

ESTTA Tracking number: **ESTTA599872**

Filing date: **04/22/2014**

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	Regents of the University of Minnesota
Granted to Date of previous extension	04/23/2014
Address	200 Oak Street SE, Suite 360 Minneapolis, MN 55455-2006 UNITED STATES

Attorney information	ELIZABETH C. BUCKINGHAM DORSEY & WHITNEY LLP 50 SOUTH SIXTH STREET SUITE 1500 MINNEAPOLIS, MN 55042-1498 UNITED STATES IP.DOCKET@DORSEY.COM, BUCKINGHAM.ELIZABETH@DORSEY.COM, REDMOND.HEATHER@DORSEY.COM, CAD- WELL.JEFFREY@DORSEY.COM Phone:612-343-2178
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### Applicant Information

Application No	86057718	Publication date	12/24/2013
Opposition Filing Date	04/22/2014	Opposition Period Ends	04/23/2014
Applicant	The University of Tennessee 719 Andy Holt Tower Knoxville, TN 37996 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 2013/06/15 First Use In Commerce: 2013/06/15  
All goods and services in the class are opposed, namely: Headwear; Short-sleeved or long-sleevedt-shirts

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BRICK BY BRICK		
Goods/Services	SERVICES IN THE NATURE OF ORGANIZING, ARRANGING AND		

	CONDUCTING ATHLETIC COMPETITIONS AND EVENTS
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Related Proceedings	86/057,767 (BRICK BY BRICK application in class 41) is also being opposed
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Attachments	Class 25.pdf(234939 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	/Elizabeth C. Buckingham/
Name	ELIZABETH C. BUCKINGHAM
Date	04/22/2014

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

In the matter of trademark application Serial No.: 86/057,718  
Filed: September 6, 2013  
For the mark: **BRICK BY BRICK**  
Published in the Official Gazette on: December 24, 2013

Regents of the University of Minnesota	)	
	)	
vs.                    Opposer,	)	Opposition No: _____
	)	
The University of Tennessee	)	Opposer's File No.: M244854
	)	
Applicant.	)	
	)	

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Opposer, Regents of the University of Minnesota, a constitutional corporation organized and existing under the laws of the State of Minnesota and having a place of business at 200 Oak Street SE, Suite 360, Minneapolis, Minnesota 55455-2006, believes that it will be damaged by registration of the mark that is the subject of the above-identified application, and hereby opposes the same under the provisions of Title 15 of the U.S. Code, including, but not limited to, Sections 1052 and 1063.

The grounds for opposition are as follows:

(1) Applicant, The University of Tennessee, a Tennessee public educational corporation having an address of 719 Andy Holt Tower, Knoxville, Tennessee 37996, has applied for registration on the Principal Register of the mark **BRICK BY BRICK** for use with "Headwear; Short-sleeved or long-sleeved t-shirts" in International Class 25 (the "Application"). The

Application was filed on September 6, 2013, assigned Serial No. 86/057,718, and published for opposition on December 24, 2013. Applicant claims June 15, 2013, as both its date of first use anywhere of the mark and its date of first use in commerce of the mark.

(2) The Application was published for opposition in the *Official Gazette* on December 24, 2013.

(3) Opposer requested and was granted an initial 30-day extension of the deadline to file an opposition to the Application by the Trademark Trial and Appeal Board ("TTAB"), which extended the deadline to January 23, 2014.

(4) Opposer requested and was granted a subsequent 60-day extension of the deadline to file an opposition to the Application by the TTAB, which extended the deadline to April 23, 2014.

(5) Opposer was established in 1851 pursuant to Chapter 3 of the Minnesota Territorial Laws of 1851. Article 8, Section 3, of the Constitution of the State of Minnesota, adopted on October 13, 1857, perpetuated all of the rights, immunities, franchises, and endowments granted or conferred upon the University by the Territorial Laws.

(6) Pursuant to its charter, Opposer operates as an institution of higher education that currently serves over 65,000 students at five campuses across the State of Minnesota. The largest of these campuses is located in the Twin Cities of Minneapolis and St. Paul (the "Twin Cities Campus").

(7) In addition to educational services, Opposer offers services in the nature of organizing, arranging, and conducting intercollegiate, intramural, and recreational athletic competitions and events. On the Twin Cities Campus, these services include fielding a football team, the Golden Gophers (collectively, the team and the football program referred to herein as

the "Team"), which competes at the Division I Football Bowl Subdivision ("FBS") level of the National Collegiate Athletic Association ("NCAA").

(8) Since at least as early as April 23, 2011, Opposer has continuously used the mark **BRICK BY BRICK** in connection with services related to the Team. Opposer has used the mark in various ways, including but not limited to the following examples: (a) on nationwide mailings to student athletes it has recruited to join the Team; (b) as a header and in other sections of a website devoted to the Team; (c) in connection with a series of online videos about the Team; and (d) on mailings to season ticket holders and prospective season ticket holders for Team games.

(9) Opposer has expended substantial amounts of money, time, and effort in promoting Opposer's **BRICK BY BRICK** mark nationwide such that the relevant public has come to identify and associate the **BRICK BY BRICK** mark with Opposer. In particular, Opposer has generated substantial goodwill in its **BRICK BY BRICK** mark among Team members and coaches, opposing football team members and coaches, potential Team recruits, fans that follow the Team, college football fans in general, media outlets that cover the Team and college football in general, students, prospective students, alumni, donors to the Team, and other relevant members of the public.

(10) Applicant is also an institution of higher education, with its main campus located in Knoxville, Tennessee.

(11) Applicant fields a football team, the Tennessee Volunteers, that also participates at the NCAA Division I FBS level.

(12) Based on information and belief, Applicant has used the **BRICK BY BRICK** mark primarily in connection with Applicant's football team.

(13) As between Opposer and Applicant, there is no question as to priority.

Opposer's first use of the **BRICK BY BRICK** mark in 2011 is prior to June 15, 2013, which is the date Applicant alleged in the Application that it first used the mark both anywhere and in interstate commerce.

(14) The goods Applicant has sought to register are highly related to the services offered by Opposer under its **BRICK BY BRICK** mark.

(15) FBS level collegiate football programs have in the past and do currently offer fans and other interested parties the opportunity to show their support by purchasing officially licensed merchandise, including clothing.

(16) Applicant offers football-related services and clothing under the **BRICK BY BRICK** mark it has applied to register.


(17) The goods Applicant has sought to register will be offered in the same channels of trade and to the same classes of consumers as the services offered by Opposer under its **BRICK BY BRICK** mark.

(18) As a result of the confusing similarity between Opposer's and Applicant's marks, because the goods of Applicant and the services of Opposer are highly related, and because the goods and services are offered in overlapping channels of commerce and directed to overlapping classes of customers, registration of Applicant's **BRICK BY BRICK** mark for the goods Applicant has sought to register is likely to cause confusion or mistake or is likely to deceive purchasers as to the source or sponsorship of such goods. Accordingly, Applicant's **BRICK BY BRICK** mark is not entitled to registration pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that registration of the Application be refused under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).


Respectfully submitted,  
REGENTS OF THE UNIVERSITY OF MINNESOTA

Date: April ~~20~~ 22, 2014

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**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) on this 22 day of April, 2014.

  
Elizabeth C. Buckingham,  
Attorney for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document has been served via first class mail on Applicant's attorney of record, Wade R. Orr, c/o LUEDEKA NEELY GROUP PC, PO BOX 1871, KNOXVILLE, TENNESSEE 37901-1871, this 22 day of April, 2014.

  
Elizabeth C. Buckingham,  
Attorney for Opposer