

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 17, 2005

Opposition No 91166257
Serial No. 78317588

Weyer, Frank M
264 S La Cienega Blvd #1224
Beverly Hills, CA 90211

The Fashion Institute of
Technology

v.

Weyer, Frank M

Kelly M. Bargmann
Clinton Square, PO Box 31051
Rochester, NY 14603

Sandra Thompson, Legal Assistant

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof.
(See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the

Trademark Trial and Appeal Board Manual of Procedure (TBMP), are available at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open: September 06, 2005

Discovery period to close: March 05, 2006

30-day testimony period for party
in position of plaintiff to close: June 03, 2006

30-day testimony period for party
in position of defendant to close: August 02, 2006

15-day rebuttal testimony period
for plaintiff to close: September 16, 2006

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "*Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board*," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

ESTTA Tracking number: **ESTTA42311**

Filing date: **08/16/2005**

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	Fashion Institute of Technology
Granted to Date of previous extension	08/17/2005
Address	Seventh Avenue at 27th Street New York, NY 10001 UNITED STATES
Party who filed Extension of time to oppose	The Fashion Institute of Technology
Relationship to party who filed Extension of time to oppose	Opposer was "misidentified by mistake" within the meaning of Section 206.03 of the TBMP and 37 CFR 2.102(b) in the Requests for Extension of Time to Oppose. Opposer's legal name is "Fashion Institute of Technology", not "The Fashion Institute of Technology."

Attorney information	Kristen M. Walsh Nixon Peabody LLP Clinton Square, PO Box 31051 Rochester, NY 14603-1051 UNITED STATES nytm@nixonpeabody.com Phone:(585) 263-1000
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Applicant Information

Application No	78317588	Publication date	04/19/2005
Opposition Filing Date	08/16/2005	Opposition Period Ends	08/17/2005
Applicant	Weyer, Frank M 264 S La Cienega Blvd #1224 Beverly Hills, CA 90211 UNITED STATES		

Goods/Services Affected by Opposition

Class 025.

All goods and services in the class are opposed, namely: Clothing, namely shirts

Attachments	DOC008.PDF (4 pages)
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Signature	/kristenmwalsh/
Name	Kristen M. Walsh
Date	08/16/2005

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

FASHION INSTITUTE OF TECHNOLOGY,

Opposer,

Opposition No. _____

- vs -

Serial No. 78/317,588

FRANK M. WEYER,

Applicant.

NOTICE OF OPPOSITION

Opposer, Fashion Institute of Technology, a community college organized under the laws of the State of New York, with a principal place of business at Seventh Avenue at 27th Street, New York, New York 10001-5992 ("Opposer"), hereby opposes registration of United States Trademark Application Serial No. 78/317,588, published in the *Official Gazette* of April 19, 2005, and requests that registration to Applicant be refused.

This Notice of Opposition is timely filed pursuant to the First 30 Day Request for Extension of Time to Oppose filed by Opposer on May 3, 2005, and the 60 Day Request for Extension of Time to Oppose for Good Cause filed by Opposer on June 16, 2005.

As grounds in support of its opposition, Opposer asserts as follows:

1. Applicant seeks to register the mark NYFIT as a trademark for "clothing, namely, shirts."
2. The opposed Application has been assigned Serial No. 78/317,588, and was filed on October 23, 2003, based upon an alleged *bona fide* intention to use the mark in commerce.

3. Opposer, established in 1944, is a public institution of higher education located in New York City that offers associate, bachelor's, and master's degrees programs in a wide range of fields in art and design, business, and technology.

4. Opposer is well-known by its acronym FIT, and has used FIT as a trade name, trademark, and service mark for many years. Opposer also uses FIT in the domain name for its website, i.e., www.fitnyc.edu.

5. Opposer is the owner of the following United States Trademark Registrations, each of which is valid, subsisting, unrevoked, and uncanceled :

Mark	Reg. No.	Reg. Date	Goods/Services
FIT	2,247,127	5/25/1999	clothing, namely, t-shirts, long-sleeved t-shirts, sweatshirts, sweatpants, hats, caps and headbands
FIT	2,238,203	4/13/1999	educational services, namely, providing courses of instruction at the college level
FIT	2,310,237	1/25/2000	drinking glasses, coffee mugs, beverage containers, paper weights, household and office utensils
F.I.T.	2,035,671	2/4/1997	educational services, namely, providing courses of instruction at the college level

6. Opposer is using and has used the mark FIT on clothing since at least as early as September 1996, long prior to the October 23, 2003 filing date of Applicant's intent-to-use application.

7. Opposer has actively, continuously, and consistently promoted its goods and services under the mark FIT on a nationwide and international basis.

8. As a result of extensive use and advertising by Opposer, the mark FIT has become well known, and Opposer has built up valuable and substantial goodwill in the mark. The FIT

mark is closely and uniquely associated with Opposer and the services and related goods that it offers.

9. The goods set forth in Application Serial No. 78/317,588 are identical to goods on which Opposer has used and is using its FIT mark. Consequently, if Applicant's mark is used on its goods, it would be likely to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

10. The NYFIT mark sought to be registered by Applicant incorporates Opposer's registered mark FIT, and is substantially similar to Opposer's FIT marks listed above.

11. Because FIT is located in New York City, customers and potential customers are likely to believe incorrectly that shirts bearing Applicant's mark NYFIT emanate from, or are licensed or approved by, Opposer.

12. Because Opposer can be found on the Internet at the website www.fitnyc.edu, customers and potential customers are likely to believe incorrectly that shirts bearing Applicant's mark NYFIT emanate from, or are licensed or approved by, Opposer.

13. Applicant's mark so resembles Opposer's previously used and registered mark FIT as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

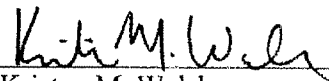
14. Based on the foregoing, the registration of NYFIT, subject of Application Serial No. 78/317,588, will cause injury and damage to Opposer.

WHEREFORE, Opposer prays that the opposition be sustained, that Application Serial No. 78/317,588 be rejected, and that the mark applied for therein be refused registration.

Respectfully submitted,

NIXON PEABODY LLP

Dated: August 16, 2005

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