

ESTTA Tracking number: **ESTTA617193**

Filing date: **07/23/2014**

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	Texas Department of Transportation
Granted to Date of previous extension	08/06/2014
Address	125 E. 11th Street Austin, TX 78701-2483 UNITED STATES

Attorney information	Dwayne K. Goetzel Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. P.O. Box 398 Austin, TX 78767-0398 UNITED STATES dkgpto@intprop.com
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Applicant Information

Application No	86097066	Publication date	04/08/2014
Opposition Filing Date	07/23/2014	Opposition Period Ends	08/06/2014
Applicant	Securityhunter, Inc. 2624 Lord Baltimore Drive, Suite K Baltimore, MD 21244 UNITED STATES		

Goods/Services Affected by Opposition

Class 021. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Coasters not of paper and not being table linen; Coasters, not of paper and other than table linen; Drinking glasses; Shot glasses
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Baseball caps and hats; Short-sleeved or long-sleeved t-shirts; T-shirts
Class 026. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Novelty buttons

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	2619887	Application Date	10/16/2000
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No.			
Registration Date	09/17/2002	Foreign Priority Date	NONE
Word Mark	DON'T MESS WITH TEXAS		
Design Mark	<p style="text-align: center;">DON'T MESS WITH TEXAS</p>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/03/09 First Use In Commerce: 2000/03/09 DECORATIVE MAGNETS Class 014. First use: First Use: 1995/04/01 First Use In Commerce: 1995/04/01 JEWELRY, NAMELY LAPEL PINS Class 020. First use: First Use: 1997/04/05 First Use In Commerce: 1997/04/05 PLASTIC KEY CHAINS		

U.S. Registration No.	2627196	Application Date	10/16/2000
Registration Date	10/01/2002	Foreign Priority Date	NONE
Word Mark	DON'T MESS WITH TEXAS		
Design Mark	<p style="text-align: center;">DON'T MESS WITH TEXAS</p>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1986/03/31 First Use In Commerce: 1986/03/31 PRINTED MATTER AND PAPER PRODUCTS, NAMELY STICKERS, DECALS, BUMPER STICKERS, PAPER FOOD CONTAINERS, PAPER BAGS, PLASTIC-TRASH BAGS, [PAPER AND] PLASTIC LITTER BAGS, GROCERY BAGS, [PLAYING CARDS;]PROMOTIONAL MATERIALS, NAMELY, PAMPHLETS AND BROCHURES IN THE FIELDS OF LITTER PREVENTION AND LITTER CLEANUP		

U.S. Registration No.	3872108	Application Date	09/08/2009
Registration Date	11/09/2010	Foreign Priority Date	NONE
Word Mark	DON'T MESS WITH TEXAS		

Design Mark	DON'T MESS WITH TEXAS
Description of Mark	NONE
Goods/Services	<p>Class 006. First use: First Use: 2006/06/00 First Use In Commerce: 2006/06/00 Non-luminous and non-mechanical metal signs; metal key chains</p> <p>Class 011. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 Plastic squeeze flashlights</p> <p>Class 016. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Printed matter and paper products, namely, postcards, posters, coasters made of paper, paper folders, temporary tattoos, trading cards, coin holders, note pad and decorative pencils</p> <p>Class 018. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 Luggage tags; backpack tags</p> <p>Class 021. First use: First Use: 2005/03/00 First Use In Commerce: 2005/03/00 Beverage containers, namely, insulated sleeve holders for beverage cups and cans; glassware, namely, pitchers, drinking glasses and shot glasses</p>

U.S. Registration No.	3149283	Application Date	12/14/2004
Registration Date	09/26/2006	Foreign Priority Date	NONE
Word Mark	DON'T MESS WITH TEXAS		
Design Mark	DON'T MESS WITH TEXAS		
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2004/12/14 First Use In Commerce: 2004/12/14 Beverage containers, namely mugs and cups		

U.S. Registration No.	3924369	Application Date	11/07/2000
Registration Date	03/01/2011	Foreign Priority Date	NONE
Word Mark	DON'T MESS WITH TEXAS		

Design Mark	DON'T MESS WITH TEXAS		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1986/04/00 First Use In Commerce: 1986/04/00 CLOTHING, NAMELY, SHIRTS, HATS AND CAPS		

U.S. Registration No.	3930439	Application Date	08/31/2009
Registration Date	03/15/2011	Foreign Priority Date	NONE

Word Mark	DON'T MESS WITH TEXAS		
Design Mark	DON'T MESS WITH TEXAS		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1986/04/00 First Use In Commerce: 1986/04/00 CLOTHING, NAMELY, T-SHIRTS, POLO SHIRTS, SHIRTS, BUTTON-FRONT SHIRTS, TWILL DRESS SHIRTS AND SWEAT SHIRTS		

Attachments	76148549#TMSN.png(bytes) 75981469#TMSN.png(bytes) 77821766#TMSN.png(bytes) 76624639#TMSN.png(bytes) 76160856#TMSN.png(bytes) 77816121#TMSN.png(bytes) Ntc of Opposition.pdf(102497 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	/Dwayne K. Goetzel/
Name	Dwayne K. Goetzel
Date	07/23/2014

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

In the Matter of the Trademark Application Serial No. **86097066** for
the mark “DO NOT MESS WITH THE U.S.” filed by Securityhunter, Inc. and Published in the
Official Gazette on April 8, 2014

Texas Department of Transportation)	
Opposer)	
)	
v.)	
)	Opposition No. _____
Securityhunter, Inc.)	
Applicant)	
_____)	

NOTICE OF OPPOSITION

The Texas Department of Transportation, a Texas state agency having an address of 125 E. 11th Street, Austin, Texas 78701-2483 (“Opposer”), believes that it will be damaged by registration of the mark DO NOT MESS WITH THE U.S. that is the subject of application Serial No. 86097066, published in the *Official Gazette* on April 8, 2014, and therefore requests that registration to Applicant be refused.

As grounds in support of its opposition, Opposer asserts as follows:

1. Applicant filed intent-to-use application serial no. 86097066 on or about October 21, 2013, seeking to register DO NOT MESS WITH THE U.S. (“Applicant’s Mark”) as a trademark in International Class 21, 25 and 26 for the following goods:

Coasters not of paper and not being table linen; Coasters, not of paper and other than table linen; Drinking glasses; Shot glasses, in International Class 21;

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Baseball caps and hats; Short-sleeved or long-sleeved t-shirts; T-shirts, in International Class 25;

Novelty buttons, in International Class 26.

2. Opposer has used the DON'T MESS WITH TEXAS mark ("Opposer's Mark") since at least as early as 1986 in connection with various goods and services in several different classes.

3. Opposer is the owner of the following U.S. Registrations for Opposer's Mark, for use in connection with the products indicated:

a. U.S. Reg. No. 2619887, for use in connection with decorative magnets, lapel pins, and plastic key chains in classes 9, 14, and 20;

b. U.S. Reg. No. 2627196, for use in connection with decals, bumper stickers and other printed materials in class 16;

c. U.S. Reg. No. 3872108, for use in connection with, among other things, coasters in class 16, and glassware, drinking glasses and shot glasses in class 21;

d. U.S. Reg. No. 3149283, for use in connection with beverage containers in class 21; and,

e. U.S. Reg. Nos. 3924369 and 3930439, for use in connection with clothing in class 25.

4. The filing date of Applicant's intent-to-use application is well after the first use of Opposer's Mark, in addition to being after the filing date and registration date for Opposer's Mark as shown in the above-referenced registrations.

5. Opposer has dedicated an enormous amount of time, money and effort in advertising, promoting and popularizing Opposer's Mark and in preserving the goodwill associated therewith.

6. Applicant's DO NOT MESS WITH THE U.S. mark is confusingly similar to Opposer's DON'T MESS WITH TEXAS mark with respect to, *inter alia*, the sight, sound and

meaning of the marks, and with respect to the goods and/or services offered (or that could be offered) thereunder.

7. As a result of such confusing similarity between the respective marks and the goods and/or services offered (or that could be offered) thereunder, damage and harm will result to Opposer and its prior trademark rights, and confusion may result in the marketplace. For example, registration of Applicant's DO NOT MESS WITH THE U.S. mark may result in the loss of revenue and sales of products and/or services marketed under Opposer's DON'T MESS WITH TEXAS mark, as well as harm Opposer's reputation.

8. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of Applicant's DO NOT MESS WITH THE U.S. mark in connection with the specified goods, which are or could be confusingly similar to the goods and/or services previously offered by Opposer. Such registration would be a source of damage and injury to the Opposer, for the reasons set forth above.

9. In light of such likely harm and confusion, the Patent and Trademark Office should refuse to register Applicant's Mark in light of Opposer's prior use, and earlier filing and registration date.

WHEREFORE, Opposer prays that application Serial No. 86097066 be rejected, and that the mark therein sought for the goods therein specified in International Class 21, 25 and 26 be denied and refused.

Respectfully submitted,

/Dwayne K. Goetzel/

Dwayne K. Goetzel
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**ATTORNEYS FOR OPPOSER
TEXAS DEPARTMENT OF
TRANSPORTATION**

CERTIFICATE OF SERVICE

I hereby certify I caused a true and correct copy of the foregoing *Notice of Opposition* to be served upon Applicant, as set forth below, by first class, U.S. Mail, on this 23rd day of July 2014.

Michael S. Rogers
Securityhunter, Inc.
2624 Lord Baltimore Dr., Suite K
Baltimore, Maryland 21244-2661

/Dwayne K. Goetzel/

Dwayne K. Goetzel