

ESTTA Tracking number: **ESTTA174270**

Filing date: **11/13/2007**

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	Northern Illinois University		
Entity	Educational Institution	Citizenship	United States
Address	1425 W. Lincoln Hwy DeKalb, IL 60115-2825 UNITED STATES		

Attorney information	James G. Fahey Sorling Law Office 607 East Adams Street Suite 800 Springfield, IL 62701 UNITED STATES jgfahey@sorlinglaw.com Phone:217-544-1144
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Applicant Information

Application No	77112719	Publication date	11/06/2007
Opposition Filing Date	11/13/2007	Opposition Period Ends	12/06/2007
Applicant	Marble Sportswear, Inc. 9465 Wilshire Boulevard, Suite 850 Beverly Hills, CA 90210 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 005. All goods and services in the class are opposed, namely: Pharmaceutical, veterinary and sanitary preparations, namely, anticoagulants; dietetic substances, namely, food and sugar, adapted for medical use, food for babies; medical plasters, materials for dressings, namely, surgical and wound dressings; material for teeth, namely, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides</p>
<p>Class 006. All goods and services in the class are opposed, namely: Crucible of common metals and their alloys; metal building materials, namely, soffits, fascia, and sheet metal; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; iron, and small items of metal hardware, namely, vaults, metal door knocker, mail slots, boxes and plates, metal keys and hooks, metal pulleys, nuts, washes, springs, hinges, drawer pulls and knobs, metal door viewers, panels, guards and chains, and ceiling medallions; pipes and tubes of metal; goods of common metal not included in other classes, namely, common metal, unwrought and semi-worked, for future manufacture; iron ores</p>
<p>Class 008. All goods and services in the class are opposed, namely: Hand operated tools and implements, namely, crowbars, gardening tools, namely, trowels, weeding forks, spades, hoes, hand-held cutting tools, hammers, hand hooks and jacks, hand saws, clamps, picks, ratchet wrenches, hatchets,</p>

socket wrenches, chisels, pruners, pumps, paint scrapers, shears, riveting tools, planes, chef's, carving, household, paring, table, vegetable and thin bladed kitchen knives, pliers, and screwdrivers; cutlery, namely, knives, spoons, forks, and serving spoons and forks, ladles, cheese knives and spreaders, knife sharpeners; razors
Class 015. All goods and services in the class are opposed, namely: Musical instruments, namely, accordions, acoustic basses and guitars, banjos, bass guitars, bongo drums, brass instruments, namely, bugles, English horns, flutes, French horns, horns, saxophones, trombones, castanets, cellos, clarinets, conga drums, cymbals, drums, electric basses, electric guitars, electronic musical keyboards, fiddles, guitars, harmonicas, harps, kazoos, music synthesizers, organs, pianos, recorders, shofars, tambourines, triangles, violins, ukuleles and xylophones
Class 017. All goods and services in the class are opposed, namely: Foam, fluoro, liquid, nitrile, polysulfide, reclaimed sheets, solutions, silicone, synthetic, and acrylic rubber; gutta-percha, gum, asbestos, and mica for use in the manufacture of shoes and tires and vehicles and houses and commercial buildings and office equipment; plastics in extruded form for use in manufacture; packing, stopping and insulating materials, namely, flexible pipes, not of metal
Class 027. All goods and services in the class are opposed, namely: Carpets, rugs, mats and matting, linoleum; and materials for covering existing floors; wall hangings not of textile

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Dilution	Trademark Act section 43(c)
Other	We believe that the mark will be in violation of Northern Illinois University's common law rights. We also believe that the use of their mark is likely to cause confusion among consumers into believing that Northern Illinois University is associated with their products and services.

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77219219	Application Date	06/29/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NIU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1957/07/01 First Use In Commerce: 1957/07/01 Caps; Short sets; Tops; Jerseys; Headgear, namely, hats, caps		

Attachments	77219219#TMSN.jpeg (1 page)(bytes) Notice of Opposition-NIU.pdf (1 page)(26281 bytes) Affidavit #1-NIU.pdf (2 pages)(169208 bytes) Affidavit #2-NIU.pdf (2 pages)(203560 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/James G. Fahey/
Name	James G. Fahey
Date	11/13/2007

Northern Illinois University was founded in 1899, and the University has been using the "NIU" mark extensively in connection with education, entertainment, services, sporting activities, and athletic equipment since July 1, 1957. We believe that the mark will be in violation of Northern Illinois University's common law rights. We also believe that the use of their mark is likely to cause confusion among consumers into believing that Northern Illinois University is associated with their products and services. Northern Illinois University spends approximately \$500,000 annually in marketing initiatives. Northern Illinois University opposes the mark.

AFFIDAVIT

STATE OF MICHIGAN)
) SS
COUNTY OF Ottawa)

I, Richard Rademaker, state under oath that I am over 18 years of age, of sound mind, and if called upon could competently testify to the following:

- 1) I am a founding member and the CEO for The Licensing Resource Group (“LRG”).
- 2) Founded in 1991, LRG performs day-to-day administration, royalty management, compliance and enforcement services, marketing, merchandising, design and brand development for a number of colleges and universities throughout the United States.
- 3) LRG has managed Northern Illinois University’s brand and licensing program since 2000. The University’s brand includes the “NIU” mark, and many “NIU” items are not only offered locally, but nationally via the internet.
- 4) Northern Illinois University’s brands generated approximately \$105,000 in royalties during the 2006/2007 fiscal year.
- 5) Northern Illinois University has used their brand in the following trademark categories.
 14. Jewelry; namely, bracelets, rings, pendants, necklaces.
 16. Paper goods and printed material; namely, stationery, note pads, newsletters, books, magazines.
 18. Leather goods; namely, wallets, umbrellas, backpacks, book bags, sports bags.
 21. Novelty items; namely, mugs, shot glasses, coffee cups.
 24. Fabrics; namely, golf towels, beach towels.
 25. Clothing; namely, shirts, tops, sweatshirts, short sets, jerseys, and headgear; namely, hats, visors.
 28. Sporting goods and games; namely, golf balls, footballs.
 41. Educational and entertainment; namely, sporting events, training seminars.

