

ESTTA Tracking number: **ESTTA916138**

Filing date: **08/16/2018**

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 Regents of The University of Texas System
Granted to Date of previous extension	09/08/2018
Address	210 West 7th Street Austin, TX 78701 UNITED STATES

Attorney information	Alexandra H. Bistline Pirkey Barber PLLC 600 Congress Ave., Suite 2120 Suite 2120 Austin, TX 78701 UNITED STATES abistline@pirkeybarber.com, jmatthysse@pirkeybarber.com, bbarber@pirkeybarber.com, eolson@pirkeybarber.com, tmcentral@pirkeybarber.com 5123225200
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Applicant Information

Application No	86952132	Publication date	07/10/2018
Opposition Filing Date	08/16/2018	Opposition Period Ends	09/08/2018
Applicant	LongHorn Coffee 715 W Highland San Angelo, TX 76903 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. First Use: 2016/01/01 First Use In Commerce: 2016/01/01 All goods and services in the class are opposed, namely: Fresh Roasted Coffee

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1231408	Application Date	08/03/1981
Registration Date	03/15/1983	Foreign Priority Date	NONE
Word Mark	LONGHORNS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1914/00/00 First Use In Commerce: 1914/00/00 Entertainment Services-Namely, College Sport Games and Events Rendered Live and Through the Media of Radio and Television		

U.S. Registration No.	1342737	Application Date	08/27/1984
Registration Date	06/18/1985	Foreign Priority Date	NONE
Word Mark	LONGHORNS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 COLLEGE IMPRINTED DRINKING GLASSES, CUPS, JIGGERS AND SHOT GLASSES, NOT OF PRECIOUS METAL Class 025. First use: First Use: 1982/04/00 First Use In Commerce: 1982/04/00 COLLEGE IMPRINTED SHIRTS, T-SHIRTS, SWEATERS, JACKETS, CAPS, WARM-UP PANTS, RAINCOATS, PONCHOS, HAT BANDS AND SWEAT BANDS		

U.S. Registration No.	4512724	Application Date	01/04/2011
Registration Date	04/08/2014	Foreign Priority Date	NONE
Word Mark	LONGHORN NETWORK		
Design Mark	LONGHORN NETWORK		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2013/03/00 First Use In Commerce: 2013/03/00 Computer application software for mobile phones and mobile devices to enable users to access live and pre-recorded television programs and audio and video recordings in the fields of collegiate athletics, fine art and entertainment performances, collegiate life, seminars and lectures of an educational nature, and other collegiate events and to access previews, replays, sports-related information, current event news-related information, entertainment-related information, education information, and information in the field of television and audio and video entertainment, namely, information on television scheduling, television previews and television replays, all on their mobile phones and mobile devices Class 041. First use: First Use: 2011/08/26 First Use In Commerce: 2011/08/26 Entertainment services, namely, production and distribution of television pro-		

	grams; Entertainment and education in the nature of scheduling of programs in the fields of collegiate athletics, fine art and entertainment performances, collegiate life, seminars and lectures of an educational nature, and other collegiate events, all transmitted via a global computer network, via wireless and mobile devices, and through the mediums of television, interactive television, and radio; entertainment and education in the nature of programs in the fields of collegiate athletics, fine art and entertainment performances, collegiate life, seminars and lectures of an educational nature, and other collegiate events, all transmitted via a global computer network, via wireless and mobile devices, and through the mediums of television, interactive television, and radio; production and distribution of programs featuring collegiate athletics, fine art and entertainment performances, collegiate life, seminars and lectures of an educational nature, and other collegiate events, all programs able to be transmitted to the final consumer after distribution via a global computer network, via wireless and mobile devices, and through the mediums of television, interactive television, and radio; entertainment services, namely, providing sports-related information, providing current event news-related information, providing entertainment-related information, providing information about education, providing entertainment information in the field of television and audio and video entertainment, namely, information on television scheduling, television previews and television replays, all transmitted via a global computer network, via wireless and mobile devices, and through the mediums of television, interactive television, and radio; provision of non-downloadable sports programs in the nature of sports replays via video-on-demand service
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U.S. Registration No.	4751660	Application Date	10/15/2014
Registration Date	06/09/2015	Foreign Priority Date	NONE
Word Mark	LONGHORN BAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1903/00/00 First Use In Commerce: 1903/00/00 Educational services, namely, a collegiate level program for students to participate in a college band for course credit; entertainment services, namely, musical performances by a college band		

