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ESTTA Tracking number: **ESTTA644475**

Filing date: **12/15/2014**

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	New York Institute of Technology
Granted to Date of previous extension	12/14/2014
Address	Northern Boulevard Old Westbury, NY 11568-8000 UNITED STATES

Attorney information	Patrick J. Gallagher Fulbright & Jaworski LLP 98 San Jacinto Boulevard, Suite 1100 Austin, TX 78701-4255 UNITED STATES martin.rosenfeld@nortonrosefulbright.com, nyipdocket@nortonrosefulbright.com, patrick.gallagher@nortonrosefulbright.com Phone:1 612 321 2812

Applicant Information

Application No	86122972	Publication date	06/17/2014
Opposition Filing Date	12/15/2014	Opposition Period Ends	12/14/2014
Applicant	New York Technology Council, Inc. 307 West 38th Street, Suite 1305 New York, NY 10018 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Educational services, namely, conducting seminars, webinars, classes, workshops, conferences, and panel discussions in the fields of business, technology, funding, investing, legal and accounting anddistribution of educational materials in connection therewith

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1640814	Application Date	05/31/1989
Registration Date	04/09/1991	Foreign Priority Date	NONE

Word Mark	NEW YORK TECH
Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1958/12/00 First Use In Commerce: 1958/12/00 [EDUCATIONAL SERVICES, NAMELY, -PROVIDING COURSES OF IN-STRUCTION AT THE COLLEGE AND GRADUATE LEVEL; PROVIDING COURSES AND PROGRAMS OF CONTINUING EDUCATION FORCREDIT AND/OR NONCREDIT;] PROVIDING EDUCATIONAL AND ATHLETIC COURSES AND PROGRAMS FOR MINORS; ORGANIZING, ARRANGING AN-DCONDUCTING ATHLETIC, CULTURAL AND SOCIAL ACTIVITIES

U.S. Registration No.	1634896	Application Date	05/31/1989
Registration Date	02/12/1991	Foreign Priority Date	NONE
Word Mark	NEW YORK TECH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1962/09/00 First Use In Commerce: 1962/09/00 CLOTHING ARTICLES, NAMELY, T-SHIRTS, SWEATSHIRTS AND SWEAT-PANTS, WARMUP JACKETSAND PANTS, ATHLETIC UNIFORMS		

U.S. Registration No.	1640475	Application Date	05/31/1989
Registration Date	04/09/1991	Foreign Priority Date	NONE
Word Mark	NEW YORK TECH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1958/12/00 First Use In Commerce: 1958/12/00 printed matter, namely, - calendars, diaries, academic catalogs, coursebooks, academic directories, laboratory books, textbooks, lecture notes and outlines, academic lists, forms, schedules, certificates, diplomas and posters; stationery products, namely, - folders, paper or file holders, file or book crates, ring bind-ers, shopping bags		

Attachments	NOP 86122972.pdf(109592 bytes) Exhibit A to NOP 86122972.pdf(152928 bytes)

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	/Patrick J. Gallagher/
Name	Patrick J. Gallagher

Date	12/15/2014

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

In the matter of Application Serial No. 86/122,972 by New York Technology Council, Inc.
to register the mark NYTECH NEW YORK TECHNOLOGY COUNCIL
Published June 17, 2014

NEW YORK INSTITUTE OF TECHNOLOGY, Opposer, v. New York Technology Council, Inc., Applicant.	Opposition No. _____

NOTICE OF OPPOSITION

NEW YORK INSTITUTE OF TECHNOLOGY ("NYIT" or "Opposer"), a New York educational corporation, having a place of business at Old Westbury, New York 11568, believes that it will be damaged by registration of Application Serial No. 86/122,972 for the mark NYTECH NEW YORK TECHNOLOGY COUNCIL and hereby opposes the same under the provisions of 15 U.S.C. § 1063.

