

ESTTA Tracking number: **ESTTA404270**

Filing date: **04/18/2011**

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	University of Tennessee		
Entity	Corporation	Citizenship	Tennessee
Address	719 Andy Holt Tower Knoxville, TN 37996 UNITED STATES		

Attorney information	Mark S. Graham, Esq. Luedeka, Neely & Graham, P.C. P.O. Box 1871 Knoxville, TN 37901-1871 UNITED STATES mgraham@lng-patent.com, mbradford@lng-patent.com, lprichard@lng-patent.com Phone:865-546-4305		
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#### Registration Subject to Cancellation

Registration No	3382718	Registration date	02/12/2008
Registrant	Syracuse University 303 University Place Syracuse, NY 132442020 UNITED STATES		

#### Goods/Services Subject to Cancellation

Class 041. First Use: 1988/10/25 First Use In Commerce: 1988/10/25 All goods and services in the class are cancelled, namely: educational and entertainment services namely, the presentation of college level sporting events, all for promoting activities of, showing support for, and/or showing affiliation with a University, its students, alumni and athletic teams
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#### Grounds for Cancellation

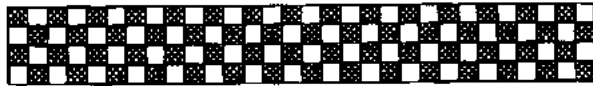
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

#### Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1333972	Application Date	09/26/1984
Registration Date	05/07/1985	Foreign Priority Date	NONE
Word Mark	BIG ORANGE COUNTRY		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 006. First use: First Use: 1961/00/00 First Use In Commerce: 1961/00/00 [ Metal Novelty License Plates; Metal Key Chain Having Attached Coin Purse ] Class 016. First use: First Use: 1936/00/00 First Use In Commerce: 1936/00/00 Window Stickers Class 021. First use: First Use: 1965/00/00 First Use In Commerce: 1965/00/00 [ Buckets ] Class 025. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 [ Caps ]

U.S. Registration No.	2616220	Application Date	07/23/1999
Registration Date	09/10/2002	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	

Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 1995/06/21 First Use In Commerce: 1995/06/21 watches Class 016. First use: First Use: 1996/07/05 First Use In Commerce: 1996/07/05 prints, posters, decals, magnets and stationery Class 020. First use: First Use: 1993/11/24 First Use In Commerce: 1993/11/24 plastic license plates and flags; non-metal key chains Class 021. First use: First Use: 1998/08/01 First Use In Commerce: 1998/08/01 [ stained glass wallhangings ] Class 024. First use: First Use: 1993/08/01 First Use In Commerce: 1993/08/01 afghans Class 025. First use: First Use: 1993/08/01 First Use In Commerce: 1993/08/01 ties, shirts, sweaters, vests, and bandanas Class 041. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 entertainment services in the nature of intercollegiate sports exhibitions

U.S. Registration No.	2899370	Application Date	10/17/2002
Registration Date	11/02/2004	Foreign Priority Date	NONE
Word Mark	THE BIG ORANGE ARMY		

Design Mark	<b>The Big Orange Army</b>
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2002/07/30 First Use In Commerce: 2002/10/01 CLOTHING, NAMELY SHIRTS, T-SHIRTS AND TANK TOPS; FOOTWEAR; AND HEADGEAR, NAMELY, HATS AND CAPS

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	The word ORANGE alone, and in combination with other words, letters, symbols, graphics, and/or designs, and/or the color orange, alone and in combination with other colors including, but limited to the colors white, black, and/or baby blue, and/or words, letters, designs, and/or graphics including but not limited to the word #orange,# the word #white,# the letters #T,# #UT,# and/or other letter/word combinations including, but not limited to, the terms #VOLS,# #UT FUTURE,# #UT Knoxville,# #UT Chattanooga,# #UT Memphis,# #UT Martin,# #UT Hospital,# #UT Health Sciences Center,# and other terms and word/letter/color combinations, and has used numerous other marks including but not limited to, the color orange and/or the word #orange,# including but not limited to, the marks ORANGE AND WHITE and BIG ORANGE		
Goods/Services	collegiate, graduate, and professional-level educational services, research and development services, intercollegiate and other sporting, academic, entertainment, and other exhibitions, performances, and activities associated with the university, clothing, shirts, pants, outerwear, footwear, headwear, ties, sweaters, vests, bandanas, jewelry, glassware, watches, prints, posters, decals, magnets, stationery, license plates, flags, key chains, video recordings, audio recordings, and a wide range of other related goods and services		

Attachments	75758771#TMSN.gif ( 1 page )( bytes ) 78175738#TMSN.gif ( 1 page )( bytes ) 6638600-topto-20110418-PetitionForCancellation.pdf ( 8 pages )(22723 bytes )
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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	/msg/
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Name	Mark S. Graham, Esq.
Date	04/18/2011



Mark” of Respondent or as Respondent’s “ORANGE Mark”), registered on the Principal Register in International Class 041 for “educational and entertainment services namely, the presentation of college level sporting events, all for promoting activities of, showing support for, and/or showing affiliation with a University, its students, alumni and athletic teams” (referred to herein at times as “Respondent’s Services”), and the named Respondent herein, is Syracuse University, a non-profit educational corporation having an address at 303 University Place, Syracuse, New York 13244.

