

ESTTA Tracking number: **ESTTA36155**

Filing date: **06/20/2005**

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

<b>Name</b>	The Heisman Trophy Trust
<b>Granted to Date of previous extension</b>	06/18/2005
<b>Address</b>	17 Battery Place, Suite 943 New York, NY 10004 UNITED STATES

<b>Attorney information</b>	James M. Gibson Fitzpatrick, Cella, Harper & Scinto 30 Rockefeller Plaza New York, NY 10012-3800 UNITED STATES jgibson@fchs.com Phone:(212) 218-2100
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#### Applicant Information

<b>Application No</b>	76545073	<b>Publication date</b>	04/19/2005
<b>Opposition Filing Date</b>	06/20/2005	<b>Opposition Period Ends</b>	06/18/2005
<b>Applicant</b>	Heisman Winners Association, LLC 9002 Chancellor Row, Suite 1000 Dallas, TX 75247		

UNITED STATES
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**Goods/Services Affected by Opposition**

Class 025.

All goods and services in the class are opposed, namely: (Based on Intent to Use)  
Clothing, namely jerseys and hats

Class 028. First Use: 20030401 First Use In Commerce: 20030401

All goods and services in the class are opposed, namely: (Based on Use in Commerce)  
Sports memorabilia, namely resin figurines, bobble heads, and collectible football helmets

<b>Attachments</b>	NOTICE OF OPPOSITION.pdf ( 20 pages )
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<b>Signature</b>	/JMG/
<b>Name</b>	James M. Gibson
<b>Date</b>	06/20/2005

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

_____	x	
	:	
The Heisman Trophy Trust,	:	
	:	Opposition No. _____
Opposer,	:	
	:	Serial No.: 76/545,073
v.	:	
	:	
Heisman Winners Association, LLC	:	
	:	
Applicant.	:	
_____	x	

Commissioner for Trademarks  
Attn.: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

The Heisman Trophy Trust (hereinafter "Opposer" or "the Trust"), a trust created and existing under the laws of the State of New York, having an office and place of business at 17 Battery Place, Suite 943, New York, New York 10004, believes it will be damaged by the registration of the mark shown in United States Trademark Application Serial No. 76/545,073 (hereinafter "the '073 Application"), filed on September 16, 2003 by Heisman Winners Association LLC (hereinafter "Applicant"), for "clothing, namely jerseys and hats" in International Class 25, and "sports memorabilia, namely resin figures, bobble heads, and collectible football helmets" in International Class 28, and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Opposer is a trust which was established under the laws of the State of New York for the purpose of promoting collegiate and other non-professional athletics and maintaining the value and integrity of the Heisman Trophy, including its intellectual property rights. Specifically, the Heisman Award and its indicia are familiar to even the most casual sports enthusiasts due to the Trust's efforts in promoting high school and college football, winners of the Heisman Trophy, and football excellence in general. The Trust's efforts culminate every year with the nationally televised Heisman Award ceremony presenting the Heisman Trophy to the outstanding college football player of the year. These outstanding athletes and the game of football have been promoted under the Heisman Trophy or other Heisman indicia and trademarks for about 70 years.

2. The actual trophy which is awarded to Heisman winners is a distinctive statuette mounted on a base, depicting a football player in a particular pose (the "Heisman Trophy Pose") which has remained essentially the same for decades.

3. Opposer is the owner by assignment of U.S. Registration No. 936,852 for the design mark showing the Heisman Trophy, for "promoting interest, excellence and sportsmanship in intercollegiate football through the medium of an annual award" in International Class 41. This registration is valid and incontestible. Opposer, itself and through its predecessors, began use of this mark at least as early as December 16, 1936, and has used it exclusively and continuously from that date to the present. The Trust also owns several other federal registrations and applications for marks using the word "Heisman" in connection with its Heisman Award enterprise, including applications for marks for use on or in connection with

clothing. Copies of printouts from the U.S. Patent and Trademark Office relating to these registrations are attached hereto as Exhibit A (collectively the "Heisman Marks").

