

ESTTA Tracking number: **ESTTA172160**

Filing date: **10/31/2007**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Board of Trustees of the Leland Stanford Junior University
Granted to Date of previous extension	10/31/2007
Address	Stanford Univ, Office of General Counsel Bldg 170, Main Quad, 3rd Floor Stanford, CA 94305 UNITED STATES

Correspondence information	Beth H. Parker Bingham McCutchen LLP Three Embarcadero Center Suite 1800 San Francisco, CA 94111 UNITED STATES beth.parker@bingham.com, george.fox@bingham.com Phone:(415) 393-2000
----------------------------	--

Applicant Information

Application No	78900960	Publication date	07/03/2007
Opposition Filing Date	10/31/2007	Opposition Period Ends	10/31/2007
Applicant	STANFORD FINANCIAL GROUP COMPANY 5050 Westheimer Houston, TX 77056 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. First Use: 2001/06/15 First Use In Commerce: 2001/06/15 All goods and services in the class are opposed, namely: PRINTED PERIODICALS IN THE FIELD OF GLOBAL NEWS AND WEALTH MANAGEMENT
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1221613	Application Date	03/21/1980
Registration Date	12/28/1982	Foreign Priority Date	NONE
Word Mark	STANFORD		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class 016. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Paper Goods-Namely, Writing Paper and Envelopes, Pens, Pen Sets, Desk Sets, Calendars, Binders, Notebooks, Pencils, Napkins, Letter Openers and Photo Albums</p> <p>Class 025. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Clothing-Namely, Sweatshirts, T-Shirts, Sweaters, Robes, Hats, Socks, Jerseys, Running Suits, Jackets, Shorts, Ponchos and Pants</p> <p>Class 028. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 Sporting Goods-Namely, Tennis Balls, Golf Balls, Footballs and Toy Flying Saucers for Toss Game</p> <p>Class 041. First use: First Use: 1891/00/00 First Use In Commerce: 1891/00/00 Educational Services, Teaching Students at University Level</p> <p>Class 042. First use: First Use: 1891/00/00 First Use In Commerce: 1891/00/00 Research Services, Rendering Research Services in the Sciences, Arts and the Like</p>

Attachments	Notice of Opposition to STANFORD EAGLE.pdf (5 pages)(16730 bytes)
-------------	--

Signature	/gf/
Name	George L. Fox
Date	10/31/2007

1. Applicant has requested protection in the United States of the word mark STANFORD EAGLE for “printed publications in the field of global news and wealth management” in International Class 016. The application was filed on June 5, 2006, and was published in the *Official Gazette* on July 3, 2007.

2. Opposer is owner of U.S. Registration Number 1,221,613 for the word mark STANFORD, which was filed with the United States Patent and Trademark Office on March 21, 1980, for the following goods and services:

International Class 016: Paper Goods – namely, writing paper and envelopes, pens, pen sets, desk sets, calendars, binders, notebooks, pencils, napkins, letter openers and photo albums. First Use: 19600000; First Use in Commerce: 19600000.

International Class 025: Clothing – namely sweatshirts, T-shirts, sweaters, robes, hats, socks, jerseys, running suits, jackets, shorts, ponchos and pants. First Use: 19600000; First Use in Commerce: 19600000.

International Class 028: Sporting Goods – namely, tennis balls, golf balls, footballs and toy flying saucers for toss game. First Use: 19600000; First Use in Commerce: 19600000.

International Class 041: Educational Services, teaching students at university level. First Use: 18910000; First Use in Commerce: 18910000.

International Class 042: Research Services, rendering research services in the sciences, arts and the like. First Use: 18910000; First Use in Commerce: 18910000.

3. Opposer’s STANFORD registration is valid and incontestable, and constitutes prima facie evidence of Opposer’s exclusive right to use the STANFORD mark in commerce with the goods and services specified therein. There is no issue as to priority.

4. Opposer is nationally and internationally renown for the educational services that it provides under the STANFORD mark. Opposer’s educational programs, which

include the Stanford Graduate School of Business, the Stanford Graduate Program in Journalism, and the Stanford Economics Department, are regularly ranked among the best educational programs in the nation and the world.

5. Opposer's STANFORD mark has become famous as an identifier of Opposer's renown educational services, as well as other goods and services offered by Opposer. As a result, the STANFORD mark has become a valuable asset of Opposer and the principal symbol of its goodwill.

6. Applicant's STANFORD EAGLE mark is confusingly similar to Opposer's STANFORD mark.

7. The term "eagle" is widely used in connection with news periodicals and is thus merely descriptive, while the distinctive portion of Applicant's mark – STANFORD – is identical in sound, appearance and commercial impression to Opposer's mark.

8. The dominant portion of Applicant's mark is identical to Opposer's mark and, consequently, consumers are likely to be confused about Opposer's affiliation with, or sponsorship of, products and services offered under the STANFORD EAGLE mark.

9. The goods that Applicant intends to provide under the STANFORD EAGLE mark contribute to the likelihood of confusion.

10. Applicant seeks registration in International Class 016 for "printed publications in the field of global news and wealth management." Upon information and belief, the chief purpose of such publications is to disseminate information about global news and wealth management. Such publications thus have an educational nature.

11. Opposer STANFORD mark is registered for paper goods in International Class 016, as well as clothing and sporting goods in International Classes 025 and 028, respectively. Consumers have thus come to recognize that goods bearing the STANFORD mark, including paper goods, emanate from Opposer.

12. Opposer's educational programs, including the Stanford Graduate School of Business, the Stanford Graduate Program in Journalism, and the Stanford Economics

Department provide education relating to global issues and financial markets.

13. Because well-known and highly regarded educational programs offered by Opposer under the STANFORD mark provide education relating to global issues and financial markets, and because consumers recognize that goods bearing the STANFORD mark emanate from Opposer, consumers are likely to be confused about Opposer's affiliation with, or sponsorship of, any "printed publications in the field of global news and wealth management" offered by Applicant under the STANFORD EAGLE mark.

14. The STANFORD mark serves to distinguish Opposer as the source of goods and services bearing or rendered in connection with the mark, and serves to indicate the high quality of those goods and services.

15. Applicant's intended adoption of STANFORD EAGLE, a mark confusingly similar to Opposer's STANFORD mark, comes long after Opposer established extensive good will and fame in the STANFORD mark.

16. The fame of Opposer's STANFORD mark gives Opposer the right to preclude the use of confusingly similar marks that are likely to tarnish or blur Opposer's mark by eroding or lessening the capacity of Opposer's STANFORD mark to identify and distinguish Opposer's goods and services in the minds of consumers.

17. Applicant's use of the STANFORD EAGLE mark is likely to tarnish or blur Opposer's STANFORD mark by creating negative associations with Opposer's mark or weakening the distinctive significance of Opposer's mark and its capacity to give customers the assurance of quality and satisfaction they have had when purchasing goods and services bearing the STANFORD mark.

WHEREFORE, Stanford University prays that this opposition be sustained and that the registration sought by Application Serial No. 78900960 be denied.

