and homeowners insurance brokerage services.

(d) Reg. No. 2,774,497 - KB HOME MORTGAGE - for mortgage lending services in connection with the construction of, and to assist in the purchase of, single family and multiple family dwelling units.

(e) Reg. No. 2,825,554 - KB HOME - for mortgage lending in connection with the construction and brokerage of single family and multiple family dwelling units.

(f) Reg. No. 2,832,387 - KB HOME - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development. Although not listed in the registration, Opposer also owns and uses this mark in interstate commerce in connection with homeowner's insurance brokerage services.

Current printouts of the USPTO TSDR records for the aforementioned six registrations are submitted herewith as Exhibit A.

2. Opposer is also the owner of all right, title, and interest in and to the unregistered service marks:

a) KB - First Use in 2002 – for insurance agency, administration, underwriting, and consulting services in the field of homeowner’s insurance, property and casualty insurance, and mortgage payment protection insurance.

b) KB - First Use in 2002 - for mortgage lending in connection with the construction and brokerage of single family and multiple family dwelling units.

c) KB HOME INSURANCE – First use 2002 – for homeowners insurance brokerage services.

d) KB HOME INSURANCE AGENCY - first use on March 4, 2002 – for insurance agency, administration, underwriting, and consulting services in the field of homeowner’s insurance, property and casualty insurance, and mortgage payment protection insurance.

3. Since long prior to the filing of the Applicant’s Application No. 87035985, and prior to any first use date Applicant may claim, Opposer has continuously used its KB Marks in interstate commerce in connection with the aforementioned services.

4. Opposer's KB Marks are inherently distinctive. Additionally, they have been extensively used, promoted, and advertised by Opposer, and are thus distinctive indications of Opposer as the source of high quality services, generating valuable goodwill for Opposer.

5. Opposer's Registration Nos. 2,706,002; 2,749,283; 2,768,634; 2,825,554; and 2,832,387 are incontestable, and are thus conclusive evidence of their validity and of the validity of the marks covered by those registrations, and of Opposer's ownership of, and exclusive right to use, the marks covered by those registrations.

6. Notwithstanding Opposer's prior established rights in its KB Marks, Applicant, on May 13, 2016, filed an application with the United States Patent and Trademark Office to register the alleged mark UKB (Ser. No. 87035985) for a variety of banking and financial services, including mortgage lending and other services associated with building and real estate, and for a variety of goods used for banking, lending, and other financial services, including bank cards, credit cards, debit cards, card readers, banking software, and related goods.

7. Goods and services listed in the published application are closely related to services offered by Opposer under its KB Marks.

8. On information and belief, Applicant made no use of its alleged mark in commerce prior to the filing date of its application, which is based on a declaration of bona fide intent to use the mark in commerce.

**COUNT I - LIKELIHOOD OF CONFUSION - § 2(d)**

9. Opposer repeats and realleges the allegations of paragraphs 1 through 8 above and incorporates each paragraph by reference as if set forth here.

10. The mark sought to be registered by Applicant so resembles Opposer's KB Marks that its use and registration in connection with Applicant's services is likely to cause confusion, mistake, and to deceive as to the source or origin of Applicant's services, or to cause the public to assume erroneously that Applicant's services are in some way connected with and/or sponsored by or affiliated with Opposer, or vice versa, all within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), as amended, and will injure and damage Opposer and the goodwill and reputation that has been established in Opposer's KB Marks.

**COUNT II - DECEPTION/FALSE SUGGESTION OF CONNECTION - § 2(a)**

11. Opposer repeats and realleges the allegations of paragraphs 1 through 9 above and incorporates each paragraph by reference as if set forth here.

12. The mark sought to be registered by Applicant so closely resembles Opposer's KB Marks that it is likely to cause deception, in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a), as amended, since the mark sought to be registered points uniquely to Opposer, and purchasers will assume that services sold under the mark sought to be registered are connected with Opposer.

13. By reason of all of the foregoing, Opposer will be damaged by the registration of Applicant's mark, and registration should be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of the alleged mark in Application No. 87035985 be denied.

