ESTTA Tracking number: **ESTTA869672**

Filing date: **01/08/2018**

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

| | |
|---|---|
| Proceeding | 92067118 |
| Party | Defendant<br>Pentagon Federal Credit Union |
| Correspondence Address | CARRIE A SHUFFLEBARGER<br>THOMPSON HINE<br>312 WALNUT ST 14TH FLOOR<br>CINCINNATI, OH 45202<br>UNITED STATES<br>Email: Carrie.shufflebarger@ThompsonHine.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Carrie A. Shufflebarger |
| Filer's email | carrie.shufflebarger@thompsonhine.com, clif.mccann@thompsonhine.com, docket@thompsonhine.com |
| Signature | /cas/ |
| Date | 01/08/2018 |
| Attachments | 7 Penfed V. RoundPoint Answer and Counterclaim.pdf(90405 bytes ) |

## Registration Subject to the filing

| | | | |
|---|---|---|---|
| Registration No. | 4571735 | Registration date | 07/22/2014 |
| Registrant | ROUNDPOINT MORTGAGE SERVICING CORPORATION<br>5016 PARKWAY PLAZA BOULEVARD, SUITE 200<br>CHARLOTTE, NC 28217<br>UNITED STATES | | |

## Goods/Services Subject to the filing

Class 036. First Use: 2013/07/31 First Use In Commerce: 2013/07/31
All goods and services in the class are requested, namely: Financial services, namely, mortgage planning; Home appraisal services; Insurance agencies; Loan financing; Mortgage banking services, namely, origination, acquisition, servicing, securitization and brokerage of mortgage loans; Mortgage lending; Mortgage procurement for others; Real estate agencies; Real estate appraisal and valuation; Real estate brokerage

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

| | | |
|---|---|---|
| ROUNDPOINT MORTGAGE SERVICES CORPORATION<br><br>Petitioner/Counterclaim Respondent,<br><br>v.<br><br>PENTAGON FEDERAL CREDIT UNION,<br><br>Registrant/Counterclaimant. | : | Cancellation No. 92067118<br><br>Registration No 4,807,511 |

**ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM**

Pursuant to Fed. R. Civ. P. 13 and Trademark Rule 2.114(b)(3)(i), Registrant Pentagon Federal Credit Union ("PenFed") submits the following Answer, Affirmative Defenses, and Counterclaim in response to Petitioner RoundPoint Mortgage Servicing Corporation's ("RoundPoint") Amended Petition to Cancel.

With respect to the preamble paragraph, PenFed lacks sufficient information to either admit or deny the allegations in the preamble paragraph, and therefore denies same.

1. PenFed lacks sufficient information to admit or deny the allegations in Paragraph 1 of the Petition for Cancellation, and therefore denies same.

2. PenFed lacks sufficient information to admit or deny the allegations in Paragraph 2 of the Petition for Cancellation, and therefore denies same.

3. PenFed admits Exhibit A is a copy of U.S. Registration No. 4,571,735 and the TSDR status information for this registration as of December 8, 2017, which speaks for itself. PenFed denies the remaining allegations of Paragraph 3.

4. PenFed admits it has a business address at 2930 Eisenhower Avenue, Alexandria, Virginia 22314, and that it owns U.S. Registration No. 4,807,511 for use of the mark

with "credit union services; credit unions." PenFed further admits the application to register this mark was filed on January 14, 2015, and registered on September 8, 2015. PenFed denies the remaining allegations in Paragraph 4.

5. PenFed lacks sufficient information to admit or deny the allegations in Paragraph 5 of the Petition for Cancellation, and therefore denies same.

6. PenFed admits that it began use of at least as early as January 1, 2015. PenFed denies the remaining allegations in Paragraph 6 of the Petition for Cancellation.

7. PenFed admits that U.S. Registration No. 4,571,735 recites a filing date of December 12, 2013. PenFed denies the remaining allegations in Paragraph 7 of the Petition for Cancellation.

8. PenFed admits that it uses the mark in connection with services that include providing mortgage loans and lending and related services. PenFed lacks sufficient information to admit or deny the remaining allegations in Paragraph 8 of the Petition for Cancellation, and therefore denies same.

9. PenFed lacks sufficient information to admit or deny the allegations in Paragraph 9 of the Petition for Cancellation, and therefore denies same.

10. PenFed admits that Petitioner's mark so resembles marks owned and used by PenFed since prior to July 2013 as to be likely, when used in connection with the services of Petitioner, to cause confusion, or to cause mistake, or to deceive. PenFed denies the remaining allegations in Paragraph 10 of the Petition for Cancellation.

11. PenFed denies the allegations in Paragraph 11 of the Petition for Cancellation.

PenFed denies the allegations in the final Paragraph of the Petition for Cancellation, and accordingly prays that RoundPoint's Petition to Cancel Registration No. 4,807,511 be refused.

**AFFIRMATIVE DEFENSES**

1. RoundPoint's Petition for Cancellation fails to state a claim upon which relief may be granted.

2. RoundPoint's Petition for Cancellation fails insofar as PenFed possesses priority rights for the use of marks containing or consisting of a pentagon-shaped design in connection with mortgage services.

