

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF NEW YORK**

NEW YORK STATE DEPARTMENT OF )  
ECONOMIC DEVELOPMENT f/k/a THE )  
NEW YORK STATE DEPARTMENT )  
OF COMMERCE ECONOMIC )  
DEVELOPMENT, )  
an official agency within the administrative )  
offices of the State of New York )  
 )  
Plaintiff, )  
 )  
v. )  
 )  
I LOVE SANTA BARBARA, INC. )  
 )  
Defendant. )  
\_\_\_\_\_ )

Civil Action No.

**COMPLAINT  
AND DEMAND  
FOR JURY TRIAL**

Plaintiff New York State Department of Economic Development (hereinafter “NYSDED” or “Plaintiff”), by and through undersigned counsel, hereby files this Complaint against Defendant I Love Santa Barbara, Inc. (hereinafter “Defendant”) and states as follows:

**THE PARTIES**

1. NYSDED is an official agency within the administrative offices of the State of New York, having an address at 30 South Pearl Street, 6<sup>th</sup> floor, Albany, NY 12245.

2. Upon information and belief, Defendant I Love Santa Barbara, Inc. is a California corporation owned by Stephen C. Gaither, with a principal place of business at 102 Calle Palo Colorado, Santa Barbara, California 93105.

### JURISDICTION AND VENUE

3. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1071(b)(1), which provides that a party dissatisfied with a final decision of the United States Trademark Trial and Appeal Board may institute a new civil proceeding challenging such decision.

4. This Court also has subject matter jurisdiction pursuant to 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331, 1338, and 1367, and Declaratory Judgment pursuant to 28 U.S.C. §2201.

5. Personal jurisdiction exists over Defendant because they have sufficient minimum contacts with the forum as a result of transacting and doing business within the State of New York and the Northern District of New York. Personal jurisdiction also exists over Defendant because of its conduct in offering its services under the Infringing Marks within the State of New York and the Northern District of New York. Upon investigation and information, the Infringing Marks are being used to promote and advertise services at issues on the websites [www.visitsantabarbara.com](http://www.visitsantabarbara.com) and [www.montecitomarketing.com](http://www.montecitomarketing.com), which are affiliated with Defendant.

6. Venue is proper within this judicial district under 28 U.S.C. § 1391(b).

### NATURE OF THE ACTION

7. This Action seeks *de novo* review, pursuant to 15 U.S.C. § 1071(b), of an administrative decision by the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (the “TTAB”) in a trademark opposition proceeding brought by NYSDDED entitled *New York State Department of Economic Development v. I Love Santa Barbara, Inc.*, Opposition No. 91165648 (hereinafter the “Opposition”). By Order dated October 31, 2007 the TTAB dismissed the Opposition of NYSDDED and permitted the registration of the Defendant’s “**I♥SB**” (the “First Infringing Mark”), which is the subject of Defendant’s U.S. Trademark

Application Serial No. 78/364,580 (“Defendant’s Application”). A true and accurate copy of the TTAB Order dated October 31, 2007 is attached hereto as **Exhibit A**.

8. NYSDED’s Opposition was based on Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and alleged that the First Infringing Mark, when used as a trademark for “promoting Santa Barbara, California as a place to live and visit and the economic development thereof” identified in International Class 35 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between NYSDED and Defendant, or as to the origin, sponsorship, or approval of Defendant’s goods, services and other commercial activities.

9. The Opposition was also based on the grounds that the trademarks of NYSDED (defined below as the “NYSDED Marks”) are of sufficient fame and reputation among consumers so that when the First Infringing Mark is used in connection with the services set forth in the application, a false connection, sponsorship or affiliation with NYSDED and/or the NYSDED marks will be presumed by consumers.

10. The TTAB found that NYSDED failed to properly enter its exhibits into the record and, therefore, failed to establish the NYSDED Marks had priority over the Infringing Mark. As such, the TTAB never reached the issue of likelihood of confusion.

11. This Action also involves a claim for trademark infringement under the Lanham Act, 15 U.S.C. § 1051 *et seq.*, based on the likelihood of confusion as to the relationship, sponsorship or affiliation with NYSDED caused by Defendant’s use of the First Infringing Mark and use of the designation:





to identify its services of “promoting Santa Barbara, California as a place to live and visit and the economic development thereof,” since at least as early as March 3, 2002 (“Second Infringing Mark”). The Second Infringing Mark registered with the U.S. Patent and Trademark Office as U.S. Trademark Registration No. 3,001,095 on September 27, 2005. The First Infringing Mark and the Second Infringing Mark shall be referred to collectively as “the Infringing Marks.”






12. NYSDED seeks an Order of this Court: (1) Reversing the TTAB Order, which dismissed the Opposition; (2) Sustaining the Opposition and dismissing Defendant’s application for a U.S. Trademark Registration for the First Infringing Mark; (3) Cancelling U.S. Trademark Registration No. 3,001,095 for the Second Infringing Mark; (4) Enjoining Defendant from further use of the Infringing Marks; and (5) Finding Defendant liable for: (a) trademark infringement under 15 U.S.C. § 1114, (b) trademark dilution under 15 U.S.C. § 1135(c), (c) common law infringement, and (d) common law unfair competition.

**BACKGROUND FACTS**

**The NYSDED Trademark and Products**

13. NYSDED is the owner of the entire right, title and interest in and to, *inter alia*, the following federally-registered trademarks and/or service marks:

<i>Registration Number</i>	<i>Trademark</i>	<i>Goods and Services</i>
1,555,836		T-shirts, gloves, hats, jackets, sport shirts, sweaters, scarves, sweatshirts, and shoes.
1,558,379		Promoting the State of New York as a tourist attraction and enhancing its economic development.

2,431,705		Traveling Bags, tote bags, drawstring pouches, all-purpose sports bags, cosmetic bags sold empty, umbrellas, parasols and walking sticks.
2765,227		Promoting the economic development of New York State.
2,765,228		Promoting the economic development of New York State.
2,769,939		Promoting the economic development of New York State.
2,788,008		Promoting the economic development of New York State.

14. Annexed hereto as **Exhibit B** are true and accurate copies of printouts from the United States Patent and Trademark Office web site evidencing NYSDDED’s ownership of these trademarks. All of the registrations set forth in **Exhibit B** are valid, subsisting, unrevoked and uncanceled. Additionally, many of these registrations are incontestable. NYSDDED also owns common law rights in the above and other marks. These registered and common law trademarks are collectively referred to as the “NYSDDED Marks.”

