

ESTTA Tracking number: **ESTTA187539**

Filing date: **01/18/2008**

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 | JeffreyGoldstein |
| Granted to Date of previous extension | 01/19/2008 |
| Address | 696 10th Avenue #5C New York, NY 10019 UNITED STATES |

| | |
|----------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------|
| Attorney information | Erik Pelton Erik M. Pelton & Associates, PLLC PO Box 100637 Arlington, VA 22210 UNITED STATES emp@tm4smallbiz.com Phone:703-525-8009 |
|----------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------|

Applicant Information

| | | | |
|------------------------|------------------------------------------------------------------------------|------------------------|------------|
| Application No | 77191593 | Publication date | 11/20/2007 |
| Opposition Filing Date | 01/18/2008 | Opposition Period Ends | 01/19/2008 |
| Applicant | Woodard, Steve P 10220 Empire Ave Cupertino, CA 95014 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|----------------------------------------------------------------------------------------------------------------------------------------------|
| Class 025. All goods and services in the class are opposed, namely: Shirts; Hats; Pants; Shoes; Swimwear; Underwear; Jackets; Ties; Socks |
|----------------------------------------------------------------------------------------------------------------------------------------------|

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Mark Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|----------------|-----------------------|------------|
| U.S. Application No. | 77295906 | Application Date | 10/04/2007 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | LABEL NEW YORK | | |
| Design Mark | | | |
| Description of | NONE | | |

| | |
|----------------|------------------------------------------------------------------------------------------------------------------------------------------|
| Mark | |
| Goods/Services | Class 025. First use: First Use: 2006/01/00 First Use In Commerce: 2006/04/00 clothing and apparel; shirts; hooded sweatshirts; thermals |

| | |
|-------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Attachments | 77295906#TMSN.jpeg (1 page)(bytes) LABEL - Notice of Opposition.pdf (6 pages)(25598 bytes) LABEL - Notice of Opposition - Exhibit A.pdf (10 pages)(924212 bytes) |
|-------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|---------------|
| Signature | /ErikMPelton/ |
| Name | Erik Pelton |
| Date | 01/18/2008 |

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

| | | |
|-------------------|---|---------------------------------|
| JEFFREY GOLDSTEIN |) | Opposition No. _____ |
| Opposer, |) | |
| |) | <i>In the matter of:</i> |
| vs. |) | |
| |) | Application Serial No. 77191593 |
| STEVE P. WOODARD |) | Published on November 20, 2007 |
| Applicant. |) | Mark: LABEL |

NOTICE OF OPPOSITION

In the matter of the application for registration of the mark LABEL for “Shirts; Hats; Pants; Shoes; Swimwear; Underwear; Jackets; Ties; Socks” in International Class 25, filed May 29, 2007, by Steve P. Woodward (“Applicant”), assigned Serial No. 77191593, and published for opposition in the Official Gazette of November 20, 2007, Jeffrey Goldstein (“Opposer”) believes that he would be damaged by such registration, and hereby opposes the registration of Applicant’s mark pursuant to 15 USC §1063 and 37 CFR §2.104.

As grounds of opposition, it is alleged that:

1. Opposer, since at least April of 2006 has been, and is now, using the mark LABEL NEW YORK in connection with clothing and apparel; shirts; hooded sweatshirts; thermals.
2. Opposer filed on October 4, 2007, an application to register LABEL NEW YORK in connection with “clothing and apparel; shirts; hooded sweatshirts; thermals.”
3. Applicant seeks to register the proposed mark LABEL, Serial Number 77191593, for “Shirts; Hats; Pants; Shoes; Swimwear; Underwear; Jackets; Ties; Socks,” based on an intent to use the mark in commerce, as is evidenced by publication of said mark in the Official Gazette in the November 20, 2007, issue.

4. Application Serial Number 77191593 was filed by Applicant on May 29, 2007.
5. Opposer's use of the mark LABEL NEW YORK has been valid and continuous since at least April of 2006 and has not been abandoned. LABEL NEW YORK is a mark which is symbolic of extensive good will and consumer recognition. As a result of the substantial amounts of time and effort in advertising and promotion, Opposer has developed an exceedingly valuable goodwill in respect to its mark.
6. Upon information and belief, Opposer alleges that the goods of Opposer and the services of Applicant are offered or to be offered in similar channels of commerce and offered to similar customers.
7. Applicant's proposed mark and Opposer's LABEL NEW YORK mark are similar in sound, appearance and meaning.
8. Applicant's proposed mark and Opposer's LABEL NEW YORK mark are likely to be confused.
9. Upon information and belief, Opposer's first use of the LABEL NEW YORK mark precedes Applicant's first use of its mark in commerce.
10. Upon information and belief, Opposer's first use of the LABEL NEW YORK mark precedes the filing of Applicant's application to register Applicant's mark in the United States Patent and Trademark Office.
11. As a result of confusing similarity between Opposer's LABEL NEW YORK mark with Applicant's mark and because the goods of Applicant and Opposer are very similar, are in similar channels of commerce, and are directed to similar customers, registration of the proposed mark LABEL in connection with Applicant's goods is likely to deceive purchasers as to the

source or sponsorship of such goods and services, to cause confusion, to cause mistake, or to deceive.