3. PenFed reserves the right to assert additional affirmative defenses as this case progresses.

## COUNTERCLAIM

Registrant-Counterclaimant Pentagon Federal Credit Union ("PenFed"), a United States federally chartered credit union with headquarters located at 7940 Jones Branch Dr, McLean, VA 22102 (formerly 2930 Eisenhower Avenue, Alexandria, VA 22314), is being damaged by Petitioner RoundPoint Mortgage Services Corporation's ("RoundPoint") U.S. Registration No. 4,571,735 for the mark depicted below ("RoundPoint's Mark"), and hereby petitions for cancellation of the same:

ROUNDPOINT

As grounds for this Petition for Cancellation, PenFed alleges that:

1. PenFed is the Registrant/Defendant in pending Trademark Cancellation No. 92067118, in which RoundPoint seeks cancellation of PenFed's Registration No. 4,807,511 for the mark PENFED CREDIT UNION ("PenFed's Registered Mark"), alleging said mark is likely to cause confusion with RoundPoint's Mark ROUNDPOINT ("RoundPoint's Mark") in violation of Section 2(d) of the Lanham Act.

2. PenFed has standing to petition to cancel the registration for RoundPoint's Mark pursuant to Section 14 of the Lanham Act, because PenFed has a real interest in the proceeding and such registration is causing damage to PenFed.

3. Established as the Pentagon Federal Credit Union in 1935, PenFed is a federally chartered credit union, serving members in all 50 states and the District of Columbia, as well as in Guam, Puerto Rico, Okinawa, and Portugal.

4. Since 1935, PenFed has continuously used and maintained common law rights in marks in which the most distinctive element is the word "PENTAGON," an abbreviation of the word "PENTAGON," and/or the design of a pentagon shape (hereafter "Pentagon Marks") to advertise its mortgage loan services and other financial services.

5. PenFed has continuously used and maintained common law rights in PENTAGON FEDERAL CREDIT UNION in connection with mortgage and other financial services since it was established in 1935. At least since 2005, PenFed has continuously used and maintained common law rights in PENFED in connection with such services. Beginning at least several years before July 2013, PenFed's customers have referred to PenFed by the abbreviations PENTAGON FEDERAL, PENFED, and PENTAGON in connection with such services. PenFed has at different times used variations on the above marks in connection with financial services.

6. PenFed has used a number of pentagon designs since 1935, alone or as parts of composite marks, in connection with mortgage and financial services, as illustrated by the following examples. Beginning at least as early as 1977, PenFed has continuously used and maintained common law rights in an image of a pentagon in the form of three concentric pentagons, as depicted below:

This design was the subject of U.S. Registration No. 1,159,402, registered on June 30, 1981. The registration was cancelled in 2016, notwithstanding that PenFed continued to use it. PenFed used the design in different colors and included a globe in the design to indicate that PenFed provides services to customers outside the United States.

7. Beginning at least as early as 2010, and as used in 2013, when RoundPoint claims to have begun using its pentagon design, PenFed used a pentagon design in the form of two concentric pentagons in connection with mortgage services, as depicted below:

8. PenFed has at different times used pentagon designs in connection with financial services that have not included a globe to indicate PenFed's global reach. For example, since at least as early as August 9, 2004, including 2013 when RoundPoint claims to have begun using its pentagon design, PenFed has continuously used and maintained common law rights in a pentagon design that frames an image of an eagle as depicted below:

in connection with charitable foundation services, namely providing financial support to uniformed forces and veterans for financial literacy, housing, and support for the wounded.

9. PenFed has continuously used and maintained common law rights in an image of a pentagon in the form of:

and typically colored in different shades of blue:

beginning on or before January 1, 2015. This design, depicted in black, is the design claimed in PenFed's Registered Mark.

10. PenFed's longstanding use of marks in which the most distinctive element is the word PENTAGON, an abbreviation thereof, and/or a pentagon design began long prior to RoundPoint's use of or application to register its mark.

11. RoundPoint's Mark so resembles the marks previously used by PenFed in commerce as to be likely, when used in connection with RoundPoint's services, to cause confusion, deception or mistake as to the affiliation, connection or association of RoundPoint with PenFed, and/or the origin, sponsorship, or approval of RoundPoint's services or commercial activities by PenFed under 15 U.S.C. § 1052(d). The aforesaid likelihood of confusion is damaging PenFed within the meaning of 15 U.S.C. § 1063.

12. PenFed is being damaged by the registration of RoundPoint's Mark because the registration grants RoundPoint statutory rights under the Trademark Act of 1946, which tend to restrict, interfere with, and damage PenFed in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, PenFed prays this Petition for Cancellation be sustained, and that U.S. Registration No. 4,571,735 be canceled.

Please charge the appropriate filing fee to the credit card account of PenFed's counsel, as provided through the ESTTA filing system.

Please direct all correspondence to Carrie A. Shufflebarger, Esq., at Thompson Hine, LLP, 312 Walnut Street, Fourteenth Floor, Cincinnati, Ohio 45202, and all calls to the same at (513) 352-6678.

Date: January 8, 2018

Respectfully submitted,

/s/ Carrie A. Shufflebarger
Carrie A Shufflebarger
Thompson Hine LLP
312 Walnut Street
Fourteenth Floor
Cincinnati, OH 45202
(513) 352.6670
carrie.shufflebarger@thompsonhine.com

Clifton McCann
Thompson Hine LLP
1919 M Street NW, Suite 700
Washington, DC 20036
clifton.mccann@thompsonhine.com

Attorneys for Applicant/Counterclaimant

**CERTIFICATE OF SERVICE**

I certify that a copy of the foregoing is being served via electronic mail on the following, on this 8th of January, 2018:

Lori T. Milvain
Latham Shuker Eden & Beaudine LLP
111 N. Magnolia Ave, Suite 1400
Orlando, FL 32801
lmilvain@lseblaw.com

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger