

ESTTA Tracking number: **ESTTA293988**

Filing date: **07/07/2009**

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 | American Council on Education |
| Granted to Date of previous extension | 07/08/2009 |
| Address | One Dupont Circle, N.W. Washington, DC 20036 UNITED STATES |

| | |
|----------------------|--|
| Attorney information | Patrick J. Jennings Pillsbury Winthrop Shaw Pittman, LLP 2300 N Street, N.W. Washington, DC 20037 UNITED STATES va-logocops@pillsburywinthrop.com |
|----------------------|--|

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 77597773 | Publication date | 03/10/2009 |
| Opposition Filing Date | 07/07/2009 | Opposition Period Ends | 07/08/2009 |
| Applicant | Center for the Application of Information Technologies (CAIT) Horrabin Hall 90 Western IL University1 University Circle Macomb, IL 61455 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 041. First Use: 2007/07/01 First Use In Commerce: 2007/07/01 All goods and services in the class are opposed, namely: Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of Adult Education; Education services, namely, providing live and on-line GED Preparation in the field of Adult Education |
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Grounds for Opposition

| | |
|--------------------------------------|--|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | Applicant is not the rightful owner of the opposed mark. |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 1321397 | Application Date | 03/06/1984 |
| Registration Date | 02/19/1985 | Foreign Priority | NONE |

| | | | |
|---------------------|--|------|--|
| | | Date | |
| Word Mark | GED | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 1971/00/00 First Use In Commerce: 1971/00/00 Educational Testing Services | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3448412 | Application Date | 09/17/2007 |
| Registration Date | 06/17/2008 | Foreign Priority Date | NONE |
| Word Mark | GED TESTING SERVICE | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 041. First use: First Use: 1963/00/00 First Use In Commerce: 1963/00/00 Educational testing servivces, namely, provding adults who did not receive a high school diploma with the opportunity to earn their jurisdiction's high school equivalency credential by passing a battery of five tests in reading, writing, mathematics, social studies, and science | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2613984 | Application Date | 06/26/2000 |
| Registration Date | 09/03/2002 | Foreign Priority Date | NONE |
| Word Mark | GED | | |

| | |
|---------------------|---|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 041. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 EDUCATIONAL TESTING SERVICES |

| | |
|-------------|---|
| Attachments | 73468985#TMSN.gif (1 page)(bytes) 77280949#TMSN.jpeg (1 page)(bytes) 76076788#TMSN.jpeg (1 page)(bytes) GED-i Opposition.pdf (16 pages)(615930 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 | /Pat Jennings/ |
| Name | Patrick J. Jennings |
| Date | 07/07/2009 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

American Council on Education,)
)
 Opposer,)
)
 v.)
)
 Center for the Application of Information)
 Technologies (CAIT),)
)
)
 Applicant.)

Ser. No. 77/597,773

Opp. No. _____

NOTICE OF OPPOSITION

Opposer American Council on Education (“Opposer”) is or will be damaged by the registration of the mark GED-i, Serial No. 77/597,773, and hereby opposes the registration of the same pursuant to 37 C.F.R. § 2.101(b). Allegations with respect to Opposer are based on actual knowledge. All other allegations are based on information and belief. As grounds for the opposition, Opposer, by its attorneys, aver as follows:

Opposer and its GED Mark

1. Opposer is a Washington, D.C. non-profit corporation with an address of One DuPont Circle, N.W., Washington, D.C. 20036.
2. Founded in 1918, Opposer is the major coordinating body for higher education institutions in the United States, representing more than 1,600 colleges and universities, and more than 200 related associations.
3. Opposer seeks to provide leadership and a unifying voice on key higher education issues and influence public policy through advocacy, research, and program initiatives.
4. Membership in Opposer is open to accredited, degree-granting colleges and universities and higher education associations within the United States.