3. Respondent claims use of its ORANGE Mark in commerce for Respondent’s Services commencing on or about October 25, 1988.

4. For many years prior to the filing date of the application which issued as the ‘718 Registration and since long before any alleged earlier commencement of use of Respondent’s ORANGE Mark thereof anywhere or in commerce, Petitioner and/or its licensees and/or affiliates have offered, sold, and provided and continue to offer, sell and provide in interstate commerce a wide variety of goods and services under several marks and names consisting of the word ORANGE alone, and in combination with other words, letters, symbols, graphics, and/or designs, and/or the color orange, alone and in combination with other colors including, but limited to the colors white, black, and/or baby blue, and/or words, letters, designs, and/or graphics including but not limited to the word “orange,” the word “white,” the letters “T,” “UT,” and/or other letter/word combinations including, but not limited to, the terms “VOLS,” “UT FUTURE,” “UT Knoxville,” “UT Chattanooga,” “UT Memphis,” “UT Martin,” “UT Hospital,” “UT Health Sciences Center,” and other terms and word/letter/color combinations, and has used numerous other marks including but not limited to, the color orange and/or the word “orange,”

including but not limited to, the marks ORANGE AND WHITE, BIG ORANGE, BIG ORANGE COUNTRY, THE BIG ORANGE ARMY, an orange and white checkerboard pattern design mark and a vast array of products colored orange, in whole or in part, including, but not limited to, products and items colored totally or primarily only orange and/or various combinations of orange and white, colored primarily or substantially orange and/or bearing the word “orange,” various of the aforementioned marks having been used since at least as early as 1891 (collectively referred to at times as “Petitioner’s ORANGE Marks” or the “ORANGE Marks” of Petitioner) for and in connection with substantially all of UT’s services, goods, and activities (and those of its licensees) including, but not limited to, the aforementioned goods and services and others including, but not limited to, collegiate, graduate, and professional-level educational services, research and development services, intercollegiate and other sporting, academic, entertainment, and other exhibitions, performances, and activities associated with the university, clothing, shirts, pants, outerwear, footwear, headwear, ties, sweaters, vests, bandanas, jewelry, glassware, watches, prints, posters, decals, magnets, stationery, license plates, flags, key chains, video recordings, audio recordings, and a wide range of other related goods and services (the aforementioned collectively “Petitioner’s Goods and Services”).

5. Petitioner is the owner of U.S. Registration No. 1,333,972 for the mark BIG ORANGE COUNTRY for use with “window stickers”; U.S. Registration No. 2,616,220 for a design mark consisting of an orange checkerboard pattern for use with “watches, prints, posters, decals, magnets, stationery, plastic license plates and flags, nonmetal key chains, afghans, ties, sweaters, vests, bandanas, and entertainment services in the nature of intercollegiate sports exhibitions”; and U.S. Registration No. 2,899,370 for the mark THE BIG ORANGE ARMY for

use with “clothing, namely shirts, t-shirts, and tank tops, footwear, and headgear, namely, hats and caps.” The ‘972 Registration, the ‘220 Registration, and the ‘370 Registration shall collectively be referred to herein as “Petitioner’s ORANGE Registrations” and they are included generally as part of the ORANGE Marks of Petitioner.

6. The ORANGE Marks of Petitioner have been prominently and extensively used and promoted in commerce nationwide for many decades, and since long before the filing date of the ‘718 Registration and before any alleged first use by Respondent of its ORANGE Mark anywhere or in commerce for any of Respondent’s Services. The ORANGE Marks of Petitioner have been and are being used, shown, and displayed on and in regional, national and international television and radio broadcasts in connection with Petitioner’s Goods and Services and have been and are being seen and/or heard by hundreds of millions of people around the world in association with Petitioner’s Goods and Services since long before the filing date of the ‘718 Registration and before any alleged first use by Respondent of its ORANGE Mark anywhere or in commerce for any of Respondent’s Services. As a result of extensive prior use and promotion of the ORANGE Marks of Petitioner, Petitioner is now and for some time has been the owner of strong, valuable, and famous exclusive rights and goodwill in the ORANGE Marks of Petitioner for Petitioner’s Goods and Services, which rights and good will arose and subsisted in the minds of the general public at large long before the filing date of the ‘718 Registration and any alleged first use by Respondent of the ORANGE Mark of its ‘718 Registration for any of Respondent’s Services.