15. NYSDDED was created to promote travel and tourism in and to the State of New York throughout the country and world by, for example, distributing pamphlets and promotion on the Internet.

16. Since 1977, NYSDDED, directly and through its predecessors, licensees, and marketing partners, has been engaged in the sale of a wide spectrum of goods and services under

the NYSDDED Marks, including, but not limited to, advertising and licensing in commerce related to travel and tourism (“NYSDDED Products”).

17. For many years, and long prior to Defendant’s filing its applications, NYSDDED has used the NYSDDED Marks in interstate commerce throughout the United States and in connection with a variety of goods and services in printed and paper products, apparel, jewelry, toys, advertising, and multimedia fields.

18. NYSDDED has expended substantial amounts of time, effort, and money in advertising and promoting its goods and services under the NYSDDED Marks. As a result, consumers, potential consumers, and the general public have come to associate and identify the NYSDDED Marks with NYSDDED and NYSDDED derives substantial goodwill from such identification.

19. As a result of NYSDDED’s advertising and promotional activities, the NYSDDED Marks have become famous, both in the United States and throughout the world.

**Defendant’s Activities**

20. Defendant owns and operates different websites on the Internet at, for example, [www.visitsantabarbara.com](http://www.visitsantabarbara.com) and [www.montecitomarketing.com](http://www.montecitomarketing.com), bearing the Infringing Marks, marks confusingly similar to NYSDDED’s Marks, and promoting travel and tourism to Santa Barbara, California (“Defendant’s Services”).

21. Upon investigation and information, the services at issue are being marketed and advertised using the Infringing Marks on the websites located at [www.visitsantabarbara.com](http://www.visitsantabarbara.com) and [www.montecitomarketing.com](http://www.montecitomarketing.com), which are affiliated with Defendant.

22. On February 9, 2004, with full knowledge of the famous NYSDDED Marks, Defendant filed two trademark registration applications with the U.S. Patent and Trademark

Office for the First and Second Infringing Marks, respectively, for use in connection with:  
“promoting Santa Barbara, California as a place to live and visit and the economic development thereof.”

23. The Infringing Marks, as Defendant is currently using them, are likely to cause confusion as to the relationship, sponsorship or affiliation between NYSDDED and Defendant and its services.

### **FIRST CLAIM FOR RELIEF**

#### **(Trademark Infringement Under 15 U.S.C. § 1114)**

24. NYSDDED realleges and incorporates by reference the allegations above.

25. Defendant’s services are marketed through the same channels of trade and to the same customers through which NYSDDED’s service are marketed.

26. Defendant’s use of the Infringing Marks in its marketing and advertising is likely to cause confusion or to cause mistake, or to deceive consumers as to the origin, sponsorship or approval of Defendant’s services of NYSDDED’s services and products, or is likely to cause consumers to believe that Defendant and NYSDDED is somehow affiliated, connected or associated with each other when, in fact, they are not.

27. The NYSDDED Marks and the goodwill of the businesses associated with them in the United States and throughout the world are of great and significant value, are highly distinctive and arbitrary, and have become universally associated in the public mind with the State of New York and its various attractions, commercial markets, entertainment venues, and inviting atmosphere.

28. Defendant has advertised and marketed Defendant’s Services to the consuming public in competition with NYSDDED, in or affecting interstate commerce.

29. Defendant's use of the Infringing Marks constitutes an infringement of NYSDDED's Marks in violation of the Federal Lanham Act, 15 U.S.C. §1114.

30. Defendant's infringement has and continues to injure the goodwill of NYSDDED and its high-quality products and services.

31. Defendant's infringement of the NYSDDED Marks has been willful and deliberate for the purpose of misleading consumers and injuring the goodwill of NYSDDED.

32. Pursuant to 15 U.S.C. §1117, NYSDDED is entitled to damages for Defendant's infringement, an accounting of profits made by Defendant by its actions and recovery of NYSDDED's costs of this action.

33. The acts of Defendant make this an exceptional case entitling NYSDDED to recover treble damages and reasonable attorneys' fees pursuant to 15 U.S.C. §1117.

34. Defendant's use of the Infringing Marks has caused and will continue to cause irreparable harm to NYSDDED, unless Defendant is enjoined from further use.

35. Pursuant to 15 U.S.C. §1116, NYSDDED is entitled to preliminary and permanent injunctive relief to prevent Defendant's continuing infringement of the NYSDDED Marks.

36. NYSDDED does not have an adequate remedy at law, and will continue to be damaged by the use of the Infringing Mark unless this Court enjoins Defendant from such use.

### **SECOND CLAIM FOR RELIEF**

#### **(Trademark Dilution Under 15 U.S.C. § 1125(c))**

37. NYSDDED realleges and incorporates by reference the allegations above.

38. NYSDDED's Marks are "famous marks" worldwide within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c)(1) as a result of NYSDDED's continuous and

exclusive use of the NYSDDED Marks. NYSDDED Marks became famous marks prior to Defendant's use of the Infringing Marks.

39. Defendant has used and continues to use marks confusingly similar to the NYSDDED Marks on or in connection with the advertising, marketing and promotion of Defendant's Services.

40. The use in commerce of Defendant's Services is likely to dilute, blur, tarnish, and/or whittle away the distinctiveness of the NYSDDED Marks.

41. As a direct and proximate result of Defendant's conduct, NYSDDED has suffered damage to their valuable NYSDDED Marks and other damages in an amount to be proved at trial.

42. NYSDDED does not have an adequate remedy at law, and will continue to be damaged by the use of the Infringing Marks unless this Court enjoins Defendant from such use.

### **THIRD CLAIM FOR RELIEF**

#### **(Common Law Trademark Infringement)**

43. NYSDDED realleges and incorporates by reference the allegations above.

44. As a result of the experience, care and service of NYSDDED in producing and providing the NYSDDED Products, the NYSDDED Products have become widely known and have acquired a worldwide reputation for excellence. Moreover, the NYSDDED Marks have become associated with the NYSDDED Products, and have come to symbolize the reputation for quality and excellence of the NYSDDED Products.

