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Filing date: **07/08/2015**

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

Proceeding	91222425
Party	Plaintiff The New School
Correspondence Address	Lynn M. Humphreys Morrison & Foerster LLP 425 Market Street San Francisco, CA 94105-2482 UNITED STATES TMDocket@mofo.com, LHumphreys@mofo.com, LSimpson@mofo.com
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Lynn M. Humphreys/
Date	07/08/2015
Attachments	First Amended Notice of Opposition 13446-6001.503 (86402561).pdf(388981 bytes)

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

THE NEW SCHOOL

Opposer,

vs.

PARSONS XTREME GOLF, LLC,

Applicant.

Opposition No.: 91222425

Application No.: 86/402,561

Mark::PARSONS XTREME

Filed: September 22, 2014

Published for Opposition: February 17, 2015

FIRST AMENDED NOTICE OF OPPOSITION

Opposer filed a Notice of Opposition on June 17, 2015. Pursuant to Trademark Trial and Appeal Board Manual of Procedure (TBMP) Rule 507.1, Opposer may amend its pleading within 21 days as a matter of course. Accordingly, Opposer hereby serves the First Amended Notice of Opposition.

Opposer, The New School, (“Opposer”), a New York corporation having its principal place of business at 66 W. 12th Street, New York, NY 10011, believes that it will be damaged by registration of the mark shown in Application Serial No. 86/402,561 (“the Application”), filed by Parsons Xtreme Golf, LLC (“Applicant”), a Delaware limited liability company having its principal place of business at 15475 N. 84th Street, Scottsdale, AZ 85260, on September 22, 2014, and hereby opposes the same.

As grounds for the opposition, it is alleged as follows:

1. The New School is a private university in New York City, founded in 1919. The New School’s Parsons School of Design, widely known and referred to under the mark PARSONS, is an art and design school that is one of the five schools of The New School. Parsons was the first school in the United States to offer programs in fashion design, graphic

design, and advertising, and has been offering its design curriculum under the PARSONS name since 1941. Parsons is widely regarded as one of the most prestigious art and design schools in the world. Since substantially prior to the filing date of the Application, and any use by Applicant of the mark in the Application, Opposer has continuously used the PARSONS mark in connection with its wide range of educational and design-related services.

OPPOSER'S RIGHTS

2. Opposer owns U.S. Registration No. 2,475,942 for the PARSONS mark for “educational services, namely, providing on and off site lectures and instruction at the undergraduate, graduate, and adult education levels in the fields of fine arts, liberal arts, environmental design, communications design, illustration, interior design, fashion design, product design, photography, and architecture” in International Class 41. U.S. Registration No. 2,475,942 issued on August 7, 2001, from an application filed on Jun. 8, 2000, and has attained incontestable status. Attached as Exhibit A are true and correct copies of the registration certificate, Notice of Acceptance of Section 8 and Section 15 Affidavits, Notice of Acceptance of Section 8 Declaration and Section 9 Renewal, Assignment, and the TSDR record for U.S. Registration No. 2,475,942. Opposer owns the mark covered by this registration, the registration itself, and the goodwill and reputation of the services connected with and symbolized by the mark. Opposer has used the mark in connection with these services since long prior to the filing date of the Application.

3. Opposer has continuously offered and promoted its wide range of educational and design services under the PARSONS mark since at least as early as 1941. Through continuous use and promotion of its marks, Opposer has acquired common law rights in the PARSONS mark.

LIKELIHOOD OF CONFUSION AND FALSE SUGGESTION OF A CONNECTION

4. By its Application Serial No. 86/402,561, Applicant seeks to register the mark PARSONS XTREME for “Retail store services and on-line retail store services in the field of golf equipment, clothing, eyewear, footwear, headwear, bags of all kinds, umbrellas, accessories

made of leather and imitations of leather, and accessories for all of the foregoing goods; providing on-line consumer product information in the field of golf-related products and services; providing on-line product registration services for golf-related products for the purpose of providing customer service in the field of golf-related products and services; advertising and marketing” in International Class 35.

