

ESTTA Tracking number: **ESTTA318334**

Filing date: **11/23/2009**

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	Scholastic Inc.
Granted to Date of previous extension	11/22/2009
Address	557 Broadway New York, NY 10012 UNITED STATES

Attorney information	Edward H. Rosenthal Frankfurt Kurnit Klein & Selz PC 488 Madison Avenue New York, NY 10022 UNITED STATES pto@fkks.com Phone:212-980-0120
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**Applicant Information**

Application No	77658166	Publication date	05/26/2009
Opposition Filing Date	11/23/2009	Opposition Period Ends	11/22/2009
Applicant	Scholastic Rowing Association of America 1515 Norristown Road Maple Glen, PA 19002 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 014. First Use: 1934/05/00 First Use In Commerce: 1934/05/00 All goods and services in the class are opposed, namely: Precious metal trophies
Class 016. All goods and services in the class are opposed, namely: Event programs
Class 041. First Use: 1934/05/00 First Use In Commerce: 1934/05/00 All goods and services in the class are opposed, namely: Organizing and conducting regattas for high school students

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2511956	Application Date	04/14/2000
Registration Date	11/27/2001	Foreign Priority	NONE

		Date	
Word Mark	SCHOLASTIC		
Design Mark	<b>SCHOLASTIC</b>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/09/01 First Use In Commerce: 1999/09/01 computer software and CD-ROMs in the field of testing and assessment of reading skills		

U.S. Registration No.	2586322	Application Date	07/17/2000
Registration Date	06/25/2002	Foreign Priority Date	NONE

Word Mark	SCHOLASTIC		
Design Mark			

Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1988/08/00 First Use In Commerce: 1988/08/00 prerecorded video tapes, prerecorded audio tapes, prerecorded video discs and prerecorded CD-ROMs in the fields of science, math, reading, spelling, phonics, literature, geography, history and social studies; hand-held computers; electronic game programs; electronic game software; electronic game cartridges; video game cartridges; and video game programs		

U.S. Registration No.	1685119	Application Date	10/11/1990
Registration Date	05/05/1992	Foreign Priority Date	NONE

Word Mark	SCHOLASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1955/00/00 First Use In Commerce: 1955/00/00 prerecorded computer programs, prerecorded audio recordings, prerecorded audio/visual programs, and prerecorded video programs, all for use in the field of education		

U.S. Registration No.	1344129	Application Date	11/30/1984
Registration Date	06/25/1985	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1984/09/01 First Use In Commerce: 1984/09/01 PRERECORDED COMPUTER PROGRAMS WITH INSTRUCTION HANDBOOK, ALL SOLD AS A UNIT

U.S. Registration No.	1569434	Application Date	03/24/1989
Registration Date	12/05/1989	Foreign Priority Date	NONE

Word Mark	SCHOLASTIC
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Description of Mark	NONE
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Goods/Services	Class 009. First use: First Use: 1988/08/00 First Use In Commerce: 1988/08/00 COMPUTER AND VIDEO PROGRAMS FOR EDUCATIONAL USE
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U.S. Registration No.	3286090	Application Date	04/17/2006
Registration Date	08/28/2007	Foreign Priority Date	NONE

Word Mark	SCHOLASTIC COACH AND ATHLETIC DIRECTOR
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Description of Mark	NONE
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Goods/Services	Class 016. First use: First Use: 2003/09/01 First Use In Commerce: 2003/09/01 Magazine for athletic department personnel of high schools, parochial schools, preparatory schools, junior colleges and non-school athletic programs
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U.S. Registration No.	1567119	Application Date	03/17/1989
Registration Date	11/21/1989	Foreign Priority Date	NONE

Word Mark	SCHOLASTIC
Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1988/08/00 First Use In Commerce: 1988/08/00 STUDENT NEWSPAPERS, MAGAZINES, BOOKS, CHARTS, WORKBOOKS, BOOK CLUB CATALOGS FOR EDUCATIONAL USE

U.S. Registration No.	1672577	Application Date	10/11/1990
Registration Date	01/21/1992	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1922/09/00 First Use In Commerce: 1922/09/00 newspapers, magazines, fiction and non-fiction paperback and hardcover books, wall charts, workbooks, catalogs, calendars, instructional books, posters, teaching manuals, spirit masters, and cardboard displays for books; all for educational use by students and teachers, at primary and secondary school levels		

U.S. Registration No.	2433658	Application Date	04/14/2000
Registration Date	03/06/2001	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1998/09/01 First Use In Commerce: 1998/09/01 Printed material, namely, books, magazines and pamphlets in the field of testing		