45. Defendant's use of the Infringing Marks, including the exact color scheme used by NYSDDED, has caused and continues to cause confusion as to the source and/or sponsorship of Defendant's products.

46. Defendant's actions constitute trademark infringement in violation of NYSDDED's rights under the common law of the State of New York. Said infringement has and continues to injure the goodwill of NYSDDED and its products and services.

47. NYSDDED is entitled to damages for Defendant's infringement and an accounting of profits made by Defendant through its actions and recovery of NYSDDED's costs in this action.

48. The acts of Defendant have been malicious and calculated to injure NYSDDED. The willful, wanton and malicious nature of Defendant's conduct entitles NYSDDED to an award of its reasonable attorneys fees and punitive damages against Defendant.

49. Defendant's infringement of the NYSDDED Marks is injuring NYSDDED's goodwill and, unless enjoined from doing so by this Court, will continue to do so.

50. NYSDDED is entitled to preliminary and permanent injunctive relief to prevent Defendant's continued infringement of the NYSDDED Marks.

#### **FOURTH CLAIM FOR RELIEF**

##### **(False Designation of Origin Under 15 U.S.C. §1125(a))**

51. NYSDDED realleges and incorporates by reference the allegations above.

52. This claim arises under §43(a) of The Lanham Act (15 U.S.C. §1125(a)).

53. The use of the Infringing Marks by Defendant is a false designation of origin or sponsorship as to services made available by Defendant and tends falsely to represent that Defendant's services originate from NYSDDED or that said services have been sponsored, approved, authorized or licensed by NYSDDED or are in some way affiliated or connected with NYSDDED or that NYSDDED's goods and/or services originate from Defendant or are sponsored, approved, authorized or licensed by Defendant.

54. Defendant's conduct is likely to confuse, mislead and deceive a not insubstantial number of relevant consumers and members of the public as to the origin of the services or to cause said persons to believe that the services have been sponsored, approved, authorized or licensed by NYSDDED or are in some way affiliated with NYSDDED or that NYSDDED's goods and services originate from Defendant or are sponsored or licensed by Defendant all in violation of §43(a) of the Lanham Act (15 U.S.C. 1125(a)).

55. NYSDDED has no adequate remedy at law.

**FIFTH CLAIM FOR RELIEF**

**(Cancellation of Trademarks Under 15 U.S.C. §1119)**

56. NYSDDED realleges and incorporates by reference the allegations above.

57. Based on the TTAB Order of October 31, 2007, Defendant's Application will likely register as a U.S. Trademark Registration. In the event that the mark covered by Defendant's Application is registered or will register, NYSDDED seeks a ruling under 15 U.S.C. §1119 that such registration, and U.S. Trademark Registration No. 3,001,095, issued erroneously and such registrations be cancelled in view of NYSDDED's prior rights.

58. In view of the identity and similarity of the Infringing Marks to the NYSDDED Marks, and the identity and close relationship of Defendant's services with NYSDDED's Products, the Infringing Marks as applied to Defendant's services so resemble the NYSDDED Marks, as applied to the products and serves marketed and sold by NYSDDED in connection with the NYSDDED Marks, as to be likely to cause confusion or cause mistake or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d) and Defendant is entitled to cancellation of the Infringing Marks under 15 U.S.C. §1119.

## PRAYER FOR RELIEF

WHEREFORE, Plaintiff requests this Court to enter judgment:

1. Reversing the TTAB Order dated October 31, 2007, which dismissed NYSDDED's opposition and permitted registration of the First Infringing Mark.
2. Sustaining NYSDDED's Opposition as to Defendant's Application with the U.S. Patent and Trademark Office.
3. Ordering that Defendant, their officers, agents, servants, employees, attorneys, confederates, and all persons acting for, with, by, through or under them be enjoined and restrained, at first during the pendency of this action and, thereafter, permanently:
  - (a) From using in any manner the Infringing Marks or in combination with any word or words which so resemble the NYSDDED Marks as to be likely to cause confusion, deception, or mistake;
  - (b) From further diluting and infringing the NYSDDED Marks; and
  - (c) From otherwise competing unfairly with PEI or any of its authorized licensees in any manner.
4. Ordering that Defendant be required to deliver to NYSDDED any and all products, guarantees, circulars, price lists, labels, signs, prints, packages, wrappers, pouches, receptacles, advertising matter, promotional, and other materials in the possession of Defendant or under its control bearing the Infringing Marks.
5. Ordering that Defendant be required to deliver up for destruction their entire inventory of said products bearing the Infringing marks.
6. Ordering that Defendant, within thirty (30) days after service of judgment with notice of entry thereof upon it, be required to file with the Court and serve upon NYSDDED a

written report under oath setting forth in detail the manner in which Defendant has complied with paragraphs 2 through 4, *supra*.

7. Ordering Defendant to expressly voluntarily abandon any pending federal, state or international trademark application which include, in whole or in part, an infringement of NYSDDED Marks, including Defendant's Application, and, in the event any such applications mature to registration prior to the issuance of any such Order, including U.S. Registration No. 3,001,095, that Defendant be required to expressly voluntarily cancel such registrations

8. Ordering that U.S. Trademark Registration No. 3,001,095 and any federal registration issuing from U.S. Serial No. 78/364,580 be cancelled pursuant to 15 U.S.C. §1119.

9. Finding Defendant liable for:

- (a) Trademark Infringement under 15 U.S.C. § 1114;
- (b) Trademark dilution under 15 U.S.C. § 1125(c);
- (c) Common law trademark infringement; and
- (d) False Designation of Origin under 15 U.S.C. 1125(a);

10. Ordering that Defendant account for and pay over to NYSDDED all profits realized by Defendant for infringement of NYSDDED's registered and common law trademarks.

11. Ordering that NYSDDED be awarded actual damages in an amount to be determined at trial.

12. Ordering Defendant Pay to NYSDDED treble damages.

13. Ordering that NYSDDED be awarded reasonable attorneys' fees and costs.

14. Ordering that NYSDDED have such other and further relief as the Court may deem equitable and proper.

**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, NYSDSD demands a jury trial on all triable issues that are raised by this Complaint.

Respectfully submitted,

HESLIN ROTHENBERG FARLEY & MESITI P.C.

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*Attorneys for Plaintiff*

Dated: December 28, 2007

# **EXHIBIT A**

THIS OPINION  
IS NOT A PRECEDENT OF  
THE T.T.A.B.

