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

Proceeding	91183698
Party	Defendant Southern Illinois Miners, LLC
Correspondence Address	PATRICIA S. THOMPSON HEITLAND LEACH, LLC 46 MARSHALL PL SAINT LOUIS, MO 63119-2321 UNITED STATES trishthompson@simmonscooper.com
Submission	Motion to Amend/Amended Answer or Counterclaim
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Signature	/Paul A. Lesko/
Date	07/15/2010
Attachments	2010-6-28 Applicant Southern Illinois Miners, LLC's Motion To Amend.pdf (4 pages)(158312 bytes) 2010-6-28 Exhibit A - Applicant's Amended Answer to Notice of Opposition No. 91183196.pdf (20 pages)(902264 bytes)

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

The Board of Regents, The University of Texas System, Registrant, v. Southern Illinois Miners, LLC Applicant.	)))))))))	Opposition Nos. 91183196 and 91183698

APPLICANT SOUTHERN ILLINOIS MINERS, LLC'S MOTION TO AMEND 1) APPLICANT'S ANSWER TO NOTICE OF OPPOSITION NO. 91183196 AND 2) APPLICANT'S ANSWER TO NOTICE OF OPPOSITION NO. 91183698

Pursuant to FED. R. Civ. P. 15(a), 37 CFR §2.107, and TBMP 507, Applicant Southern Illinois Miners, LLC moves to amend its answers to Registrant's notices of opposition to plead counterclaims seeking the partial cancellation of Registrant's marks.[1] Applicant submits its proposed amended answer as Exhibit A hereto.[2]

Rule 15(a) states that leave to amend "shall be freely given when justice so requires." In *Foman v. Davis*, 371 U.S. 178, 182 (1962), the Supreme Court held that leave to amend shall be freely given in the absence of the following or similar factors:

- undue delay;
- bad faith or dilatory motive on the part of the movant;
- repeated failure to cure deficiencies by amendments previously allowed;
- undue prejudice to the opposing party by virtue of allowance of the amendment; or
- futility of amendment.

[1] On June 25, 2010, Registrant indicated they would oppose this motion.

[2] Applicant's Exhibit A is an answer to the opposition filed March 26, 2008. Should Registrant's motion to amend its notice of opposition be entered, Applicant will respond with an answer incorporating the same counterclaims.

Accord Intrepid v. Pollock, 907 F.2d 1125 (Fed. Cir. 1990); TBMP 507.02 (stating that "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party").

No factor weighing against leave to amend is present here. Applicant has not unduly delayed in moving to amend its complaint. Applicant has no bad-faith or dilatory motive; rather, given that trial is imminent, Applicant simply wishes to conform its Answer to the evidence discovered in this case. Namely, Registrant admitted during discovery that it does not utilize its marks in conjunction with collegiate baseball (and has not for many years). In view of this, Registrant's registrations (which encompass collegiate baseball) are too broad, and must be narrowed by partial cancellation. Applicant further seeks to limit Registrant's marks to "collegiate" uses as well. Given that the Registrant's marks are utilized solely in conjunction with the University of Texas at El Paso, such a limitation on Registrant's overly broad goods and service is required.

This is Applicant's first amendment, and it has not repeatedly failed to cure deficiencies in its Answers. Applicant's proposed amendment, furthermore, is not futile and does not violate settled law.

Most important, the amendment will in no way prejudice Registrant. Registrant made it clear that it has not had a collegiate baseball team since the mid-1980s, and that its marks are utilized solely with the University of Texas at El Paso activities. Despite this, it sought and received overly broad registrations. Registrant cannot make any plausible claim that it was unaware of this information. Registrant will suffer no prejudice whatsoever through this

amendment (no additional discovery is required as Registrant has necessarily been aware of these facts since the mid-1980s, etc.).

Additionally, and more importantly, Registrant is itself also attempting to amend its Notices of Opposition at this same time. Allowing both sides to amend their claims to conform to the evidence would further expedite these proceedings.

Therefore, Applicant asks the Board for leave to amend its Answers, as justice requires.