U.S. Registration No.	2444550	Application Date	05/17/2000
Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1988/08/00 First Use In Commerce: 1988/08/00 Mail order catalog services featuring general merchandise for children, namely books, posters, multimedia products, toys and games, software and CD-ROMs		

U.S. Registration No.	2988840	Application Date	09/27/2004
Registration Date	08/30/2005	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2004/05/01 First Use In Commerce: 2004/05/01 Credit card services		

U.S. Registration No.	3290768	Application Date	04/17/2006
Registration Date	09/11/2007	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC COACH AND ATHLETIC DIRECTOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/09/01 First Use In Commerce: 2003/09/01 Online magazine for athletic department personnel of high schools, parochial schools, preparatory schools, junior colleges, colleges and non-school athletic programs		

U.S. Registration No.	2392914	Application Date	03/19/1999
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Registration Date	10/10/2000	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark	<b>SCHOLASTIC</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1993/09/01 First Use In Commerce: 1993/09/01 Providing information via a global computer network about children's books, book clubs, book fairs, educational curriculum programs and materials, magazines, computer software, television programs, films, home video, instructional activities and games		

U.S. Registration No.	1677924	Application Date	10/11/1990
Registration Date	03/03/1992	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1981/00/00 First Use In Commerce: 1981/00/00 production of educationally oriented television shows and video programs; conducting fairs and/or conferences promoting new developments and technology in educational materials and books		

U.S. Registration No.	2711978	Application Date	06/22/2001
Registration Date	04/29/2003	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark	<b>SCHOLASTIC</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2001/09/01 First Use In Commerce: 2001/09/01 Educational services, namely providing on-line tutoring services for students in the fields of math, science, language arts, social studies, geography and history via a global computer network		

U.S. Registration No.	2437177	Application Date	04/14/2000
Registration Date	03/20/2001	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark	<b>SCHOLASTIC</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1999/08/01 First Use In Commerce: 1999/08/01 Providing information in the field of educational testing via a global computer network		

U.S. Registration No.	2648284	Application Date	11/22/2000
Registration Date	11/12/2002	Foreign Priority Date	NONE
Word Mark	SCHOLASTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1988/08/00 First Use In Commerce: 1988/08/00 Production of educationally oriented television shows and video programs; conducting educational conferences		

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## 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	/Edward H. Rosenthal/
Name	Edward H. Rosenthal
Date	11/23/2009

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

Applicant : Scholastic Rowing Association of America  
Trademark : SCHOLASTIC ROWING ASSOCIATION OF AMERICA  
Serial No. : 77/658,166  
Filed : January 28, 2009  
Published : May 26, 2009  
Int'l Classes : 014, 016, 041

SCHOLASTIC INC.,	X	
	:	Opposition No. _____
Opposer,	:	
	:	
-against-	:	<b><u>NOTICE OF OPPOSITION</u></b>
	:	
SCHOLASTIC ROWING	:	
ASSOCIATION OF AMERICA,	:	
	:	
Applicant.	:	
	X	

Opposer, Scholastic Inc. (“Opposer”), a corporation organized under the laws of the State of New York and doing business at 557 Broadway, New York, New York 10012, believes that it would be damaged by registration of the mark shown in Serial No. 77/658,166, and hereby opposes the same.

As grounds for opposition, it is alleged as follows:

1. Opposer has been using the mark SCHOLASTIC in commerce and without interruption since at least as early as 1922 in connection with a wide variety of goods and

services. Said use has been valid and continuous since the date of first use and has not been abandoned.

2. Opposer is the owner of numerous trademark registrations for the trademark SCHOLASTIC and various trademarks that incorporate the word SCHOLASTIC, including, without limitation, registrations in International Classes 9, 16, 35, 36 and 41.

3. Opposer is the owner of Reg. No. 2511956 for the mark SCHOLASTIC in Class 9 in connection with “computer software and CD-ROMs in the field of testing and assessment of reading skills.”

4. Opposer is the owner of Reg. No. 2586322 for the mark SCHOLASTIC in Class 9 in connection with “prerecorded video tapes, prerecorded audio tapes, prerecorded video discs and prerecorded CD-ROMs in the fields of science, math, reading, spelling, phonics, literature, geography, history and social studies; hand-held computers; electronic game programs; electronic game software; electronic game cartridges; video game cartridges; and video game programs.”

5. Opposer is the owner of Reg. No. 1685119 for the mark SCHOLASTIC in Class 9 in connection with “prerecorded computer programs, prerecorded audio recordings, prerecorded audio/visual programs, and prerecorded video programs, all for use in the field of education.”

6. Opposer is the owner of Reg. No. 1344129 for the mark SCHOLASTIC in Class 9 in connection with “prerecorded computer programs with instruction handbook, all sold as a unit.”