As grounds for opposition, Opposer asserts that:

1. On November 19, 2013, New York Technology Council, Inc. ("Applicant") filed Application Serial No. 86/122,972 to register NYTECH NEW YORK TECHNOLOGY COUNCIL ("Applicant's Mark") based on Applicant's *bona fide* intent-to-use the mark in commerce with the following services: educational services, namely, conducting seminars, webinars, classes, workshops, conferences, and panel discussions in the fields of business, technology, funding, investing, legal and accounting and distribution of educational materials in connection therewith, in International Class 41.

2. Opposer has continuously, since at least as early as December, 1958, used the NEW YORK TECH mark in connection with providing educational and athletic courses and

programs for minors; organizing, arranging and conducting athletic, cultural and social activities. Opposer uses its NEW YORK TECH mark for a variety of goods and services offered in connection with its educational and athletic courses.

3. NYIT owns the following federal trademark registrations:

Mark	**Reg. No./Serial No./ Date**	**Classes/Goods/Services**
NEW YORK TECH	1,640,814 April 9, 1991	41 - providing educational and athletic courses and programs for minors; organizing, arranging and conducting athletic, cultural and social activities.
NEW YORK TECH	1,634,896 February 12, 1991	25 - clothing articles, namely, t-shirts, sweatshirts and sweatpants, warmup jackets and pants, athletic uniforms
NEW YORK TECH	1,640,475 April 9, 1991	16 - printed matter, namely, - calendars, diaries, academic catalogs, coursebooks, academic directories, laboratory books, textbooks, lecture notes and outlines, academic lists, forms, schedules, certificates, diplomas and posters; stationery products, namely, - folders, paper or file holders, file or book crates, ring binders, shopping bags

The foregoing registrations, and all common law rights in the NEW YORK TECH mark are referred to herein as "Opposer's Mark." The registrations for Opposer's Mark are valid,

subsisting and enforceable (Printouts from the TSDR database for each of these registrations are attached as Exhibit A). Registration Nos. 1640814; 1634896; and 1640475 are incontestable.

4. By virtue of promotional and advertising activities, Opposer has gained a valuable reputation for its NEW YORK TECH mark and has created an exclusive association between NEW YORK TECH and its services in the minds of the buying public. Moreover, Opposer's Mark acquired distinctiveness long before Applicant applied for or used Applicant's Mark.

5. Opposer will be damaged by the registration of Applicant's Mark because Applicant's Mark so closely resembles Opposer's Mark, and proposed to be used in connection with identical services, so as to be likely to cause confusion, mistake, and deception.

6. Priority is not an issue. Opposer has used Opposer's Mark since prior to Applicant's application date of November 19, 2013. Applicant has not yet alleged a date of first use.

7. Purchasers and prospective purchasers are likely to falsely believe that services offered under Applicant's Mark are sponsored, endorsed, or approved by NYIT, or are in some way affiliated, connected, or associated with NYIT or Opposer's Mark. Therefore, registration of Applicant's Mark should be refused under 15 U.S.C. § 1052(d).

8. Registration of Applicant's Mark would be a source of damage to Opposer because it would enable Applicant to trade on and receive the benefit of the goodwill in the NEW YORK TECH mark, which Opposer has built up at great labor and expense over decades.

9. Opposer will be further damaged by registration of the Applicant's Mark because registration would provide Applicant with various statutory presumptions to which it is not entitled.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice Of Opposition has been served by mailing said copy on December 15, 2015, via First Class Mail, postage prepaid to:

Mary Sotis
Sarah Y. Lippman
Frankfurt Kurnit Klein & Selz, PC
488 Madison Ave FL 10
New York, New York 10022-5754
United States

/patrick j. gallagher/
Attorney for Opposer

Int. Cl.: 16

Prior U.S. Cl.: 38

Reg. No. 1,640,475

United States Patent and Trademark Office

Registered Apr. 9, 1991

TRADEMARK
PRINCIPAL REGISTER

NEW YORK TECH

NEW YORK INSTITUTE OF TECHNOLOGY (NEW YORK EDUCATIONAL CORPORATION)
NORTHERN BLVD.
OLD WESTBURY, NY 11568

FOR: PRINTED MATTER, NAMELY, - CALENDARS, DIARIES, ACADEMIC CATALOGS, COURSEBOOKS, ACADEMIC DIRECTORIES, LABORATORY BOOKS, TEXTBOOKS, LECTURE NOTES AND OUTLINES, ACADEMIC LISTS, FORMS, SCHEDULES, CERTIFICATES, DIPLOMAS AND POSTERS; STATIONERY PRODUCTS, NAMELY, - FOLDERS, PAPER OR FILE HOLDERS, FILE OR BOOK CRATES, RING BINDERS, SHOPPING BAGS, IN CLASS 16 (U.S. CL. 38).