5. This application was filed on September 22, 2014 on an intent-to-use basis, well after Opposer’s first use of its PARSONS mark and well after Opposer registered its PARSONS mark.

6. Applicant’s PARSONS XTREME mark is substantially similar in sight, sound, meaning, and commercial impression to Opposer’s PARSONS mark as to be likely to cause confusion, or to cause mistake, or to deceive, and to falsely suggest a connection with Opposer.

7. PARSONS is the dominant element in both Applicant’s and Opposer’s marks because it is the first word. Thus, PARSONS is the word most likely to be remembered and used by consumers to indicate the source of the respective goods and services. The term XTREME is a variation of the word “extreme,” which is a laudatory adjective and does not serve to distinguish Applicant’s mark from Opposer’s well-known mark. Consumers are likely to believe that Applicant’s Parsons School of Design, an institution widely known for its cutting-edge approach to design, is the source of PARSONS XTREME products and services. Therefore, Applicant’s mark and Opposer’s mark are confusingly similar in appearance, sound, meaning, connotation, and commercial impression. Moreover, Opposer’s PARSONS mark points uniquely and unmistakably to Opposer’s Parsons School of Design in the fields of product and fashion design, and Applicant’s mark falsely suggests a connection with Opposer.

8. On information and belief, Applicant’s services are related and complementary to the design education services that Opposer offers under its PARSONS mark. Parsons is a leading school for art and design, including graphic design, advertising, product, and fashion design in the United States. Parsons is known to have educated some of the most renowned and innovative designers behind leading brands. Furthermore, as part of the design program curriculum, Parsons students design and present a wide variety of products and collections for

public exhibition in the fields of product design, fashion, technology, and advertising. On information and belief, Applicant will be offering its retail services to consumers interested in innovative design, and who are likely to be familiar with Opposer's PARSONS mark and renowned design school.

9. On information and belief, Applicant intends to offer its proposed goods through channels of trade that may overlap with those used by Opposer for its services under the PARSONS mark or to consumers familiar with the Parsons School of Design.

10. In view of the fact that Applicant's PARSONS XTREME mark is substantially similar in sight, sound, meaning, and commercial impression to Opposer's PARSONS mark; that on information and belief, Applicant's goods and Opposer's services are related and complementary and that the channels of trade and customer bases for Applicant's and Opposer's respective services appear to be the same or overlapping, Applicant's PARSONS XTREME mark so resembles Opposer's PARSONS mark as to be likely to cause confusion, or to cause mistake, or to deceive under 15 U.S.C. § 1052(d). Additionally, Opposer's PARSONS mark is widely known in the fields of product and fashion design, and Applicant's mark falsely suggests a connection with Opposer under 15 U.S.C. § 1052(a). Opposer would thereby be damaged by registration of Applicant's PARSONS XTREME mark. Opposer's goodwill and reputation will be jeopardized by Applicant's use and registration of the PARSONS XTREME mark.

PRIMARILY MERELY A SURNAME

11. On information and belief, Applicant's mark is primarily the surname of Robert (Bob) Parsons, the founder of Applicant Parsons Xtreme Golf. Attached as Exhibit B is a true and correct copy of the *What Do The Numbers Mean?* page printed on July 8, 2015 from Applicant's website at http://pxg.com/PXG_What_Numbers_Mean.pdf. As noted above, the term XTREME is a variation of the word "extreme" and is merely a laudatory adjective, while the word GOLF is generic and has been disclaimed by the Applicant. Accordingly, Applicant's mark is primarily merely a surname, which is non-registrable under 15 U.S.C. § 1052(e)(4).

12. Moreover, Applicant filed the Application on September 23, 2014 on an intent-to-use basis. Applicant has not yet filed a Statement of Use. Accordingly, on information and belief, the Mark is a non-registrable surname that has not become distinctive as used in connection with Applicant's goods or services as required by 15 U.S.C. § 1052(f).

