

ESTTA Tracking number: **ESTTA1253658**

Filing date: **12/12/2022**

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	World Trade Centers Association, Inc.
Granted to date of previous extension	12/14/2022
Address	115 BROADWAY, SUITE 1202 NEW YORK, NY 10006 UNITED STATES
Attorney information	FARA S. SUNDERJI DORSEY & WHITNEY LLP 51 WEST 52ND STREET NEW YORK, NY 10019-6119 UNITED STATES Primary email: ny.trademark@dorsey.com Secondary email(s): sunderji.fara@dorsey.com, ewing.bruce@dorsey.com, sadler.lindsey@dorsey.com 212.415.9200
Docket no.	495606-00125

Applicant information

Application no.	90477763	Publication date	08/16/2022
Opposition filing date	12/12/2022	Opposition period ends	12/14/2022
Applicant	WTC Group Inc. 1389 LINDSEY PL DELTA, BC, V3M6V1 CANADA		

Goods/services affected by opposition

Class 009. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Downloadable computer software for freight forwarding services, namely, for use in management of tracking assets and specialized freight transportation services, supply chain logistics and reverse logistics management and for data management and tracking freight
Class 035. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Business consulting and management with relation to providing online services and digital marketing in the field of freight forwarding services
Class 039. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Freight transportation services, namely, freight transportation by air; freight transportation by truck; freight transportation by rail; freight transportation by ship; warehousing; stevedoring; providing vessel mooring facilities in the nature of

wharves; supply chain logistics and reverse logistics, namely, the transportation of goods for others by air, rail, ship, or truck

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols	Trademark Act Section 2(a)

Marks cited by opposer as basis for opposition

U.S. registration no.	1469489	Application date	09/26/1986
Register	Principal		
Registration date	12/15/1987	Foreign priority date	NONE
Word mark	WORLD TRADE CENTER		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: Mar 1961 First Use In Commerce: Mar 1961 ASSOCIATION SERVICES -- NAMELY, FOSTERING AND PROMOTING WORLD TRADE AND INTERNATIONAL BUSINESS RELATIONSHIPS		

U.S. registration no.	1749086	Application date	05/21/1992
Register	Principal		
Registration date	01/26/1993	Foreign priority date	NONE
Word mark	WTC		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: Apr 17, 1968 First Use In Commerce: Apr 17, 1968 association services; namely, fostering and promoting world trade and international business relationships		

U.S. registration no.	4857631	Application date	07/14/2014
Register	Principal		
Registration date	11/24/2015	Foreign priority date	NONE
Word mark	WTCA		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Jan 25, 1970 First Use In Commerce: Jan 25, 1970 ASSOCIATION SERVICES, NAMELY, FOSTERING AND PROMOTING INTERNATIONAL BUSINESS AND TRADE RELATIONSHIPS		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark	WTC		
Goods/services	Services related to trade shows and special events, logistics management, supply chain logistics, transportation logistics and warehousing, and international trade; providing business information via a website; and education services in the areas of seminars, educational course, and developmental programs focusing on business and international trade, effective logistics management, and logistics cost optimization		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark	WORLD TRADE CENTER		
Goods/services	Services related to trade shows and special events, logistics management, supply chain logistics, transportation logistics and warehousing, and international trade; providing business information via a website; and education services in the areas of seminars, educational course, and developmental programs focusing on business and international trade, effective logistics management, and logistics cost optimization		

Attachments	Notice of Opposition - WTCGROUP.COM Design Application.pdf(166194 bytes)
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Signature	/fss/
Name	FARA S. SUNDERJI
Date	12/12/2022

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

In the matter of Application Serial No: 90/477,763
For the Mark: **WTC WTCGROUP.COM & Design**



Published August 16, 2022

WORLD TRADE CENTERS	:	
ASSOCIATION, INC.,	:	
	:	Opposition No. _____
Opposer,	:	
	:	
v.	:	<u>NOTICE OF OPPOSITION</u>
	:	
WTC GROUP INC.	:	
	:	
Applicant.	:	

Opposer World Trade Centers Association, Inc. (“WTCA” or “Opposer”), a non-profit trade association incorporated under the laws of the state of Delaware and located in New York, New York, believes it will be damaged by registration of the mark **WTC WTCGROUP.COM & Design** (the “Subject Mark”), shown above, sought to be registered by Application Serial No. 90/477,763, published in the Official Gazette on August 16, 2022, in International Classes 9, 35, and 39, and having been granted an extension of time to oppose until December 14, 2022, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. WTCA is a non-profit trade association located in New York, New York, formed in 1969 to promote international business relationships and encourage participation in world trade, including through facilitating international trade logistics.

2. For many years, and prior to the filing date of the application herein opposed, the trademarks WORLD TRADE CENTER, WTC, and other WTC-formative marks have been exclusively used by Opposer and/or its licensee members in connection with a wide variety of services, including association services; services related to trade shows and special events, logistics management, supply chain logistics, transportation logistics and warehousing, and international trade; providing business information via a website; and education services in the areas of seminars, educational course, and developmental programs focusing on business and international trade, effective logistics management, and logistics cost optimization.

