

ESTTA Tracking number: **ESTTA331018**

Filing date: **02/08/2010**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Educational Testing Service		
Entity	not-for-profit corporation	Citizenship	New York
Address	Rosedale Road Princeton, NJ 08541 UNITED STATES		

Attorney information	Lile H. Deinard Dorsey & Whitney LLP 250 Park Avenue, Floor 15 New York, NY 10177 UNITED STATES deinard.lile@dorsey.com, robertson.sarah@dorsey.com, hernandez.jose@dorsey.com, ny.trademark@dorsey.com		
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Registration Subject to Cancellation

Registration No	3707197	Registration date	11/03/2009
Registrant	TEFL Institute Corporation 1906 W. Irving Park Road Chicago, IL 60613 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2005/01/01 First Use In Commerce: 2005/01/01 All goods and services in the class are cancelled, namely: Educational and informational services, namely, providing language instruction for the purpose of teaching English as a foreign language domestically and internationally and distribution of related printed and downloadable materials therewith

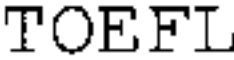
Grounds for Cancellation


Genericness	Trademark Act section 23
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation


U.S. Registration No.	1103427	Application Date	01/13/1978
Registration Date	10/03/1978	Foreign Priority Date	NONE
Word Mark	TOEFL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1964/02/00 First Use In Commerce: 1964/02/00 INFORMATION MANUALS DEALING WITH EDUCATIONAL TESTING Class 041. First use: First Use: 1964/02/00 First Use In Commerce: 1964/02/00 EDUCATIONAL TESTING SERVICES-NAMELY, ADMINISTERING TESTS DEALING WITH LANGUAGES

U.S. Registration No.	2461224	Application Date	12/15/1999
Registration Date	06/19/2001	Foreign Priority Date	NONE
Word Mark	TOEFL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1991/12/31 First Use In Commerce: 1991/12/31 Computer programs recorded on magnetic disks, tapes, compact disks, CD-ROMs, [laser disks, video disks, optical disks,] audio cassette tapes [and video tapes] for use in the field of language proficiency testing and test preparation		

U.S. Registration No.	3168050	Application Date	10/21/2005
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	TOEFL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1991/12/31 First Use In Commerce: 1991/12/31		

	<p>Books, informational brochures, pamphlets, circulars, instruction sheets, manuals, printed guides, research reports and newsletters, all in the field of language proficiency testing and evaluation; Printed tests and printed answer sheets, all in the field of language proficiency evaluation; Educational books, paper teaching materials, study guides, workbooks and computer program manuals, all in the field of language instruction and learning and language proficiency test preparation</p> <p>Class 041. First use: First Use: 2005/09/24 First Use In Commerce: 2005/09/24 Educational services, namely creating, administering, scoring and reporting an Internet-based language proficiency test; professional development workshops in the field of language instruction and learning and language proficiency test preparation</p> <p>Class 042. First use: First Use: 2005/09/24 First Use In Commerce: 2005/09/24 Providing temporary use of non-downloadable on-line software for an Internet-based language proficiency test; development and administration of an Internet-based language proficiency test</p>
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U.S. Registration No.	3478244	Application Date	07/06/2006
Registration Date	07/29/2008	Foreign Priority Date	NONE
Word Mark	TOEFL ACCELERATOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 2007/03/31 First Use In Commerce: 2007/03/31 Printed instructional, educational, and teaching materials in the field of standardized English language tests</p> <p>Class 041. First use: First Use: 2007/03/31 First Use In Commerce: 2007/03/31 Educational services, namely, conducting programs in the field of preparing for standardized English language tests</p> <p>Class 042. First use: First Use: 2007/03/31 First Use In Commerce: 2007/03/31 Providing online non-downloadable software for preparing for standardized English language tests</p>		

Attachments	<p>75872582#TMSN.gif (1 page)(bytes) 78738224#TMSN.jpeg (1 page)(bytes) 78923859#TMSN.jpeg (1 page)(bytes) Petition for Cancellation.pdf (15 pages)(587155 bytes)</p>
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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	/lhd/
Name	Lile H. Deinard
Date	02/08/2010