Dated: July 26, 2019

Respectfully submitted,

**GRAY, PLANT, MOOTY,  
MOOTY & BENNETT, P.A.**

By /Sheldon H. Klein/  
Sheldon H. Klein  
The Watergate—Suite 700  
600 New Hampshire Avenue, NW  
Washington, DC 20037  
Tel: (202) 295-2200  
Fax: (612) 632-4444  
[sheldon.klein@gpmlaw.com](mailto:sheldon.klein@gpmlaw.com)

Dean C. Eyler  
Molly R. Littman  
80 South 8th Street  
500 IDS Center  
Minneapolis, MN 55402  
Telephone: (612) 632-3000  
Fax: (612) 632-4444  
[dean.eyler@gpmlaw.com](mailto:dean.eyler@gpmlaw.com)  
[molly.littman@gpmlaw.com](mailto:molly.littman@gpmlaw.com)

**Attorneys for Opposer KB Home**

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

In re Application No. 87035985, filed May 13, 2016, for the mark UKB, published May 30, 2017

KB HOME,	)		
	)		
Opposer,	)	Opposition	No.
	)		
<u>91237968</u>	)		
v.	)	<u>(Child to Parent Opp. No. 91226921)</u>	
	)		
KOOKMIN BANK CO., LTD.,	)		
	)		
Applicant.	)		
	)		

**FIRST AMENDED NOTICE OF OPPOSITION**

Opposer KB Home, a Delaware corporation, having an address of 10990 Wilshire Boulevard, Los Angeles, California 90024, United States, believes that it will be damaged by the registration of the above-identified mark and hereby opposes the same pursuant to the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063(a), as amended.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the service marks KB, KB HOME, KB HOME & Design, and KB HOME MORTGAGE, and registrations therefor on the Principal Register of the United States Patent and Trademark Office (hereinafter the "KB Marks"), as follows:

(a) Reg. No. 2,706,002 - KB - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development. Although not listed in the registration, Opposer also owns and uses this mark in interstate commerce in connection with mortgage lending

services in connection with the construction of, and to assist in the purchase of, single family and multiple family dwelling units, and homeowner's insurance brokerage services.



~~(b)~~ (b) Reg. No. 2,749,283 - ~~KB-HOME & (Rectangle) Design~~  
- for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development.



(c) Reg. No. 2,768,634 - ~~KB-HOME & (Square) Design~~ - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development. Although not listed in the registration, Opposer also owns and uses this mark in interstate commerce in connection with mortgage lending services in connection with the construction of, and to assist in the purchase of, single family and multiple family dwelling units, and homeowners insurance brokerage services.

(d) Reg. No. 2,774,497 - KB HOME MORTGAGE - for mortgage lending services in connection with the construction of, and to assist in the purchase of, single family and multiple family dwelling units.

(e) Reg. No. 2,825,554 - KB HOME - for mortgage lending in connection with the construction and brokerage of single family and multiple family dwelling units.

(f) Reg. No. 2,832,387 - KB HOME - for construction services, namely, planning, laying out and construction of residential communities; construction of single family and multiple family dwelling units; real estate development. Although not listed in the registration, Opposer also owns and uses this mark in interstate commerce in connection with homeowner's insurance brokerage services.

\_\_\_\_ Current printouts of the USPTO TSDR records for the aforementioned six registrations are submitted herewith as Exhibit A. -

2. Opposer is also the owner of all right, title, and interest in and to the unregistered service ~~mark KB HOME INSURANCE for homeowner's insurance brokerage services, and said mark is included in the term "KB Marks" used herein.~~ marks:

a) KB - First Use in 2002 - for insurance agency, administration, underwriting, and consulting services in the field of homeowner's insurance, property and casualty insurance, and mortgage payment protection insurance.

b) KB - First Use in 2002 - for mortgage lending in connection with the construction and brokerage of single family and multiple family dwelling units.

c) KB HOME INSURANCE - First use 2002 - for homeowners insurance brokerage services.

d) KB HOME INSURANCE AGENCY - first use on March 4, 2002 - for insurance agency, administration, underwriting, and consulting services in the field of homeowner's insurance, property and casualty insurance, and mortgage payment protection insurance.

3. ~~2.~~ Since long prior to the filing of the Applicant's Application No. 87035985, and prior to any first use date Applicant may claim, Opposer has continuously used its KB Marks in interstate commerce in connection with the aforementioned services.

4. ~~3.~~ Opposer's KB Marks are inherently distinctive. Additionally, they have been extensively used, promoted, and advertised by Opposer, and are thus distinctive indications of Opposer as the source of high quality services, generating valuable goodwill for Opposer.

5. ~~4.~~ Opposer's Registration Nos. 2,706,002; 2,749,283; 2,768,634; 2,825,554; and 2,832,387 are incontestable, and are thus conclusive evidence of their validity and of the validity

of the marks covered by those registrations, and of Opposer's ownership of, and exclusive right to use, the marks covered by those registrations.

6. ~~5.~~ Notwithstanding Opposer's prior established rights in its KB Marks, Applicant, on May 13, 2016, filed an application with the United States Patent and Trademark Office to register the alleged mark UKB (Ser. No. 87035985) for a variety of banking and financial services, including mortgage lending and other services associated with building and real estate, and for a variety of goods used for banking, lending, and other financial services, including bank cards, credit cards, debit cards, card readers, banking software, and related goods.

