

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

The New York State Department of Economic Development fka  
The New York State Department of Commerce Economic  
Development

v.

Michael Nnamdi Stewart

Opposition No. 91162024  
to application Serial No. 78243227  
filed on April 29, 2003

Lawrence V. Molnar of CMG Worldwide, Inc. for The New York  
State Department of Economic Development fka The New York  
State Department of Commerce Economic Development.

Michael Nnamdi Stewart, pro se.

Before Seeherman, Hohein and Walters, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

New York State Department of Economic Development  
(hereafter "opposer" or "NYSDED") has opposed the  
application of Michael Nnamdi Stewart to register I♥NC, as  
shown below, as a trademark for "clothing, namely, t-shirts,  
shirts, slacks, jeans, jackets, sweaters, caps, parkas,

shorts, jogging suits, sweat suits, vests, neckties, leisure suits, rainwear, scarf's [sic], sport coats, cheerleading tops and cheerleading skirts, sleepwear, underwear, socks, athletic jerseys, shorts, hats, visors, leather jackets, suede jackets, belts, footwear."<sup>1</sup>



Applicant has disclaimed exclusive rights to use "NC."

As grounds for opposition, opposer has alleged that since 1977 opposer and its predecessors have engaged in a program to promote travel and tourism in the state of New York; that since 1977 it has been engaged in the sale and distribution of a wide spectrum of goods and services under the mark I♥NY; that opposer owns registrations for various

I♥NY marks, including Registration No. 1555836 for T-shirts, gloves, hats, jackets, sportshirts, sweaters,

scarves, sweatshirts and shoes for the mark ; that

opposer's marks are famous; that they became famous prior to the date that applicant can claim any rights in his I♥NC

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<sup>1</sup> Application Serial No. 78243227, filed April 29, 2003, and asserting first use on December 31, 2001, and first use in commerce on January 1, 2002.

mark; and that applicant's mark is likely to cause confusion or mistake or to confuse the public into believing that applicant's goods are associated with opposer, in violation of Section 2(d) of the Trademark Act.<sup>2</sup>

In his answer to the notice of opposition applicant admits that the mark I♥NY is synonymous with the state of New York; admits that opposer has registered the marks listed in the notice of opposition, but denies their validity; and admits that his mark sounds similar to I♥NY. Applicant otherwise denies the salient allegations of the notice of opposition.

#### **The Record**

Opposer has sought to make of record, by notice of reliance, a number of exhibits. However, we note that many of these exhibits are not appropriate for submission under a notice of reliance.<sup>3</sup> Further, applicant has not treated the exhibits as being of record, such that we could deem them to have been stipulated into the record.

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<sup>2</sup> Opposer also asserted that registration of applicant's I♥NC mark would likely dilute the distinctive quality of opposer's I♥NY marks, in violation of Section 43(c) of the Trademark Act. However, opposer never discussed this ground in its brief, and we therefore consider this claim to have been waived.

<sup>3</sup> In this respect, the present proceeding is very similar to the situation in *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ 1400 (TTAB 1998), in which the opposer there also attempted to submit, by notice of reliance, declarations of the opposer's officer and photocopies of goods on which the opposer's marks appeared. The Board found that those exhibits were not properly

First, opposer has submitted printouts from a number of websites. However, webpages may not be made of record by notice of reliance. See *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, n.3 (TTAB 2004), in which the Board stated:

Internet evidence is not proper subject matter for introduction by notice of reliance because the evidence is not self-authenticating. As the Board has stated in the past, the element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). See also TBMP §704.08 (2d ed. rev. 1, March 2004).

Accordingly, Exhibits A, C, D, CC, EE, FF and II and the copy of the Kwigy-Bo website that is part of Exhibit Q are not properly of record, and have not been considered.

Second, opposer has submitted "soft" copies of its trademark registrations. Trademark Rule 2.122(d) provides the manner in which an opposer may properly make its registrations of record:

(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a

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made of record by opposer's notice of reliance, and they were not considered.

copy of a registration showing status and title, see §2.6(b)(4).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Moreover, the Board's August 19, 2005 decision denying opposer's motion for summary judgment referred opposer to TBMP §704.03(b)(1) regarding the procedures for introducing during the initial testimony period a registration owned and pleaded by a plaintiff. See footnote 9. The registrations submitted by opposer are not copies prepared by the Office showing current status of and current title to the registrations. Accordingly, opposer's registrations are not properly of record. Exhibits JJ, KK, LL, MM, NN and OO have not been considered.

Opposer has submitted copies of the declarations of Thomas Regan and Danielle Luhmann that it had submitted in connection with its motion for summary judgment. Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. Thus, to be part of the evidentiary record to be considered at final

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hearing, the evidence must be properly introduced in evidence during the appropriate testimony period. See TBMP §528.05(a). Trademark Rule 2.123(b) provides, in part, that "[b]y written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses." No stipulation has been submitted to allow opposer to submit the testimony of its witnesses by affidavit or declaration. Accordingly, exhibits F and G are not properly of record, and have not been considered.

Opposer has submitted photoprints of what it asserts to be licensed products. Opposer states that these exhibits have been submitted pursuant to Trademark Rule 2.122. However, there is nothing in this rule that provides for the submission of photoprints of products under a notice of reliance. As previously discussed, Trademark Rule 2.122(d)(2) provides that a registration owned by a party may be made of record by a notice of reliance if the registration has been prepared by the Patent and Trademark Office and shows current status and title to the registration. Trademark Rule 2.122(e) provides that printed publications and official records can be made of record by a notice of reliance<sup>4</sup>. Photoprints of products obviously do

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<sup>4</sup> Trademark Rule 2.122(e) provides as follows:

not fall under any of these categories. See Hard Rock Cafe Licensing Corp. v. Elsea, supra. Accordingly, Exhibits I, J, K, L, M, N, O, P, Q, R, S, T, U and V have not been considered. Similarly, photoprints showing a retail store cannot be made of record by notice of reliance, and Exhibit DD has therefore not been considered.

Opposer has also submitted copies of license agreements for several of the products shown in the above-mentioned exhibits. Because these agreements are not printed publications or official records, they cannot be made of record by a notice of reliance. Accordingly, Supplemental Exhibits J, K, L, M, N, O, P, Q, R, S, T, U, V, W and BB have not been considered.

Similarly, Exhibit H, opposer's listing of advertising expenditures, and Exhibit PP, "an electronic communication"

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(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

purporting to list opposer's licensee's customers in North Carolina, cannot be made of record by a notice of reliance, and these exhibits have not been considered.

Opposer has also submitted with its notice of reliance copies of catalogs which appear to be catalogs of its licensees or sublicensees. However, because there is no evidence that these catalogs are available to the general public in libraries or of general circulation among members of the public, they cannot be treated as printed publications. See *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960), finding that Fuller Brush Catalogues should not be admitted into evidence by notice of reliance. The assumption underlying the rule that printed publications, such as books and periodicals, may be submitted by notice of reliance is that a party is or may readily become familiar with printed matter in libraries open to the public or in general circulation. *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090 (TTAB 1979). See also *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, n. 10 (TTAB 1976) ("Applicant's objections to opposer's catalogs and house publications are well taken because it has not been shown that they are 'available to the general public in libraries or of general circulation'"); and *Standard Pressed Steel Co. v. Midwest Chrome Process Co.*, 183 USPQ 758, n. 2 (TTAB



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1974) (Brochures and price lists distributed by third parties do not constitute printed publications, such as books and periodicals, available to the general public in libraries or of general circulation). Accordingly, Exhibits W, X, Y, Z, AA and BB are not properly of record, and have not been considered.

There are exhibits that opposer submitted under notice of reliance that are properly of record. They are Exhibit B, pages from a book; Exhibit E, a newspaper article; and Exhibit GG, which is applicant's responses to opposer's interrogatories. Opposer has also attempted to submit applicant's responses to opposer's request for production of documents. Trademark Rule 2.120(j)(3)(ii) provides, however, that "A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)." Moreover, applicant has responded to most of opposer's interrogatories as follows:

Refer to the attached documentations;  
Applicant has made available all  
information to the nature of their  
business. The opposer's answer to this  
question will be found within these  
documents."

Because applicant has submitted the documents he produced as his responses to opposer's interrogatories, the documents

are of record pursuant to Trademark Rule 2.120(j)(5).

