

ESTTA Tracking number: **ESTTA687043**

Filing date: **07/31/2015**

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	The Board of Trustees of the Leland Stanford Junior University
Granted to Date of previous extension	08/05/2015
Address	Building 170, 3rd Floor Main Quad, Stanford University Stanford, CA 94305 UNITED STATES

Attorney information	Laura C. Gustafson Pillsbury Winthrop Shaw Pittman Four Embarcadero Center 22nd Floor San Francisco, CA 94111 UNITED STATES sftrademarks@pillsburylaw.com, laura.gustafson@pillsburylaw.com Phone:415.983.6318
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Applicant Information

Application No	86424768	Publication date	04/07/2015
Opposition Filing Date	07/31/2015	Opposition Period Ends	08/05/2015
Applicant	Chuck Fuery 425 Sherman Avenue, Suite 330 Palo Alto, CA 94306 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 1986/05/00 First Use In Commerce: 1986/05/00 All goods and services in the class are opposed, namely: Assessment and management of real estate; Lease of real estate; Leasing of real estate; Providing real estate listings via the Internet; Real estate brokerage; Real estate investment services; Real estate listing; Real estate management services; Real estate service, namely, rental property management; Residential real estate agency services
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

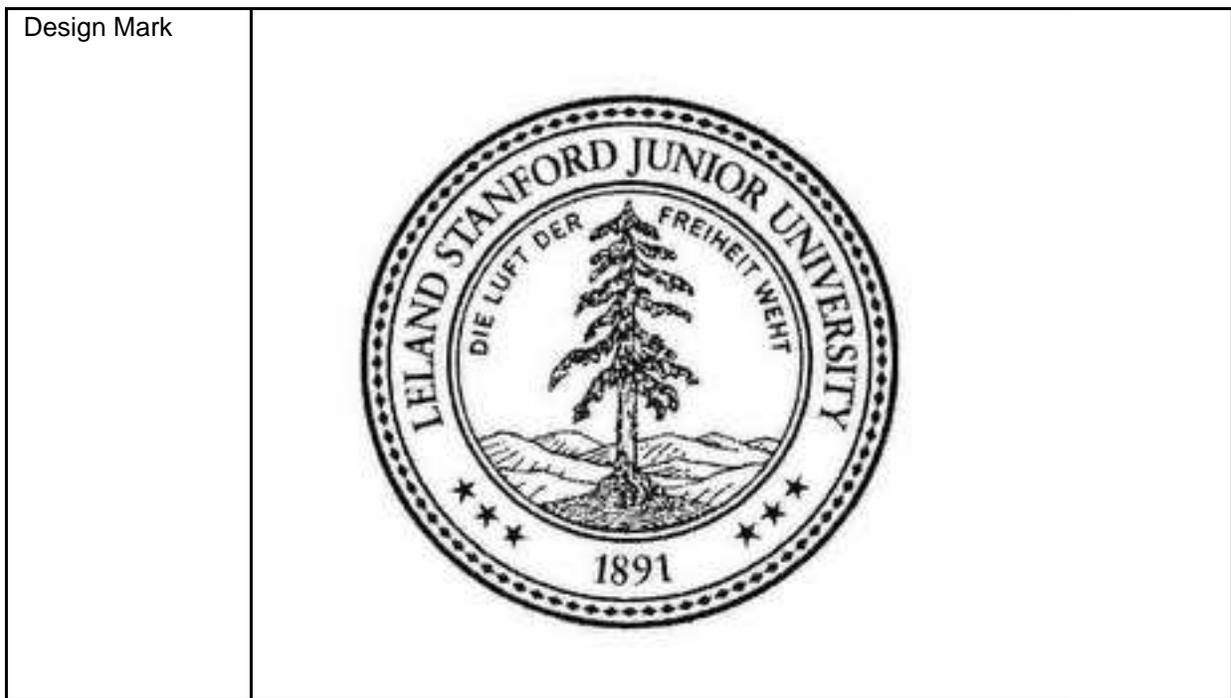
Marks Cited by Opposer as Basis for Opposition