7. ~~6.~~ Goods and services listed in the published application are closely related to services offered ~~under~~ by Opposer under its KB Marks.

8. ~~7.~~ On information and belief, Applicant made no use of its alleged mark in commerce prior to the filing date of its application, which is based on a declaration of bona fide intent to use the mark in commerce.

#### **COUNT I - LIKELIHOOD OF CONFUSION - § 2(d)**

9. ~~8.~~ Opposer repeats and realleges the allegations of paragraphs 1 through ~~7~~8 above and incorporates each paragraph by reference as if set forth here.

10. ~~9.~~ The mark sought to be registered by Applicant so resembles Opposer's KB Marks that its use and registration in connection with Applicant's services is likely to cause confusion, mistake, and to deceive as to the source or origin of Applicant's services, or to cause the public to assume erroneously that Applicant's services are in some way connected with and/or sponsored by or affiliated with Opposer, or vice versa, all within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), as amended, and will injure and damage Opposer and the goodwill and reputation that has been established in Opposer's KB Marks.

#### **COUNT II - DECEPTION/FALSE SUGGESTION OF CONNECTION - § 2(a)**

11. ~~10.~~ Opposer repeats and realleges the allegations of paragraphs 1 through 9 above and incorporates each paragraph by reference as if set forth here.

12. ~~11.~~ The mark sought to be registered by Applicant so closely resembles Opposer's KB Marks that it is likely to cause deception, in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a), as amended, since the mark sought to be registered points uniquely to Opposer, and purchasers will assume that services sold under the mark sought to be registered are connected with Opposer.

~~**COUNT III - DILUTION BY BLURRING - § 43(e)**~~

~~12. — Opposer repeats and realleges the allegations of paragraphs 1 through 11 above and incorporates each paragraph by reference as if set forth here.~~

~~13. — As a separate cause of action and ground for relief, Opposer alleges that Applicant's use and attempted registration of the mark sought to be registered constitutes dilution by blurring, in violation of Section 43(e) of the Trademark Act of 1946, 15 U.S.C. § 1125(e), as amended.~~

~~14. — Opposer's KB Marks are famous. They are widely recognized by the general consuming public of the United States as a designation of source of Opposer's services.~~

~~15. — Opposer's KB Marks have been extensively used and promoted throughout the United States for many years, and such use has been substantially exclusive.~~

~~16. — A substantial amount of services have been sold and provided under Opposer's KB Marks throughout the United States.~~

~~17. — Opposer's KB Marks enjoy a high degree of recognition.~~

~~18. — Applicant's application was filed long after Opposer's KB Marks became famous.~~

~~19. Applicant's applied for alleged mark is likely to cause an association arising from the similarity between Applicant's alleged mark and Opposer's KB Marks that impairs the distinctiveness of Opposer's KB Marks.~~

~~20. Applicant's alleged mark and Opposer's KB Marks are highly similar.~~

~~21. Opposer's KB Marks are highly distinctive.~~

~~22. Applicant's alleged mark dilutes by blurring Opposer's KB Marks, within the meaning of Section 43(e) of the Trademark Act of 1946, 15 U.S.C. §1125(e), as amended.~~

13. ~~23.~~ By reason of all of the foregoing, Opposer will be damaged by the registration of Applicant's alleged's mark, and registration should be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of the alleged mark in Application No. 87035985 be denied.

~~KB HOME~~

Dated: July 26, 2019

Respectfully submitted.

GRAY, PLANT, MOOTY,  
MOOTY & BENNETT, P.A.

By: \_\_\_\_\_

\_\_\_\_\_/Sheldon H. Klein/

\_\_\_\_\_  
Sheldon H. Klein

~~Gray, Plant, Mooty, Mooty & Bennett, P.A.~~

~~The Watergate—Suite 700  
600 New Hampshire Avenue, NW  
Washington, D.C. DC 20037~~

~~Tel.: (202) 295-2200~~

~~Fax: (202) 295-2265-612) 632-4444~~

~~Email: sheldon.klein@gpmlaw.com~~

~~sheldon.klein@gpmlaw.com~~

Dean C. Eyler

Molly R. Littman

80 South 8th Street

500 IDS Center

[Minneapolis, MN 55402](#)  
[Telephone: \(612\) 632-3000](#)  
[Fax: \(612\) 632-4444](#)  
[dean.eyler@gpmlaw.com](mailto:dean.eyler@gpmlaw.com)  
[molly.littman@gpmlaw.com](mailto:molly.littman@gpmlaw.com)

~~November 22, 2017~~ ~~Attorney~~ Attorneys for  
Opposer KB Home