Mailed: 10/31/07

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

New York State Department of Economic Development fka The  
New York State Department of Commerce

v.

I Love Santa Barbara, Inc.

Opposition No. 91165648  
to application Serial No. 78364580  
filed on February 9, 2004

Lawrence V. Molinar of CMG Worldwide, Inc. for The New York  
State Department of Economic Development fka The New York  
State Department of Commerce.

Jeffrey Furr for I Love Santa Barbara, Inc.

Before Quinn, Holtzman and Taylor, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

I Love Santa Barbara, Inc. filed an application to  
register the mark shown below

**I ♥ SB**

for services identified as "promoting Santa Barbara, California as a place to live and visit and the economic development thereof" in International Class 35.<sup>1</sup>

The New York State Department of Economic Development opposed registration, alleging that since 1977 opposer and its predecessors have engaged in a program to promote travel and tourism in the state of New York; that since 1977 it has been engaged in the sale and distribution of a wide spectrum of goods and services under its I♥NY marks; that I♥NY marks have become synonymous with the state of New York and its various attractions, commercial markets and entertainment venues; that opposer owns registrations of various I♥NY marks for a variety of goods and services, including printed and paper products, apparel, jewelry, toys, advertising and multimedia; that opposer's marks are famous; and that applicant's mark is likely to cause confusion or mistake or to confuse the public into believing that applicant's goods are associated with opposer, in violation of Section 2(d) of the Trademark Act.<sup>2</sup>

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<sup>1</sup> Application Serial No. 78364580, filed on February 9, 2004, alleging March 1, 2002 as the date of first use anywhere and in commerce.

<sup>2</sup> Opposer also asserted that registration of applicant's I♥SB mark would likely dilute the distinctive quality of opposer's I♥NY marks, in violation of Section 43(c) of the Trademark Act. However, opposer never discussed this ground in its brief, and, moreover, it identified likelihood of confusion as the only issue in the case. (Brief, p. 13). Accordingly, we consider the dilution claim to have been waived.

In its answer to the notice of opposition, applicant "does not deny" that opposer "obtained" its pleaded registrations, but applicant goes on to essentially deny the validity of several of the registrations by indicting that they are either expired or canceled. (Paragraph 5). In addition, applicant "does not deny" that opposer's registrations are *prima facie* evidence of the validity of the registered marks and of opposer's exclusive right to use I♥NY in commerce in connection with the goods and services listed in the registrations. (Paragraph 6). Applicant denied the other salient allegations of the notice of opposition. Applicant also pleaded certain affirmative defenses, and further set forth allegations that serve to amplify its denials.

#### The Record

There are numerous critical problems with the record sought to be introduced by opposer. Opposer did not take any testimony, but rather sought to make of record, essentially by notice of reliance, a number of exhibits. We note, however, that almost all of these exhibits are not appropriate for introduction under a notice of reliance.<sup>3</sup>

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<sup>3</sup> These evidentiary problems are virtually identical to the ones the Board encountered in Opposition No. 91162024, *The New York State Department of Economic Development v. Michael Nnamdi Stewart* (final decision dated March 13, 2007). In that decision, the Board stated that the evidentiary matters were reminiscent of the ones in *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998), wherein the opposer also attempted to submit,

**Opposition No. 91165648**

In this connection, applicant, in its brief, objected to several of the exhibits on a variety of grounds. (Brief, pp. 2-4).

In order to determine what constitutes the record upon which we must decide this case, we will examine the parties' notices of reliance.

Opposer has submitted printouts from various websites. Webpages may not be made of record, however, by notice of reliance. As the Board stated in *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1302 n.3 (TTAB 2004):

Internet evidence is not proper subject matter for introduction by notice of reliance because the evidence is not self-authenticating. As the Board has stated in the past, the element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). See also TBMP §704.08 (2d ed. rev. 1 March 2004).

Accordingly, Exhibits A, C, D, CC, EE, FF, UU and VV, and the copy of the Kwigy-Bo website that is part of Exhibit Q are not properly of record, and have not been considered.

Opposer has submitted "soft" copies of its pleaded trademark registrations. Trademark Rule 2.122(d) provides

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by notice of reliance, declarations of the opposer's officer and photocopies of goods on which the opposer's marks appeared. The Board found that those exhibits were not properly made of record by opposer's notice of reliance, and they were not considered.

the manner in which an opposer may properly make its registration(s) of record:

- (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see §2.6(b)(4).
- (2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Further, the Board's June 30, 2006 decision denying opposer's motion for summary judgment indicated that "opposer did not submit sufficient evidence of its ownership of its pleaded registrations," specifically noting that opposer did not submit status and title copies of its registrations, and referring opposer to Trademark Rule 2.122(d)(1) and TBMP §528.05(d) (2d ed. rev. 2004). The

Board thus found that priority of use remained an issue for trial. The registrations submitted by opposer during its testimony period are not copies prepared by the Office showing current status of and current title to the registrations.<sup>4</sup> Accordingly, opposer's registrations are not properly of record. Exhibits MM, NN, OO, PP, QQ, RR, SS and TT have not been considered.

Opposer submitted the declarations of Thomas Regan and Danielle Luhmann; these declarations were also submitted in connection with its motion for summary judgment. Evidence submitted with a motion for summary judgment is of record only for purposes of that motion. Thus, to be part of the evidentiary record to be considered at final hearing, the evidence must be properly introduced in evidence during the appropriate testimony period. TBMP §528.05(a) (2d ed. rev. 2004). Further, Trademark Rule 2.123(b) provides, in part, that "[b]y written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses."

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<sup>4</sup> The Board's new rules allow proof of a pleaded registration by submission of a "current printout of information from the electronic database records of the USPTO showing the current status and title of the registration" as an alternative to submission of a status and title copy of the registration. See Trademark Rule 2.122(d) (effective August 31, 2007, by Final Rule Notice, 72 Fed. Reg. 42242 (August 1, 2007)). However, the rule, as now amended, applies only to cases filed on or after the effective date of August 31, 2007, and it is not applicable here. Further, and in any event, the copies submitted by opposer are mere photocopies of the registrations, and are not copies retrieved from a USPTO electronic database.