5. In furtherance of its mission and objective, Opposer is solely responsible for the development and dissemination of GED[®] tests.
6. Created in 1942 to support World War II soldiers, Opposer's GED tests offered thousands of veterans a chance at assimilating back into civilian life and an opportunity to attend a college or university.
7. Opposer's GED credential is the United States' most widely accepted and respected high school equivalency credential.
8. Opposer's GED credentials are awarded in all 50 states, the District of Columbia, U.S. territories and insular areas, and internationally.
9. An estimated 17 million people have passed Opposer's GED[®] tests since 1942.
10. Opposer owns three United States trademark registrations for the GED trademark: Reg. Nos. 1,321,397; 2,613,984; and 3,448,412.
11. United States Trademark Registration No. 1,321,397 covers the  mark. Issued on February 19, 1985, the registration covers "educational testing services" and is statutorily incontestable. The  mark was first used in commerce at least as early as 1971.
12. United States Trademark Registration No. 2,613,984 covers the GED mark. Issued on September 3, 2002, the registration covers "educational testing services" and is statutorily incontestable. The GED mark was first used in commerce at least as early as 1999.
13. United States Trademark Registration No. 3,448,412 covers the GED TESTING SERVICE mark. Issued on June 17, 2008, the registration covers "educational testing services, namely, providing adults who did not receive a high school diploma with the opportunity to earn their jurisdiction's high school equivalency credential by passing a battery of five tests in

reading, writing, mathematics, social studies, and science.” The GED TESTING SERVICE mark was first used in commerce at least as early as 1963.

14. Opposer’s registration are valid, subsisting, and *prima facie* evidence of the validity and registration of the marks, Opposer’s ownership of the marks, and Opposer’s exclusive right to use the marks in commerce on or in connection with the services specified in the registrations. Printouts from the United States Patent and Trademark Office’s TARR System showing the status and title of each registration are attached as Exhibit A.

Applicant and its GED-i Mark

15. The Center for the Application of Information Technologies (CAIT) (“Applicant”) is a non-profit organization organized under the laws of the state of Illinois with an address of Horrabin Hall 90, Western Illinois University, 1 University Circle, Macomb, Illinois 61455.

16. On October 22, 2008, Applicant filed an application to register the mark GED-i for use in connection with “continuing education services, namely, providing live and on-line continuing professional education seminars in the field of adult education; education services, namely, providing live and on-line GED preparation in the field of adult education.” The application contains a July 1, 2007 date of first use in commerce.

17. The United States Patent and Trademark Office published Applicant’s Mark on March 10, 2009.

Count One
Likelihood of Confusion, 15 U.S.C. § 1052(d)

18. Opposer repeats and re-alleges each and every allegation set forth in Paragraphs 1 through 17.

19. The GED-i mark, when used in connection with the services set forth in Application Serial No. 77/597,773, so resembles Opposer's GED mark as to be likely to cause confusion, cause mistake, or deceive pursuant to the provisions of 15 U.S.C. § 1052(d).

20. Opposer's rights in the GED mark predate any rights that Applicant could assert in the GED-i mark.

21. The GED-i mark is similar in sound, appearance, meaning, and overall commercial impression to Opposer's GED mark.

22. The GED-i mark contains all of Opposer's GED mark.

23. The application to register the GED-i mark covers services that are closely related and complementary to Opposer's services.

24. Opposer has not authorized or licensed Applicant to use the GED mark.

Applicant does not own the GED-i Mark

25. Opposer repeats and re-alleges each and every allegation set forth in Paragraphs 1 through 24.

26. Upon information and belief, Applicant does not own the GED-i mark and did not own the mark when it filed Serial No. 77/597,773.

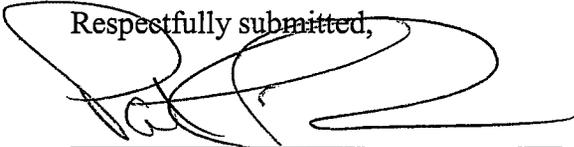
27. Upon information and belief, Applicant is merely a vendor for the rightful owner of the GED-i mark, the Illinois Community College Board, and was not entitled to file the application to register the GED-i mark.

28. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void under 37 C.F.R. § 2.71(d).

For the foregoing reasons, Opposer believes it is or will be damaged by the registration of the GED-i mark. WHEREFORE, Opposer respectfully requests that the Trademark Trial and

Appeal Board refuse to register the GED-i mark and sustain this opposition on all grounds.