Accordingly, Exhibit HH has been considered.

There are also problems with applicant's evidentiary submissions. Applicant has submitted what he has captioned "Applicant's Testimony, Exhibits, and Closings," three pages of what appears to be argument that is more in the nature of a brief, although part of it has the subtitle "Applicant's Testimony." The statements made in these three pages do not constitute trial testimony, as provided in Trademark Rule 2.123, and we do not give it any evidentiary value. With respect to the documents that applicant submitted as exhibits, since there has been no acceptable testimony authenticating the documents, we would normally consider only those documents that could have been submitted under a notice of reliance (because they are self-authenticating). The letters written to applicant by opposer's agent would not have been acceptable for submission in this manner; however, in its brief opposer treats these letters as being of record by discussing them in terms of the issue of likelihood of confusion. Brief, p. 22. Accordingly, we deem the letters as having been stipulated into the record.

One exhibit that applicant submitted as part of his "testimony" is an excerpt from the July 18, 2005 issue of "Business Week." The periodical "Business Week" qualifies as a printed publication under Trademark Rule 2.122(e), a

fact that opposer has recognized in its brief. Page 5. However, opposer has asked the Board to exclude this exhibit "on grounds that it fails to meet the competency requirement of Rule 2.122(e) ... and pursuant to Rule 802 of the Federal Rules of Evidence, on grounds that it is inadmissible hearsay." Id. With respect to the first ground, it is opposer's position that there are factual errors in the specific article, and therefore the article does not meet the competency requirement of Rule 2.122(e). Rule 2.122(e) provides that a printed publication or official record can be made of record by notice of reliance "if the publication or official record is competent evidence and relevant to an issue." We are aware of no case law that requires the publication to contain no errors of fact in order for the publication to be acceptable under this rule, and we see no reason to interpret the rule in this manner. As opposer has recognized by its hearsay objection, a printed publication can be used only for what the publication shows on its face, but it is not evidence of the truth of the statements made in it. Thus, even though there may be factual errors in an article, we do not treat the article as proof of the statements made therein; rather we consider the article as merely showing that the statements appeared in the publication and may have been seen by the relevant public. Accordingly, we overrule opposer's objection to the extent

that this article will be treated of record, although we agree that the probative value of the article is limited.

In addition to opposer's Exhibits B, E, GG and HH, and the exhibits submitted by applicant, the record includes the pleadings and the file of the opposed application. Both parties have filed briefs.<sup>5</sup>

**Facts**

Because the record is so limited, we have very little factual information. With respect to opposer and its activities, the book and the newspaper article (Exhibits B and E) cannot, as opposer has pointed out, be used to prove the truth of the statements made therein. However, we have certain admissions made by applicant in his answer and in his brief which we will treat as undisputed facts. They are that "Applicant is [sic] with adequate facts that NYSDDED [opposer] and its precursor have engaged in a program to promote travel and tourism in the state of New York beginning as early as 1977," brief, p. 1; that opposer registered the marks listed in the notice of opposition, although applicant has denied the registrations' validity, brief, p. 2; and that the "I♥NY mark is synonymous with the state of New York", brief, p. 3. Applicant also stated that

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<sup>5</sup> In its brief opposer "respectfully directs the Board and Applicant" to various notices of opposition that it filed against third-party applications. p. 28. To the extent that opposer asks the Board to take judicial notice of these proceedings, that request is denied.

his mark "sounds similar to I♥NY," but denied that the connotation and commercial impression of the I♥NC mark is the same as I♥NY "because Opposer's marks are used to promote travel and tourism for the State of New York, while Applicant's mark is in no way associated with the promotion of travel and tourism to the State of New York." Id.