U.S. Registration No.	4917942	Application Date	04/20/2015
Registration Date	03/15/2016	Foreign Priority Date	NONE
Word Mark	LONGHORN RUN		

Design Mark	LONGHORN RUN
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2011/04/00 First Use In Commerce: 2011/04/00 Athletic and sports event services, namely, arranging, organizing, operating and conducting foot races; organizing and conducting foot races to raise money for university student programs

U.S. Registration No.	5001160	Application Date	05/14/2015
Registration Date	07/19/2016	Foreign Priority Date	NONE
Word Mark	LONGHORNS		
Design Mark	LONGHORNS		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Retail store services, namely, clothing, hats, gift items, mugs, drinking glasses, jewelry, fashion accessories, gourmet foods, sporting goods, bags, backpacks, and plush toys		

Attachments	85981200#TMSN.png(bytes) 86424090#TMSN.png(bytes) 86603301#TMSN.png(bytes) 86629769#TMSN.png(bytes) Notice of Opposition - UTEX755.pdf(22121 bytes)
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Signature	/Alexandra H. Bistline/
Name	Alexandra H. Bistline
Date	08/16/2018

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

In Re Serial No. 86/952,132	§	
Filed: March 24, 2016	§	
Mark: LONG*HORN COFFEE COMPANY	§	
Published: July 10, 2018	§	
	§	
The Board of Regents of	§	
The University of Texas System,	§	
	§	Opposition No. _____
Opposer,	§	
	§	
v.	§	
	§	
LongHorn Coffee composed of Scott Deckers,	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

The Board of Regents of the University of Texas System (“Opposer”), a state agency with a principal place of business at 210 West 7th Street, Austin, Texas 78701, believes that it will be damaged by registration of the mark shown in U.S. Serial No. 86/952,132, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts the following:

1. Opposer is a Texas state agency established for the purpose of governing The University of Texas System (the “UT System”), a system of highly regarded institutions of higher education, including The University of Texas at Austin (“UT” or “the University”). The powers and duties of Opposer are set forth generally at Chapter 65 of the Texas Education Code. Specific authority to manage and control the University is conferred upon Opposer by Chapter 67.02 of the Texas Education Code.

2. The flagship academic institution within the UT System is The University of Texas at Austin. Founded in 1883, UT is world-renowned for providing outstanding educational

services at the college and graduate levels. The University provides educational programs in a broad spectrum of disciplines, such as textiles and apparel, marketing, journalism, education, fine arts, liberal arts, and law. In addition to providing high-quality educational services, UT provides entertainment services, such as college athletics events, and related products and services.

3. Through its athletics department and recreational sports division, the University competes in many sports and activities, including football, basketball, baseball, golf, rowing, soccer, softball, swimming and diving, tennis, track and field, volleyball, and fishing. UT's teams have been highly successful over the years, winning numerous national and conference championships and other events.

4. Annually, UT's college athletics events are attended by hundreds of thousands of fans and are exhibited through radio, television, and internet broadcast to millions of viewers.

5. UT also operates an extensive trademark licensing program, through which it licenses its trademarks under controlled conditions for use in connection with a wide range of goods and services sold to the public. The University's licensed products are extremely popular, and its licensing program has grown to be one of the most successful collegiate licensing programs in the world.

6. In connection with these goods, and to promote its services and programs through the sale of licensed products, Opposer has adopted and long and continuously used the marks LONGHORN, LONGHORNS, LONGHORN BAND, LONGHORN FOUNDATION, LONGHORN RUN, LONGHORN NETWORK, and numerous other marks incorporating "LONGHORN" or "LONGHORNS" (the "LONGHORN Marks").

7. Opposer’s LONGHORN Marks are inherently distinctive, serving to identify and indicate the source of Opposer’s goods and services to the consuming public, and to distinguish Opposer’s goods and services from those of others. Opposer licenses the LONGHORN Marks to numerous third parties for use on a wide variety of goods and services, including restaurant services offering coffee, coffee mugs, bottled water, and related products and services.

8. As a result of Opposer’s use and promotion of its LONGHORN Marks, the marks have become distinctive and are recognized by consumers. Opposer has invested significant effort and resources in advertising and promoting its LONGHORN Marks and the products and services sold under those marks, with the result that the purchasing public has come to know, rely on, and recognize the goods and services of Opposer by those marks. Opposer has established valuable goodwill in its LONGHORN Marks.