**Opposition No. 91165648**

No stipulation has been submitted to allow opposer to submit the testimony of its witnesses by affidavit or declaration. Accordingly, Exhibits F and G are not properly of record, and have not been considered.

Opposer submitted several photo prints of what it asserts to be licensed products. While opposer cites to Trademark 2.122 in submitting these exhibits, there is nothing in this rule that provides for the submission of photo prints of products under a notice of reliance. As previously discussed, Trademark Rule 2.122(d)(2) concerns registrations, and Trademark Rule 2.122(e) provides for the introduction of printed publications and official records under a notice of reliance. Photo prints of products do not fall under any of these categories. *See Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d at 1403-05. Accordingly, Exhibits I, J, K, L, M, N, O, P, Q, R, S, T, U, V and DD have not been considered.

Opposer also submitted copies of license agreements for several of the products shown in the above-mentioned exhibits. Because these agreements are not printed publications or official records, they cannot be made of record by a notice of reliance. Accordingly, Supplemental Exhibits K, L, M, N, O, P, Q, R, S, T, U, V, W, X and Y have not been considered.

**Opposition No. 91165648**

Similarly, the photo prints of a storyboard for a television commercial, and the photo prints of "image captures" and artwork attributable to the production of two motion pictures and a television program, are not proper subject matter for introduction by way of a notice of reliance. Accordingly, Exhibits GG, HH, II and JJ have not been considered.

Opposer also submitted copies of license agreements related to the uses in the above media. As indicated above, because license agreements are neither printed publications nor official records, they cannot be made of record by a notice of reliance. Accordingly, Supplemental Exhibits Z, AA, BB and CC have not been considered.

The fact that opposer has accompanied its notice of reliance with counsel's affidavit is of no moment. Mr. Molinar affirms in his affidavit "the authenticity of the photo prints submitted as true and accurate images of said specimens, as well as the existence of agreements." Firstly, the affidavit in itself is inappropriate inasmuch as the parties did not agree thereto. See Trademark Rule 2.123(b). Secondly, as indicated earlier, the photo prints and license agreements are not proper subject matter for introduction by way of notice of reliance, and Mr. Molinar's affidavit does not cure opposer's failure to follow the

**Opposition No. 91165648**

proper procedures for making this evidence of record in a Board proceeding.

Exhibit H, opposer's listing of advertising expenditures, and Exhibit WW, copies of written communications between the parties' attorneys, cannot be made of record by a notice of reliance, and these exhibits have not been considered.

Opposer also has submitted with its notice of reliance copies of catalogs that appear to be catalogs of some of its licensees or sub licensees. However, because there is no evidence that these catalogs are available to the general public in libraries or of general circulation among members of the public, they cannot be treated as printed publications. See *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960) [finding that Fuller Brush catalogs should not be admitted into evidence by notice of reliance]. The assumption that printed publications, such as books and periodicals, may be submitted by notice of reliance is that a party is or may readily become familiar with printed matter in libraries open to the public or in general circulation. *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090 (TTAB 1979). See also *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) ["Applicant's objections to opposer's catalogs and house publications are

**Opposition No. 91165648**

well taken because it has not been shown that they are 'available to the general public in libraries or of general circulation'"); and *Standard Pressed Steel Co. v. Midwest Chrome Process Co.*, 183 USPQ 758, 760 n.2 (TTAB 1974) [Brochures and price lists distributed by third parties do not constitute printed publications, such as books and periodicals, available to the general public in libraries or of general circulation]. Accordingly, Exhibits W, X, Y, Z, AA and BB are not properly of record, and have not been considered.

There are a few exhibits that opposer submitted under notice of reliance that are properly of record. They are Exhibit B, excerpts from a book; Exhibit E, a newspaper article; and Exhibit KK, applicant's responses to opposer's interrogatories. Opposer also attempted to introduce applicant's responses to opposer's request for production of documents, Exhibit LL. Trademark Rule 2.120(j)(3)ii) provides, however, that "[a] party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)." The produced documents are not admissible by notice of reliance. Accordingly, Exhibit LL

is not properly of record, and these documents have not been considered.

Applicant, for its part, did not take testimony or introduce any other evidence. Applicant did, however, attach to its brief notices of reliance accompanied by exhibits. There are problems with applicant's evidentiary submissions as well.

The overriding problem with applicant's submission is its untimeliness. A notice of reliance must be filed during the offerer's testimony period; applicant failed to take this action during the appropriate time period. See TBMP §704.02 (2d ed. rev. 2004). Further, exhibits attached to a brief can be given no consideration unless they were properly made of record during the time for taking testimony. See TBMP §704.05(b) (2d ed. rev. 2004). Accordingly, none of the exhibits accompanying applicant's brief have been considered in reaching our decision.

In addition to opposer's Exhibits B, E and KK, the record includes the pleadings and the file of the opposed application. Both parties have filed briefs.

#### Facts

As is readily apparent from the above rulings, there is very little factual information that is properly of record about the parties. With respect to opposer and its activities, the book and newspaper article (Exhibits B and

**Opposition No. 91165648**

E), the only documents of record that contain any information about opposer, cannot be used to prove the truth of the statements made therein.

With respect to applicant and its activities, we have only the interrogatory answers that it provided to opposer. Applicant was incorporated in 2002, and since that time "has been actively developing the core business of PhotoTours, Inc. which has been designed to promote the sale of real estate and tourism in and around Santa Barbara, California, using both online and print outlets." (No. 1). Applicant states that it "is currently using [its mark] online and intends to use [its mark] in connection with various tangible goods once it has been registered," and that "[w]hile there are prototypes of such goods and services and the actual use of [its mark] online, to date there has been no actual offer of sale of these goods or services bearing applicant's mark." (No. 3). Further, applicant states that the trade channels for its products are "print media and Internet" (No. 8), and that its customers are "local businesses, real estate brokers and agents; and tourists and real estate consumers from a global audience" (No. 9).

**Standing**

A threshold requirement to bring an opposition proceeding is that the plaintiff must establish its standing. See *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d

**Opposition No. 91165648**

1023 (Fed. Cir. 1999). We find that opposer has failed to do so in this case.