Respectfully submitted,

By: _____

Paul A. Lesko
Simmons Browder Gianaris
Angelides & Barnerd LLC
707 Berkshire Blvd
East Alton, IL 62024
Email: plesko@simmonfirm.com

Certificate of Service

The undersigned certifies that a true and complete copy of the foregoing Applicant's Answer to Notice of Opposition was served upon the following attorneys(s) of record by mailing a copy on this 28th day of June, 2010 via First Class Mail, postage prepaid, in an envelop addressed to:

Louis T. Pirkey
William G. Barber
Susan J. Hightower
PIRKY BARBER LLP
600 Congress Avenue, Suite 2120
Austin, Texas 78701

Paul A. Lesko
Attorneys for Southern Illinois Miners, LLC

Exhibit A

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

The Board of Regents, The University of Texas System, Opposer, v. Southern Illinois Miners, LLC Applicant.	))))))))))	Opposition Nos. 91183196 and 91183698

APPLICANT'S AMENDED ANSWER TO NOTICE OF OPPOSITION NO. 91183196

Applicant, Southern Illinois Miners, LLC, an Illinois limited liability company with a principal place of business at 1000 Miners Drive, Marion, Illinois 62959, by its counsel, hereby answers the Notice of Opposition to its Application identified under Serial Number 77/034407, filed by The Board of Regents, The University of Texas System, and states the following responses to the paragraphs of such Notice of Opposition:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1, and therefore, denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2, and therefore, denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3, and therefore, denies the same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 4, and therefore, denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 5, and therefore, denies the same.

6. Applicant denies the allegations contained in paragraph 6.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 7, and therefore, denies the same.

8. Applicant admits the allegations contained in paragraph 8.

9. Applicant admits the allegation contained in paragraph 9.

10. Applicant admits that Applicant's application Ser. No. 77/034407 was initially refused on the grounds of an alleged likelihood of confusion with Opposer's Registration Nos. 1,228,753, 1,590,813 and 1,590,965. Applicant denies the remaining allegations contained in paragraph 10.

11. Applicant denies the allegations contained in paragraph 11.

12. Applicant denies the allegations contained in paragraph 12.

13. Applicant admits the allegation contained in paragraph 13.

14. Applicant denies the allegations contained in paragraph 14.

15. Applicant denies the allegations contained in paragraph 15.

16. Applicant denies the allegations contained in paragraph 16.

FIRST AFFIRMATIVE DEFENSE

17. Applicant alleges that the Notice of Opposition fails to allege facts sufficient to entitle Opposer to the remedy sought.

SECOND AFFIRMATIVE DEFENSE

18. Applicant alleges that Applicant's use of the trademark MINERS as set forth in the Application does not create a likelihood of confusion with Opposer's alleged use of its MINERS mark, and the Notice of Opposition is therefore without merit.

WHEREFORE, having fully answered the Notice of Opposition, Applicant respectfully requests that the Notice of Opposition be dismissed and the Application identified under Serial Number 77/034407 for the mark MINERS be approved for registration.

COUNTERCLAIMS FOR PARTIAL ABANDONMENT OF REGISTRATION NOS. 1,228,753, 1,590,813, 1,591,100, 2,992,329 AND 3,397,296

BACKGROUND

1. Applicant, the Southern Illinois Miners, LLC, is an Illinois limited liability company with a principal place of business at 1000 Miners Drive, Marion, Illinois 62959.

2. Applicant owns trademark application 91183196 for the mark MINERS in International Class Nos. 16, 25, and 41.

3. Upon information and belief, Registrant is the owner of the following registrations: 1) Registration No. 1,228,753 for the word mark MINERS for "Entertainment services – namely, sponsoring and conducting college athletic exhibitions and competitions, in Class 41," 2) Registration No. 1,590,965 for the word mark MINERS for "College imprinted clothing, namely, shirts, hats and baby shirts, in Class 25," 3) Registration No. 1,590,813 for the word mark MINERS for "Printed programs for college sporting events and media guides, in Class 16," 4) Registration No. 1,591,100 for the word mark MINERS for "Miniature basketballs, in Class 28," 5) Registration No. 2,992,329 for a gold miner design for "Clothing, namely shirts, hats, baby shirts and baby pants, in Class 25" and "Educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games and events rendered live and through the media of radio and television,

musical concerts and entertainment, and performances of dramatic works, in Class 41," and 6) Registration No. 3,397,296 for a pick-axe design mark for "Shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits, in Class 25."

4. Registrant has opposed the application for trademark recited in paragraph 2 above with its trademark registrations recited in paragraph 3 above.

5. Registrant utilizes its marks solely for collegiate usages.

6. Registrant does not utilize its mark for collegiate baseball teams, or for that matter, for any baseball teams, and has not for over twenty years.

7. To the contrary, Applicant's application is utilized for "professional baseball."

8. At a minimum then, Registrant's marks are used differently from Applicant's usages, in that Registrant's marks (as its registrations recite) are utilized on goods and services for "professional baseball" while Registrants marks are utilized for collegiate and/or non-baseball purposes.

9. To the extent Registrant's marks fail to limit their goods and services solely to collegiate and/or non-baseball uses, they are broader than Registrant's actual uses, and therefore need to be partially cancelled.