12. Consumers familiar with Opposer's LABEL NEW YORK mark are likely to mistakenly believe that Applicant's goods are sponsored, authorized, associated with or otherwise approved by Opposer because the proposed mark closely resembles Opposer's LABEL NEW YORK mark. Deficiencies or faults in the quality of Applicant's goods are likely to reflect negatively upon, tarnish and seriously injure the reputation which Opposer has established for goods provided under the LABEL NEW YORK mark. This confusion is likely to result in loss of revenues to Opposer and damage Opposer's reputation.

13. Applicant's use of the LABEL mark does or is likely to falsely suggest a relationship between Applicant's goods and Opposer. Such use of the LABEL NEW YORK mark by Applicant is likely to cause confusion, mistake or deception with respect to the source or sponsorship of Applicant's services. Such use is likely to cause a significant level of sales by Applicant to consumers who would be confused by the use of the proposed mark into believing that Opposer is the source of Applicant's services, resulting in ill-gotten gains by Applicant. Applicant's use of the proposed mark is therefore likely to result in Applicant's trading off and benefiting from the goodwill associated with Opposer, resulting in ill-gotten gains by Applicant.

14. Upon information and belief, Applicant is not currently using, and has never used, the LABEL mark in commerce in the United States.

15. Opposer's application Serial Number 77295906 was refused registration on January 11, 2008, by USPTO Examining Attorney Jay K. Flowers. See attached Exhibit A. Applicant's application was cited as a potential conflict to Opposer's application in the January 11, 2008, Office Action.

16. Opposer is likely to be damaged by registration of Applicant's mark in that the prima facie effect of registration of Applicant's mark would tend to impair Opposer's right to use the wording and/or design contained in Applicant's mark.

17. Opposer is likely to be damaged by registration of Applicant's mark in that the prima facie effect of registration of Applicant's mark would tend to impair Opposer's right to register its LABEL NEW YORK mark with the U.S. Patent and Trademark Office.

18. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of the Lanham Act, and Opposer would be damaged thereby.

WHEREFORE, Opposer, Jeffrey Goldstein, prays that the application for registration of the mark LABEL, Serial No. 77191593, be refused and that this Opposition be sustained in favor of Opposer.

The fee required by Sect. 2.6(a)(17) is enclosed herewith.

Opposer hereby appoints Erik M. Pelton, member of the Bar of the State of New Jersey, and Christopher Shiplett, member of the Bar of the Commonwealth of Virginia, of the firm Erik M. Pelton & Associates, PLLC, at PO Box 100637, Arlington, Virginia 22210, to act as counsel in the matter of the opposition identified above, to prosecute said opposition, to transact all business in the Patent and Trademark Office, and in the United States courts connected with the opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

Respectfully submitted for Opposer,
JEFFREY GOLDSTEIN

Date: January 18, 2008

By: /ErikMPelton/
Erik M. Pelton, Esq.
Attorney for Opposer

Erik M. Pelton & Associates, PLLC
PO Box 100637
Arlington, Virginia 22210

Phone: 703.525.8009
Fax:703.525.8089
Email: emp@tm4smallbiz.com

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

JEFFREY GOLDSTEIN
Opposer,

vs.

STEVE P. WOODARD
Applicant.

) Opposition No. _____
)
)

) *In the matter of:*
)

) Application Serial No. 77191593
) Published on November 20, 2007
) Mark: LABEL

CERTIFICATE OF SERVICE

I hereby certify that a true and copy of the foregoing Notice of Opposition has been served on the following by mailing said copy on January 18, 2008, via First Class mail, postage prepaid, to Applicant at:

Steve P Woodard
10220 Empire Avenue
Cupertino, CA 95014

By: /ErikMPelton/
Erik M. Pelton, Esq.