9. Opposer’s LONGHORN Marks are famous within the meaning of 15 U.S.C. § 1125(c).

10. A student or fan of UT is often referred to as a “longhorn.”

11. In addition to its extensive common law rights, Opposer is the owner of numerous federal trademark registrations covering various LONGHORN Marks, including but not limited to the following:

Mark	U.S. Reg. No.	Registration Date	Goods & Services
LONGHORNS	1,231,408	March 15, 1983	Entertainment services – namely, college sport games and events rendered live and through the media of radio and television (Class 41)
LONGHORNS	1,342,737	June 18, 1985	College imprinted drinking glasses, cups, jiggers and shot glasses, not of precious metal (Class 21) College imprinted shirts, t-shirts,

Mark	U.S. Reg. No.	Registration Date	Goods & Services
			sweaters, jackets, caps, warm-up pants, raincoats, ponchos, hat bands and sweat bands (Class 25)
LONGHORN NETWORK	4,512,724	April 8, 2014	<p>Computer application software for mobile phones and mobile devices to enable users to access live and pre-recorded television programs and audio and video recordings in the fields of collegiate athletics, fine art and entertainment performances . . . (Class 9)</p> <p>Entertainment services, namely, production and distribution of television programs; Entertainment and education in the nature of scheduling of programs in the fields of collegiate athletics, fine art and entertainment performances . . . ; entertainment services, namely, providing sports-related information . . . (Class 41)</p>
LONGHORN BAND	4,751,660	June 9, 2015	Educational services, namely, a collegiate level program for students to participate in a college band for course credit; entertainment services, namely, musical performances by a college band (Class 41)
LONGHORN RUN	4,917,942	March 15, 2016	Athletic and sports event services, namely, arranging, organizing, operating and conducting foot races; organizing and conducting foot races to raise money for university student programs (Class 41)
LONGHORNS	5,001,160	July 19, 2016	Retail store services, namely, clothing, hats, gift items, mugs, drinking glasses, jewelry, fashion accessories, gourmet foods, sporting goods, bags, backpacks, and plush toys (Class 35)

Each registration listed in the chart above is valid and subsisting, and the first two are incontestable pursuant to 15 U.S.C. § 1065.

12. Applicant LongHorn Coffee composed of Scott Deckers (the “Applicant”) is a sole proprietorship with a principal place of business at 715 W Highland, San Angelo, Texas 76903. Applicant filed U.S. Serial No. 86/952,132 (the “Application”) pursuant to 15 U.S.C. § 1051(a) on March 24, 2016 for the mark LONG*HORN COFFEE COMPANY covering “fresh roasted coffee” in Class 30.

13. Applicant is located in San Angelo, Texas and, upon information and belief, was aware of Opposer’s famous LONGHORN Marks when it filed the Application.

14. Opposer has priority based on its prior use and registration of its LONGHORN Marks in the United States.

15. Opposer’s LONGHORN Marks became famous long prior to Applicant’s filing date or claimed first-use date of January 1, 2016.

16. Applicant’s goods are identical or highly similar to the goods and services for which Opposer has long used and registered its LONGHORN Marks.

17. Upon information and belief, Applicant’s goods travel in the same or similar channels of trade as Opposer’s products and services, and will be used by the same or similar types of consumers who purchase and use Opposer’s goods and services.

18. Opposer has not given Applicant permission or approval to register the LONGHORN Marks or the mark LONG*HORN COFFEE COMPANY.

19. The fame of the University is such that, should the mark LONG*HORN COFFEE COMPANY be used in connection with Applicant’s goods, a connection with UT would be

presumed. Thus, registration of the mark LONG*HORN COFFEE COMPANY should be refused under 15 U.S.C. § 1052(a).

20. Applicant's mark LONG*HORN COFFEE COMPANY so resembles Opposer's LONGHORN Marks as to be likely, when used in connection with the goods identified in the Application, to cause confusion, or to cause mistake, or to deceive. Registration therefore should also be refused under 15 U.S.C. § 1052(d).

21. Applicant's mark LONG*HORN COFFEE COMPANY is likely to cause dilution by blurring of Opposer's famous LONGHORN Marks, and registration should also be refused under 15 U.S.C. § 1125(c).

22. Registration of Applicant's mark LONG*HORN COFFEE COMPANY on the Principal Register would damage Opposer because it would confer upon Applicant statutory presumptions to which Applicant is not entitled in view of Opposer's longstanding prior use and registration of its LONGHORN Marks.

WHEREFORE, Opposer prays that U.S. Serial No. 86/952,132 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber PLLC, Account No. 50-3924/UTEX755/AHB, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: August 16, 2018

/Alexandra H. Bistline/

William G. Barber

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ATTORNEYS FOR OPPOSER