

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

ELON UNIVERSITY

Opposer,

v.

KABUSHIKI KAISHA PHENIX

Applicant.

Attorney Docket No. 033124.024

Opposition No. _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
BOX TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

Elon University believes it will be damaged by the registration of Application Serial No. 76/485,307 for a Design Mark filed on January 27, 2003 by Kabushiki Kaisha Phenix published in the Official Gazette on September 23, 2003, and opposes the same. The grounds for this opposition are as follows:

1. Elon University is a non-profit educational institution of North Carolina, located and doing business at 101 Haggard Avenue, Elon, North Carolina 27244 ("Elon").
2. Kabushiki Kaisha Phenix ("KKP") is a corporation of Japan located and doing business at 3-15 Nihonbashi Muromachi 4-chome Chuo-ku, Tokyo, Japan.

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3. Elon is the owner of U.S. Registration No. 2,514,968 for the ELON PHOENIX Design for paper goods, namely, pennants, napkins, window stickers, bumper stickers, decals, sticker sheets, portfolios, notebooks, note pads, folders for papers, pens, pencils, paper and plastic gift bags, banners and posters; glassware, namely, shorts, t-shirts, hats, caps, socks, jackets, pants, sweatsuits, sweatshirts, sweatpants, sleepwear, rainwear, sweaters and visors; education and entertainment services, namely, providing educational courses at the college and graduate level, and promoting and conducting college level men's and women's sporting events;

4. Elon is the owner of U.S. Registration No. 2,644,043 for a Phoenix design for paper goods, namely, pennants, napkins, window stickers, bumper stickers, decals, sticker sheets, portfolios, notebooks, note pads, folder for papers, pens, pencils, paper and plastic gift bags, banners and posters; glassware, namely, drinking glasses, cups mugs; trash cans; clothing for men, women and children, namely, shorts, t-shirts, hats, caps, socks, jackets, pants, sweatsuits, sweatshirts, sweatpants, sleepwear, rainwear, sweaters and visors; education and entertainment services, namely, providing educational courses at the college and graduate level, and promoting and conducting college level men's and women's sporting events;

5. Elon is the owner U.S. Serial No. 76/172,411 for the ELON PHOENIX (Stylized) mark for education and entertainment services, namely, providing educational courses at the college and graduate level, and promoting and conducting college level men's and women's sporting events. (Collectively the marks listed in paragraphs 3-5 herein are "Elon's Phoenix Marks").

6. KKP is the owner of U.S. Serial No. 76/485,307 for the Design mark ("Applicant's Design Mark"), for backpacks, wallets and sportsbag ("Applicant's Goods").

7. Since long prior to January 27, 2003, Applicant's filing date of its intent to use Application Serial No. 76/485,307 for Applicant's Design Mark for Applicant's Goods, Opposer has been and is now engaged in the business of advertising, offering for sale and selling Opposer's Goods/Services under Opposer's Phoenix Marks in interstate commerce in the United States.

8. Since long prior to any use of Applicant's Design Mark by Applicant for Applicant's Goods in interstate commerce in the United States, Opposer has been and is now engaged in the business of advertising, offering for sale and selling Opposer's Goods/Services under the Opposer's Phoenix Marks in interstate commerce in the United States.

9. Due to Opposer's long, established and exclusive use of the Opposer's Phoenix Marks in connection with Opposer's Goods/Services, the Opposer's Phoenix Marks have become well known as designating Opposer's Goods/Services throughout the United States.

10. Opposer enjoys substantial and exclusive goodwill and a fine reputation throughout the United States in connection with Opposer's Phoenix Marks for Opposer's Goods/Services. Opposer's goodwill and reputation will be harmed by the use and registration of the Applicant's Design Mark for Applicant's Goods.

11. Applicant's Design Mark so resembles Opposer's previously used and registered Opposer's Phoenix Marks as to be likely, when applied to the Applicant's Goods, to cause confusion, mistake or to deceive persons by creating the erroneous impression that the Applicant's goods originate with or are associated with the Opposer, or that the Applicant's Goods are authorized, endorsed or sponsored by the Opposer.

12. Upon information and belief, the bona fides of Applicant's intent to use the Applicant's Design Mark in commerce is not apparent from materials of record in the subject

application, and Opposer challenges same and leaves Applicant to its proofs with regard to the nature and sufficiency of its intent to use the Applicant's Design Mark at the time of filing Application Serial No. 76/485/307.

13. Applicant's filing of Application Serial No. 76/485,307 for Applicant's Design Mark is without license, authorization or permission from Opposer.

14. The granting of a trademark registration for Applicant's Design Mark to Applicant would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer in Opposer's Phoenix Marks.

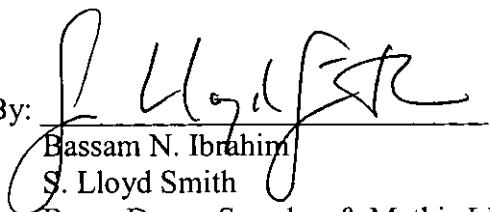
15. Opposer would be damaged if Application Serial No. 76/485,307 is granted because Applicant will obtain statutory rights in Applicant's Design Mark in violation and derogation of the established prior rights of Opposer in Opposer's Phoenix Marks.

16. WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 76/485,307 be rejected and the registration of Applicant's Design Mark as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

March 22, 2004

Respectfully submitted,

ELON UNIVERSITY

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March 22, 2004



Honorable Commissioner for Trademarks
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Attention: TTAB - Fee

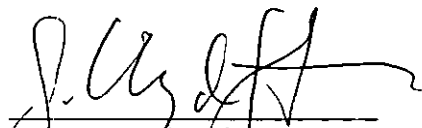
Re: Elon University v. Kabushiki Kaisha Phenix
Opposition to U.S. Trademark Application
Serial No. 76/485,307 for Design Mark
Attorney Docket: 033124.024

Commissioner:

Attached hereto with respect to the above-identified application is a Notice of Opposition, in duplicate.

Also attached is a check in the amount of \$300.00 covering the government fee. Any deficiency in the fee should be charged to our Deposit Account. No. 02-4800. A duplicate copy of this letter is enclosed.

Respectfully submitted,


Bassam N. Ibrahim
S. Lloyd Smith
Attorneys for Opposer

Enclosures