

ESTTA Tracking number: **ESTTA388159**

Filing date: **01/13/2011**

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

### Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

#### Petitioner Information

Name	Cleveland State University		
Entity	state university	Citizenship	Ohio
Address	2300 Euclid Avenue AC 231 Cleveland, OH 44115 UNITED STATES		

Attorney information	Colleen F. Goss Fay Sharpe LLP 1228 Euclid Avenue The Halle Building, 5th Floor Cleveland, OH 44115 UNITED STATES uspto@faysharpe.com, cfgoss@faysharpe.com, jfry@faysharpe.com Phone: 216.363.9000
----------------------	---

#### Registration Subject to Cancellation

Registration No	3735435	Registration date	01/05/2010
Registrant	CampusEAI Consortium 11th Floor 1940 East 6th Street Cleveland, OH 44114 UNITED STATES		

#### Goods/Services Subject to Cancellation

Class 041. First Use: 2005/09/20 First Use In Commerce: 2005/09/20 All goods and services in the class are cancelled, namely: educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology
---

#### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

#### Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3671697	Application Date	06/18/2008
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	CLEVELAND STATE UNIVERSITY		

Design Mark	<b>CLEVELAND STATE UNIVERSITY</b>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals

U.S. Registration No.	3694718	Application Date	06/19/2008
Registration Date	10/13/2009	Foreign Priority Date	NONE

Word Mark	CLEVELAND STATE UNIVERSITY 1964 A
-----------	-----------------------------------

Design Mark	
-------------	---

Description of Mark	The mark consists of a shield divided into quarters, with three leaves in the upper left quadrant, an infinity symbol in the upper right quadrant, a quill, open book and cog in the lower right quadrant, and the letter a in the lower left quadrant, with the image of a multi-columned building appearing above the shield, all encircled by the words "CLEVELAND STATE UNIVERSITY 1964".
---------------------	---

Goods/Services	Class 041. First use: First Use: 1965/00/00 First Use In Commerce: 1965/00/00 lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities,
----------------	---

	natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals
--	--

Attachments	77502102#TMSN.jpeg ( 1 page )( bytes ) 77502758#TMSN.jpeg ( 1 page )( bytes ) Doc005.PDF ( 17 pages )(1318173 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	/colleenfgoss/
Name	Colleen F. Goss
Date	01/13/2011



### PETITIONER AND ITS TRADEMARK

3. Petitioner, for many years, and since long prior to any date of first use upon which Registrant can rely, has adopted, used and is using the trademarks CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design in connection with, among other things, educational services at the undergraduate and graduate level as well as educational research. This use has been continuous and uninterrupted up to and including the present time.

4. Petitioner is the owner of United States Principal Trademark Registration No. 3,671,697 ("697 Registration"), issued August 25, 2009 for the trademark CLEVELAND STATE UNIVERSITY for lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals. This registration is valid, subsisting, unrevoked and uncanceled. Copies of a TARR report and Assignment report in accordance with Rule 2.122(d)(1) are attached as Exhibit A.

5. Petitioner is the owner of United States Principal Trademark Registration No. 3,694,718 ("718 Registration"), for the trademark CLEVELAND STATE UNIVERSITY 1964 w/Design for lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public

health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals. This registration is valid, subsisting, unrevoked, and uncanceled. Copies of a TARR report and Assignment report in accordance with Rule 2.122(d)(1) are attached as Exhibit B.

6. Petitioner has continuously used its distinctive CLEVELAND STATE UNIVERSITY trademark in connection with the services covered by the '697 Registration since at least as early as 1964.

7. Petitioner has continuously used its distinctive CLEVELAND STATE UNIVERSITY 1964 w/Design trademark in connection with the services covered by the '718 registration since at least as early as 1965.

8. Petitioner has extensively and prominently advertised and promoted its CLEVELAND STATE UNIVERSITY formative trademarks and the goods and services provided under the marks throughout the United States and especially in Northeast Ohio. Petitioner has developed substantial and exclusive goodwill and reputation in connection with the term CLEVELAND STATE UNIVERSITY and the goods and services with which the CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design marks are used.