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

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EDUCATIONAL TESTING SERVICE, :
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 Petitioner, : Cancellation No.
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 -against- :
 : PETITION FOR CANCELLATION
 :
 TEFL Institute Corporation, :
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 :
 Registrant. :
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 :
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Petitioner Educational Testing Service (“Petitioner”), a not-for-profit corporation duly organized and existing under the Education Law of the State of New York, having a principal place of business at Rosedale Road, Princeton, New Jersey 08541, believes that it will be damaged by Registration No. 3,707,197 for TEFL Institute issued on the Supplemental Register to the TEFL Institute Corporation on November 3, 2009 for *educational and informational services, namely, providing language instruction for the purpose of teaching English as a foreign language domestically and internationally and distribution of related printed and downloadable materials therewith*, in International Class 41 (the “Registration”), and hereby petitions to cancel the same.

As grounds for the petition, it is alleged that:

1. Petitioner is now, and for many years has been, engaged in the creation, development, and administration of educational assessments including standardized tests for graduate school admission, for college admission and for measuring English-language proficiency for academic and business purposes.

2. Continuously since 1964, Petitioner, through its development and administration of the TOEFL test, among other activities, has been at the forefront of evaluating the English proficiency of people whose native language is not English. Thousands of colleges and universities in the United States and Canada require TOEFL test scores from their international applicants. Academic institutions in other countries, as well as certain independent organizations, agencies and foreign governments, also rely on TOEFL test scores to evaluate their employees' English-language proficiency. In addition, several medical certification and licensing agencies require TOEFL test scores.

3. Petitioner is the owner of the entire right, title and interest in and to the trademark TOEFL and to the federal registrations set forth below:

<u>Trademark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods & Services</u>	<u>First Use</u>
TOEFL	1103427	10/03/78	Information manuals dealing with educational testing (Cl. 16) Educational testing services, namely, administering tests dealing with languages (Cl. 41)	1964
TOEFL	2461224	06/19/01	Computer programs recorded on magnetic disks, tapes, compact disks, CD-ROMs, and audio cassette tapes for use in the field of language proficiency testing and test preparation (Cl. 9)	1991
TOEFL	3168050	11/07/06	Books, informational brochures, pamphlets, circulars, instruction sheets, manuals, printed guides, research reports and newsletters, all in the field of language proficiency testing and evaluation; Printed tests and printed answer sheets, all in the field of language proficiency evaluation; Educational books, paper teaching materials, study guides, workbooks and computer program manuals, all in the field of language instruction and learning and language proficiency test preparation (Cl. 16)	1991

<u>Trademark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods & Services</u>	<u>First Use</u>
			Educational services, namely creating, administering, scoring and reporting an Internet-based language proficiency test; professional development workshops in the field of language instruction and learning and language proficiency test preparation. (Cl. 41)	
			Providing temporary use of non-downloadable on-line software for an Internet-based language proficiency test; development and administration of an Internet-based language proficiency test. (Cl. 42)	
TOEFL ACCELERATOR	3478244	7/29/08	Printed instructional, educational, and teaching materials in the field of standardized English language tests. (Cl. 16)	2007
			Educational services, namely, conducting programs in the field of preparing for standardized English language tests. (Cl. 41)	
			Providing online non-downloadable software for preparing for standardized English language tests. (Cl. 42)	

In addition, the TOEFL mark is registered in 92 countries around the world.

4. As a result of Petitioner's long and prominent use of its TOEFL trademark since at least as early as 1964, for and in connection with its products and services, the TOEFL trademark has acquired national and worldwide recognition as identifying exclusively the products and services of Petitioner, and the vast and valuable goodwill symbolized by the TOEFL mark belongs exclusively to Petitioner.

5. The TOEFL test is made available nationally and worldwide by Petitioner and administered by authorized institutions and/or through members of the ETS Preferred Network under contract with Petitioner. Since 1964, nearly 20 million students have taken the TOEFL

test in more than 110 countries, including the U.S., and over 7,300 institutions in the U.S. and worldwide use scores from the test.