10) LRG is not aware of any competing marks currently existing in commerce.

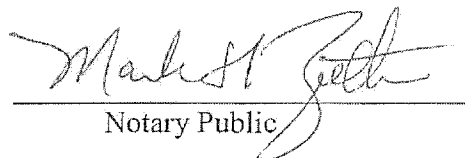
Further Affiant sayeth not.

The undersigned, being hereby warned that willful false statements are made punishable by fine or imprisonment, or both, and that such willful false statements may jeopardize the validity of Northern Illinois University's application and/or registration, declares that he is properly authorized to execute this document on behalf of the University, and believes the University to be entitled to use the marks identified above in commerce, and that no other person, firm, corporation, or association has the right to use the marks in commerce, either in the identical form or in such near resemblance when used on or in connection with the goods/services provided by the University to cause confusion, mistake or to deceive, and that the statements included above are made of his own knowledge and are true, or made upon information and belief to be true.



Richard Rademaker, CEO
Licensing Resource Group
442 Century Lane, Suite 100
Holland, Michigan 49423
(616) 395-0676

Signed and sworn before me on this 12th day of November, 2007.


Notary Public

MARK H. ZIETLOW
NOTARY PUBLIC, STATE OF MICHIGAN
COUNTY OF OTTAWA
MY COMMISSION EXPIRES 12-25-2007
ACTING IN THE COUNTY OF Ottawa

AFFIDAVIT

STATE OF ILLINOIS)
)
COUNTY OF DEKALB) ss

I, Kenneth L. Davidson, state under oath that I am over 18 years of age, of sound mind, and if called upon could competently testify to the following:

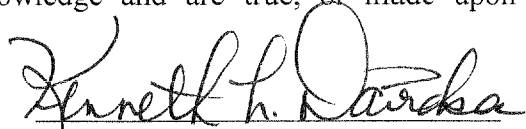
- 1) I am the Vice President and General Counsel for Northern Illinois University.
- 2) Northern Illinois University (“NIU”) was chartered in 1895 and is a comprehensive teaching and research institution with a diverse and international student body of more than 25,000.
- 3) NIU is also a Division 1 member of the National Collegiate Athletic Association (“NCAA”) and Mid-American Athletic Conference.
- 4) NIU has extensively used “Northern Illinois University” and “NIU” in connection with entertainment services, sporting activities, athletic apparel and equipment in addition to its educational research and training services, since July 7, 1957.
- 5) Northern Illinois University has an annual operating budget of over \$16,000,000 and receives over \$110,000 annually in royalties from retail sales involving the NIU mark.
- 6) NIU spends approximately \$500,000 annually in marketing initiatives. These expenditures do not include the extraordinary amount of money expended independently by the NCAA advertising NIU in paper or electronic media, or the amount of publicity the marks enjoy in non-athletic related activities in the media associated with the University’s educational, community and research agenda.
- 7) As a result of NIU’s long, extensive and substantially exclusive use, the marks have become well known in a favorable context to the public and enjoy tremendous goodwill, thereby representing a valuable asset of our client.
- 8) The marks have become distinctive of the University’s goods and services due to its substantive and continuous use in commerce on a national level for almost fifty (50) years.
- 9) Licensing Resource Group (“LRG”) manages the University’s marks and licensing program. According to Todd Rathjen, Director of Operations at LRG, NIU has used the proposed marks in the following trademark categories.

14. Jewelry; namely, bracelets, rings, pendants, necklaces.

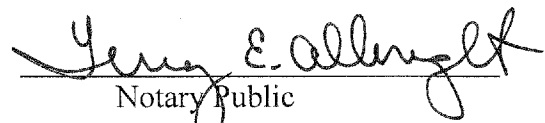
- 16. Paper goods and printed material; namely, stationery, note pads, newsletters, books, magazines.
 - 18. Leather goods; namely, wallets, umbrellas, backpacks, book bags, sports bags.
 - 21. Novelty items; namely, mugs, shot glasses, coffee cups.
 - 24. Fabrics; namely, golf towels, beach towels.
 - 25. Clothing; namely, shirts, tops, sweatshirts, short sets, jerseys, and headgear; namely, hats, visors.
 - 28. Sporting goods and games; namely, golf balls, footballs.
 - 41. Educational and entertainment; namely, sporting events, training seminars.
- 10) NIU sent a cease and desist letter via certified mail to Marble Sportswear, Inc. in June 2007, notifying Marble Sportswear they were infringing upon NIU's rights, but Marble Sportswear refused to respond and even persists in its efforts to secure the "NIU" trademark.

Further Affiant sayeth not.

The undersigned, being hereby warned that willful false statements are made punishable by fine or imprisonment, or both, and that such willful false statements may jeopardize the validity of Northern Illinois University's application and/or registration, declares that he is properly authorized to execute this document on behalf of the University, and believes the University to be entitled to use the marks identified above in commerce, and that no other person, firm, corporation, or association has the right to use the marks in commerce, either in the identical form or in such near resemblance when used on or in connection with the goods/services provided by the University to cause confusion, mistake or to deceive, and that the statements included above are made of his own knowledge and are true, or made upon information and belief to be true.


Kenneth L. Davidson

Signed and sworn before me on this 31st day of October, 2007.


Notary Public