3. WTCA currently has more than 300 licensee members worldwide, including more than forty in the United States. WTCA's members are licensed by WTCA, among other things, to operate WORLD TRADE CENTER and/or WTC-branded facilities to promote international business and trade. The association and its licensed members serve as an international ecosystem of global connections, iconic properties and integrated trade services under the umbrella of the prestigious brand.

4. Ever since its adoption and use of the WORLD TRADE CENTER, WTC, and WTC-formative marks (collectively, "Opposer's WTC Marks"), Opposer and/or its licensees have widely used and extensively sold, advertised and promoted services in interstate commerce bearing Opposer's WTC Marks. As a consequence of same, the consuming public and trade have come to recognize and do recognize Opposer's WTC Marks as being used by Opposer and/or its member licensees, and to identify and associate Opposer's WTC Marks with Opposer, and Opposer derives substantial goodwill and value from the aforesaid recognition, association and identification by the consuming public and trade.

5. In addition to its common law rights, Opposer is the owner of the following U.S. trademark registrations, among others:

Trademark	Reg. Info.	Goods/Services
WORLD TRADE CENTER	Reg. No. 1469489 Reg. Date: Dec. 15, 1987	Cl. 42: <i>Association services -- namely, fostering and promoting world trade and international business relationships</i>
WTC	Reg. No. 1749086 Reg. Date: Jan. 26, 1993	Cl. 42: <i>Association services; namely, fostering and promoting world trade and international business relationships</i>
WTCA	Reg. No. 4857631 Reg. Date: Nov. 24, 2015	Cl. 35: <i>Association services, namely, fostering and promoting international business and trade relationships</i>

6. Each of these registrations is valid and subsisting, unrevoked and un-cancelled, and Opposer is the owner of these registrations and all of the goodwill represented thereby. Moreover, Registration Nos. 1469489, 1749086, and 4857631 are incontestable pursuant to 15 U.S.C. § 1065.

7. By the application herein opposed, Applicant seeks to register the mark WTC WTCGROUP.COM & Design for “*Downloadable computer software for freight forwarding services, namely, for use in management of tracking assets and specialized freight transportation services, supply chain logistics and reverse logistics management and for data management and tracking freight*” in International Class 9; “*Business consulting and management with relation to providing online services and digital marketing in the field of freight forwarding services*” in International Class 35; and “*Freight transportation services, namely, freight transportation by air; freight transportation by truck; freight transportation by rail; freight transportation by ship; warehousing; stevedoring; providing vessel mooring facilities in the nature of wharves; supply chain logistics and reverse logistics, namely, the transportation of goods for others by air, rail, ship, or truck*” in International Class 39. The subject Application was filed based on an intent-to-use the Subject Mark in interstate U.S. commerce, pursuant to 15 U.S.C. § 1051(b).

COUNT I
Likelihood of Confusion

8. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 7 hereof as if fully set forth herein.

9. Applicant's Subject Mark so resembles Opposer's WTC Marks, as to be likely, when used in connection with Applicant's goods and services, to cause confusion, to cause mistake, or to deceive, with consequent injury to Opposer, the consuming public, and the trade.

10. Specifically, and without limitation, the marketing and sale of Applicant's aforementioned goods and services under the Subject Mark is likely to cause consumers to believe that Applicant's goods and services are those of Opposer, that Applicant's goods and services are associated with the services of Opposer, and/or that Applicant is somehow related to or licensed by Opposer. Accordingly, Applicant's Subject Mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

COUNT II
False Suggestion of a Connection

11. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 10 hereof as if fully set forth herein.

12. Applicant's Subject Mark is a close approximation of Opposer's WTC Marks, and because of the extensive use of Opposer's WTC Marks by Opposer and its more than 300 licensees, Applicant's Subject Mark would be recognized by consumers and the trade as pointing uniquely and unmistakably to Opposer.

13. Opposer is not connected with the goods to be sold and the services to be rendered by Applicant as identified in the Application herein opposed. Yet, because of the renown and reputation of Opposer's WTC Marks and Opposer's identity, the public and the trade

will presume a connection between Opposer and Applicant when Applicant's Subject Mark is used in connection with such goods and services. Accordingly, Applicant's Subject Mark is not entitled to registration pursuant to 15 U.S.C. § 1052(a).

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Subject Mark and prays this opposition be sustained, and that Application Serial No. 90/477,763 be denied.

Please recognize as attorneys for Opposer in this proceeding Bruce R. Ewing and Fara S. Sunderji, members of the Bar of the State of New York, and Lindsey Sadler, member of the Bar of the State of Colorado.

Please address all correspondence to Fara Sunderji at the below address.

Dated this 12th of December, 2022.

DORSEY & WHITNEY LLP

By: */Fara S. Sunderji/*

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