7. Opposer is the owner of Reg. No. 1569434 for the mark SCHOLASTIC in Class 9 in connection with “computer and video programs for educational use.”

8. Opposer is the owner of Reg. No. 3286090 for the mark SCHOLASTIC COACH AND ATHLETIC DIRECTOR in Class 16 in connection with a “magazine for athletic department personnel of high schools, parochial schools, preparatory schools, junior colleges and non-school athletic programs.”

9. Opposer is the owner of Reg. No. 1567119 for the mark SCHOLASTIC in Class 16 in connection with “student newspapers, magazines, books, charts, workbooks, book club catalogs for educational use.”

10. Opposer is the owner of Reg. No. 1672577 for the mark SCHOLASTIC in Class 16 in connection with “newspapers, magazines, fiction and non-fiction paperback and hardcover books, wall charts, workbooks, catalogs, calendars, instructional books, posters, teaching manuals, spirit masters, and cardboard displays for books; all for educational use by students and teachers, at primary and secondary school levels.”

11. Opposer is the owner of Reg. No. 2433658 for the mark SCHOLASTIC in Class 16 in connection with “Printed material, namely, books, magazines and pamphlets in the field of testing.”

12. Opposer is the owner of Reg. No. 2444550 for the mark SCHOLASTIC in Class 35 for “Mail order catalog services featuring general merchandise for children, namely books, posters, multimedia products, toys and games, software and CD-ROMs.”

13. Opposer is the owner of Reg. No. 2988840 for the mark SCHOLASTIC in Class 36 for “credit card services.”

14. Opposer is the owner of Reg. No. 3290768 for the mark SCHOLASTIC COACH AND ATHLETIC DIRECTOR in Class 41 in connection with “online magazine for athletic

department personnel of high schools, parochial schools, preparatory schools, junior colleges, colleges and non-school athletic programs.”

15. Opposer is the owner of Reg. No. 2392914 for the mark SCHOLASTIC in Class 41 in connection with “providing information via a global computer network about children's books, book clubs, book fairs, educational curriculum programs and materials, magazines, computer software, television programs, films, home video, instructional activities and games.”

16. Opposer is the owner of Reg. No. 1677924 for the mark SCHOLASTIC in Class 41 in connection with “production of educationally oriented television shows and video programs; conducting fairs and/or conferences promoting new developments and technology in educational materials and books.”

17. Opposer is the owner of Reg. No. 2711978 for the mark SCHOLASTIC in Class 41 in connection with “Educational services, namely providing on-line tutoring services for students in the fields of math, science, language arts, social studies, geography and history via a global computer network.”

18. Opposer is the owner of Reg. No. 2437177 for the mark SCHOLASTIC in Class 41 in connection with “Providing information in the field of educational testing via a global computer network.”

19. Opposer is the owner of Reg. No. 2648284 for the mark SCHOLASTIC in Class 41 in connection with “Production of educationally oriented television shows and video programs; conducting educational conferences.”

20. Through Opposer’s many decades of use, advertising and promotion of its trademark SCHOLASTIC, as well as trademarks incorporating the trademark SCHOLASTIC,

the trademark SCHOLASTIC is symbolic of extensive good will and consumer recognition and has come to be associated by the public exclusively with Opposer and the goods and services provided by Opposer.

21. Among other uses, Opposer has used its trademark SCHOLASTIC, as well as trademarks incorporating the trademark SCHOLASTIC, in connection with various educational and entertainment services, including a print and online sports magazine called SCHOLASTIC COACH AND ATHLETIC DIRECTOR targeted at athletic department personnel of high schools, parochial schools, preparatory schools, junior colleges and non-school athletic programs.

22. Applicant, Scholastic Rowing Association of America (“Applicant”), has applied for a trademark registration for the mark SCHOLASTIC ROWING ASSOCIATION OF AMERICA for “Precious metal trophies” in International Class 014, “Event programs” in International Class 016 and “Organizing and conducting regattas for high school students” in International Class 041 (the “Application”).

23. Applicant’s use of the name SCHOLASTIC ROWING ASSOCIATION OF AMERICA is likely to cause confusion, or to cause mistake or to deceive by suggesting that Applicant’s goods and/or services are endorsed, authorized, sponsored, associated with or approved by Opposer.

WHEREFORE, Opposer requests that this opposition be sustained and that Application Serial No. 77/658,166 be rejected.

A duplicate copy of this Notice of Opposition and the required fee are enclosed herewith.

Dated: New York, New York  
November 23, 2009

Respectfully submitted,

FRANKFURT KURNIT KLEIN  
& SELZ, PC

By: /Edward H. Rosenthal/  
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Attorneys for Opposer, Scholastic Inc.