4. Throughout the years, the Trust has, itself and through its predecessors, licensed numerous clothing manufacturers to make, sell, and distribute throughout the United States clothing items bearing the image of the football player in the Heisman Trophy Pose and/or using the Heisman Marks. Among many other clothing items, articles bearing the Heisman Marks have included jerseys, jackets, shirts, sweatshirts, t-shirts, hats, polo shirts, and sweatshirts. The Heisman Marks have also been used in connection with the sale of and/or promotion of sports memorabilia such as football helmets, footballs, and other types of memorabilia virtually identical to the goods listed in the '073 application. The Trust owns trademark rights in its Heisman Marks for such goods at common law. Over time these marks have come to signify the Trust and the prestige and high level of excellence embodied in the Heisman Award.

5. On September 16, 2003 Applicant filed the '073 Application seeking registration for its proposed "HWA and design" mark for "clothing, namely jerseys and hats in International Class 25, and "sports memorabilia, namely resin figures, bobble heads, and collectible football helmets" in Class 28. The mark consists of the letters "HWA" which, upon information and belief, is an acronym for "Heisman Winners Association," and a football player carrying a football. The player's pose in the proposed mark is confusingly similar to the Heisman Trophy Pose, as it has been used for years on the Heisman Trophy and in connection with Opposer's or its predecessors' activities in connection with the Heisman Award.

In addition, the letters "HWA" which, upon information and belief, mean "Heisman Winners Association," are confusingly similar to the Heisman Marks and consumers hearing or seeing the words "Heisman Winners Association" are likely to believe that Applicant's goods emanate from the Opposer or that Opposer sponsors or endorses Applicant's goods, when such is not the case.

6. Opposer, itself and through its predecessors and since long prior to the filing date of the '073 Application, has advertised, promoted, sold and distributed throughout the United States in interstate commerce goods bearing the Heisman Marks. As a result, the aforementioned marks have become identified in the minds of the public and trade with a single source: Opposer.

7. Applicant's goods are identical to some of the goods which have featured Opposer's Heisman Marks, namely football helmets, footballs, jerseys and hats among others. Upon information and belief, Applicant's proposed goods would enter the stream of commerce and be sold in the same or similar channels of trade and would be marketed to the same or a similar class of consumers that are and have been the target of Opposer's own promotion and use of the Heisman Marks.

8. By reason of the substantial similarity between Opposer's Heisman Marks and the mark shown in the '073 Application, and the fact that the goods and channels of trade are believed to be virtually identical, Applicant is not entitled to registration of the proposed trademark in association with the goods recited in the '073 Application on the grounds that such registration is likely to cause confusion with Opposer's Heisman Marks.

9. The consuming public, upon seeing Applicant's proposed mark in association with its goods, is likely to believe that the goods are made, endorsed or sponsored by Opposer, or that there is a trade connection or affiliation between Opposer and its goods, on the one hand, and Applicant and its goods, on the other.

10. Opposer will be damaged by the confusion which will result to the public if Applicant is permitted to obtain a registration for the proposed trademark. Any faults or defects which might be found in Applicant's goods would reflect adversely upon and seriously injure the valuable reputation and goodwill of Opposer.

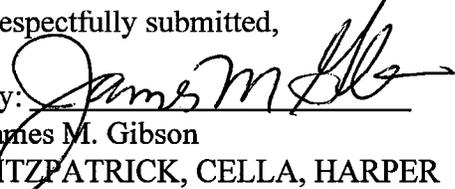
11. For the foregoing reasons, Opposer would be greatly damaged by the registration of the proposed mark by Applicant.

WHEREFORE, Opposer respectfully requests that the instant Opposition be sustained, and registration of the '073 Application be refused.

Please address all correspondence relating to this opposition to James M. Gibson at Fitzpatrick, Cella, Harper & Scinto, 30 Rockefeller Plaza, New York, New York 10112-3800.