13. For the above-mentioned reasons, Opposer will be damaged by the registration of Applicant's mark.

WHEREFORE, Opposer prays that application Serial No. 86/402,561 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,



Lynn M. Humphreys
Attorney for Opposer
The New School

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6327
Facsimile: (415) 268-7522

Dated: July 8, 2015

EXHIBIT A

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 2,475,942

United States Patent and Trademark Office

Registered Aug. 7, 2001

**SERVICE MARK
PRINCIPAL REGISTER**

PARSONS

NEW SCHOOL UNIVERSITY (NEW YORK COR-
PORATION)
66 WEST 12TH STREET
NEW YORK, NY 10011

DESIGN, ILLUSTRATION, INTERIOR DESIGN,
FASHION DESIGN, PRODUCT DESIGN, PHOTO-
GRAPHY, AND ARCHITECTURE, IN CLASS 41 (U.S.
CLS. 100, 101 AND 107).

FOR: EDUCATIONAL SERVICES, NAMELY,
PROVIDING ON AND OFF SITE LECTURES AND
INSTRUCTION AT THE UNDERGRADUATE,
GRADUATE, AND ADULT EDUCATION LEVELS
IN THE FIELDS OF FINE ARTS, LIBERAL ARTS,
ENVIRONMENTAL DESIGN, COMMUNICATIONS

FIRST USE 0-0-1941; IN COMMERCE 0-0-1941.

SER. NO. 78-011,900, FILED 6-8-2000.

STEVEN BERK, EXAMINING ATTORNEY



UNITED STATES PATENT AND TRADEMARK OFFICE

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

REGISTRATION NO: 2475942 SERIAL NO: 78/011900 MAILING DATE: 09/10/2007
REGISTRATION DATE: 08/07/2001
MARK: PARSONS
REGISTRATION OWNER: THE NEW SCHOOL

CORRESPONDENCE ADDRESS:

Mark A. Fowler
Satterlee Stephens Burke & Burke LLP
Suite 1130
230 Park Avenue
New York NY 10169

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(1)

THE COMBINED AFFIDAVIT 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 ACKNOWLEDGEMENT

15 U.S.C. Sec. 1065

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 15 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1065.

ACCORDINGLY, THE SECTION 15 AFFIDAVIT IS ACKNOWLEDGED.

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

041.

THOMPkins, LISA LORRIN
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

Side - 1



**NOTICE OF ACCEPTANCE OF §8
DECLARATION AND §9 RENEWAL
MAILING DATE: Feb 8, 2012**

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: 2475942
MARK: PARSONS
OWNER: THE NEW SCHOOL

Side - 2

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

FIRST-CLASS
MAIL
U.S POSTAGE
PAID

Lynn M. Humphreys
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105-2482

TRADEMARK ASSIGNMENT

Electronic Version v1.1
 Stylesheet Version v1.1

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	CHANGE OF NAME

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
New School University	FORMERLY New School for Social Research	06/21/2005	CORPORATION: NEW YORK

RECEIVING PARTY DATA

Name:	The New School
Street Address:	66 W 12th St
City:	New York
State/Country:	NEW YORK
Postal Code:	10011
Entity Type:	CORPORATION: NEW YORK

PROPERTY NUMBERS Total: 7

Property Type	Number	Word Mark
Registration Number:	2009281	THE NEW SCHOOL
Registration Number:	1920284	MANNES
Registration Number:	2475942	PARSONS
Registration Number:	2554142	THE SHORTEST DISTANCE TO KNOWLEDGE
Registration Number:	2744943	KOIP
Registration Number:	3034487	MILANO MIX
Registration Number:	3062394	PIIM

CORRESPONDENCE DATA

Fax Number: (312)782-6494
Correspondence will be sent via US Mail when the fax attempt is unsuccessful.
 Phone: 312=782-6495
 Email: daniel@keganlaw.com
 Correspondent Name: Daniel Kegan
 Address Line 1: 79 W Monroe St #1320