We note applicant's statements, in its answer, that it "does not deny" that opposer obtained certain registrations (Paragraph 5), and that opposer's registrations are *prima facie* evidence of the validity of the registered marks and of opposer's exclusive right to use I♥NY in commerce in connection with the goods and services listed in the registrations (Paragraph 6). We find, however, that the answer did not relieve opposer of its burden of proof relative to standing. There is no clear admission by applicant and, in fact, applicant went on in the next sentence of its answer to point out that several specific registrations were canceled.

Opposer has the burden to prove its standing. Opposer failed to meet this burden because it did not make its evidence properly of record. It is very apparent that opposer itself did not consider applicant's answer as an admission of any aspect of opposer's case, including standing or priority. Thus, opposer did not rely on any perceived "admissions" made by applicant in its answer such that opposer believed it had no need to file evidence to prove its standing. Further, opposer, in its brief, relied upon its improperly submitted evidence rather than on any perceived admissions by applicant. Thus, opposer was not

under a mistaken belief that it did not need to file evidence to prove its standing. And, indeed, opposer, during its testimony period, attempted to make certain evidence of record, including its registrations. However, as discussed above, the evidence was improperly submitted and thus cannot be considered.

In sum, the record is devoid of any probative evidence to establish that opposer is more than a mere intermeddler. Accordingly, we find that opposer has failed to prove its standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

**Priority and Likelihood of Confusion**

Even assuming opposer had proven its standing, opposer has failed to establish priority. For the same reasons as set out above in finding a lack of proof regarding standing, opposer has failed to prove that it has priority.

Opposer, during its testimony, attempted to introduce evidence bearing on priority. Opposer's burden in this regard should have been clear to opposer when it received the Board's pre-trial order denying opposer's motion for summary judgment. In the order, the Board reviewed the pleadings and opposer's evidence bearing on priority. The Board found that priority remained an issue for trial because "opposer did not submit sufficient evidence of its ownership of its pleaded registrations." Thus, opposer was

Opposition No. 91165648

on notice that it needed to take affirmative action during its testimony period to make the registrations of record or to otherwise prove its priority. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Because opposer did not prove priority, it cannot succeed on the ground of likelihood of confusion.

**Decision:** The opposition is dismissed.

# **EXHIBIT B**

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-05-14 14:39:20 ET

Serial Number: 73758742 Assignment Information

Registration Number: 1555836

Mark



(words only): I NY

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1997-05-23

Filing Date: 1988-10-20

Transformed into a National Application: No

Registration Date: 1989-09-12

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-01-15

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

I. NEW YORK STATE DEPARTMENT OF ECONOMIC DEVELOPMENT

**Address:**

NEW YORK STATE DEPARTMENT OF ECONOMIC DEVELOPMENT  
ONE COMMERCE PLAZA  
ALBANY, NY 12245

United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** New York

---

**GOODS AND/OR SERVICES**

---

**International Class:** 025

**Class Status:** Active

T-SHIRTS, GLOVES, HATS, JACKETS, SPORTSHIRTS, SWEATERS, SCARVES, SWEATSHIRTS AND SHOES

**Basis:** 1(a)

**First Use Date:** 1977-07-15

**First Use in Commerce Date:** 1977-07-15

---

**ADDITIONAL INFORMATION**

---

**Lining and Stippling:** THE LINING IN THE DRAWING REPRESENTS THE COLOR RED.

**Design Search Code(s):**

02.11.01 - Hearts excluding hearts as carriers or depicted on playing cards

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**MADRID PROTOCOL INFORMATION**

---

(NOT AVAILABLE)

---

**PROSECUTION HISTORY**

---

1997-05-23 - Section 8 (6-year) accepted & Section 15 acknowledged

1996-05-08 - Post Registration action mailed - Section 8

1995-09-08 - Section 8 (6-year) and Section 15 Filed

1989-09-12 - Registered - Principal Register

1989-06-20 - Published for opposition

1989-05-20 - Notice of publication

1989-01-24 - Approved for Pub - Principal Register (Initial exam)

1989-01-17 - Examiner's amendment mailed

1989-01-06 - Non-final action mailed

1988-12-23 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

---

**Correspondent**

WILLIAM J MCCANN JR  
DEPARTMENT OF ECONOMIC DEVELOPMENT  
ONE COMMERCE PLAZA  
ALBANY, NY 12245

---

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-05-14 14:39:39 ET

Serial Number: 76015092 Assignment Information

Registration Number: 2431705

Mark



(words only): I NY

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-04-02

Filing Date: 2000-03-31

Transformed into a National Application: No

Registration Date: 2001-02-27

Register: Principal

Law Office Assigned: LAW OFFICE 109

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 830 -Post Registration

Date In Location: 2007-04-02

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. New York State Department of Economic Development, The

**Address:**  
New York State Department of Economic Development, The  
One Commerce Plaza  
Albany, NY 12245

United States

**Legal Entity Type:** State Agency

**State or Country Where Organized:** New York

---

**GOODS AND/OR SERVICES**

---

**International Class:** 018

**Class Status:** Active

Traveling bags, tote bags, drawstring pouches, all purpose sports bags, cosmetic bags sold empty, umbrellas, parasols and walking sticks

**Basis:** 1(a)

**First Use Date:** 1977-07-15

**First Use in Commerce Date:** 1984-00-00

---

**ADDITIONAL INFORMATION**

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**Lining and Stippling:** The drawing is lined for the color red.

**Design Search Code(s):**

**02.11.01** - Hearts excluding hearts as carriers or depicted on playing cards

**Prior Registration Number(s):**

1555836

1558379

1704940

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2007-04-02 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-03-27 - Assigned To Paralegal

2007-02-05 - Section 8 (6-year) and Section 15 Filed

2007-02-05 - Section 8 (6-year) and Section 15 Filed

2007-02-05 - PAPER RECEIVED

2006-11-24 - Case File In TICRS

2006-10-19 - Review Of Correspondence Complete

2006-03-21 - FAX RECEIVED

2006-01-26 - Counter claim opp. for Proceeding No.