Dated: New York, New York  
June 20, 2005

Respectfully submitted,

By:   
James M. Gibson  
FITZPATRICK, CELLA, HARPER  
& SCINTO  
30 Rockefeller Plaza  
New York, NY 10112-3800  
(212) 218-2100  
Attorneys for Opposer,  
The Heisman Trophy Trust

# **Exhibit A**



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<b>Word Mark</b>	THE HEISMAN MEMORIAL TROPHY AND DESIGN
<b>Goods and Services</b>	IC 041. US 107. G & S: PROMOTING INTEREST, EXCELLENCE AND SPORTSMANSHIP IN INTERCOLLEGIATE FOOTBALL THROUGH THE MEDIUM OF AN ANNUAL AWARD. FIRST USE: 19361216. FIRST USE IN COMMERCE: 19361216
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	020119 020905 020919 220503 240710
<b>Serial Number</b>	<b>72354602</b>
<b>Filing Date</b>	March 19, 1970
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Registration Number</b>	0936852
<b>Registration Date</b>	June 27, 1972
<b>Owner</b>	(REGISTRANT) DOWNTOWN ATHLETIC CLUB OF NEW YORK CITY, INC. CORPORATION NEW YORK 19 WEST STREET NEW YORK NEW YORK 10004
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	MICHAEL J. COMERFORD

**Description of Mark** THE MARK COMPRISES THE CONFORMATION OF A STATUETTE ON A BASE.  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20020802.  
**Renewal** 2ND RENEWAL 20020802  
**Live/Dead Indicator** LIVE

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**Typed Drawing**

<b>Word Mark</b>	HEISMAN TROPHY AWARD
<b>Goods and Services</b>	IC 041. US 107. G & S: PROMOTING INTEREST, EXCELLENCE AND SPORTSMANSHIP IN INTER-COLLEGIATE FOOTBALL THROUGH THE MEDIUM OF AN ANNUAL AWARD. FIRST USE: 19361216. FIRST USE IN COMMERCE: 19361216
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	73477457
<b>Filing Date</b>	April 26, 1984
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	March 18, 1986
<b>Registration Number</b>	1397161
<b>Registration Date</b>	June 10, 1986
<b>Owner</b>	(REGISTRANT) DOWNTOWN ATHLETIC CLUB OF NEW YORK CITY, INC. CORPORATION NEW YORK 19 WEST STREET NEW YORK NEW YORK 10004
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	RUSSELL H. FALCONER
<b>Prior Registrations</b>	0936852;0936853
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TROPHY AWARD" APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL-2(F)
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).

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Indicator**

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**Typed Drawing**

<b>Word Mark</b>	HEISMAN
<b>Goods and Services</b>	IC 041. US 107. G & S: PROMOTING INTEREST, EXCELLENCE AND SPORTSMANSHIP IN INTERCOLLEGIATE FOOTBALL THROUGH THE MEDIUM OF AN ANNUAL AWARD. FIRST USE: 19361216. FIRST USE IN COMMERCE: 19361216
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	73477456
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<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	March 18, 1986
<b>Registration Number</b>	1397160
<b>Registration Date</b>	June 10, 1986
<b>Owner</b>	(REGISTRANT) DOWNTOWN ATHLETIC CLUB OF NEW YORK CITY, INC. CORPORATION NEW YORK 19 WEST STREET NEW YORK NEW YORK 10004
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	RUSSELL H. FALCONER
<b>Prior Registrations</b>	0936852;0936853
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL-2(F)
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	LIVE