OP \$190.00 2009281

Address Line 4: Chicago, ILLINOIS 60603-4969

ATTORNEY DOCKET NUMBER: NEW SCHOOL NAME CHANGE @7

NAME OF SUBMITTER: Daniel Kegan

Signature: /daniel kegan/

Date: 10/09/2006

Total Attachments: 1
source=NewSchool-NameJun05#page1.tif

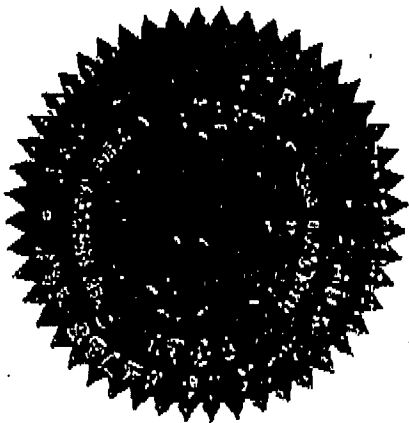


THE NEW SCHOOL
AMENDMENT OF CHARTER

This Instrument Witnesseth That the Board of Regents for and on behalf of the Education Department of the State of New York at their meeting of June 21, 2005,

An application having been made by and on behalf of the trustees of New School University, for an amendment of its charter, it was

Voted, that the provisional charter of New School University, located in the city, county, and state of New York, which was granted by action of the Board of Regents on June 22, 1934 under the corporate name "New School for Social Research"; which provisional charter was made absolute by Regents action on January 17, 1941; such charter having been amended on various occasions, the last amendment having been granted on June 17, 2003, and the corporation was consolidated by Regents action on June 22, 1984 with the Parsons School of Design, an education corporation, and consolidated by Regents action on September 24, 1993 with the Mannes College of Music, an education corporation be, and the same hereby is, amended to change the corporate name to "The New School" and to amend the names of the two academic divisions of the corporation from "Parsons School of Design" to "Parsons The New School for Design" and "Mannes College of Music" to "Mannes College The New School for Music."



Granted, June 21, 2005, by the Board of Regents of The University of the State of New York, for and on behalf of the State Education Department, and executed under the seal of said University and recorded as Number 23,972.

Tom Bennett
Chancellor

R. L. Hill
President of the University and
Commissioner of Education

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Mark: PARSONS

PARSONS

US Serial Number: 78011900 Application Filing Date: Jun. 08, 2000
US Registration Number: 2475942 Registration Date: Aug. 07, 2001
Register: Principal
Mark Type: Service Mark
Status: The registration has been renewed.
Status Date: Feb. 08, 2012
Publication Date: May 15, 2001

Mark Information

Mark Literal Elements: PARSONS
Standard Character Claim: No
Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Educational services, namely, providing on and off site lectures and instruction at the undergraduate, graduate, and adult education levels in the fields of fine arts, liberal arts, environmental design, communications design, illustration, interior design, fashion design, product design, photography, and architecture

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: 1941

Use in Commerce: 1941

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: THE NEW SCHOOL
Owner Address: 66 W 12TH ST
NEW YORK, NEW YORK 10011
UNITED STATES
Legal Entity Type: CORPORATION State or Country Where Organized: NEW YORK

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynn M. Humphreys Docket Number: 13446-600100
Attorney Primary Email Address: lhumphreys@mofo.com Attorney Email Authorized: No

Correspondent

Correspondent: Lynn M. Humphreys

Name/Address: Morrison & Foerster LLP
425 Market Street
San Francisco, CALIFORNIA 94105-2482
UNITED STATES

