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Filing date: **03/09/2020**

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	Clark Capital Management Group, Inc.
Granted to Date of previous extension	03/11/2020
Address	1650 MARKET STREET 53rd Floor PHILADELPHIA, PA 19103 UNITED STATES
Attorney information	CAMILLE M. MILLER COZEN O'CONNOR 1650 MARKET STREET SUITE 2800 PHILADELPHIA, PA 19103 UNITED STATES cmiller@cozen.com, treginelli@cozen.com, kgibbs@cozen.com, phipdocketing@cozen.com, cbranka@cozen.com 2156657273

**Applicant Information**

Application No	88307857	Publication date	11/12/2019
Opposition Filing Date	03/09/2020	Opposition Period Ends	03/11/2020
Applicant	Capital One Financial Corporation 12077-0470 / Trademarks 15000 Capital One Drive Richmond, VA 23238 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Downloadable Mobile application software for use in the review and funding of automobile loans being assigned to a lender; Downloadable mobile application software for use in purchasing automobiles and automobile financing; Downloadable mobile application software for use by automobile dealers to assist customers in obtaining automobile loans</p>
<p>Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Automobile lending services, namely, installment loans; providing information about automobile financing; providing an Internet website portal for use in selling and assigning automobile loans; providing an Internet website portal for use in automobile financing; providing an Internet website portal for use by automobile dealers to assist custom-</p>

ers in obtaining automobile loans

## Grounds for Opposition

Priority and likelihood of confusion

Trademark Act Section 2(d)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1662756	Application Date	09/21/1990
Registration Date	10/29/1991	Foreign Priority Date	NONE
Word Mark	NAVIGATOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1987/03/10 First Use In Commerce: 1987/03/10 investment advisory services in the field of stocks and mutual funds		

U.S. Registration No.	2639961	Application Date	06/10/1998
Registration Date	10/22/2002	Foreign Priority Date	NONE
Word Mark	NAVIGATOR FUND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/04/01 First Use In Commerce: 2002/04/01 INVESTMENT ADVISORY SERVICES IN THE FIELD OF STOCKS AND MUTUAL FUNDS		

U.S. Registration No.	4453183	Application Date	04/12/2012
Registration Date	12/24/2013	Foreign Priority Date	NONE
Word Mark	NAVIGATOR FUNDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/04/01 First Use In Commerce: 2002/04/01 mutual fund brokerage, distribution, investment; mutual fund services, namely, mutual fund brokerage, mutual fund distribution and the administration and man-		

	agement of mutual funds, financial portfolio solutions, and investments; investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocationservices; stock brokerage services; fund investment consultation; funds investment
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Attachments	85596252#TMSN.png( bytes ) CCMG450966 Capital One FUNDING NAVIGATOR Opposition.pdf(223847 bytes )
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Signature	/Camille M. Miller/
Name	CAMILLE M. MILLER
Date	03/09/2020

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

CLARK CAPITAL	)	
MANAGEMENT GROUP, INC.,	)	Opposition No.: _____
	)	
Opposer,	)	Serial No.: 88/307,857
	)	
v.	)	Mark: FUNDING NAVIGATOR
	)	
CAPITAL ONE FINANCIAL	)	
CORPORATION,	)	
	)	
Applicant.	)	
_____	)	

**OPPOSER CLARK CAPITAL MANAGEMENT GROUP, INC.’S NOTICE OF  
OPPOSITION TO APPLICANT CAPITAL ONE FINANCIAL CORPORATION**

Opposer Clark Capital Management Group, Inc. (“Clark Capital”), a Pennsylvania corporation with a principal place of business at One Liberty Place, 1650 Market Street, Philadelphia, PA 19103, believes that it will be damaged by the allowance and/or registration of the mark shown in the above-referenced application, published in the November 12, 2019 issue of the *Official Gazette*, and pursuant to 37 CFR 2.101 hereby files this notice of opposition against Capital One Financial Corporation (“Capital One” or “Applicant”) on the following grounds:

1. Applicant, Capital One, is a Delaware corporation with a place of business at 15000 Capital One Drive, Richmond, VA 23238.
2. On February 19, 2019, Applicant filed an intent-to-use application with the U.S. Patent and Trademark Office to register the mark FUNDING NAVIGATOR (the “Applicant’s Mark”) in connection with certain goods and services in Classes 9 and 36.
3. This application was afforded U.S. Trademark Application No. 88/307,857 (the “857 Application”) and the mark underlying this application published on the Trademark