FIRST COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 1,228,753

10. Applicant incorporates paragraphs 1-9 herein.

11. Registrant's Registration No. 1,228,753 broadly states that it is utilized for "Entertainment services – namely, sponsoring and conducting college athletic exhibitions and

competitions, in Class 41," despite the fact the Registrant has not utilized this mark in conjunction with collegiate baseball for over twenty years.

12. Registrant has thus abandoned the use of its marks for collegiate baseball, and for baseball in its entirety.

13. In view of its overly broad description of goods and services, the description of goods and services for Registration No. 1,228,753 should be partially cancelled, and limited to "Entertainment services – namely, sponsoring and conducting college athletic exhibitions (excluding college baseball) and competitions, in Class 41."

14. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

15. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball.

SECOND COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 1,590,813

16. Applicant incorporates paragraphs 1-15 herein.

17. Registrant's Registration No. 1,590,813 broadly states that it is utilized for "Printed programs for college sporting events and media guides, in Class 16," despite the fact the Registrant has not utilized this mark in conjunction with collegiate baseball for over twenty years.

18. Registrant has thus abandoned the use of its marks for collegiate baseball, and for baseball in its entirety.

19. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "Printed programs for college sporting events (excluding college baseball) and media guides, in Class 16."

20. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

21. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball.

THIRD COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 2,992,329

22. Applicant incorporates paragraphs 1-21 herein.

23. Registrant's Registration No. 2,992,329 broadly states that it is utilized for "Clothing, namely shirts, hats, baby shirts and baby pants, in Class 25" and "Educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games and events rendered live and through the media of radio and television, musical concerts and entertainment, and performances of dramatic works, in Class 41," despite the fact the Registrant has not utilized this mark in conjunction with collegiate baseball for over twenty years, and despite the fact the Registrant only utilizes its marks (as confirmed by Registration No. 1,590,965) for "College imprinted clothing" and has done so for at least the last twenty years.

24. Registrant has thus abandoned the use of its marks for collegiate baseball and for clothing beyond "[c]ollege imprinted" clothing.

25. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "College imprinted clothing, namely shirts, hats, baby shirts and baby pants, in Class 25" and "Educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games (excluding college baseball) and events rendered live and through the media of radio and television, musical concerts and entertainment, and performances of dramatic works, in Class 41."

26. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

27. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball, and that Registrant does not utilize its mark in conjunction with clothing other than "[c]ollege imprinted" clothing, while Applicant's mark is utilized for merchandise and clothing for a professional sports team (not collegiate).

FOURTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 1,591,100.

28. Applicant incorporates paragraphs 1-27 herein.

29. Registrant's Registration No. 1,591,100 broadly states that it is utilized for "Miniature basketballs, in Class 28," despite the fact the Registrant only utilizes its marks (as confirmed by Registration No. 1,590,965) for "College imprinted" merchandise and has done so for at least the last twenty years.

30. Registrant has thus abandoned the use of its marks for merchandise beyond "[c]ollege imprinted" merchandise.

31. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "College imprinted miniature basketballs, in Class 28."

32. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

33. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball.

FIFTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 3,397,296.

34. Applicant incorporates paragraphs 1-33 herein.

35. Registrant's Registration No. 3,397,296 broadly states that it is utilized for "Shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits, in Class 25," despite the fact the Registrant utilizes its marks on "[c]ollege imprinted" clothing only, and has so for at least the last 20 years.

36. Registrant has thus abandoned the use of its marks for use on clothing beyond "[c]ollege imprinted" clothing.

37. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "College imprinted clothing, namely shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits, in Class 25."

38. This amendment to the goods and services will align Registrant with its actual uses of its mark, as well as with Registration No. 1,228,753.

39. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

40. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark for clothing other than "[c]ollege imprinted" clothing.

WHEREFORE, Applicant respectfully requests that Registration Nos. 1,228,753, 1,590,813, 1,591,100, 2,992,329 and 3,397,296 be partially cancelled, and limited as stated in the above paragraphs, or as the Trademark Trial and Appeal Board sees fit.

APPLICANT'S AMENDED ANSWER TO NOTICE OF OPPOSITION NO. 91183698

Applicant, Southern Illinois Miners, LLC, an Illinois limited liability company with a principal place of business at 1000 Miners Drive, Marion, Illinois 62959, by its counsel, hereby

answers the Notice of Opposition to its Application identified under Serial Number 77/043344, filed by The Board of Regents, The University of Texas System, and states the following responses to the paragraphs of such Notice of Opposition:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1, and therefore, denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2, and therefore, denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3, and therefore, denies the same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 4, and therefore, denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 5, and therefore, denies the same.