7. Petitioner and its licensees and affiliates have expended considerable time, effort, and expense in using, promoting, advertising, popularizing, and making known the ORANGE



Marks of Petitioner for and in connection with Petitioner's Goods and Services, with the result that Petitioner has established extensive, valuable, and famous exclusive rights and goodwill in the ORANGE Marks as symbols of a source or origin of Petitioner's Goods and Services.

8. The ORANGE Marks of Petitioner are distinctive, well known, and famous in commerce in the United States, and are and have been widely known and famous in commerce in the United States since long before the filing date of the '718 Registration and any alleged first use by Respondent of its ORANGE Mark anywhere or in commerce for any of Respondent's Services.

9. In addition to Respondent's constructive knowledge of Petitioner's prior use and registration of its ORANGE Marks including, but not limited to, those of Petitioner's Registrations, on information and belief, Respondent had actual knowledge of or reason to know of Petitioner's prior use of its well-known and famous ORANGE Marks for and in connection with Petitioner's Goods and Services prior to the date of filing of the application in the USPTO which issued as the '718 Registration, or prior to any other date on which Respondent may seek to rely herein.

10. Petitioner has and for some time has had both actual and constructive use priority anywhere and everywhere in the United States in commerce and otherwise of its ORANGE Marks with respect to the ORANGE Mark of the '718 Registration as a result of Petitioner's significantly earlier filing date of Petitioner's Registrations and Petitioner's significantly earlier actual and continuous regional and nationwide prior use of Petitioner's ORANGE Marks in commerce for and in connection with Petitioner's Goods and Services since a date long before the filing date of the application which issued as the '718 Registration and prior to any alleged

earlier commencement of use of the ORANGE Mark by Respondent in U.S. commerce or any other alleged date of priority on which Respondent may seek to rely herein.

11. Respondent's Services are the same as or are related to all or part of Petitioner's Goods and Services offered under Petitioner's ORANGE Marks. On information and belief, Respondent's Services are or will be offered and/or provided under the ORANGE Mark through the same channels of trade and advertising media and are or will be directed to the same general class of purchasers as Petitioner's Goods and Services offered and provided under Petitioner's ORANGE Marks.

12. The ORANGE Mark of the '718 Registration so resembles Petitioner's ORANGE Marks, as to be likely, when used on, for, or in connection with Respondent's Services, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers and users as well as the public at large are all likely to mistakenly believe that Respondent's Services offered or sold under the ORANGE Mark of the '718 Registration are provided, sponsored, endorsed, or approved by the source of the Goods and/or Services of Petitioner sold, marketed or provided under Petitioner's ORANGE Marks, and/or that the source of Respondent's Services is in some way affiliated, connected, or associated with the source of Petitioner's Goods and/or Services sold, marketed or provided under Petitioner's ORANGE Marks, all to the detriment of and damage to Petitioner and its goodwill connected with its ORANGE Marks.

13. Continued registration of the ORANGE Mark of the '718 application would be a further source of damage to Petitioner inasmuch as use of the ORANGE Mark by Respondent for Respondent's Services dilutes and/or is likely to dilute the distinctive quality of Petitioner's famous ORANGE Marks to the detriment and damage of Petitioner.

14. Continued registration of the ORANGE Mark would be a still further source of damage to Petitioner because it would, among other things, confer upon Respondent various statutory presumptions to which it is not entitled in view of Petitioner's long prior use, prior registration, and other priority rights in and with respect to its ORANGE Marks and its superior rights therein under the federal Trademark Act, Title 15 of the United States Code.

15. In view of the above, Respondent's '718 registration should be cancelled pursuant to at least 15 U.S.C. §§ 1052(d), 1064, 1065, and 1125.

WHEREFORE, Petitioner, the University of Tennessee, urges and prays that this Honorable Board, upon consideration of the grounds set forth herein, determine that Petitioner has made out good and sufficient reasons to find and adjudge that Petitioner is being damaged by registration of the ORANGE Mark of Respondent's '718 Registration, and order that the same be cancelled forthwith.

A fee in the amount of \$300.00 as required by the Commissioner for Trademarks is filed herewith. The commissioner is authorized to draw on the Deposit Account of Luedeka, Neely & Graham, Account No. 12-2355, if the filing fee is insufficient or if the payment is inadvertently omitted.

Respectfully submitted,

Date: April 18, 2011

s/Mark S. Graham  
Mark S. Graham, Esq., Reg. No. 32,355  
Michael J. Bradford, Esq., Reg. No. 52,646  
LUEDEKA, NEELY & GRAHAM, P.C.  
Attorneys for Potential Petitioner  
P.O. Box 1871  
Knoxville, TN 37901  
(865) 546-4305

**CERTIFICATE OF SERVICE**

This is to certify that a true and exact copy of the foregoing PETITION FOR CANCELLATION is being served on Respondent at its correspondence address of record by first class mail, postage prepaid:

George McGuire, Esquire  
BOND, SCHOENECK & KING, PLLC  
One Lincoln Center  
Syracuse, NY 13202-1355

Date: April 18, 2011

s/Mark S. Graham  
Mark S. Graham