9. Petitioner's services under the CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design trademarks have received unsolicited national, regional, and local media attention.

10. As a result of these efforts, combined with providing quality education services to hundreds of thousands of students under the CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design trademarks, the relevant consuming public has come to recognize CLEVELAND STATE UNIVERSITY as distinguishing Petitioner's services from those of others and the mark has become well-known and famous.

11. Petitioner has acquired significant and exclusive trademark rights and interest in and to the CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design trademarks both under its federal registrations for such

trademarks as well as at common law for rights in and to such marks in association with educational services at the undergraduate and graduate level, as well as educational research.

#### REGISTRANT'S TRADEMARK REGISTRATION

12. On October 16, 2008, Registrant applied to register the mark UNIVERSITY OF CLEVELAND for educational services, namely, providing university level courses and instruction, and educational research in Class 41. This application was assigned Serial No. 77/594,292 and was based on Applicant's asserted use of the mark in commerce.

13. On April 1, 2009, Registrant amended its application to register the mark UNIVERSITY OF CLEVELAND to seek registration on the Supplemental Register.

14. On January 5, 2010, Registration 3,735,435 issued as a U.S. Trademark Registration on the Supplemental Register for the mark CLEVELAND UNIVERSITY with the word UNIVERSITY disclaimed in association with "educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology" in Class 41.

#### COUNT ONE: LIKELIHOOD OF CONFUSION SECTION 2(d) OF THE LANHAM ACT, 15 U.S.C. §1052(d)

15. On information and belief, the services identified by Registrant's UNIVERSITY OF CLEVELAND mark are virtually identical to Petitioner's services.

16. Petitioner's use, filing and registration of the CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design trademarks is long before Applicant's filing date or any date of first use on which Applicant can rely.

17. Registrant's mark, UNIVERSITY OF CLEVELAND, which is the subject of Registration No. 3,735,435, so resembles Petitioner's previously used and registered marks as to be likely, when applied to the services set forth in Petitioner's registrations, to cause confusion, mistake or deception for purposes of Section 2(d) of the Trademark Act.

18. Petitioner will be damaged by registration of the designation UNIVERSITY OF CLEVELAND in association with Registrant's services in that, consumers are likely to believe that Registrant's services originate with or are sponsored by Petitioner and any inadequacies in Registrant's services are likely to be attributed to Petitioner, all of which will cause injury to Petitioner.

COUNT TWO:  
TRADEMARK DILUTION  
SECTION 43(c) OF THE LANHAM ACT, 15 U.S.C. §1125(c)

19. Petitioner's CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design trademarks have become famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

20. Petitioner's CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design trademarks will be diluted by the registration of Applicant's CLEVELAND UNIVERSITY mark.

21. For the reasons noted above, Petitioner would be damaged by registration of the UNIVERSITY OF CLEVELAND registration.

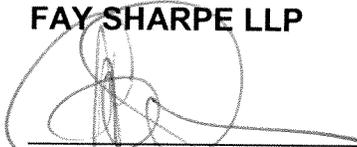
WHEREFORE, Petitioner respectfully requests that this petition be sustained and that registration be cancelled.

The required \$300.00 cancellation fee accompanies this Petition.

Respectfully Submitted,

**FAY SHARPE LLP**

Dated: 1-13-11

  
\_\_\_\_\_  
Colleen F. Goss, Esq.  
Jude A. Fry, Esq.  
1228 Euclid Avenue  
The Halle Building, 5<sup>th</sup> Floor  
Cleveland, Ohio 44115  
(216) 363-9000  
cfgoss@faysharpe.com  
jfry@faysharpe.com  
uspto@faysharpe.com

Attorneys for Opposer,  
Cleveland State University

CERTIFICATE OF SERVICE

I hereby certify that this PETITION TO CANCEL was filed electronically with the United States Patent and Trademark Office, Trademark Trial and Appeal Board on January 13, 2011 and that a copy of the foregoing PETITION TO CANCEL was served by first class mail, postage prepaid, on Registrant, CampusEAI Consortium, 1940 East 6<sup>th</sup> Street, 11<sup>th</sup> Floor, Cleveland, Ohio 44114 on January 13, 2011.