2001-02-27 - Registered - Principal Register

2000-12-05 - Published for opposition

2000-11-03 - Notice of publication

2000-09-18 - Approved for Pub - Principal Register (Initial exam)

2000-09-14 - Examiner's amendment mailed

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

LAWRENCE V. MOLNAR,

**Correspondent**

LAWRENCE V. MOLNAR,  
10500 CROSSPOINT BOULEVARD  
INDIANAPOLIS, IN 46256

---

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2007-05-14 14:40:00 ET**

**Serial Number:** 76340791 Assignment Information

**Registration Number:** 2765228

**Mark**



**(words only):** I NY

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2003-09-16

**Filing Date:** 2001-11-21

**Transformed into a National Application:** No

**Registration Date:** 2003-09-16

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 115

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 900 -File Repository (Franconia)

**Date In Location:** 2003-09-29

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. New York State Department of Economic Development

**Address:**

New York State Department of Economic Development  
30 South Pearl Street  
Albany, NY 12245

United States

**Legal Entity Type:** STATE GOVERNMENT AGENCY**State or Country Where Organized:** New York**Phone Number:** 518 292 5100

---

**GOODS AND/OR SERVICES**

---

**International Class:** 035**Class Status:** Active

PROMOTING THE ECONOMIC DEVELOPMENT OF NEW YORK STATE

**Basis:** 1(a)**First Use Date:** 2002-00-00**First Use in Commerce Date:** 2002-00-00

---

**ADDITIONAL INFORMATION**

---

**Disclaimer:** "NY"

**Description of Mark:** The mark consists of a heart's upper left quadrant of a blue background with white stars. The remaining portions of the heart consist of horizontal stripes of equal thickness. The stripes alternate in color. Beginning from the top and every other stripe moving down to the bottom is red. The second stripe and every other stripe thereafter is white. Thus, the lettering is black and the heart consists of a red, white and blue design..

**Design Search Code(s):**

02.11.13 - Hearts used as backgrounds or carriers

26.09.05 - Squares made of broken or dotted lines

26.09.25 - Squares with curved sides

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2003-09-16 - Registered - Principal Register

2003-07-08 - Allowed for Registration - Principal Register (SOU accepted)

2003-07-08 - Assigned To Examiner

2003-07-03 - Assigned To Examiner

2003-07-02 - Case File In TICRS

2003-06-18 - Statement of use processing complete

2003-05-27 - Amendment to Use filed

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-05-14 14:40:19 ET

Serial Number: 73759037 Assignment Information

Registration Number: 1558379

Mark



(words only): I LOVE NY

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1997-06-01

Filing Date: 1988-10-21

Transformed into a National Application: No

Registration Date: 1989-09-26

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 -File Repository (Franconia)

Date In Location: 1997-06-17

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. NEW YORK STATE DEPARTMENT OF ECONOMIC DEVELOPMENT

**Address:**

NEW YORK STATE DEPARTMENT OF ECONOMIC DEVELOPMENT  
ONE COMMERCE PLAZA  
ALBANY, NY 12245

United States

Legal Entity Type: State Agency

State or Country Where Organized: New York

**GOODS AND/OR SERVICES**

**International Class:** 035

**Class Status:** Active

PROMOTING THE STATE OF NEW YORK AS A TOURIST ATTRACTION AND ENHANCING ITS ECONOMIC DEVELOPMENT

**Basis:** 1(a)

**First Use Date:** 1977-07-15

**First Use in Commerce Date:** 1977-07-15

**ADDITIONAL INFORMATION**

**Lining and Stippling:** THE MARK IS LINED FOR THE COLOR RED.

**Design Search Code(s):**

02.11.01 - Hearts excluding hearts as carriers or depicted on playing cards

**Prior Registration Number(s):**

1179477

**MADRID PROTOCOL INFORMATION**

(NOT AVAILABLE)

**PROSECUTION HISTORY**

1997-06-01 - Section 8 (6-year) accepted & Section 15 acknowledged

1996-05-28 - Post Registration action mailed Section 8 & 15

1995-09-08 - Section 8 (6-year) and Section 15 Filed

1989-09-26 - Registered - Principal Register

1989-07-04 - Published for opposition

1989-06-03 - Notice of publication

1989-02-13 - Approved for Pub - Principal Register (Initial exam)

1989-01-23 - Communication received from applicant

1989-01-09 - Non-final action mailed

1988-12-29 - Assigned To Examiner

1988-11-30 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

GLENN A. WEINER, ESQ.

**Correspondent**

WILLIAM J MCCANN JR  
NEW YORK STATE DEPARTMENT OF ECONOMIC  
DEVELOPMENT  
ONE COMMERCE PLAZA  
ALBANY, NY 12245

---

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-05-14 14:40:40 ET

Serial Number: 76340790 Assignment Information

Registration Number: 2765227

Mark



(words only): INY

Standard Character claim: No

Current Status: Registered.

Date of Status: 2003-09-16

Filing Date: 2001-11-21

Transformed into a National Application: No

Registration Date: 2003-09-16

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 -File Repository (Franconia)

Date In Location: 2003-09-29

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LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. New York State Department of Economic Development

**Address:**

New York State Department of Economic Development  
30 South Pearl Street  
Albany, NY 12245

United States

**Legal Entity Type:** STATE GOVERNMENT AGENCY**State or Country Where Organized:** New York**Phone Number:** 518 292 5100

---

**GOODS AND/OR SERVICES**

---

**International Class:** 035**Class Status:** Active

PROMOTING THE ECONOMIC DEVELOPMENT OF NEW YORK STATE

**Basis:** 1(a)**First Use Date:** 2002-00-00**First Use in Commerce Date:** 2002-00-00

---

**ADDITIONAL INFORMATION**

---

**Disclaimer:** "NY"

**Description of Mark:** The mark consists of a heart's upper left quadrant of a blue background with white stars. The remaining portions of the heart consist of horizontal stripes of equal thickness. The stripes alternate in color. Beginning from the top and every other stripe moving down to the bottom is red. The second stripe and every other stripe thereafter is white. Thus, the lettering is black and the heart consists of a red, white and blue design

**Design Search Code(s):****01.01.10** - Stars, three or more; Three or more stars**01.01.13** - Stars - multiple stars with five points**02.11.13** - Hearts used as backgrounds or carriers**24.09.05** - American flags; Flags, American**24.09.25** - Bunting (flags); Flags, signal; Other flags

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2003-09-16 - Registered - Principal Register

2003-07-08 - Allowed for Registration - Principal Register (SOU accepted)

