

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

IN RE: APPLICATION SERIAL NO. 88/464,710

SACRAMENTO PUBLIC LIBRARY
AUTHORITY,

Opposer,

v.

SACRAMENTO PUBLIC LIBRARY
FOUNDATION,

Applicant.

Opposition No. _____

Serial No.: 88/464,710
Filed: June 7, 2019
Published: December 3, 2019
Mark: SACRAMENTO PUBLIC LIBRARY
FOUNDATION

NOTICE OF OPPOSITION

Opposer Sacramento Public Library Authority (“Library”) believes that it will be damaged by the registration of the mark shown in Application Serial No. 88/464,710 and hereby opposes the same. As grounds for opposition, the Library alleges as follows:

1. The Library is an unincorporated entity formed as a joint powers authority between the County of Sacramento and the Cities of Citrus Heights, Elk Grove, Galt, Isleton, Rancho Cordova, and Sacramento. The Library’s governing board comprises representatives from each member jurisdiction and was formed for the purpose of providing public library services within the member jurisdictions. The Library operates the Sacramento Public Library, with a principal place of business at 828 I Street, Sacramento CA 95814.

2. Applicant Sacramento Public Library Foundation (“Applicant”) is a nonprofit 501(c)(3) corporation organized under the laws of the state of California with its principal place of business at 2411 Alhambra Blvd., Suite 120, Sacramento, CA 95817.

3. On June 7, 2019, Applicant filed Application Serial No. 88/464,710 (the “Application”) to register the mark SACRAMENTO PUBLIC LIBRARY FOUNDATION on the

Principal Register in International Class 36 for "Charitable fundraising to support and promote the activities and programs of the Sacramento public library and other community literacy programs" with an alleged first use date of June 11, 1984 ("Applicant's Mark"). The United States Patent and Trademark Office published the Application for opposition on December 3, 2019.

4. The Library has used the name and mark SACRAMENTO FREE PUBLIC LIBRARY since at least as early as 1879 and has continuously used the shortened name and mark SACRAMENTO PUBLIC LIBRARY ("Library's Mark") in commerce since at least as early as 1977, if not earlier. Thus, from a time long prior to the filing date of the Application, or any earlier date of actual use of the mark shown in the Application upon which the Applicant can rely, and continuously to the present, the Library has used its Mark in connection with its public library services and related services to the residents of the greater Sacramento area and to the general public.

5. The Library currently operates 28 physical libraries distributed throughout Citrus Heights, Elk Grove, Galt, Isleton, Rancho Cordova, and Sacramento. It is recognized as a leading public organization serving the entire Sacramento community, and it was just awarded the Jerry Kline Community Impact Prize in recognition of its extraordinary engagement with the Sacramento community. Through decades of use in the provision of library services (including fundraising for the Library's activities and programs), the Library has developed substantial goodwill in its Mark. The relevant public associates the Library's Mark with the Library.

6. The Applicant was formed in June 1984 for the sole and express purpose of raising private funds to support the activities and programs of the Library. Thus, the Library gave Applicant permission to make limited use of the Library's Mark for the purpose of fundraising for the Library, including calling itself SACRAMENTO PUBLIC LIBRARY FOUNDATION.

7. In recent years, the Applicant and Library began having disagreements about working together. Among others, Applicant broadened its fundraising to fund for programs and

activities outside of the Library. Indeed, the way in which Applicant continued to use the Library's Mark made it likely that donors would not understand that their funds would no longer necessarily help fund the Library's services.

8. While the Library has tried to work out a relationship with the Applicant, they have been unable to resolve their differences and opinions. The Library advised the Applicant that it no longer has permission to use the Library's Mark. But the Applicant continues to use the Library's Mark without the Library's permission.

9. In addition, under California law for charitable fundraising, which track similar principles to trademark law, Applicant is required to receive written consent from the Library to fundraise with Library's Mark and name. Applicant does not have the Library's written consent, in violation of such California law.

10. The Applicant has now filed this Application trying to claim, incorrectly, that it owns a mark that incorporates the Library's Mark in its entirety. Applicant's Mark SACRAMENTO PUBLIC LIBRARY FOUNDATION is confusingly similar to the Library's Mark SACRAMENTO PUBLIC LIBRARY. Applicant's Mark contains the entirety of the Library's Mark followed only by the generic word "FOUNDATION." Furthermore, the services listed in the Application are similar to, or overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those services offered under the Library's Mark.

11. Applicant's Mark is therefore likely to confuse, cause mistake among, or deceive the relevant public into believing that Applicant is sponsored by, endorsed by, or in some manner related to the Library, and is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C.A. §1052(d).

12. On information and belief, Applicant continues to use Applicant's Mark with the intent to confuse, cause mistake among, and deceive the public into believing the Applicant's services are associated with, sponsored by, or endorsed by the Library.

13. For the reasons set forth in this Notice of Opposition, the Library believes that it