U.S. Registration	1221613	Application Date	03/21/1980
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No.			
Registration Date	12/28/1982	Foreign Priority Date	NONE
Word Mark	STANFORD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Paper Goods-Namely, Writing Paper and Envelopes, Pens, [Pen Sets,] Desk Sets,Calendars, Binders, Notebooks, Pencils,Napkins [, Letter Openers and Photo Albums]</p> <p>Class 025. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Clothing-Namely, Sweatshirts, T-Shirts,Sweaters, [Robes,] Hats, Socks, Jerseys, Running Suits, Jackets, Shorts, Ponchos and Pants</p> <p>Class 028. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Sporting Goods-Namely, [Tennis Balls,] Golf Balls, Footballs and Toy Flying Saucers for Toss Game</p> <p>Class 041. First use: First Use: 1891/00/00 First Use In Commerce: 1891/00/00 Educational Services, Teaching Studentsat University Level</p> <p>Class 042. First use: First Use: 1891/00/00 First Use In Commerce: 1891/00/00 Research Services, Rendering Research Services in the Sciences, Arts and the Like</p>		

U.S. Registration No.	2194918	Application Date	03/21/1997
Registration Date	10/13/1998	Foreign Priority Date	NONE
Word Mark	STANFORD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1959/00/00 First Use In Commerce: 1959/00/00 inpatient and outpatient medical services		

U.S. Registration No.	2610164	Application Date	07/15/1999
Registration Date	08/20/2002	Foreign Priority Date	NONE
Word Mark	LELAND STANFORD JUNIOR UNIVERSITY DIE LUFT DER FREIHEIT WEHT ORGANIZED 1891		



Description of Mark	NONE
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Goods/Services	<p>Class 014. First use: First Use: 1995/09/00 First Use In Commerce: 1995/09/00 Jewelry</p> <p>Class 016. First use: First Use: 1995/09/00 First Use In Commerce: 1995/09/00 Paper goods; namely, writing paper and envelopes, pens, pen sets, desk sets, calendars, binders, notebooks, pencils, [[paper napkins,]] letter openers [[andphoto albums]]</p> <p>Class 025. First use: First Use: 1995/09/00 First Use In Commerce: 1995/09/00 Clothing, namely, [[sweaters,]] t-shirts, sweatshirts, [[robes, hats, socks,ties, jerseys, running suits, jackets, shorts, ponchos and pants]]</p> <p>Class 041. First use: First Use: 1995/09/00 First Use In Commerce: 1995/09/00 Educational Services, namely, providingcourses of instruction at the University level</p>
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U.S. Application/ Registra- tion No.	NONE	Application Date	NONE
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Registration Date	NONE
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Word Mark	STANFORD
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Goods/Services	residential and commercial land and real estate operations, develop- ment, leasing, finance, investment and managemenT
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Attachments	75751516#TMSN.png(bytes) Notice of Opposition.PDF(235746 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	/Laura C. Gustafson/
Name	Laura C. Gustafson
Date	07/31/2015

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

THE BOARD OF TRUSTEES OF THE LELAND STANFORD JUNIOR UNIVERSITY)	OPPOSITION NO.
)	<u>NOTICE OF OPPOSITION</u>
Opposer,)	
vs.)	Trademark: STANFORD PROPERTY & FINANCE
CHUCK FUERY)	Serial Number 86-424768
Applicant.)	

Opposer, The Board of Trustees of the Leland Stanford Junior University, a California non-profit body having corporate powers, having a business address at Stanford University, Office of the General Counsel, Building 170, Main Quad, 3rd Floor, Stanford, California 94305 (“Opposer”), believes that it is being or will be damaged by registration of the mark shown in Serial No. 86-424768 and filed by Chuck Fuery (“Applicant”), and hereby opposes the registration of said mark.

The grounds for the opposition are as follows:

1. Opposer owns and for over 100 years has continuously used and is using in commerce the name and mark, STANFORD (the “Opposer’s Mark”), for and in connection with its world-renowned educational and research services. In addition, for many decades and continuously to the present, Opposer has used its STANFORD mark in connection with a wide variety of related goods and services, including residential and commercial land and real estate operations, development, leasing, finance, investment and management.

2. Opposer owns the following U.S. Patent and Trademark Office registrations for the STANFORD mark, among others:

Mark	Reg. No.	Reg. Date
STANFORD	1221613	12/28/1982
STANFORD	2194918	10/13/1998
	2610164	08/20/2002

3. Through extensive use and promotion and over 100 years' use, Opposer's STANFORD mark has become and is famous.

4. Opposer has been using the STANFORD mark continuously in interstate commerce for residential and commercial land and real estate operations, development, leasing, finance, investment and management since long prior to Applicant's filing date and claimed first use date. Among the land holdings owned, developed and leased by Opponent are, for example, the STANFORD RESEARCH PARK (established over 60 years ago) and the STANFORD SHOPPING CENTER (established over 60 years ago).

