

ESTTA Tracking number: **ESTTA484596**

Filing date: **07/20/2012**

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	International Trade Administration (ITA), U.S. Dept. of Commerce
Granted to Date of previous extension	07/21/2012
Address	1401 Constitution Ave NW Washington, DC 20230 UNITED STATES

Correspondence information	International Trade Administration 1401 Constitution Ave NW Washington, DC 20230 UNITED STATES lgrunstra@doc.gov
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Applicant Information

Application No	85489140	Publication date	05/22/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	07/21/2012
Applicant	Network International Exports, Inc Suite 296-J 3972 Barranca Parkway Irvine, CA 92606 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Developing international student exchange programs

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Applicant lacked a bona fide intent to use the design mark in connection with the identified services as of the filing date of the application pursuant to Trademark Act Â§ 1(b), 15 U.S.C. Â§ 1051(b).

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3834368	Application Date	12/22/2009
Registration Date	08/17/2010	Foreign Priority	NONE

		Date	
Word Mark	STUDY TEXAS		
Design Mark			
Description of Mark	The mark consists of a white star within a white outlined red figure of the state of Texas superimposed on a blue figure of the United States with the word "Study Texas" appearing in black text to the right of the figure.		
Goods/Services	Class 035. First use: First Use: 2009/04/15 First Use In Commerce: 2009/05/01 Recruitment of students for higher education institutions		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY CALIFORNIA		
Goods/Services	Educational services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY GEORGIA		
Goods/Services	Educational services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY ILLINOIS		
Goods/Services	Educational services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY MISSISSIPPI		
Goods/Services	Educational services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY NEW JERSEY		
Goods/Services	Educational services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY NEW YORK		
Goods/Services	Educational services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY NORTH CAROLINA		
Goods/Services	Educational services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY OREGON		
Goods/Services	Educational services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY WASHINGTON		
Goods/Services	Educational services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY WESTERN MASSACHUSETTS		
Goods/Services	Educational services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STUDY WISCONSIN		
Goods/Services	Educational services		

Attachments	77899211#TMSN.jpeg (1 page)(bytes) Study California_opposition.pdf (5 pages)(1257849 bytes)
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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	/s/ Lydia Grunstra
Name	International Trade Administration
Date	07/20/2012

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

In the matter of trademark application Serial No. 85489140
For the mark "STUDY CALIFORNIA"
Published in the Official Gazette on May 22, 2012

International Trade Administration,
U.S. Department of Commerce,

Opposer

v.

Network International Exports, Inc.,

Applicant

Opposition No. _____

NOTICE OF OPPOSITION

The International Trade Administration (ITA), an agency of the U.S. Department of Commerce, headquartered at 1401 Constitution Ave NW, Washington, D.C. 20230, believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

- 1) The U.S. Foreign & Commercial Service (hereafter "Commercial Service") is the trade promotion arm of ITA.
- 2) The Commercial Service's mission is to help U.S. companies begin exporting and/or increase sales to new global markets.
- 3) To aid U.S. colleges and universities in exporting their educational services, the Commercial Service facilitates the formation of state-wide consortia, which allow schools in a particular state to combine their marketing efforts to recruit foreign students.
- 4) The Commercial Service established its first statewide consortia in Oregon and Washington in 1999.
- 5) To date, ITA has facilitated the formation of a number of educational consortia, including, but not limited to, Study California, Study Georgia, Study Illinois, Study Mississippi, Study New Jersey, Study New York, Study North Carolina, Study Oregon, Study Texas, Study Washington, Study Western Massachusetts, and Study Wisconsin.
- 6) Since at least as early as 2000, the Commercial Service has advertised its "Study [State]" consortia services at national and regional conferences hosted by NAFSA (originally the National Association of Foreign Student Advisers, now the Association of International

Educators), the world's largest nonprofit professional association dedicated to international education.