Phone: 415 268 6327

Fax: 415 268 7522

Correspondent e-mail: lhumphreys@mofo.com

Correspondent e-mail No
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 08, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - MAILED	
Feb. 08, 2012	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	70131
Feb. 08, 2012	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	70131
Feb. 07, 2012	TEAS SECTION 8 & 9 RECEIVED	
Feb. 07, 2012	ATTORNEY REVOKED AND/OR APPOINTED	
Feb. 07, 2012	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Sep. 10, 2007	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70131
Aug. 02, 2007	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Aug. 02, 2007	TEAS SECTION 8 & 15 RECEIVED	
Feb. 15, 2007	CASE FILE IN TICRS	
Oct. 11, 2006	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 07, 2001	REGISTERED-PRINCIPAL REGISTER	
May 15, 2001	PUBLISHED FOR OPPOSITION	
May 02, 2001	NOTICE OF PUBLICATION	
Nov. 21, 2000	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 24, 2000	ASSIGNED TO EXAMINER	76834

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Aug. 07, 2011

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Feb. 08, 2012

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: New School University

Assignment 1 of 1

Conveyance: CHANGE OF NAME

Reel/Frame: [3405/0392](#)

Pages: 3

Date Recorded: Oct. 09, 2006

Supporting Documents: [assignment-tm-3405-0392.pdf](#)

Assignor

Name: [NEW SCHOOL UNIVERSITY](#)

Execution Date: Jun. 21, 2005

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW YORK

DBA, AKA, TA, Formerly: FORMERLY NEW SCHOOL FOR SOCIAL RESEARCH

Assignee

Name: [THE NEW SCHOOL](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW YORK

Address: 66 W 12TH ST
NEW YORK, NEW YORK 10011

Correspondent

Correspondent Name: DANIEL KEGAN

Correspondent Address: 79 W MONROE ST #1320
CHICAGO, IL 60603-4969

Domestic Representative - Not Found

EXHIBIT B

WHAT THE NUMBERS MEAN

PXG founder Bob Parsons served as a rifleman with the United States Marine Corps during the Vietnam War. A recipient of the Purple Heart Medal, Combat Action Ribbon and Vietnamese Cross of Gallantry, Parsons credits his service in the Marine Corps for his successes in life.

PXG's unique club numbering system is a tribute to the brave men and women who serve in the United States Marine Corps. The Marine Corps' Military Occupational Specialty (MOS) is a system for categorizing career fields. All enlisted and officer Marines are assigned a four digit code denoting their occupational field and specialty.



DRIVER – MOS 0811

Field Artillery Cannoneer: As a member of a field artillery howitzer battery, cannoneers prepare artillery pieces and equipment for movement, combat and firing.



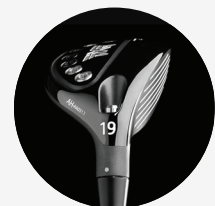
IRONS & WEDGES – MOS 0311

Rifleman: The riflemen employ the M16A2 service rifle, the M203 grenade launcher and the squad automatic weapon (SAW). Riflemen are the primary scouts, assault troops and close combat forces available to the Marine Air Ground Task Force.



FAIRWAY WOODS – MOS 0341

Mortarman: Mortarmen are responsible for the tactical deployment of the 60mm light mortar and the 81mm medium mortar. Mortarmen provide indirect fire in support of the rifle and LAR squads/platoons/companies and the infantry and LAR battalions. They are located in the weapons platoons of the rifle and LAR companies and the weapons company of the infantry battalion.



HYBRIDS – MOS 0317

Scout Sniper: The scout sniper is a Marine skilled in field craft and marksmanship who delivers long range, precision fire on selected targets from concealed positions in support of combat operations. They have a secondary mission of gathering information for intelligence purposes.

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on July 8, 2015 I served a copy of:

FIRST AMENDED NOTICE OF OPPOSITION

on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

Frankie Ho
YAM Capital
15475 N 84TH ST
Scottsdale, AZ 85260-1827

I declare under penalty of perjury under the laws of the United States and the State of California that the above is true and correct.

Executed at San Francisco, California, this 8th day of July, 2015.

Nguyet Tran
(typed)



(signature)