FIRST USE 12-0-1958; IN COMMERCE 12-0-1958.

SEC. 2(F).

SER. NO. 74-800,022, FILED 5-31-1989.

LIZ KULICK, EXAMINING ATTORNEY

Side - 1

NOTICE OF ACCEPTANCE OF §8 DECLARATION AND §9 RENEWAL

MAILING DATE: Apr 11, 2011

The declaration and renewal application filed in connection with the registration identified below meets the requirements of Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§1058 and 1059. The declaration is accepted and renewal is granted. The registration remains in force.

For further information about this notice, visit our website at: http://www.uspto.gov. To review information regarding the referenced registration, go to http://tarr.uspto.gov.

REG NUMBER: **1640475**
MARK: **NEW YORK TECH**
OWNER: **New York Institute Of Technology**

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

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Mark N. Mutterperl
Fulbright & Jaworski L.L.P.
666 Fifth Avenue
NEW YORK, NY 10103

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

REGISTRATION NO: 1634896 SERIAL NO: 74/800021 MAILING DATE: 02/12/2011
REGISTRATION DATE: 02/12/1991
MARK: NEW YORK TECH
REGISTRATION OWNER: NEW YORK INSTITUTE OF TECHNOLOGY

CORRESPONDENCE ADDRESS:

Mark N. Mutterperl
Fulbright & Jaworski LLP
666 Fifth Avenue
NEW YORK NY 10103-3198

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

****

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

****

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
025.

NO EMPLOYEE NAME FOUND
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

ORIGINAL

Int. Cl.: 41

Prior U.S. Cl.: 107

Reg. No. 1,640,814

United States Patent and Trademark Office Registered Apr. 9, 1991

SERVICE MARK
PRINCIPAL REGISTER

NEW YORK TECH

NEW YORK INSTITUTE OF TECHNOLOGY (NEW YORK EDUCATIONAL CORPORATION)
NORTHERN BLVD.
OLD WESTBURY, NY 11568

FOR: EDUCATIONAL SERVICES, NAMELY, -PROVIDINGCOURSES OF INSTRUCTION AT THE COLLEGE AND GRADUATE LEVEL; PROVIDING COURSES OF INSTRUCTION AT CONTINUING EDUCATION FOR CREDIT AND/OR NONCREDIT; PROVIDING EDUCATIONAL AND ATHLETIC COURSES AND PROGRAMS FOR MINORS; ORGANIZING, ARRANGING AND CONDUCTING ATHLETIC, CULTURAL AND SOCIAL ACTIVITIES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 12-0-1958; IN COMMERCE 12-0-1958.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TECH", APART FROM THE MARK AS SHOWN.

SEC. 2(F).

SER. NO. 73-803,599, FILED 5-31-1989.

LIZ KULICK, EXAMINING ATTORNEY

Side - 1

NOTICE OF ACCEPTANCE OF §8 DECLARATION AND §9 RENEWAL
MAILING DATE: Apr 19, 2011

The declaration and renewal application filed in connection with the registration identified below meets the requirements of Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§1058 and 1059. The declaration is accepted and renewal is granted. The registration remains in force.

For further information about this notice, visit our website at: http://www.uspto.gov. To review information regarding the referenced registration, go to http://tarr.uspto.gov.

REG NUMBER:	**1640814**
MARK:	**NEW YORK TECH**
OWNER:	**NEW YORK INSTITUTE OF TECHNOLOGY**

Side - 2

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