6. Petitioner's trademark TOEFL is a distinctive and well-known mark and became well-known long prior to the filing date of the application upon which the Registration sought to be cancelled herein is based and the date of first use claimed in such Registration.

Cancellation Ground 1: Registrant's Trademark Is the Generic Name for the Claimed Services and Should Be Cancelled.

7. Petitioner restates and realleges the averments set forth in paragraphs 1 through 6 of this Petition.

8. TEFL is an acronym for Teaching English as a Foreign Language. Upon information and belief, the term "TEFL" is in widespread use both nationally and internationally by many schools, institutions and online services as the common name for teaching English as a foreign language. (See print-out of Google search results for "TEFL" attached as Exhibit A.) Accordingly, the term "TEFL" has become a generic term for teaching English as a foreign language. In addition, the term "Institute" is generic for an educational institution and especially one providing an usually brief intensive course of instruction on selected topics relating to a particular field, such as teaching English as a foreign language.

9. In its entirety, the mark TEFL Institute is generic for educational and informational services, namely, providing language instruction for the purpose of teaching English as a foreign language domestically and internationally and distribution of related printed and downloadable materials therewith. These terms are incapable of distinguishing applicant's goods or services since their primary significance to the relevant public is that of common words, and are thus not registrable on the Principal Register under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(f), or on the Supplemental Register under Section 23(a) of the Lanham Act, 15

U.S.C. § 1091(a). Since Petitioner is engaged in the sale of closely related goods and services, and does not wish to be foreclosed from using the terms covered by the Registration descriptively in its business, Petitioner seeks cancellation of the Registration under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3).

Cancellation Ground 2: Registrant's Trademark Is Confusingly Similar to Petitioner's TOEFL Trademark and Should Be Cancelled.

10. Petitioner restates and realleges the averments set forth in paragraphs 1 through 9 of this Petition.

11. In the alternative, in the event that the Board finds that Registrant's TEFL Institute mark is not generic and is instead merely descriptive, Petitioner's TOEFL trademark and Registrant's TEFL Institute trademark are confusingly similar in sight, sound and meaning. Further, Petitioner's goods and services bearing the TOEFL trademark and the services covered by the Registrant's TEFL Institute trademark are very closely related.

12. As result of the foregoing, the purchasing public familiar with Petitioner's goods and services bearing the well-known TOEFL trademark are likely to be confused, misled or deceived into thinking the Registrant's TEFL Institute services are the services of Petitioner or are in some way sponsored by or connected with Petitioner, to Petitioner's irreparable damage and injury, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

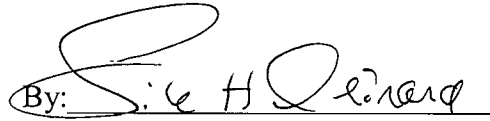
WHEREFORE, Petitioner respectfully requests that this Petition be granted and that Registration No. 3,707,197 be cancelled pursuant to 15 U.S.C. § 1064.

Please recognize as attorneys for Petitioner in this proceeding Lile H. Deinard, Sarah Robertson and Jose L. Hernandez, members of the Bar of the State of New York, whose address is Dorsey & Whitney LLP, 250 Park Avenue, New York, New York, 10177, telephone number (212) 415-9200.

Dated: New York, New York

February 8, 2010

DORSEY & WHITNEY LLP

By: 

Lile H. Deinard, Esq.

Sarah Robertson, Esq.

Jose L. Hernandez, Esq.

250 Park Avenue
New York, New York 10177
(212) 735-0778

Attorneys for Petitioner
EDUCATIONAL TESTING SERVICE

Exhibit A



tefl

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TEFL qualifications - Teacher Recruitment - British Council

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English International, **TEFL/TESL**

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TEFL Articles | EnglishClub.com

English Club **TEFL** Articles A selection of articles and essays related to the teaching of English as a second or foreign language. ...

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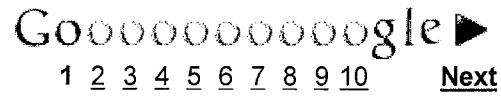
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