

TTAB

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

In the matter of Application Serial No. 76/163,965
Filed November 13, 2000
Mark: Miscellaneous Design
Published in the *Official Gazette* on June 4, 2002.



08-01-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #61

UNIVERSITY OF LOUISVILLE,)
)
Opposer,)
)
v.)
)
MAX PLANCK GESELLSCHAFT ZUR FORDERUNG)
DER WISSENSCHAFTEN E.V.)
)
Applicant.)

OPPOSITION NO.

NOTICE OF OPPOSITION

Box TTAB FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

02 AUG 30 PM 8:44

TRADEMARK TRIAL AND APPEAL BOARD

Opposer, UNIVERSITY OF LOUISVILLE, a Kentucky Institution of Higher Education, with its principal place of business at 2301 South Third Street, Louisville, Kentucky 40292 (hereinafter "the University" or "Opposer"), believes that it will be damaged by registration of the mark shown in the application bearing Serial No. 76/117,633 and hereby opposes such registration. As grounds for opposition, the University submits the following:

1. Since as early as 1952, the University has continuously used in commerce a fanciful design mark containing a graphical representation consisting of what may be described as an artistic rendering of the profile of the mythological Goddess Minerva or Athena, or perhaps a Greco-Roman warrior wearing a protective military helmet, (“the University’s Mark”) and is the owner of a registration of same on the Principal Register, for *inter alia*, education services including “providing courses of instruction at the university level; educational research; arranging and conducting . . . exhibitions, conferences. . . and festivals,” namely Registration Number 2,011,566. A true copy of said registration is attached hereto.

2. On November 13, 2000, the applicant, Max Planck Gesellschaft Zur Forderung Der Wissenschaften E.V. (hereinafter “Applicant”), filed an intent-to-use application, Serial Number 76/163,965, seeking registration of a fanciful design mark consisting of what may be described as an artistic rendering of the profile of the mythological Goddess Minerva or Athena, or perhaps a Greco-Roman warrior wearing a protective military helmet “for educational services, namely, conducting classes, seminars, conferences and workshops in the field of science; training services in the field of science; cultural activities, namely, organizing exhibitions in the field of science” in international class 41; and “for scientific research; association services, namely, promoting the interests of the sciences, including by maintaining research institutes” in international class 42. That application was published in the *Official Gazette* on June 4, 2002. A true copy of said publication is attached hereto.

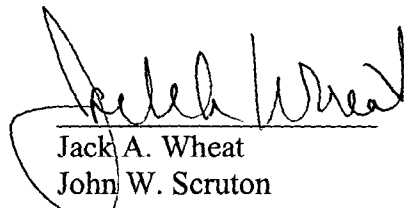
3. The University’s continued use The University’s Mark predates the filing of the intent-to-use application by Applicant. Therefore, The University has priority of use.

4. The mark sought to be registered, if used with Applicant’s services, is so similar to the University’s Mark as to create a likelihood of confusion, or to cause mistake, or to

deceive, within the meaning of Section 2(d) of the Trademark Act of 1946 (15 U.S.C. § 1052(d)), all to the University's irreparable damage.

5. The University will be damaged by registration of the mark sought to be registered in that, if registration issues, (a) consumers are likely to purchase Applicant's services believing them to be the University's services, or to be sponsored by or associated with the University; (b) any defects in Applicant's services are likely to be attributed to the University; and (c) registration of Applicant's mark will give Applicant the presumptive right to use the mark with its services. All of these effects of registration will cause injury to the University.

WHEREFORE, Opposer prays that Application Serial No. 76/163,965 be refused and that the registration sought therein be denied in both international class 41 and international class 42.



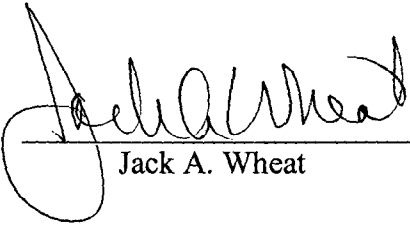
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Attorneys for Opposer

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Box TTAB FEE,

Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on

July 30, 2002.



Jack A. Wheat

261W:00013:258771:LOUISVILLE

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,011,566

Registered Oct. 29, 1996

**SERVICE MARK
PRINCIPAL REGISTER**



UNIVERSITY OF LOUISVILLE (KENTUCKY
CORPORATION)
2301 SOUTH THIRD STREET
LOUISVILLE, KY 40292

FOR: EDUCATION AND ENTERTAINMENT,
NAMELY, PROVIDING COURSES OF IN-
STRUCTION AT THE UNIVERSITY LEVEL;
EDUCATIONAL RESEARCH; ARRANGING
AND CONDUCTING ATHLETIC EVENTS AND
TOURNAMENTS, EXHIBITIONS, CONFER-
ENCES, LIVE PERFORMANCES AND FESTI-
VALS, IN CLASS 41 (U.S. CLS. 100, 101 AND
107).

FIRST USE 0-0-1952; IN COMMERCE
0-0-1973.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "UNIVERSITY" AND "1798",
APART FROM THE MARK AS SHOWN.

THE LINING SHOWN IN THE DRAWING IS
A FEATURE OF THE MARK AND IS NOT IN-
TENDED TO INDICATE A SPECIFIC COLOR.

SEC. 2(F) AS TO "UNIVERSITY OF LOUIS-
VILLE".

SER. NO. 74-676,891, FILED 5-19-1995.

MARY ROSSMAN, EXAMINING ATTORNEY

JUNE 4, 2002

U.S. PATENT AND TRADEMARK OFFICE

TM 151

SN 76-162,608. LIGHTSOURCE TELECOM, LLC, CLEVELAND, OH. FILED 11-9-2000.

