

ESTTA Tracking number: **ESTTA1015588**

Filing date: **11/14/2019**

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 University		
Entity	not-for-profit corporation	Citizenship	New York
Address	70 Washington Square South New York, NY 10012 UNITED STATES		

Attorney information	Jason D. Jones FROSS ZELNICK LEHRMAN & ZISSU, P.C. 151 WEST 42ND STREET, 17TH FLOOR NEW YORK, NY 10036 UNITED STATES jjones@fzlj.com, ttabfiling@fzlj.com 212-813-5900
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**Applicant Information**

Application No	88503034	Publication date	10/29/2019
Opposition Filing Date	11/14/2019	Opposition Period Ends	11/28/2019
Applicant	Song,ZhiWei No24 LouXia DingShe Vil. HuShi Tn. xiuyu Putian, 351146 CHINA		

**Goods/Services Affected by Opposition**

Class 009. First Use: 2018/11/22 First Use In Commerce: 2018/11/22 All goods and services in the class are opposed, namely: Bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; Chargers for electric batteries; Contact lenses; Electric navigational instruments; Electrical cables and cordsets; Electrical outlet plates; Electronic collars to train animals; Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, MP3 players, mobile telephones, smart telephones, digital cameras, global positioning systems and personal digital assistants; Protective covers and cases for cell phones, laptops and portable media players; Protective helmets; Radio receivers; Wireless ear buds; Batteries for electronic cigarettes; Cabinets for loudspeakers; Consumer electronic products, namely, audio amplifiers, audio speakers, audio receivers, electrical audio and speaker cables and connectors, audio decoders, video decoders, speakers, power conversion devices, power converters, and power inverters; Converters for electric plugs; Digital video cameras; Earphones and headphones; Measuring rulers; Monopods used to take photographs by positioning a smartphone or camera beyond the normal range of the arm; Smartphone mounts
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**Applicant Information**

Application No	88513834	Publication date	10/29/2019
Opposition Filing Date	11/14/2019	Opposition Period Ends	11/28/2019
Applicant	Song,ZhiWei No.24 LouXia DingShe Vil. HuShi Town xiuyu dist. Putian Fujian, 351146 CHINA		


### Goods/Services Affected by Opposition

Class 025. First Use: 2018/11/28 First Use In Commerce: 2018/11/28 All goods and services in the class are opposed, namely: Athletic uniforms; Belts; Bras; Coats; Gloves; Hats; Insoles; Scarfs; Shoes; Shorts; Skirts; Sleepwear; Socks; Swimsuits; Tee shirts; Under-pants; Underwear; Yoga pants; Yoga shirts
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	VOID AB INITIO FOR NON-USE UNDER 15 U.S.C. &sect; 1051(a)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3770376	Application Date	06/10/2009
Registration Date	04/06/2010	Foreign Priority Date	NONE
Word Mark	NYU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1896/00/00 First Use In Commerce: 1896/00/00 Educational services, namely, providing courses, lecture series, and seminars at the undergraduate and graduate level; providing extension, continuing, and community education, namely, offering classes, lecture series, and seminars on various topics of interest to the public in diverse educational disciplines, including history, literature, economics, science, current events news, government affairs and politics, education, journalism, business, engineering, law, medicine, social issues, culture, and child care		
U.S. Registration	1789490	Application Date	12/24/1992

No.			
Registration Date	08/24/1993	Foreign Priority Date	NONE
Word Mark	NYU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1896/00/00 First Use In Commerce: 1940/00/00 adult and children clothing; namely, T-shirts, sweatshirts, and pants, shorts, jackets, sweaters, hats, shoes		

Attachments	77756732#TMSN.png( bytes ) F3286092.PDF(370861 bytes )
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Signature	/s/ Jason D. Jones
Name	Jason D. Jones
Date	11/14/2019

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

In the matter of Application Serial Nos. 88/503,034 and 88/513,834  
Mark: NYV

NEW YORK UNIVERSITY,

Opposer,

-against-

ZHIWEI SONG,

Applicant.

Opposition No. \_\_\_\_\_

**CONSOLIDATED NOTICE OF OPPOSITION**

Opposer New York University (“Opposer”), a New York not-for-profit corporation with an address of 70 Washington Square South, New York, NY 10012, believes that it will be damaged by the issuance of a registration for the mark NYV in International Class 9 as applied for in Application Serial No. 88/503,034 and in International Class 25 as applied for in Application Serial No. 88/513,834 (collectively, the “Applications”), both filed by ZhiWei Song (“Applicant”), and therefore opposes the same. As grounds for the opposition, Opposer, by its counsel Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

**FACTS**

A. Opposer and Its NYU Mark

1. Opposer New York University, also known as NYU, is an educational institution that was founded in 1831. For nearly two centuries, Opposer has continuously provided educational services at the undergraduate and graduate level and, through extension, continuing education and community education programs.