Respectfully submitted,



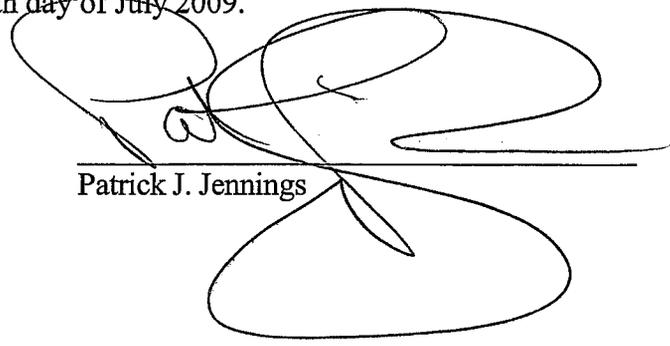
Dated: July 7, 2009

Patrick J. Jennings
Pillsbury Winthrop Shaw Pittman, LLP
2300 N Street, N.W.
Washington, D.C. 20037
Phone: 202-663-8000

Counsel for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing "NOTICE OF OPPOSITION" has been served on Center for the Application of Information Technologies (CAIT), with an address of Horrabin Hall 90, Western Illinois University, 1 University Circle, Macomb, Illinois 61455, via first class mail, postage prepaid, this 7th day of July 2009.

A large, stylized handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

Patrick J. Jennings

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-07-07 13:54:03 ET

Serial Number: 73468985 Assignment Information Trademark Document Retrieval

Registration Number: 1321397

Mark



(words only): GED

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2005-03-18

Filing Date: 1984-03-06

Transformed into a National Application: No

Registration Date: 1985-02-19

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 834 -Post Registration

Date In Location: 2005-03-18

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. American Council on Education

Address:

American Council on Education
One Dupont Cir.

Washington, DC 20036
United States
Legal Entity Type: Corporation
State or Country of Incorporation: D.C.

GOODS AND/OR SERVICES

International Class: 042
Class Status: Active
Educational Testing Services
Basis: 1(a)
First Use Date: 1971-00-00
First Use in Commerce Date: 1971-00-00

ADDITIONAL INFORMATION

Design Search Code(s):
26.03.01 - Ovals as carriers and single line borders

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-07-06 - Attorney Revoked And/Or Appointed
2006-07-06 - TEAS Revoke/Appoint Attorney Received
2005-03-18 - First renewal 10 year
2005-03-18 - Section 8 (10-year) accepted/ Section 9 granted
2005-01-18 - Combined Section 8 (10-year)/Section 9 filed
2005-01-18 - PAPER RECEIVED
1991-03-12 - Section 8 (6-year) accepted & Section 15 acknowledged
1991-02-20 - Response received for Post Registration action
1990-08-27 - Post Registration action mailed Section 8 & 15
1990-06-14 - Section 8 (6-year) and Section 15 Filed

1985-02-19 - Registered - Principal Register

1984-12-11 - Published for opposition

1984-11-26 - Notice of publication

1984-11-02 - Notice of publication

1984-10-09 - Approved for Pub - Principal Register (Initial exam)

1984-09-07 - Communication received from applicant

1984-07-20 - Examiner's amendment mailed

1984-06-25 - Assigned To Examiner

1984-06-18 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Patrick J. Jennings

Correspondent

Patrick J. Jennings

Pillsbury Winthrop Shaw Pittman LLP

2300 N Street, N.W.

Washington DC 20037

Phone Number: 202-663-8000

Fax Number: 703-770-7901

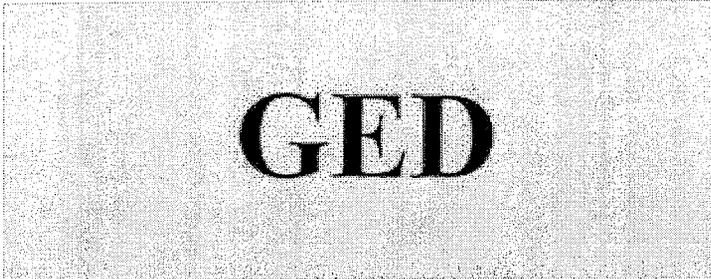
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-07-07 13:53:59 ET

Serial Number: 76076788 Assignment Information Trademark Document Retrieval

Registration Number: 2613984

Mark



(words only): GED

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2008-01-30

Filing Date: 2000-06-26

Transformed into a National Application: No

Registration Date: 2002-09-03

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-01-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. AMERICAN COUNCIL ON EDUCATION

Address:

AMERICAN COUNCIL ON EDUCATION
One Dupont Circle, N.W.

