

TTAB

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

December 11, 2006

In the matter of trademark application Serial No. 78/464,311
For the mark I ♥ NJ
Published in the Official Gazette on November 15, 2005

NEW YORK STATE DEPARTMENT OF ECONOMIC DEVELOPMENT
(Opposer)

V.

RAYMOND NICHOLAS MANIACI
(Applicant)

UNITED STATES PATENT AND
TRADEMARK TRIAL AND APPEAL BOARD
PO BOX 1451
ALEXANDRIA, VA 22313-1451

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION No. 91168496

Applicant, Raymond Nicholas Maniaci, having an address at 8 Madison Heights, Wyckoff, New Jersey 07481, is responding to New York State Department of Economic Development (NYSDDED), f/k/a the New York State Department of Commerce, hereinafter referred to as Opposer, opposition letter to the registration of the I ♥ NJ mark, published in the Official Gazette on November 15, 2005. Applicant pleads and alleges as follows:

1. Applicant is without sufficient knowledge that NYSDDED and its predecessors have engaged in a program to promote travel and tourism in the state of New York beginning as early as 1977.

2. Applicant is without sufficient knowledge that NYSDDED and its predecessors have been continuously engaged in the sale and distribution of goods and services bearing the I ♥ NY, but denies that the registration of the I ♥ NJ mark will effect Opposer's commerce related to New York State travel and tourism.

3. Applicant admits the I ♥ NY mark is synonymous with the state of New York.

4. Applicant is without sufficient knowledge to the interstate commerce of Opposer, but denies that the registration I ♥ NJ will disturb that goodwill.

5. Applicant, through thorough research, admits to Opposer's registration of the marks listed in their opposition, but denies their registrations' validity because some listed are expired, cancelled, and/or different class marks from Applicant. Opposer's registration 1795587 has expired, registration 1704940 has been cancelled, registration 1805333 has expired, registration 1805354 has been cancelled, 1694568 has been cancelled, 1825861 has been cancelled, 1801667 has been cancelled, 1725475 has been cancelled and 1701791 has been cancelled.

6. Applicant denies that the I ♥ NY registrations are prima facie evidence of the validity of Opposer's mark because some listed in Opposer's opposition letter are no longer in existence, have been cancelled, and are different class marks from Applicant. Applicant is without sufficient knowledge of Sections 7(b), 22 and 33(a) of the Lanham Act.

7. Applicant is without sufficient knowledge of the amount of time and effort Opposer has put into promoting the I ♥ NY marks. Regardless, Applicant denies that the registration of the I ♥ NJ mark will effect Opposer's commerce related to New York State travel and tourism and its goodwill therein.

8. Applicant admits on August 9, 2004, he filed a trademark registration application for the mark I ♥ NJ in International Class 25.

COUNT I: LIKELIHOOD OF CONFUSION

9. Applicant hereby incorporates by reference the replies in Paragraphs 1 through 8 hereof as if fully set forth herein.

10. Applicant denies the I ♥ NJ mark is similar in sight because the design of the logo is different in letters (Applicant's "J" to Opposer's "Y"), letter size, heart design and color usage in commerce. Applicant denies his mark sounds similar to I ♥ NY as it represents two different states and regions. Applicant denies the connotation and commercial impression of the I ♥ NJ mark is the same as I ♥ NY because Opposer's marks are used, according to its opposition letter, 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.

11. Applicant is without sufficient knowledge that Opposer's marks are "famous" pursuant to Section 43(c) of the Lanham Act.

12. Applicant denies that his mark is the same or similar as Opposer's marks, therefore the public will not believe that the mark is affiliated or associated with,

connected to or sponsored by Opposer. In addition, Applicant takes meticulous measures to note on each and every good the source of the goods.

13. Applicant also denies his mark is likely to cause confusion, mistake, or deceive the public because, as stated prior, he identifies on each good the source of the goods. Applicant is without sufficient knowledge that his mark is in violation of Section 2(d) of the Lanham Act.

14. Applicant denies Opposer's claims in this paragraph and considers it highly speculative. Applicant affirmatively alleges that Applicant's mark is not confusingly similar to Opposer's "I NY" mark in that they are associated with very different geographical areas. It is very unlikely that consumers will confuse New York with New Jersey as states, as well as "J" and "Y" as letters.

15. Applicant is without sufficient knowledge of Opposer's prior and superior statutory and common-law rights in the I ♥ NY marks.

COUNT II: LIKELIHOOD OF DILUTION

16. Applicant hereby incorporates by reference the replies in Paragraphs 1 through 15 hereof as if fully set forth herein.

17. Applicant is without sufficient knowledge of that Opposer's marks are famous and became famous prior to the date of Applicant's application according to Section 43(c) of the Lanham Act.

18. Applicant denies the registration and use of the I ♥ NJ mark will dilute the quality of Opposer's marks because past marks containing "I" with the heart design from other individuals and companies have been registered after Opposer's marks and Opposer

is still thriving in commerce.¹ Opposer has previously acquiesced to the registration of marks containing "I" with the heart design. Applicant further affirmatively alleges that the United States Patent and Trademark Office did not site Opposer's marks as confusingly similar to Applicant's mark during examination of Applicant's application. This supports Applicant's position that the marks are not confusingly similar.

19. Applicant is without sufficient knowledge to the speculative damages that Opposer may incur, but denies the likelihood of confusion and dilution allegations.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed, with prejudice, in its entirety, and that a registration issue to Applicant for its mark.

Respectfully Submitted,



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CERTIFICATE OF MAILING

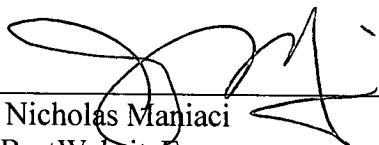
I hereby certify that this paper is being deposited on December 11, 2006 with the United States Postal Service in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK TRIAL AND APPEAL BOARD,
PO BOX 1451, ALEXANDRIA VA 22313-1451

¹ Registration Numbers: 1801592; 2945424; 3001095; 2660340; 2960210; 2416975; 2788215; 2550022; 2990103; 2982434; 3028944; 2604382; 2561469; 2382272; 1568566; 2321795; 2524339; 1234075; 2297518, 1648234; 2077304; etc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing has been served upon the following parties in this matter (Opposition No. 91168496), by U.S. First Class mail, postage prepaid, this 11th day of December 2006.



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