6. Applicant denies the allegations contained in paragraph 6.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 7, and therefore, denies the same.

8. Applicant admits the allegations contained in paragraph 8.

9. Applicant admits the allegation contained in paragraph 9.

10. Applicant admits that Applicant's application Ser. No. 77/043344 was initially refused on the grounds of an alleged likelihood of confusion with Opposer's Registration Nos. 1,228,753, 1,590,813, and 1,590,965. Applicant denies the remaining allegations contained in paragraph 10.

11. Applicant denies the allegations contained in paragraph 11.

12. Applicant denies the allegations contained in paragraph 12.

13. Applicant admits the allegation contained in paragraph 13.

14. Applicant denies the allegations contained in paragraph 14.

15. Applicant denies the allegations contained in paragraph 15.

16. Applicant denies the allegations contained in paragraph 16.

FIRST AFFIRMATIVE DEFENSE

17. Applicant alleges that the Notice of Opposition fails to allege facts sufficient to entitle Opposer to the remedy sought.

SECOND AFFIRMATIVE DEFENSE

18. Applicant alleges that Applicant's use of the trademark SOUTHERN ILLINOIS MINERS & Design as set forth in the Application does not create a likelihood of confusion with Opposer's alleged use of its MINERS marks, and the Notice of Opposition is therefore without merit.

WHEREFORE, having fully answered the Notice of Opposition, Applicant respectfully requests that the Notice of Opposition be dismissed and the application identified under Serial Number 77/043344 for the mark SOUTHERN ILLINOIS MINERS & Design be granted registration.

COUNTERCLAIMS FOR PARTIAL ABANDONMENT OF REGISTRATION NOS. 1,228,753, 1,590,813, 1,591,100, 2,992,329 AND 3,397,296

BACKGROUND

1. Applicant, the Southern Illinois Miners, LLC, is an Illinois limited liability company with a principal place of business at 1000 Miners Drive, Marion, Illinois 62959.

2. Applicant owns trademark application 91183198 for the mark SOUTHERN ILLINOIS MINERS & Design in International Class Nos. 16, 25, and 41.

3. Upon information and belief, Registrant is the owner of the following registrations: 1) Registration No. 1,228,753 for the word mark MINERS for "Entertainment services – namely, sponsoring and conducting college athletic exhibitions and competitions, in Class 41," 2) Registration No. 1,590,965 for the word mark MINERS for "College imprinted clothing, namely, shirts, hats and baby shirts, in Class 25," 3) Registration No. 1,590,813 for the word mark MINERS for "Printed programs for college sporting events and media guides, in Class 16," 4) Registration No. 1,591,100 for the word mark MINERS for "Miniature basketballs, in Class 28," 5) Registration No. 2,992,329 for a gold miner design for "Clothing, namely shirts, hats, baby shirts and baby pants, in Class 25" and "Educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games and events rendered live and through the media of radio and television, musical concerts and entertainment, and performances of dramatic works, in Class 41," and 6) Registration No. 3,397,296 for a pick-axe design mark for "Shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits, in Class 25."

4. Registrant has opposed the application for trademark recited in paragraph 2 above with its trademark registrations recited in paragraph 3 above.

5. Registrant utilizes its marks solely for collegiate usages.

6. Registrant does not utilize its mark for collegiate baseball teams, or for that matter, for any baseball teams, and has not for over twenty years.

7. To the contrary, Applicant's application is utilized for "professional baseball."

8. At a minimum then, Registrant's marks are used differently from Applicant's usages, in that Registrant's marks (as its registrations recite) are utilized on goods and services for "professional baseball" while Registrants marks are utilized for collegiate and/or non-baseball purposes.

9. To the extent Registrant's marks fail to limit their goods and services solely to collegiate and/or non-baseball uses, they are broader than Registrant's actual uses, and therefore need to be partially cancelled.

FIRST COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 1,228,753

10. Applicant incorporates paragraphs 1-9 herein.

11. Registrant's Registration No. 1,228,753 broadly states that it is utilized for "Entertainment services – namely, sponsoring and conducting college athletic exhibitions and competitions, in Class 41," despite the fact the Registrant has not utilized this mark in conjunction with collegiate baseball for over twenty years.

12. Registrant has thus abandoned the use of its marks for collegiate baseball, and for baseball in its entirety.

13. In view of its overly broad description of goods and services, the description of goods and services for Registration No. 1,228,753 should be partially cancelled, and limited to "Entertainment services – namely, sponsoring and conducting college athletic exhibitions (excluding college baseball) and competitions, in Class 41."

14. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

15. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball.

SECOND COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 1,590,813

16. Applicant incorporates paragraphs 1-15 herein.

17. Registrant's Registration No. 1,590,813 broadly states that it is utilized for "Printed programs for college sporting events and media guides, in Class 16," despite the fact the Registrant has not utilized this mark in conjunction with collegiate baseball for over twenty years.

18. Registrant has thus abandoned the use of its marks for collegiate baseball, and for baseball in its entirety.

19. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "Printed programs for college sporting events (excluding college baseball) and media guides, in Class 16."

20. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

21. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball.

THIRD COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 2,992,329

22. Applicant incorporates paragraphs 1-21 herein.

23. Registrant's Registration No. 2,992,329 broadly states that it is utilized for "Clothing, namely shirts, hats, baby shirts and baby pants, in Class 25" and "Educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games and events rendered live and through the media of radio and television, musical concerts and entertainment, and performances of dramatic works, in Class 41," despite the fact the Registrant has not utilized this mark in conjunction with collegiate baseball for over twenty years, and despite the fact the Registrant only utilizes its marks (as confirmed by Registration No. 1,590,965) for "College imprinted clothing" and has done so for at least the last twenty years.

24. Registrant has thus abandoned the use of its marks for collegiate baseball and for clothing beyond "[c]ollege imprinted" clothing.

25. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "College imprinted clothing,

namely shirts, hats, baby shirts and baby pants, in Class 25" and "Educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games (excluding college baseball) and events rendered live and through the media of radio and television, musical concerts and entertainment, and performances of dramatic works, in Class 41."

26. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

27. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball, and that Registrant does not utilize its mark in conjunction with clothing other than "[c]ollege imprinted" clothing, while Applicant's mark is utilized for merchandise and clothing for a professional sports team (not collegiate).

FOURTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 1, 591,100.

28. Applicant incorporates paragraphs1-27 herein.

29. Registrant's Registration No. 1,591,100 broadly states that it is utilized for "Miniature basketballs, in Class 28," despite the fact the Registrant only utilizes its marks (as confirmed by Registration No. 1,590,965) for "College imprinted" merchandise and has done so for at least the last twenty years.

30. Registrant has thus abandoned the use of its marks for merchandise beyond "[c]ollege imprinted" merchandise.

31. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "College imprinted miniature basketballs, in Class 28."

32. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

33. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark in conjunction with collegiate baseball, while Applicant's marks are utilized for professional baseball.

FIFTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF REGISTRATION NO. 3,397,296.

34. Applicant incorporates paragraphs 1-33 herein.

35. Registrant's Registration No. 3,397,296 broadly states that it is utilized for "Shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits, in Class 25," despite the fact the Registrant utilizes its marks on "[c]ollege imprinted" clothing only, and has so for at least the last 20 years.

36. Registrant has thus abandoned the use of its marks for use on clothing beyond "[c]ollege imprinted" clothing.

37. In view of its overly broad description of goods and services, the description of goods and services should be partially cancelled, and limited to "College imprinted clothing,

namely shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits, in Class 25."

38. This amendment to the goods and services will align Registrant with its actual uses of its mark, as well as with Registration No. 1,228,753.

39. Registrant is not using its mark on the goods or services sought to be excluded by Applicant's proposed amendment to the registration.

40. The proposed amendment to the goods and services will avoid a finding of likelihood of confusion between Registrant and Applicant's marks because the amendment makes clear that Registrant does not utilize its mark for clothing other than "[c]ollege imprinted" clothing.

WHEREFORE, Applicant respectfully requests that Registration Nos. 1,228,753, 1,590,813, 1,591,100, 2,992,329 and 3,397,296 be partially cancelled, and limited as stated in the above paragraphs, or as the Trademark Trial and Appeal Board sees fit.

Respectfully submitted,

By: _____

Paul A. Lesko
Simmons Browder Gianaris
Angelides & Barnerd LLC
707 Berkshire Blvd
East Alton, IL 62024
Email: plesko@simmonsfirm.com

Certificate of Service

The undersigned certifies that a true and complete copy of the foregoing Applicant's Answer to Notice of Opposition was served upon the following attorneys(s) of record by mailing a copy on this 28th day of June, 2010 via First Class Mail, postage prepaid, in an envelop addressed to:

Louis T. Pirkey
William G. Barber
Susan J. Hightower
PIRKY BARBER LLP
600 Congress Avenue, Suite 2120
Austin, Texas 78701

Paul A. Lesko
Attorneys for Southern Illinois Miners, LLC