

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

In the matter of trademark application Serial No. 78/255,115  
For the mark I ♥ DICK  
Published in the Official Gazette on July 27, 2004

NEW YORK STATE DEPARTMENT OF ECONOMIC DEVELOPMENT

Opposer

v.

DETROIT INDUSTRIAL CLOTHING KARTEL, L.L.C.

Applicant

NOTICE OF OPPOSITION

Opposer, New York State Department of Economic Development (“NYSDDED”), f/k/a the New York State Department of Commerce, a New York state agency organized and existing under the laws of New York, having an address at 30 South Pearl Street, 6th Floor, Albany, New York 12245, believes that it will be damaged by registration of the mark I ♥ DICK in the name of Detroit Industrial Clothing Kartel, L.L.C. (“Applicant”), published in the Official Gazette on July 27, 2004. Opposer has applied for an extension of time to oppose up to and including September 25, 2004, and hereby opposes such application.

As grounds for this Opposition, NYSDDED relies upon the rights developed by it and related entities and alleges on knowledge as to itself and otherwise upon information and belief, as follows:

1. NYSDDED, directly and through its predecessors, has engaged in a program to promote travel and tourism in the state of New York at least as early as 1977.

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2. Since 1977, NYSDDED, directly and through its predecessors, licensees, and marketing partners, has been continuously engaged in the sale and distribution of a wide spectrum of goods and services under the mark I ♥ NY, including, but not limited to, advertising and licensing in commerce related to New York State travel and tourism.

3. The I ♥ NY mark has become synonymous with the state of New York and its various and diverse attractions, commercial markets, entertainment venues, and its inviting atmosphere; a recent article on Newsweek's Periscope website stated that "I Love New York" is one of the two most famous tourism slogans.<sup>1</sup>

4. For many years, and long prior to Applicant's filing of its application, Opposer has used the mark I ♥ NY, and variations thereof, in interstate commerce throughout the United States in connection with a variety of goods and services, including goods and services in the printed & paper products, apparel, jewelry, toys, advertising, and multimedia categories. By reason thereof, and by reason of the long, continuous, and extensive use of the mark I ♥ NY, and variations thereof, in connection with Opposer's business activities, Opposer now enjoys valuable goodwill in its said marks and an enviable reputation for said goods and services sold and offered for sale under said marks.

5. Prior to Applicant's filing of its application, Opposer obtained, inter alia, the following registrations (hereinafter the "I ♥ NY registrations," "I ♥ NY marks," or "Opposer's marks"):

<u>Trademark</u>	<u>Registration Number</u>	<u>Goods or Services</u>
	1795587	Goods made from non-precious metals—boxes, bells, and keychains

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<sup>1</sup> See Ron DePasquale, "Tourism: Do Slogans Sell?" *available via* Newsweek Periscope on MSNBC.com website (visited August 31, 2004) <<http://msnbc.msn.com/id/5781999/site/newsweek>>. "Virginia is for Lovers," represents the other most famous slogan.



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address books, cookbooks, travel books, and date books; stationery; address labels; calendars; greeting cards; note cards; note pads; writing paper; desk-top diaries; photo albums; gift wrapping paper; posters; folios; playing cards; personal organizers; desk-top organizers; stationery organizers; letter openers; pens; general purpose plastic bags; paper weights; bookends; bookmarks; and paper bags



1805333

textile articles; namely, wall hangings



1805354

niteshirts, sleepwear, caps



1555836

T-shirts, gloves, hats, jackets, sportshirts, sweaters, scarves, sweatshirts, and shoes



1694568

embroidery and thimbles



1825861

toy banks



1801667

ashtrays, not of precious metal

	1725475	jewelry and chronometric instruments; namely watches and clocks
	1701791	travelling bags, tote bags, drawstring pouches, all purpose sports bags, cosmetic bags
	2431705	traveling bags, tote bags, drawstring pouches, all purpose sports bags, cosmetic bags sold empty, umbrellas, parasols, and walking sticks
	2765228	promoting the economic development of New York State
	1558379	promoting the state of New York as a tourist attraction and enhancing its economic development
	2765227	promoting the economic development of New York State
	2769939	promoting the economic development of New York State
	2788008	promoting the economic development of New York State

6. The I ♥ NY registrations are prima facie evidence of the validity of the registered marks and Opposer's exclusive right to use the I ♥ NY marks in commerce in connection with the goods and services described in those registrations, without condition or limitation, and constitute constructive notice of Opposer's ownership of the I ♥ NY marks for the goods and services described in those registrations, as provided for by Sections 7(b), 22, and 33(a) of the Lanham Act.

7. Opposer has expended substantial amounts of time and effort in advertising and promoting its goods and services under the I ♥ NY marks. As a result of such advertising and promotional activities, the I ♥ NY marks have become famous, the relevant public has come to associate and identify I ♥ NY with Opposer and Opposer derives substantial goodwill from such identification by consumers.