  
\_\_\_\_\_  
Colleen F. Goss

N:\CLEV\700117US01\RMS0020349V001.docx

# 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 2011-01-12 17:53:24 ET**

**Serial Number:** 77502102 [Assignment Information](#) [Trademark Document Retrieval](#)

**Registration Number:** 3671697

**Mark**

CLEVELAND STATE UNIVERSITY

**(words only):** CLEVELAND STATE UNIVERSITY

**Standard Character claim:** Yes

**Current Status:** Registered.

**Date of Status:** 2009-08-25

**Filing Date:** 2008-06-18

**Transformed into a National Application:** No

**Registration Date:** 2009-08-25

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 101

**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](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2009-08-25

---

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

---

1. Cleveland State University

**Address:**

Cleveland State University  
2300 Euclid Avenue, AC 321  
Cleveland, OH 44115  
United States

**Legal Entity Type:** STATE UNIVERSITY

**State or Country Where Organized:** Ohio

---

### GOODS AND/OR SERVICES

---

**International Class:** 041

**Class Status:** Active

lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals

**Basis:** 1(a)

**First Use Date:** 1964-00-00

**First Use in Commerce Date:** 1964-00-00

---

### ADDITIONAL INFORMATION

---

**Disclaimer:** "STATE UNIVERSITY"

**Section 2(f)**

---

### 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.**

2009-08-25 - Registered - Principal Register

2009-06-09 - Published for opposition

2009-05-20 - Notice of publication

2009-05-04 - Law Office Publication Review Completed

2009-04-24 - Approved for Pub - Principal Register (Initial exam)

2009-04-24 - Examiner's Amendment Entered

2009-04-24 - Notification Of Examiners Amendment E-Mailed

2009-04-24 - EXAMINERS AMENDMENT E-MAILED

2009-04-24 - Examiners Amendment -Written

2009-03-31 - Teas/Email Correspondence Entered  
2009-03-30 - Communication received from applicant  
2009-03-31 - Teas/Email Correspondence Entered  
2009-03-31 - Communication received from applicant  
2009-03-31 - Assigned To LIE  
2009-03-30 - TEAS Response to Office Action Received  
2009-03-30 - TEAS Change Of Correspondence Received  
2009-03-30 - TEAS Change Of Correspondence Received  
2008-09-29 - Notification Of Non-Final Action E-Mailed  
2008-09-29 - Non-final action e-mailed  
2008-09-29 - Non-Final Action Written  
2008-09-23 - Assigned To Examiner  
2008-06-23 - New Application Entered In Tram

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Colleen F. Goss

**Correspondent**

Colleen F. Goss

Fay Sharpe LLP

The Halle Building, 5th Floor

1228 Euclid Avenue

Cleveland OH 44115

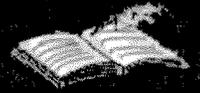
Phone Number: 216.363.9000

Fax Number: 216.363.9001



**United States Patent and Trademark Office**

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



Assignments on the Web > [Trademark Query](#)

## No assignment has been recorded at the USPTO

**For Serial Number: 77502102**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1  
Web interface last modified: Apr 30, 2009 v.2.1

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

# EXHIBIT B

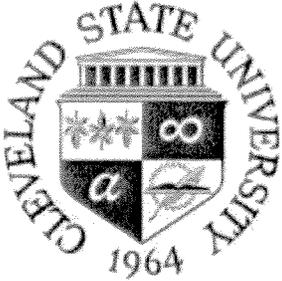
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-01-12 17:53:03 ET

**Serial Number:** 77502758 Assignment Information      Trademark Document Retrieval

**Registration Number:** 3694718

**Mark**



**(words only):** CLEVELAND STATE UNIVERSITY 1964 A

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2009-10-13

**Filing Date:** 2008-06-19

**Transformed into a National Application:** No

**Registration Date:** 2009-10-13

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 101

**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](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2009-10-13

---

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

---

1. Cleveland State University

**Address:**

Cleveland State University  
2300 Euclid Avenue, AC 321  
Cleveland, OH 44115  
United States