Official Gazette on November 12, 2019 in connection with the following goods and services (the “Applicant’s Goods and Services”): downloadable mobile application software for use in the review and funding of automobile loans being assigned to a lender; downloadable mobile application software for use in purchasing automobiles and automobile financing; downloadable mobile application software for use by automobile dealers to assist customers in obtaining automobile loans in Class 9 and automobile lending services, namely, installment loans; providing information about automobile financing; providing an internet website portal for use in selling and assigning automobile loans; providing an internet website portal for use in automobile financing; providing an internet website portal for use by automobile dealers to assist customers in obtaining automobile loans in Class 36.

4. On November 18, 2019, Clark Capital filed with the Trademark Trial and Appeal Board (“TTAB” or “Board”) a First 90-Day Request for Extension of Time to Oppose.

5. On November 18, 2019, the Board granted Clark Capital’s First 90-Day Request for Extension of Time to Oppose, allowing Clark Capital until March 11, 2020 to oppose the ‘857 Application.

6. Clark Capital is an independent asset management firm that provides financial counseling and planning services including, but not limited to, investment advisory services, investment consulting, wealth management, asset allocation, and retirement planning services to its customers, such as individuals, corporations, and institutions throughout the United States.

7. Clark Capital owns numerous U.S. trademark registrations comprising the term “NAVIGATOR” for use in connection with investment advisory, financial counseling and planning services including, but not limited to, investment advisory services, investment consulting, wealth management, asset allocation, and retirement planning services.

8. For example, on September 21, 1990, Clark Capital filed an application for registration of the mark NAVIGATOR® in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. (the “NAVIGATOR® Mark”). This application was assigned Serial No. 74/099,288 and covers the use of this mark in connection with “investment advisory services in the field of stocks and mutual funds” in Class 36. The date of first use is at least as early as March 10, 1987. This application was allowed by the Patent and Trademark Office and issued as Registration No. 1,662,756 on October 29, 1991. The mark has acquired incontestable status with the approval of its Section 15 Declaration. This registration is active and valid.

9. On June 10, 1998, Clark Capital filed an application for registration of the mark NAVIGATOR FUND® in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. (the “NAVIGATOR FUND® Mark”). This application was assigned Serial No. 75/499,466 and covers the use of this mark in connection with “investment advisory services in the field of stocks and mutual funds” in Class 36. The date of first use is at least as early as April 1, 2002. This application was allowed by the Patent and Trademark Office and issued as Registration No. 2,639,961 on October 22, 2002. The mark has acquired incontestable status with the approval of its Section 15 Declaration. This registration is active and valid.

10. On April 12, 2012, Clark Capital filed an application for registration of the mark NAVIGATOR FUNDS® in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. (the “NAVIGATOR FUNDS® Mark”). This application was assigned Serial No. 85/596,252 and covers the use of this mark in connection with “mutual fund brokerage, distribution, investment; mutual fund services, namely,

mutual fund brokerage, mutual fund distribution and the administration and management of mutual funds, financial portfolio solutions, and investments; investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services; fund investment consultation; funds investment” in Class 36. The date of first use is at least as early as April 1, 2002. This application was allowed by the Patent and Trademark Office and issued as Registration No. 4,453,183 on December 24, 2013. The mark has acquired incontestable status with the approval of its Section 15 Declaration. This registration is active and valid. The aforementioned marks in paragraphs 8-10 above are referred to collectively herein as the “NAVIGATOR® Marks” and such registrations are referred to herein as the “NAVIGATOR® Registrations”.

11. Since 1987, Clark Capital has used, and expanded its use, of the NAVIGATOR® Marks and the NAVIGATOR® Marks have developed invaluable goodwill and reputation within the financial planning industry as a designator of source of Clark Capital’s financial planning, investment advisory, and related services.

12. Clark Capital has expended substantial time, money, and resources marketing, advertising, and promoting its financial services under the NAVIGATOR® Marks.

13. Clark Capital has vigorously defended its marks against infringers and potential infringers.

14. As a result of its widespread, continuous, and exclusive use of the NAVIGATOR® Marks to identify its financial services and Clark Capital as its source, Clark Capital owns valid and subsisting federal statutory and common law rights to the NAVIGATOR® Marks.