8. On May 28, 2003, Applicant filed a trademark registration application for the mark I ♥ DICK for use in connection with “T-shirts, socks, underwear, hats, bra tops, tank tops, visors, belts, undergarments, jeans, pants, sweatshirts, sweatsuits, stockings, lingerie, tops, shirts, blouses, skirts, jumpsuits, headwear, jackets, sneakers, sandals, hosiery” in International Class 25.

#### COUNT I: LIKELIHOOD OF CONFUSION

9. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 8 hereof as if fully set forth herein.

10. Applicant’s mark I ♥ DICK, as set forth in the application opposed herein, is substantially similar in sight, connotation and commercial impression to Opposer’s I ♥ NY marks.

11. Due to the high degree of inherent distinctiveness, the duration and extent of use, the duration and extent of advertising and publicity, the geographical extent of the trading area, and the degree of recognition, Opposer’s I ♥ NY marks are “famous” pursuant to Section 43(c) of the Lanham Act.

12. Because Opposer’s I ♥ NY marks are famous and because Opposer currently uses the I ♥ NY marks in connection with a variety of goods and services, the greater the likelihood that the public will believe that the same or similar mark found on a wide range of goods or services are affiliated or associated with, connected to or sponsored by Opposer.

13. Accordingly, Applicant's mark is likely to cause confusion, mistake, or to deceive the public into believing that Applicant's goods are somehow affiliated with or associated with, connected to or sponsored by Opposer, in violation of Section 2(d) of the Lanham Act.

14. If Applicant is permitted to register or use the mark herein opposed, there would be likely confusion as to the sponsorship of the goods, resulting in damage and injury to Opposer by reason of the similarity between Applicant's mark and Opposer's marks. Persons familiar with Opposer's I ♥ NY marks will be likely to purchase Applicant's goods, believing them to be affiliated or associated with, connected to or sponsored by Opposer. Likewise, persons exposed to Applicant's I ♥ DICK mark who subsequently become acquainted with Opposer's I ♥ NY marks are likely to conclude that the goods and services offered by Opposer under its marks are in some manner affiliated or associated with, connected to or sponsored by Applicant. Any such confusion as to affiliation, association, connection, or sponsorship inevitably would result in damage and injury to Opposer.

15. Opposer will be damaged by registration of the mark shown in the application opposed herein because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark, and will give color of rights to Applicant in violation of Opposer's prior and superior statutory and common law rights in the I ♥ NY marks.

#### COUNT II: LIKELIHOOD OF DILUTION

16. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 15 hereof as if fully set forth herein.

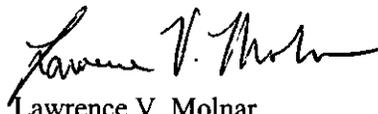
17. Pursuant to Section 43(c) of the Lanham Act, Opposer's I ♥ NY marks are famous. Opposer's I ♥ NY marks became famous prior to the date that Applicant can first lay claim to any rights in the I ♥ DICK mark.

18. The registration and use of Applicant's I ♥ DICK mark will likely dilute the distinctive quality of Opposer's famous I ♥ NY marks.

19. Opposer will be damaged by registration of the mark shown in the application opposed herein because such registration will support and assist Applicant in the diluting use of Applicant's mark, and will give color of rights to Applicant in violation of Opposer's prior and superior statutory and common law rights in the I ♥ NY marks.

WHEREFORE, Opposer prays that this Opposition be sustained and that the application for registration of the mark I ♥ DICK be in all respects refused and denied.

Respectfully submitted,



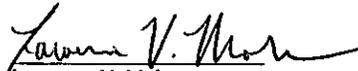
Lawrence V. Molnar  
CMG Worldwide, Inc.  
10500 Crosspoint Blvd.  
Indianapolis, IN 46256  
Attorney for Opposer

Dated: Indianapolis, IN,  
September 23<sup>rd</sup>, 2004

Certificate of Express Mail Under 37 CFR 1.10

Express Mail mailing label number: ER963965023 US  
Date of Deposit: September 23, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.



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**TTAB**

September 23, 2004

Box TTAB FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

**RE: Notice of Opposition against trademark registration application no. 78/255,115 for an "I ♥ DICK" mark in International Class 25**

Dear Sir/Madam:

Enclosed please find the following pursuant to the above-referenced Notice of Opposition:

- The original and three (3) copies of a Notice of Opposition against trademark registration application no. 78/255,115 for an "I ♥ DICK" mark in International Class 25;
- Check no. 47189 in the amount of three hundred dollars (\$300) representing Notice of Opposition filing fees;
- A postcard to be returned to CMG upon your receipt of this response package.

If you have any questions, please do not hesitate to contact me at (317) 570-5040.

Sincerely,

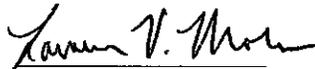
  
Lawrence V. Molnar, Esq.  
Attorney for Opposer

Enclosures

*Certificate of Express Mail Under 37 CFR 1.10*

Express Mail mailing label number: ER9U396S023 US  
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