SN 76-163,452. FOG CITY RACING, INC., LOS GATOS, CA. FILED 11-9-2000.



NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TELECOM". APART FROM THE MARK AS SHOWN.

CLASS 37—CONSTRUCTION AND REPAIR

FOR INSTALLATION OF TELECOMMUNICATIONS AND DATA NETWORKS; INSTALLATION OF BURGLAR AND FIRE ALARMS AND SECURITY MONITORING SYSTEMS FOR RESIDENTIAL AND COMMERCIAL USE (U.S. CLS. 100, 103 AND 106).

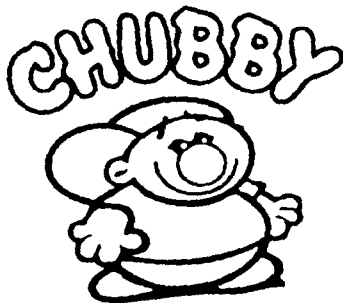
CLASS 38—COMMUNICATION

FOR TELECOMMUNICATIONS SERVICES, NAMELY, LOCAL AND LONG DISTANCE SERVICES TELEPHONE VOICE MESSAGING, CALL FORWARDING, CALLER IDENTIFICATION, CALL BLOCKING, TELECONFERENCING, WIRELESS AND CELLULAR TELEPHONE SERVICES, PERSONAL COMMUNICATIONS SERVICES, ELECTRONIC MAIL SERVICES, TRANSMISSION OF VOICE AND DATA AND VIDEO, FACSIMILE TRANSMISSION SERVICES AND PROVIDING ACCESS TO THE INTERNET AND GLOBAL COMPUTER NETWORKS (U.S. CLS. 100, 101 AND 104).

CLASS 42—SCIENTIFIC, COMPUTER AND LEGAL SERVICES

FOR TRANSMITTING INFORMATION CONCERNING THE OPERATING AND MONITORING OF BURGLAR, FIRE ALARM AND SECURITY SYSTEMS (U.S. CLS. 100 AND 101).

SN 76-163,384 S.M. JALEEL & COMPANY LIMITED, WEST INDIES, TRINIDAD, TOBAGO, FILED 11-10-2000.



CLASS 29—MEATS AND PROCESSED FOODS

FOR FRUIT-BASED SNACK FOOD, CANDIED FRUIT SNACKS, POTATO CHIPS, POTATO CRISPS, CANDIED NUTS, SHELLS, ROASTED OR OTHERWISE PROCESSED NUTS (U.S. CL. 46).

CLASS 30—STAPLE FOODS

FOR CEREAL-BASED SNACK FOOD, CANDY, CAKES, ICE CREAM, FROZEN CONFECTIONS, CORN CHIPS (U.S. CL. 46).

FOG CITY STABLES

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STABLES". APART FROM THE MARK AS SHOWN.

CLASS 41—EDUCATION AND ENTERTAINMENT

FOR HORSE SHOWING; ENTERTAINMENT IN THE NATURE OF HORSE RACES; HORSE TRAINING (U.S. CLS. 100, 101 AND 107).

CLASS 42—SCIENTIFIC, COMPUTER AND LEGAL SERVICES

FOR HORSE BREEDING AND STUD SERVICES (U.S. CLS. 100 AND 101).

SN 76-163,965. MAX PLANCK GESELLSCHAFT ZUR FORDERUNG DER WISSENSCHAFTEN E.V., MUNICH, FED REP GERMANY, FILED 11-13-2000.



CLASS 41—EDUCATION AND ENTERTAINMENT

FOR EDUCATIONAL SERVICES, NAMELY, CONDUCTING CLASSES, SEMINARS, CONFERENCES AND WORKSHOPS IN THE FIELD OF SCIENCE; TRAINING SERVICES IN THE FIELD OF SCIENCE; CULTURAL ACTIVITIES, NAMELY, ORGANIZING EXHIBITIONS IN THE FIELD OF SCIENCE (U.S. CLS. 100, 101 AND 107).

CLASS 42—SCIENTIFIC, COMPUTER AND LEGAL SERVICES

FOR SCIENTIFIC RESEARCH; ASSOCIATION SERVICES, NAMELY, PROMOTING THE INTERESTS OF THE SCIENCES, INCLUDING BY MAINTAINING RESEARCH INSTITUTES (U.S. CLS. 100 AND 101).

SN 76-165,375. MERRYCHEF LIMITED, HAMPSHIRE GU12 5XA, UNITED KINGDOM, FILED 11-15-2000.

MERRYCHEF

CLASS 9—ELECTRICAL AND SCIENTIFIC APPARATUS

FOR FOOD VENDING MACHINES (U.S. CLS. 21, 23, 26, 36 AND 38).

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July 30, 2002

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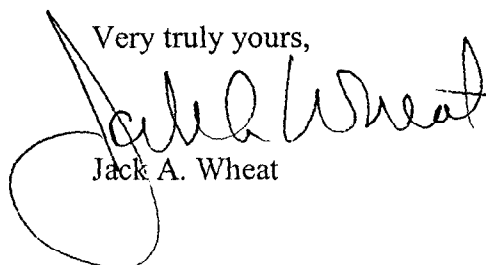
Dear TTAB:

Enclosed for filing are the following documents in connection with University of Louisville's Notice of Opposition to the above-referenced application for trademark registration:

1. Original and one copy of the Notice of Opposition;
2. Check in the amount of \$600, payable to your order, for the filing fee; and
3. Postcard acknowledging receipt.

Please contact me at the above address and telephone number if you need anything further concerning this opposition.

Very truly yours,


Jack A. Wheat

TRADEMARK TRIAL AND
APPEAL BOARD
02 AUG 30 PM 8:44

JAW:ms
Enclosures
cc: Pete Cautilli (w/encl.)