15. Clark Capital’s NAVIGATOR® Registrations have filing and first use dates that

predate the February 19, 2019 filing of the '857 Application and, thus, the NAVIGATOR® Marks have priority over Applicant's Mark.

16. Clark Capital's counsel sent Applicant's counsel correspondence notifying Applicant of Clark Capital's rights in and to the NAVIGATOR® Marks and objecting to Applicant's '857 Application and requesting withdrawal of same.

17. Applicant's counsel later responded that it would not withdraw the '857 Application.

### **COUNT 1- LIKELIHOOD OF CONFUSION**

18. Clark Capital hereby incorporates by reference the foregoing paragraphs as if set forth herein.

19. The NAVIGATOR® Marks are inherently distinctive and, through Clark Capital's longstanding use of same, has maintained distinctiveness to both the consuming public and within the financial services industries.

20. The FUNDING NAVIGATOR mark shown in the '857 Application is confusingly and deceptively similar to Clark Capital's NAVIGATOR® Marks, such that the trade and purchasing public will be confused by and deceived into believing that Applicant's Goods and Services originate with Opposer, or are otherwise authorized by, sponsored by, licensed by, affiliated with, or associated with Opposer, which is not the case.

21. Clark Capital's NAVIGATOR FUND® and NAVIGATOR FUNDS® Marks are comprised of almost identical terms as Applicant's FUNDING NAVIGATOR mark and the only slight differences are the addition of the "-ing" suffix and switching the order of the words, which is not sufficient to minimize a likelihood of confusion.

22. Applicant's '857 Application disclaims the word "FUNDING" and does not claim

any exclusive rights to the disclaimed portion of the FUNDING NAVIGATOR mark, meaning that NAVIGATOR is likely the dominant portion of Applicant's Mark, which is identical in sound and appearance to Clark Capital's NAVIGATOR® Mark and likely to cause consumer confusion, mistake, and/or deception.

23. Clark Capital's well-known NAVIGATOR® Marks and Applicant's Mark are similar in sound, appearance, meaning, and overall commercial impression as Applicant's Mark contains, in its entirety, Clark Capital's NAVIGATOR® Mark.

24. Applicant's Mark is intended to be used in connection with goods and services that are closely related to those offered under Opposer's NAVIGATOR® Marks, including, financial, loans, and lending goods and services. Consumers would likely associate such goods and services as originating from the same source as a provider of the services identified in the NAVIGATOR® Registrations.

25. Applicant's Mark, which incorporates the entirety of the NAVIGATOR® Mark and also includes "FUND," which is included in Opposer's NAVIGATOR FUND® and NAVIGATOR FUNDS® Marks, so resembles the NAVIGATOR® Marks such that if Applicant is permitted to register Applicant's Mark, consumer confusion is likely as consumers will believe that Applicant and/or its goods and services offered under Applicant's Mark are associated or affiliated with, or otherwise sponsored or endorsed by, Clark Capital when that, in fact, is not the case, and indeed the registration of Applicant's Mark for Applicant's Goods and Services will likely lead to confusion, mistake, or deception of the public within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Clark Capital will therefore be damaged by the registration of Applicant's Mark.

26. In view of the similarity of the parties' respective marks and their respective

goods and services, Applicant's use and registration of its proposed mark in International Class 9 and 36 is likely to cause confusion, or to cause mistake, or to deceive.

27. Registration of Applicant's Mark on the Principal or Supplemental Register in connection with the Applicant's Goods and Services would restrict and impair Clark Capital's right to use, develop and expand its use of its NAVIGATOR® Marks, and would otherwise cause injury and damage to Clark Capital and its NAVIGATOR® Marks, as well as damage Clark Capital's goodwill and reputation.

28. If Applicant is permitted to register its mark, and, thereby, obtain the prima facie exclusive right to use the Applicant's Mark in commerce in connection with Applicant's Goods and Services, confusion is likely to result, and Clark Capital will be damaged thereby.

WHEREFORE, Clark Capital requests that its opposition to U.S. Trademark Application Serial No. 88/307,857 be sustained and that the application be refused registration or allowance.

Respectfully submitted,



Date: March 9, 2020

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