2003-07-03 - Assigned To Examiner

2003-07-02 - Case File In TICRS

2003-06-18 - Statement of use processing complete

2003-05-26 - Amendment to Use filed

2003-05-27 - PAPER RECEIVED  
2002-11-26 - Notice of allowance - mailed  
2002-09-03 - Published for opposition  
2002-08-14 - Notice of publication  
2002-05-05 - Approved for Pub - Principal Register (Initial exam)  
2002-04-18 - Communication received from applicant  
2002-04-19 - Communication received from applicant  
2002-04-19 - PAPER RECEIVED  
2002-04-08 - Final refusal mailed  
2002-03-14 - Communication received from applicant  
2002-03-14 - PAPER RECEIVED  
2002-03-08 - Non-final action mailed  
2002-03-01 - Assigned To Examiner  
2002-02-27 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Correspondent**

NEW YORK STATE DEPT OF ECON DEV  
30 SOUTH PEARL STREET  
ALBANY, NEW YORK 12245  
Phone Number: 518 292 5100

---

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2007-05-14 14:40:59 ET**

**Serial Number: 76340792 Assignment Information**

**Registration Number: 2769939**

**Mark**



**(words only): NY**

**Standard Character claim: No**

**Current Status: Registered.**

**Date of Status: 2003-09-30**

**Filing Date: 2001-11-21**

**Transformed into a National Application: No**

**Registration Date: 2003-09-30**

**Register: Principal**

**Law Office Assigned: LAW OFFICE 115**

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location: 900 -File Repository (Franconia)**

**Date In Location: 2003-10-06**

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

**1. New York State Department of Economic Development**

**Address:**

New York State Department of Economic Development  
30 South Pearl Street  
Albany, NY 12245

United States

**Legal Entity Type:** STATE GOVERNMENT AGENCY

**State or Country Where Organized:** New York

---

**GOODS AND/OR SERVICES**

---

**International Class:** 035

**Class Status:** Active

Promoting the economic development of New York State

**Basis:** 1(a)

**First Use Date:** 2002-00-00

**First Use in Commerce Date:** 2002-00-00

---

**ADDITIONAL INFORMATION**

---

**Disclaimer:** "NEW YORK"

**Design Search Code(s):**

**02.11.01** - Hearts excluding hearts as carriers or depicted on playing cards

**02.11.25** - Blood vessels, human; Brain, human; Buttocks, human; Human, other parts of the body; Intestines, human; Lungs, human; Nerves, human; Nose, human; Spine, human; Tongue, human

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2003-09-30 - Registered - Principal Register

2003-08-07 - Allowed for Registration - Principal Register (SOU accepted)

2003-07-28 - Assigned To Examiner

2003-07-25 - Case File In TICRS

2003-07-08 - Statement of use processing complete

2003-06-03 - Amendment to Use filed

2003-06-03 - PAPER RECEIVED

2003-02-18 - Notice of allowance - mailed

2002-11-26 - Published for opposition

2002-11-06 - Notice of publication

2002-07-11 - Approved for Pub - Principal Register (Initial exam)

2002-05-23 - Communication received from applicant

2002-05-23 - PAPER RECEIVED

2002-03-08 - Non-final action mailed

2002-03-01 - Assigned To Examiner

2002-02-27 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Correspondent**

NEW YORK STATE  
DEPARTMENT OF ECONOMIC DEVELOPMENT  
30 SOUTH PEARL STREET  
ALBANY, NEW YORK 12245

---

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-05-14 14:41:14 ET

Serial Number: 76318260 Assignment Information

Registration Number: 2788008

Mark



(words only): NY

Standard Character claim: No

Current Status: Registered.

Date of Status: 2003-12-02

Filing Date: 2001-09-28

Transformed into a National Application: No

Registration Date: 2003-12-02

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 -File Repository (Franconia)

Date In Location: 2003-12-08

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. New York State Department of Economic Development

**Address:**

New York State Department of Economic Development  
30 South Pearl Street  
Albany, NY 12245

United States

**Legal Entity Type:** STATE GOVERNMENT AGENCY

**State or Country Where Organized:** New York

---

**GOODS AND/OR SERVICES**

---

**International Class:** 035

**Class Status:** Active

Promoting the economic development of New York State

**Basis:** 1(a)

**First Use Date:** 2001-05-00

**First Use in Commerce Date:** 2001-05-00

---

**ADDITIONAL INFORMATION**

---

**Disclaimer:** "NY"

**Lining and Stippling:** The drawing is lined for the color(s) red.

**Design Search Code(s):**

**02.11.01** - Hearts excluding hearts as carriers or depicted on playing cards

---

**MADRID PROTOCOL INFORMATION**

---

(NOT AVAILABLE)

---

**PROSECUTION HISTORY**

---

2003-05-02 - PAPER RECEIVED

2003-12-02 - Registered - Principal Register

2003-09-09 - Published for opposition

2003-08-20 - Notice of publication

2003-07-25 - Approved for Pub - Principal Register (Initial exam)

2003-07-23 - Examiner's amendment mailed

2003-07-22 - Previous allowance count withdrawn

2003-04-07 - Approved for Pub - Principal Register (Initial exam)

2003-04-07 - Previous action count withdrawn

2003-03-17 - Petition To Revive-Granted

2003-01-31 - Petition To Revive-Received

2003-01-31 - PAPER RECEIVED

2003-04-07 - Previous action count withdrawn

2002-03-27 - Non-final action mailed

2002-03-11 - Communication received from applicant

2002-03-11 - PAPER RECEIVED

2002-01-25 - Non-final action mailed

2001-12-17 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Correspondent**

NEW YORK STATE DEPARTMENT ET AL  
30 SOUTH PEARL STREET  
ALBANY, NY 12245

---

2003-05-27 - PAPER RECEIVED

2002-12-03 - Notice of allowance - mailed

2002-09-10 - Published for opposition

2002-08-21 - Notice of publication

2002-05-05 - Approved for Pub - Principal Register (Initial exam)

2002-04-19 - Communication received from applicant

2002-04-19 - PAPER RECEIVED

2002-04-08 - Final refusal mailed

2002-03-14 - Communication received from applicant

2002-03-14 - PAPER RECEIVED

2002-03-08 - Non-final action mailed

2002-03-01 - Assigned To Examiner

2002-02-27 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Correspondent**

NEW YORK STATE  
DEPARTMENT OF ECONOMIC DEVELOPMENT  
30 SOUTH PEARL STREET  
ALBANY, NEW YORK 12245  
Phone Number: 518 292 5100

---