5. Applicant has applied to register STANFORD PROPERTY & FINANCE for "Assessment and management of real estate; Lease of real estate; Leasing of real estate; Providing real estate listings via the Internet; Real estate brokerage; Real estate investment services; Real estate listing; Real estate management services; Real estate service, namely, rental property management; Residential real estate agency services." (Serial Number 86-424768) ("Applicant's Mark").

6. On information and belief, no actual or constructive use was made of Applicant's Mark for the covered services prior to October 15, 2014, the filing date of Applicant's application.

7. On information and belief, no actual use has been made of Applicant's Mark for the covered services.

8. Opposer first used the STANFORD mark and trade name in commerce over 100 years ago and said marks were registered and distinctive of Opposer, and became famous, long prior to the first actual or constructive use of Applicant's Mark.

9. Opposer first used the STANFORD mark and trade name in commerce for residential and commercial land and real estate operations, development, leasing, finance, investment and management and said marks were distinctive of Opposer, and became famous, long prior to the first actual or constructive use of Applicant's Mark.

10. Applicant's Mark, incorporating STANFORD as its dominant term, so resembles Opposer's STANFORD mark, registered in the U.S. Patent and Trademark Office and previously used in the United States and not abandoned, as to be likely, when used on or in connection with the services of Applicant, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act.

11. Applicant's Mark dilutes or is likely to dilute or will dilute Opposer's distinctive and famous STANFORD Mark in violation of Section 43(c) of the Act.

12. Applicant's Mark, incorporating STANFORD as its dominant element, for services long provided by and associated by consumers with Opposer, consists of or comprises matter which falsely suggests a connection with Opposer, in violation of Section 2(a) of the Lanham Act, and is likely to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, and/or as to the origin, sponsorship, or approval of Applicant's services by Opposer.

WHEREFORE, the Board should sustain this opposition and Application 86-424768 should be refused registration.

The official fee is submitted herewith. Charge any missing fee to Account No. 033975 Order No. 082288-0283801.

Date: July 31, 2015

Respectfully submitted,

The Board of Trustees of the Leland Stanford Junior University

By: 
LAURA C. GUSTAFSON
RICHARD L. KIRKPATRICK
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 2824
San Francisco, CA 94126-2824
Phone: 415.983.6318
sftrademarks@pillsburylaw.com

PROOF OF SERVICE BY MAIL

I, Laura C. Gustafson, the undersigned, hereby declare as follows:

1. I am over the age of 18 years and am not a party to the within cause. I am employed by Pillsbury Winthrop Shaw Pittman LLP in the City of San Francisco, California.

2. My business address is Four Embarcadero Center, 22nd Floor, San Francisco, CA 94111. My mailing address is Pillsbury Winthrop Shaw Pittman LLP, P.O. Box 2824, San Francisco, CA 94126.

3. I am familiar with Pillsbury Winthrop Shaw Pittman LLP's practice for collection and processing of correspondence for mailing with the United States Postal Service; in the ordinary course of business, correspondence placed in interoffice mail is deposited with the United States Postal Service with first class postage thereon fully prepaid on the same day it is placed for collection and mailing.

4. On July 31, 2015, at Four Embarcadero Center, 22nd Floor, San Francisco, California, I served a true copy of the attached document titled exactly **NOTICE OF OPPOSITION**, by placing it in an addressed, sealed envelope clearly labeled to identify the person being served at the address shown below and placed in interoffice mail for collection and deposit in the United States Postal Service on that date in accordance with ordinary business practices:

Claire Kalia
Kalia Law PC
800 W El Camino Real #180
Mountain View, CA 94040

5. The Correspondent Address given in USPTO records is:

CLAIRE KALIA
KALIA LAW PC
800 W EL CAM STE 180
800 W EL CAM
MOUNTAIN VIEW, CALIFORNIA 94040
UNITED STATES

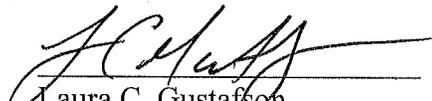
The above is not a full, recognized address. The correct address, with full street name is:

Claire Kalia
Kalia Law PC
800 W El Camino Real #180
Mountain View, CA 94040

The Notice is being sent to this address.

6. On July 31, 2015, I also sent a copy of the Notice of Opposition by email to applicant's correspondent at claire@kalia-lawpc.com.

I declare under penalty of perjury that the foregoing is true and correct. Executed July 31, 2015, at San Francisco, California.



Laura C. Gustafson