2. NYU is consistently ranked as one of the most esteemed and well-regarded institutions of learning in the United States. By way of example, in the 2019 *The Princeton Review*, NYU was named a Top 5 “Dream School” by both students and parents. By way of another example, in the 2020 *U.S. News & World Report*, the NYU School of Law was ranked as the #6 law school in the United States and the NYU Stern School of Business was ranked as the #12 business school in the United States. Alumni of NYU include heads of state, royalty, eminent scientists, inventors and entrepreneurs, media figures, founders and CEOs of Fortune 500 companies, and astronauts.

3. The popularity of NYU has also created a demand for authorized NYU merchandise and, as such, Opposer markets an array of goods under the NYU trademark (the “NYU Mark”), including but not limited to clothing, backpacks, wallets, blankets, glassware, and pet supplies. Opposer makes substantial sales of NYU-branded merchandise in the United States each year.

4. Through extensive promotion and use, and the success of Opposer’s offerings under the NYU Mark, the NYU Mark has become a strong trademark exclusively identifying the goods and services of Opposer. As such, the NYU Mark represents an enormous goodwill and is an extremely valuable asset of Opposer.

5. Through years of use and the success of Opposer’s offerings under the NYU Mark, the NYU Mark has become famous. The NYU Mark became famous prior to any date upon which Applicant can rely.

6. Opposer owns federal trademark registrations for its NYU Mark in connection with various goods and services, namely:

- U.S. Reg. No. 3,770,376 for NYU for “Educational services, namely, providing courses, lecture series, and seminars at the undergraduate and graduate level; providing extension, continuing, and community education, namely, offering classes, lecture series, and seminars on various topics of interest to the public in diverse educational disciplines, including history, literature, economics, science, current events news, government affairs and politics, education, journalism, business, engineering, law, medicine, social issues, culture, and child care” in International Class 41 based on first use in 1896; and
- U.S. Reg. No. 1,789,490 for NYU for “adult and children clothing; namely, T-shirts, sweatshirts, and pants, shorts, jackets, sweaters, hats, shoes” in International Class 25 based on first use in 1940.

B. Applicant and Its Application

7. According to the records of the United States Patent and Trademark Office (“USPTO”), applicant ZhiWei Song (“Applicant”) is a Chinese individual with an address of No. 24 LouXi DingShe Vil., HuShi Tn., Putian, China 351146.

8. According to the records of the USPTO, on July 8, 2019, Applicant filed Application Serial No. 88/503,034 to register the mark NYV (“Applicant’s Mark”) for use in connection with “Bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; Chargers for electric batteries; Contact lenses; Electric navigational instruments; Electrical cables and cordsets; Electrical outlet plates; Electronic collars to train animals; Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, MP3 players, mobile telephones, smart telephones, digital cameras, global positioning systems and personal digital assistants; Protective covers and cases for cell phones, laptops and portable media players; Protective helmets; Radio receivers; Wireless ear buds; Batteries for electronic cigarettes; Cabinets for loudspeakers; Consumer electronic products, namely, audio amplifiers, audio speakers, audio receivers, electrical audio and speaker cables and connectors, audio decoders, video decoders, speakers, power conversion devices, power converters, and power inverters; Converters for electric plugs;

Digital video cameras; Earphones and headphones; Measuring rulers; Monopods used to take photographs by positioning a smartphone or camera beyond the normal range of the arm; Smartphone mounts” in International Class 9 based on a first use in commerce of November 22, 2018 under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

9. According to the records of the USPTO, on July 15, 2019, Applicant filed Application Serial No. 88/513,834 to register Applicant’s Mark for use in connection with “Athletic uniforms; Belts; Bras; Coats; Gloves; Hats; Insoles; Scarfs; Shoes; Shorts; Skirts; Sleepwear; Socks; Swimsuits; Tee shirts; Underpants; Underwear; Yoga pants; Yoga shirts” in International Class 25 based on a first use in commerce of November 28, 2018 under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

10. Prior to Applicant’s adoption of and application to register Applicants’ Mark, Applicant was on constructive notice of Opposer’s prior rights in the NYU Mark by virtue of, *inter alia*, Opposer’s above-referenced registrations.

11. Upon information and belief, prior to Applicant’s adoption of and application to register Applicant’s Mark, Applicant was on actual notice of Opposer’s prior rights in the NYU Mark by virtue of Opposer’s extensive use thereof.

**FIRST GROUND FOR RELIEF:**  
**PRIORITY AND LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. § 1052(d)**

12. Opposer repeats the allegations contained in Paragraphs 1 through 11 above as if fully set forth herein.

13. The filing date of the Applications, and the claimed first use and first use in commerce dates alleged therein, are significantly later than Opposer’s first use of the NYU Mark and significantly after Opposer acquired rights in and a federal registration for the NYU Mark.

As such, Opposer's rights in the NYU Mark are prior and superior to any rights Applicant may claim in Applicant's Mark.