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**Typed Drawing**

<b>Word Mark</b>	HEISMAN MEMORIAL TROPHY
<b>Goods and Services</b>	IC 041. US 107. G & S: PROMOTING INTEREST, EXCELLENCE AND SPORTSMANSHIP IN INTERCOLLEGIATE FOOTBALL THROUGH THE MEDIUM OF AN ANNUAL AWARD. FIRST USE: 19361216. FIRST USE IN COMMERCE: 19361216
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	72354603
<b>Filing Date</b>	March 19, 1970
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Registration Number</b>	0936853
<b>Registration Date</b>	June 27, 1972
<b>Owner</b>	(REGISTRANT) DOWNTOWN ATHLETIC CLUB OF NEW YORK CITY, INC. CORPORATION NEW YORK 19 WEST STREET NEW YORK NEW YORK 10004
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	MICHAEL J. COMERFORD
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20020802.
<b>Renewal</b>	2ND RENEWAL 20020802
<b>Live/Dead Indicator</b>	LIVE

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**Typed Drawing**

<b>Word Mark</b>	HEISMAN TROPHY
<b>Goods and Services</b>	IC 041. US 100 101 107. G & S: promoting interest, excellence and sportsmanship in intercollegiate football through the medium of an annual award
	IC 025. US 022 039. G & S: Clothing, namely, t-shirts, polo shirts, jackets, sweatshirts, sweat pants, shorts, hats and wind resistant jackets
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	75835860
<b>Filing Date</b>	October 29, 1999
<b>Current Filing Basis</b>	1B
<b>Original Filing Basis</b>	1B
<b>Owner</b>	(APPLICANT) Heisman Trophy Trust, The vasili Krishamurti, Hon. John E. Sprizzo, N. Richard Kalikow, Sanford Wurmfeld, James E. Corcoran, Phillip Lerner, Carol A. Pisano, William J. Dockery, and Brian D. Obergfell all United States citizens TRUST NEW YORK 19 West Street New York NEW YORK 10004
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	James M. Gibson
<b>Prior Registrations</b>	0936853;1397160;1397161;AND OTHERS
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TROPHY" for the services in International Class 41 APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	TRADEMARK. SERVICE MARK
<b>Register</b>	PRINCIPAL-2(F)
<b>Live/Dead Indicator</b>	LIVE

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**Typed Drawing**

<b>Word Mark</b>	HEISMAN STORE
<b>Goods and Services</b>	IC 025. US 022 039. G & S: Clothing, namely t-shirts, polo shirts, jackets, sweatshirts, sweat pants, shorts, hats and wind resistant jackets
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	75835852
<b>Filing Date</b>	October 29, 1999
<b>Current Filing Basis</b>	1B
<b>Original Filing Basis</b>	1B
<b>Owner</b>	(APPLICANT) Heisman Trophy Trust, The Vasili Krishamurti, Ho. John E. Sprizzo, N. Richard Kalikow, Sanford Wurmfeld, James E. Corcoran, Phillip Lerner, Carol A. Pisano, William J. Dockery, and Brian D. Obergfell, all citizens of the United States TRUST NEW YORK 19 West Street New York NEW YORK 10004
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	JAMES M. GIBSON
<b>Prior Registrations</b>	0986853;1397160;1397161
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STORE" APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL-2(F)
<b>Live/Dead Indicator</b>	LIVE

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**Typed Drawing**

**Word Mark** HEISMAN HEROES  
**Goods and Services** IC 025. US 022 039. G & S: Clothing, namely t-shirts, polo shirts, jackets, sweatshirts, sweat pants, shorts, hats and wind-resistant jackets  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 75835844  
**Filing Date** October 29, 1999  
**Current Filing Basis** 1B  
**Original Filing Basis** 1B  
**Owner** (APPLICANT) Heisman Trophy Trust, The Vasili Krishamurti, Hon. John E. Sprizzo, N. Richard Kalikow, Sanford Wurmfeld, James E. Corcoran, Phillip Lerner, Carol A. Pisano, William J. Docker, and Brian D. Obergfell, all United States Citizens TRUST NEW YORK 19 West Street New York NEW YORK 10004  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** JAMES M. GIBSON  
**Prior Registrations** 0936853;1397160;1397161  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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