- 7) As a result, the agency has built up significant goodwill in the above-referenced "Study [State]" trademarks, as institutes of higher education and others in the educational services community have come to associate these marks with the Commercial Service, ITA, and the Department of Commerce's educational export services.
- 8) In 2008, ITA purchased the following domain names: studyalabama.us, studyalaska.us, studyarkansas.us, studycalifornia.us, studycolorado.us, studyconnecticut.us, studydelaware.us, studydistrictofcolumbia.us, studyflorida.us, studygeorgia.us, studyhawaii.us, studyidaho.us, studyillinois.us, studyindiana.us, studyiowa.us, studykansas.us, studykentucky.us, studylouisiana.us, studymaine.us, studymaryland.us, studymassachusetts.us, studymichigan.us, studyminnesota.us, studymississippi.us, studymissouri.us, studymontana.us, studynebraska.us, studynevada.us, studynewhampshire.us, studynewjersey.us, studynewmexico.us, studynewyork.us, studynorthcarolina.us, studyohio.us, studyoklahoma.us, studypennsylvania.us, studyrhodeisland.us, studysouthcarolina.us, studysouthdakota.us, studytennessee.us, studytexas.us, studyutah.us, studyvermont.us, studyvirginia.us, studywashington.us, studywestvirginia.us, studywisconsin.us, and studywyoming.us.
- 9) Since at least as early as 2010, if not earlier, ITA has been using the word mark "Study California" in commerce in connection with educational services.
- 10) Thirty-seven California institutions of higher education have paid to participate in ITA's Study California initiative, which provides participating schools with access to college fairs, recruiting event assistance, and international contacts.
- 11) In 2011, ITA issued a Request for Proposal (RFP) to solicit bids for the creation of a "Study California" website. The winning bidder, Second Melody, designed a logo for the website that incorporated the words "Study California" and a map of the state of California.
- 12) At the NAFSA Region XII Conference held in Reno, Nevada on November 7-11, 2011, ITA announced its plans to launch a Study California website at www.studycalifornia.us.
- 13) Network International Exports, Inc. (NEI) founder Mark Matsumoto attended the November 2011 NAFSA regional conference in Nevada and was present for ITA's announcement.
- 14) NEI is a corporation located at Barranca Parkway, Suite 296-J 3972, Irvine, California 92606.
- 15) NEI does business as "ETEC" (Education and Training Export Consortium) and/or "California ETEC."
- 16) ETEC's stated mission is to "exclusively promote the attraction of international students to the United States and expand the export of educational services globally."
- 17) ETEC has received at least one Market Development Cooperator Program (MDCP) grant from ITA to further this mission.
- 18) ETEC has advertised its services in connection with several websites, including, but not limited to, www.studycalifornia.org, www.educationsocal.com, and www.vetecusa.com.
- 19) Unlike ITA, ETEC has no "Study California" initiative, nor does the company go by the name "Study California."
- 20) ETEC does not use "Study California" as a trademark.

- 21) In November 2011, following ITA's "Study California" website launch announcement, Mr. Matsumoto sent an email to Brad Hess (MDCP Director for ITA), which stated in part: "It is our belief that launching a website with nearly the identical domain that has been used by California ETEC, www.studycalifornia.org, since 2006 will have the net impact of confusing our existing clients and provide a mixed message to California schools and Vietnam partners as we rollout the VETEC [Vietnam Education and Training Center] project. I would also note that CA ETEC has a legal right to exclusive use of the name as we have filed a previous application for trademark protection and have prior use dating back to 2008 on the internet and print materials."
- 22) The previous application for trademark protection to which Mr. Matsumoto referred was filed with the U.S. Patent & Trademark Office (USPTO) on December 29, 2009 (Serial No. 77902065). On February 16, 2010, the U.S. Patent & Trademark Office (USPTO) issued an office action citing likelihood of confusion with the mark "Study Texas" (Registration No. 3834368). ETEC never responded to this office action, and on August 16, 2010, the trademark application was abandoned.
- 23) Despite Mr. Matsumoto's assertions that ETEC had been using the Study California mark since 2008, ETEC proceeded to file an *intent-to-use* application for the mark with the USPTO on December 7, 2011.
- 24) If ETEC's mark is registered, ETEC would obtain a *prima facie* exclusive right to use the mark (consisting of the words "Study California" and a map of the state of California) in connection with educational services.
- 25) ITA opposes the registration of ETEC's mark on the grounds that ETEC did not have a bona fide intent to use the design mark in connection with the identified services as of the filing date of the application under Trademark Act § 1(b), 15 U.S.C. § 1051(b). Rather, ITA believes that ETEC filed its intent-to-use application in bad faith for the exclusive purpose of preventing ITA from using a similar mark in commerce.
- 26) Furthermore, ETEC's mark so resembles marks previously used in the United States by ITA and not abandoned (including Study California, Study Georgia, Study Illinois, Study Mississippi, Study New Jersey, Study New York, Study North Carolina, Study Oregon, Study Texas, Study Washington, Study Western Massachusetts, and Study Wisconsin) as to be likely, when used on or in connection with the services of ETEC, to cause confusion, or to cause mistake, or to deceive. Trademark Act § 2(d), 15 U.S.C. § 1052(d).
- 27) In addition, ETEC's mark so resembles a mark registered in the U.S. Patent & Trademark Office ("Study Texas," Registration No. 3834368) as to be likely, when used on or in connection with the services of ETEC, to cause confusion, or to cause mistake, or to deceive. Trademark Act § 2(d), 15 U.S.C. § 1052(d).
- 28) Finally, ITA has a bona fide intent to use a similar design mark for related goods, and is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of ETEC's registration.
- 29) ITA has invested considerable time, energy, and expense into building a brand not only for "Study California," but also for its "Study[State]" initiative nationwide and would be injured by ETEC's registration of the mark, which would not only prevent ITA from using a similar design mark for its own California consortium efforts, but would also impair ITA's ability to use the phrase "Study California" in connection with educational services in California.

30) For the above reasons, ITA respectfully requests that registration of the mark "Study California," Serial No. 85489140, be refused and that this opposition be sustained.

Respectfully submitted,

(Signature) Lydia M

Date: 7/20/12

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CERTIFICATE OF SERVICE

I hereby certify that a copy of this opposition was served via first-class U.S. mail on July 20, 2012 on the following:

Jason R. Lee
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Attorney for Applicant

(Signature) Lydia B

Date: 7/20/12

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