14. Applicant is not connected to Opposer in any way, and has not been authorized by Opposer to use or register Applicant's Mark.

15. Applicant's Mark is highly similar to Opposer's NYU Mark in appearance, sound, connotation, and commercial impression.

16. The goods identified in the Applications are related to goods that Opposer has long offered under its NYU Mark.

17. In view of the similarity of the marks and goods, use by Applicant of Applicant's Mark for the goods identified in the Applications is likely to confuse consumers into believing, falsely, that Applicant's goods originate with, are sponsored or approved by, or are otherwise connected with Opposer or the goods Opposer offers under its NYU Mark. Any use of Applicant's Mark by Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

18. As a result of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in Opposer's NYU Mark and would threaten the investment and goodwill of Opposer in its NYU Mark. Opposer therefore would be injured by registration of Applicant's Mark.

**SECOND GROUND FOR RELIEF:  
DILUTION BY BLURRING UNDER 15 U.S.C. § 1125(c)**

19. Opposer repeats the allegations contained in Paragraphs 1 through 18 above as if fully set forth herein.

20. Opposer's NYU Mark has been used continuously and/or registered by Opposer since a date prior to any date on which Applicant can rely.



21. Opposer's NYU Mark is famous and became famous long before the earliest priority date upon which Applicant can rely.

22. Applicant's use and registration of Applicant's Mark will damage Opposer by trading on the enormous goodwill associated with the Opposer's NYU Mark and diluting its distinctiveness.

23. As such, Applicant's registration of Applicant's Mark in connection with the goods identified in the Applications will dilute by blurring Opposer's famous NYU Mark in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

24. As a result of the foregoing, Opposer would be injured by registration of Applicant's Mark.

**THIRD GROUND FOR RELIEF:  
VOID *AB INITIO* FOR NON-USE UNDER 15 U.S.C. § 1051(a)**

25. Opposer repeats the allegations contained in Paragraphs 1 through 24 above as if fully set forth herein.

26. Upon information and belief, the specimens submitted with the Applications were digitally created or altered, and, in fact, Applicant's Mark was not in use in commerce in connection with the goods set forth in the Applications at the time Applicant filed the Applications under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

27. Upon information and belief, Applicant's Mark is not presently being used in commerce in connection with every good set forth in the Applications.

28. Because Applicant's Mark was not in use in commerce on or prior to the filing date of the use-based Applications in connection with the goods specified therein, the Applications are both *void ab initio* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

29. By reason of the foregoing, Opposer will be injured by registration of Applicant's Mark.

**FOURTH GROUND FOR RELIEF:**  
**FRAUD**

30. Opposer repeats the allegations contained in Paragraphs 1 through 29 above as if fully set forth herein.

31. In connection with the Applications, Applicant submitted Declarations that, *inter alia*, "the mark is in use in commerce on or in connection with the goods/services in the application[s]."

32. Based upon Opposer's investigation, the specimens submitted with the Applications were digitally created or altered and at the time Applicant filed the Applications under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), Applicant was not using Applicant's Mark in commerce in connection with the goods set forth in the Applications.

33. Because, on information and belief and the based upon Opposer's investigation, Applicant was not using Applicant's Mark in commerce in connection with the goods set forth in the Applications at the time Applicant filed the Applications under Section 1(a) of the Lanham Act, the Declarations submitted in support of the Applications were false.

34. Upon information and belief, Applicant knew that as of the filing date of the Applications its specimens were digitally created or altered, it was not using Applicant's Mark in interstate commerce in connection with all goods specified in the Applications, and that, therefore, the Declarations submitted in support of the Applications to that effect were false.

35. Upon information and belief, by falsely asserting that it was using Applicant's Mark in interstate commerce in connection with the goods specified in the Applications as of the filing dates, Applicant intended to deceive the USPTO. Upon information and belief,

Applicant's false statements—and digitally created or altered specimens—were made for the purpose of obtaining registrations to which Applicant was not entitled.

36. The USPTO would not have approved Applicant's Applications for registration but for the false statements that Applicant was using Applicant's Mark in interstate commerce in connection with the goods specified in the Applications as of the filing dates. Thus, the misstatements were material misstatements of fact.

37. As a result of Applicant's willful and material false statements in connection with the Applications, Applicant has committed fraud against the USPTO, which invalidates both of the Applications.

38. By reason of the foregoing, Opposer would be damaged by the registration of Applicant's Mark.

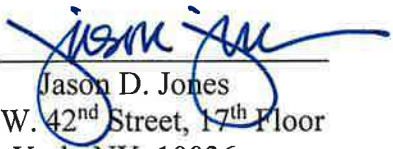
WHEREFORE, Opposer respectfully requests that this opposition be sustained in its entirety and that registration of Applicant's Mark sought by Application Serial Nos. 88/503,034 and 88/513,834 in all respects be denied.

Dated: New York, New York  
November 14, 2019

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: \_\_\_\_\_

  
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