Washington, DC 200361193
United States
Legal Entity Type: Corporation
State or Country of Incorporation: D.C.

GOODS AND/OR SERVICES

International Class: 041
Class Status: Active
EDUCATIONAL TESTING SERVICES
Basis: 1(a)
First Use Date: 1999-00-00
First Use in Commerce Date: 1999-00-00

ADDITIONAL INFORMATION

Prior Registration Number(s):
1321397

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-01-30 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-01-16 - Assigned To Paralegal

2008-01-14 - TEAS Section 8 & 15 Received

2006-07-06 - Attorney Revoked And/Or Appointed

2006-07-06 - TEAS Revoke/Appoint Attorney Received

2005-04-29 - Section 7 amendment issued

2005-04-01 - Assigned To Paralegal

2005-02-15 - Section 7 amendment filed

2005-02-15 - PAPER RECEIVED

2002-09-03 - Registered - Principal Register

2002-06-11 - Published for opposition
2002-05-22 - Notice of publication
2001-12-10 - Approved for Pub - Principal Register (Initial exam)
2001-08-13 - Communication received from applicant
2001-02-13 - Non-final action mailed
2001-01-12 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Patrick J. Jennings

Correspondent

Patrick J. Jennings
Pillsbury Winthrop Shaw Pittman LLP
2300 N Street, N.W.
Washington DC 20037
Phone Number: 202-663-8000
Fax Number: 202-663-8007

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-07-07 13:53:48 ET

Serial Number: 77280949 Assignment Information Trademark Document Retrieval

Registration Number: 3448412

Mark

GED TESTING SERVICE

(words only): GED TESTING SERVICE

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2008-06-17

Filing Date: 2007-09-17

Transformed into a National Application: No

Registration Date: 2008-06-17

Register: Principal

Law Office Assigned: LAW OFFICE 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-06-17

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. American Council On Education

Address:

American Council On Education
One DuPont Circle, N.W.

Washington, DC 20036

United States

Legal Entity Type: Corporation

State or Country of Incorporation: D.C.

GOODS AND/OR SERVICES

International Class: 041

Class Status: Active

Educational testing servivces, namely, provding adults who did not receive a high school diploma with the opportunity to earn their jurisdiction's high school equivalency credential by passing a battery of five tests in reading, writing, mathematics, social studies, and science

Basis: 1(a)

First Use Date: 1963-00-00

First Use in Commerce Date: 1963-00-00

ADDITIONAL INFORMATION

Disclaimer: "TESTING SERVICE"

Prior Registration Number(s):

1321397

2613984

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-06-17 - Registered - Principal Register

2008-04-01 - Published for opposition

2008-03-12 - Notice of publication

2008-02-25 - Law Office Publication Review Completed

2008-02-25 - Assigned To LIE

2008-01-24 - Approved for Pub - Principal Register (Initial exam)

2008-01-24 - Examiner's Amendment Entered

2008-01-24 - Notification Of Examiners Amendment E-Mailed

2008-01-24 - EXAMINERS AMENDMENT E-MAILED

2008-01-24 - Examiners Amendment -Written

2008-01-18 - Notification Of Final Refusal Emailed

2008-01-18 - Final refusal e-mailed

2008-01-18 - Final Refusal Written

2008-01-08 - Teas/Email Correspondence Entered

2008-01-08 - Communication received from applicant

2008-01-08 - TEAS Response to Office Action Received

2007-12-21 - Notification Of Non-Final Action E-Mailed

2007-12-21 - Non-final action e-mailed

2007-12-21 - Non-Final Action Written

2007-12-19 - Assigned To Examiner

2007-09-20 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Patrick J. Jennings

Correspondent

PATRICK J. JENNINGS

PILLSBURY WINTHROP SHAW PITTMAN, LLP

2300 N ST NW

WASHINGTON, DC 20037-1122

Phone Number: 202-663-8000

Fax Number: 202-663-8007