**Legal Entity Type:** STATE UNIVERSITY  
**State or Country Where Organized:** Ohio

---

### GOODS AND/OR SERVICES

---

**International Class:** 041

**Class Status:** Active

lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals

**Basis:** 1(a)

**First Use Date:** 1965-00-00

**First Use in Commerce Date:** 1965-00-00

---

### ADDITIONAL INFORMATION

---

**Color(s) Claimed:** Color is not claimed as a feature of the mark.

**Disclaimer:** "STATE UNIVERSITY"

**Description of Mark:** The mark consists of a shield divided into quarters, with three leaves in the upper left quadrant, an infinity symbol in the upper right quadrant, a quill, open book and cog in the lower right quadrant, and the letter a in the lower left quadrant, with the image of a multi-columned building appearing above the shield, all encircled by the words "CLEVELAND STATE UNIVERSITY 1964".

**Section 2(f), in part,** as to "CLEVELAND STATE UNIVERSITY 1964"

**Design Search Code(s):**

**05.03.08** - More than one leaf, including scattered leaves, bunches of leaves not attached to branches

**07.03.25** - Aquariums (buildings); Convention hall; Hospitals; Libraries, public libraries; Schools; Wash, car (commercial)

**15.07.01** - Cog wheels; Gears

**20.01.09** - Inkwells; Quill pens

**20.05.05** - Bibles (open); Books that are open; Cook books (open); Encyclopedias (open)

**24.01.02** - Shields or crests with figurative elements contained therein or superimposed thereon

**24.01.04** - Shields or crests with numbers contained therein or superimposed thereon

**24.17.12** - Infinity symbols

**26.01.08** - Circles having letters or numerals as a border; Circles having punctuation as a border; Letters, numerals or punctuation forming or bordering the perimeter of a circle

---

### 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.**

2009-10-13 - Registered - Principal Register

2009-07-28 - Published for opposition

2009-07-08 - Notice of publication

2009-06-19 - Law Office Publication Review Completed

2009-06-19 - Approved for Pub - Principal Register (Initial exam)

2009-06-17 - Teas/Email Correspondence Entered

2009-06-17 - Communication received from applicant

2009-06-17 - TEAS Response to Office Action Received

2009-06-12 - Notification Of Priority Action E-Mailed

2009-06-12 - Priority Action E-Mailed

2009-06-12 - Priority Action Written

2009-06-02 - Previous Allowance Count Withdrawn

2009-05-08 - Withdrawn From Pub - Og Review Query

2009-04-27 - Law Office Publication Review Completed

2009-04-24 - Approved for Pub - Principal Register (Initial exam)

2009-04-24 - Examiner's Amendment Entered

2009-04-24 - Notification Of Examiners Amendment E-Mailed

2009-04-24 - EXAMINERS AMENDMENT E-MAILED

2009-04-24 - Examiners Amendment -Written

2009-03-31 - Teas/Email Correspondence Entered

2009-03-30 - Communication received from applicant

2009-03-31 - Assigned To LIE

2009-03-30 - TEAS Response to Office Action Received

2009-03-30 - TEAS Change Of Correspondence Received

2009-03-30 - TEAS Change Of Correspondence Received

2008-09-29 - Notification Of Non-Final Action E-Mailed

2008-09-29 - Non-final action e-mailed

2008-09-29 - Non-Final Action Written

2008-09-23 - Assigned To Examiner

2008-06-25 - Notice Of Design Search Code Mailed

2008-06-24 - New Application Entered In Tram

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Colleen F. Goss

**Correspondent**

Colleen F. Goss

Fay Sharpe LLP

The Halle Building, 5th Floor

1228 Euclid Avenue

Cleveland OH 44155

Phone Number: 216.363.9000

Fax Number: 216.363.9001

---



**United States Patent and Trademark Office**

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



Assignments on the Web > [Trademark Query](#)

## No assignment has been recorded at the USPTO

**For Serial Number: 77502758**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1  
Web interface last modified: Apr 30, 2009 v.2.1

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)