Exhibit A

January 11, 2008, Office Action re: Serial No. 77295906

To: Goldstein, Jeffrey (emp@tm4smallbiz.com)
Subject: TRADEMARK APPLICATION NO. 77295906 - LABEL NEW YORK - N/A
Sent: 1/11/2008 12:53:29 PM
Sent As: ECOM112@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2
Attachment - 3
Attachment - 4

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/295906

MARK: LABEL NEW YORK

77295906

CORRESPONDENT ADDRESS:

ERIK M. PELTON
ERIK M. PELTON & ASSOCIATES, PLLC
PO BOX 100637
ARLINGTON, VA 22210-3637

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Goldstein, Jeffrey

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

emp@tm4smallbiz.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 1/11/2008

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Search Results

The Office records have been searched and no similar registered mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Prior Pending Application

Information regarding pending Application Serial No. 77191593 is enclosed. The effective filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

Disclaimers

The applicant must disclaim the descriptive wording "NEW YORK" apart from the mark as shown because it merely describes the geographic location of where the applicant's goods will originate. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

The wording "NEW YORK" means a state in the northeastern United States, bordering Pennsylvania, the Atlantic Ocean, New Jersey, Canada, Vermont, Massachusetts, Connecticut, Lake Erie, and Lake Ontario. Please see the attached definition from *Encarta® World English Dictionary, North American Edition* located at www.encarta.msn.com. Here, the applicant's proposed mark contains the wording "NEW YORK," which merely describes the geographic location of where the applicant's goods will originate. Thus, the applicant must disclaim the wording "NEW YORK" apart from the mark as shown.

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Section 2(e) of the Trademark Act, the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a).

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. A disclaimer does not affect the appearance of the applied-for mark.

A disclaimer does *not* physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing.

The following cases explain the disclaimer requirement more fully: *Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983); *In re EBS Data Processing, Inc.*, 212

USPQ 964 (TTAB 1981); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977).

The computerized printing format for the Office's *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use "NEW YORK" apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm'r Pats. 1983).

Identification of Goods

The identification of goods is indefinite and must be clarified because the applicant's description contains unnecessary semi-colons and the wording "clothing and apparel, hooded sweatshirts and thermals" is vague.

Applicant may adopt the following identification, if accurate:

International Class 25: Clothing and apparel, namely, shirts, hoods, sweat shirts and thermal underwear

TMEP §1402.01.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>.

/JKF/

Jay K. Flowers

USPTO

Trademark Examining Attorney

Law Office 112

Phone:(571) 272-8202

Fax:(571) 273-8202

jay.flowers@uspto.gov

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Jan 11, 2008

77191593

DESIGN MARK

Serial Number

77191593

Status

REQUEST FOR EXTENSION OF TIME TO FILE OPPOSITION

Word Mark

LABEL

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Woodard, Steve P INDIVIDUAL UNITED STATES 10220 Empire Ave Cupertino
CALIFORNIA 95014

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Shirts; Hats;
Pants; Shoes; Swimwear; Underwear; Jackets; Ties; Socks.

Filing Date

2007/05/29

Examining Attorney

SISUN, SCOTT

LABEL

Dictionary

Advertisement

Find

New York

in

Dictionary

Dictionary

Thesaurus

Translations

A B C D E F G H I J K L M N O P Q R S T U V W X Y Z



New York

new wave

New

Westminster

New World

New Year

new year

New Year's Day

New Year's Eve

New Year's
resolution

► **New York**

New York Bay

New York
English

New Yorkese

new zeals

New Zealand

New Zealand
English

New Zealand
Time

New Zild



New York

New York [nōō yāvŕk]

1. New York City city and major port in southeastern New York State, at the mouth of the Hudson River. It is the most populous city in the United States. It comprises Manhattan, the Bronx, Brooklyn, Queens, and Staten Island boroughs. Population: 8,084,316 (2002 estimate).

2. state in the northeastern United States, bordering Pennsylvania, the Atlantic Ocean, New Jersey, Canada, Vermont, Massachusetts, Connecticut, Lake Erie, and Lake Ontario.

Capital: Albany.
Population: 19,157,532 (2002 estimate).
Area: 139,831 sq km (53,989 sq mi.)

• **New York-er** *noun*

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Print Preview

See pronunciation

key

Search for "New York" in all of MSN Encarta

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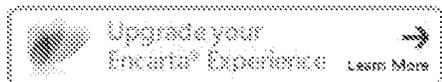
- ▶ Rediscover 'Planet Earth' on the Discovery Channel
- ▶ MSN Shopping: Best books for the season
- ▶ MSN Careers: Nail that job interview
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To: Goldstein, Jeffrey (emp@tm4smallbiz.com)
Subject: TRADEMARK APPLICATION NO. 77295906 - LABEL NEW YORK - N/A
Sent: 1/11/2008 12:53:30 PM
Sent As: ECOM112@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 1/11/2008 FOR
APPLICATION SERIAL NO. 77295906

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link
http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77295906&doc_type=OOA&mail_date=20080111
(or copy and paste this URL into the address field of your browser), or visit
<http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable **response time period**. Your response deadline will be calculated from 1/11/2008.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**