


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

In the matter of Application Serial No. 76/268,976
Filed June 11, 2001
Mark: MINERVA COLLECTION U.S.A. plus design
Published in the *Official Gazette* on July 2, 2002.


08-28-2002
U.S. Patent & TMO/TM Mail Rpt Dt. #73

UNIVERSITY OF LOUISVILLE,)
)
Opposer,)
)
v.)
)
MINERVA COLLECTION, INC.)
)
Applicant.)

OPPOSITION NO.

TRADEMARK TRIAL AND
APPEAL BOARD
02 SEP 11 AM 12:25

NOTICE OF OPPOSITION

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

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. 76/268,976 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

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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 refers to this design as its "Minerva Seal."

2. The University is the owner of registrations of its Minerva Seal on the Principal Register, including a registration for, *inter alia*, education services, namely Registration Number 2,011,566, and a registration for clothing, including "shirts, sweaters, sweatshirts, T-shirts, pajamas, underwear, pants, shorts, jogging suits, shoes, socks, belts, ties, hats, jackets, vests, coats, scarves and gloves," namely Registration Number 2,137,634. True copies of said registrations are attached hereto.

3. On June 11, 2001, the applicant, Minerva Collection, Inc. (hereinafter "Applicant"), filed an intent-to-use application, Serial Number 76/268,976, 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 clothing, namely ties, pants, shirts, boots, T-shirts, suits, jackets, underwear, belts, socks, hats, shoes and sweaters" in international class 25. That application was published in the *Official Gazette* on July 2, 2002. A true copy of said publication is attached hereto.

4. The University's continuous use of its Minerva Seal predates the filing of the intent-to-use application by Applicant. Therefore, the University has priority of use.

5. The mark sought to be registered, if used with Applicant's goods, is so similar to the University's Minerva Seal 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.

6. 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 goods believing them to be the University's goods, or to be sponsored by or associated with the University; (b) any defects in Applicant's goods 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 goods. All of these effects of registration will cause injury to the University.

WHEREFORE, Opposer prays that Application Serial No. 76/268,976 be refused and that the registration sought therein be denied.



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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 August 26, 2002.



Jack A. Wheat

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

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,137,634

Registered Feb. 17, 1998

**TRADEMARK
PRINCIPAL REGISTER**



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

FOR: CLOTHING, NAMELY, SHIRTS,
SWEATERS, SWEATSHIRTS, T-SHIRTS, PAJA-
MAS, UNDERWEAR, PANTS, SHORTS, JOG-
GING SUITS, SHOES, SOCKS, BELTS, TIES,
HATS, JACKETS, VESTS, COATS, SCARVES
AND GLOVES, IN CLASS 25 (U.S. CLS. 22 AND
39).

FIRST USE 9-1-1997; IN COMMERCE
9-1-1997.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "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.

SN 74-676,888, FILED 5-19-1995.

MARY ROSSMAN, EXAMINING ATTORNEY

CLASS 25—(Continued).

SN 76-268,976. MINERVA COLLECTION, INC., HUNTINGTON PARK, CA. FILED 6-11-2001.



U.S.A.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COLLECTION AND U.S.A.", APART FROM THE MARK AS SHOWN.

FOR CLOTHING, NAMELY TIES, PANTS, SHIRTS, BOOTS, T-SHIRTS, SUITS, JACKETS, UNDERWEAR, BELTS, SOCKS, HATS, SHOES AND SWEATERS (U.S. CLS. 22 AND 39).

SN 76-269,056. VIACOM INTERNATIONAL INC., NEW YORK, NY. FILED 6-7-2001.

SPONGEBOB SQUAREPANTS

OWNER OF U.S. REG. NO. 2,355,702.
FOR SHORTS, COATS, SOCKS, FOOTWEAR, CLOTHING BELTS, BANDANNAS, SWEATERS, DRESSES, GLOVES, GYM SHORTS, EAR MUFFS, NECKWEAR, PAJAMAS, PANTS, SHIRTS, SKI WEAR, SLACKS, SUN VISORS, SUSPENDERS, TURTLENECKS, UNDERCLOTHES, VESTS, WARM-UP SUITS, HEADWEAR, BATHROBES, BEACHWEAR (U.S. CLS. 22 AND 39).
FIRST USE 10-1-2000; IN COMMERCE 10-1-2000.

SN 76-269,195. TENNE. DON G., CHICAGO, IL. FILED 6-11-2001.

HIGH-ROLLER



WHALE-WANNABE

FOR T-SHIRTS (U.S. CLS. 22 AND 39).

CLASS 25—(Continued).

SN 76-269,784. OPRY MILLS LIMITED PARTNERSHIP, ARLINGTON, VA. FILED 6-11-2001.



FOR CLOTHING, NAMELY, CAPS, T-SHIRTS, POLO SHIRTS, AND JACKETS (U.S. CLS. 22 AND 39).
FIRST USE 5-11-2000; IN COMMERCE 5-11-2000.

SN 76-270,443. PHILLIPS-VAN HEUSEN CORPORATION, NEW YORK, NY. FILED 6-13-2001.

VAN HEUSEN

OWNER OF U.S. REG. NOS. 728,039, 1,974,190 AND OTHERS.
SEC. 2(F).
FOR NECKWEAR (U.S. CLS. 22 AND 39).
FIRST USE 3-31-1983; IN COMMERCE 3-31-1983.

SN 76-272,058. TRUSTEES OF DARTMOUTH COLLEGE, DBA DARTMOUTH COLLEGE, HANOVER, NH. FILED 6-15-2001.

DARTMOUTH COLLEGE

OWNER OF U.S. REG. NOS. 987,129, 2,101,513 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COLLEGE", APART FROM THE MARK AS SHOWN.
FOR CLOTHING, NAMELY SKI HATS, SWEATERS, SCARVES, GLOVES, MITTENS, CAPS, SOCKS, SWEAT SHIRTS, SWEAT PANTS, ATHLETIC JERSEYS, SHORTS, T-SHIRTS, KNIT SHIRTS, PANTS, HATS, HEADBANDS (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

Flaw

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August 26, 2002

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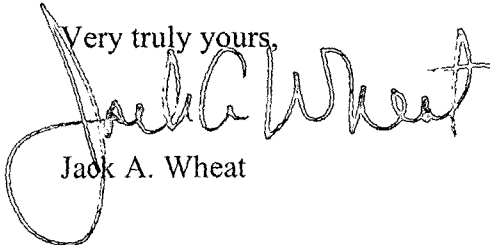
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

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 \$300, 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

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