With respect to applicant and his activities, we have only the documents that he provided to opposer. They include a business plan for Mosayk, Incorporated, which states that "we" plan to launch the brand "I Love NC" in Spring 2004, and that "we" intend the mark to be "a lifestyle brand for the people that live here and embody all the great attributes of the state of North Carolina." The plan also states that the primary objective is to acquire licensing partners, and the secondary goal is a publishing program in which the company will collaborate with institutions on books, calendars and magazines. Its primary market is "a college graduate, working men and women between the ages of 25-44," with a secondary market being "native Carolinians, foreigners, and tourist[s]." Products that are listed for the licensing program include sunglasses, wallets, tote bags, umbrellas, emblem patches, belt buckles and other accessories; apparel/headwear; automobile products and accessories; balls; checks; clothing accessories such as

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gloves, neckties, scarves, socks and headbands; collectibles; consumables; electronics such as computer accessories, compact disks and cameras; furniture/furnishings; games such as board games, playing cards and video games; gifts and novelties such as toys, key chains, magnets and pet products; health and beauty products; housewares/domestics; infant products and accessories; Internet products and services; jewelry; paper products such as paper plates, wrapping paper and business cards; publishing; signage products such as flags and pennants; and stationery/office products/school supplies.

The documents produced by applicant show an invoice from Mosayk, Inc. to The Paradies Shops in Atlanta, GA, for goods described as 192 "I LOVE NC TEES," and a delivery date of September 1, 2003. Another document is a consignment contract, dated October 16, 2003, between Mosayk, Inc. and North Carolina Remembered, Inc., by which Mosayk has delivered 18 "I Love NC" t-shirts with a retail sale price of \$14.99.

**Analysis**

A threshold requirement to bring an opposition proceeding is that the plaintiff must establish its standing. In this case, although opposer has not submitted any direct evidence of its standing, applicant has admitted that opposer and its predecessor have engaged in a program

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to promote travel and tourism in the state of New York, that opposer registered the marks listed in the notice of opposition (although applicant has denied the registrations' validity), and that the "I♥NY mark is synonymous with the state of New York." When these three admissions are taken together, we consider them adequate to show that opposer is not a mere intermeddler. Therefore, we find on the basis of these statements that opposer has standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

This brings us to a consideration of the pleaded ground. There are two aspects to a likelihood of confusion claim: priority and likelihood of confusion. Because opposer has failed to prove that it has made use of any trademarks, it cannot show that it has priority of use. Opposer did not properly make of record any of the registrations which it pleaded in its notice of opposition, nor did it submit any testimony as to its use of the marks. Although applicant has admitted that opposer and its "precursor" have engaged in a program to promote travel and tourism in New York beginning as early as 1977, there is no admission as to opposer's use of any mark in connection with such activities as of that date. As noted, in his discussion of the issue of likelihood of confusion, applicant acknowledged that his mark "sounds similar to

I♥NY," but denied that the connotation and commercial impression of the I♥NC mark is the same as I♥NY "because Opposer's marks are used to promote travel and tourism for the State of New York, while Applicant's mark is in no way associated with the promotion of travel and tourism to the State of New York." Id. Even if we treat this statement as an acknowledgement that opposer has marks that it uses to promote travel and tourism for the State of New York, the statement is not an admission that opposer used I♥NY as a trademark for such services prior to the filing date of applicant's application.

It was opposer's burden to prove it had priority. Opposer failed to do so because it did not make its evidence properly of record. It is clear that opposer was not relying on disconnected admissions made by applicant in his answer, and certainly not in his trial brief, such that opposer did not believe it had no need to file evidence to prove its priority. Even if we cobble together the various admissions made by applicant, they do not create an overall picture showing that opposer has priority of use of the mark I♥NY for any goods or services, let alone for goods or services with which applicant's use of his mark for clothing is likely to cause confusion. Cf. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed.



Cir. 1994). Because opposer did not prove priority, it cannot succeed on the ground of likelihood of confusion.<sup>6</sup>

Decision: The opposition is dismissed.

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<sup>6</sup> Opposer has cited Exhibit B, a 2004 publication called "Advertising by Design: Creating Visual Communications with Graphic Impact", in support of its statements of such "facts" as "I LOVE NEW YORK is an official State of New York brand, and it remains New York's tagline today" and "the I LOVE NEW YORK logo was judged to be one of the world's top 50 logos." Brief, p. 7. Although opposer's own objections to applicant's submission of the "Business Week" article on the ground of hearsay indicate that opposer understands this point, we reiterate that the two publications that opposer properly made of record, Exhibits B and E (Exhibit E is a July 17, 2005 article from the "Toronto Star"), cannot be used to prove the truth of the statements made therein.