

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 19, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

New York University
v.
National Yang Ming Chiao Tung University

Opposition No. 91284793

Jason D. Jones and Parker C. Eudy of Fross Zelnick Lehrman & Zissu, P.C. for:
New York University.

Alexander J. Farrell of Best & Flanagan, LLP for:
National Yang Ming Chiao Tung University.

Before Wellington, Lykos, and Brock,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

National Yang Ming Chiao Tung University (“Applicant”) seeks registration on the Principal Register for the standard character mark NYCU for “organization of exhibitions for cultural or educational purposes; providing information about education,” in International Class 41.¹

¹ Application Serial No. 97128898, filed on November 17, 2021, based on Applicant’s allegation of a bona fide intent to use the mark in commerce, under Section 1(b) of the Trademark Act.

New York University (“Opposer”) opposes registration of Applicant’s mark under Trademark Act (“the Act”) Section 2(d), 15 U.S.C. § 1052(d), alleging likelihood of confusion based on its prior common law rights and pleaded registrations for marks, including NYU (in standard characters)² and NEW YORK UNIVERSITY (in standard characters with a disclaimer of UNIVERSITY),³ both for:⁴

“educational services, namely, providing courses, lecture series, and seminars at the undergraduate and graduate level; providing extension, continuing, and community education, namely, offering classes, lecture series, and seminars on various topics of interest to the public in diverse educational disciplines, including history, literature, economics, science, current events news, government affairs and politics, education, journalism, business, engineering, law, medicine, social issues, culture, and child care,” in International Class 41.

Opposer alleges that Applicant’s mark “is identical and/or highly similar to Opposer’s NYU” mark and “the services identified in the Application are identical and/or closely related to services that Opposer has long offered under its NYU marks.”⁵ Opposer also alleges that “[t]hrough years of use and the success of Opposer’s offerings under the NYU Marks, the NYU Marks have become famous ... prior to any date that Applicant can rely upon.”⁶

² Reg. No. 3770376 (“Reg. ’376”) issued on April 6, 2010 on the Principal Register, and has been renewed.

³ Reg. No. 3798562 (“Reg. ’562”) issued on June 8, 2010 on the Principal Register pursuant to a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, and has been renewed.

⁴ 12 TTABVUE (Notice of Opposition, as amended).

⁵ 12 TTABVUE 8-9 (N. of Opp. ¶¶ 13, 15). Opposer refers to itself as “NYU” in the Notice of Opposition and in its trial briefs; it also refers to the two pleaded marks as “the NYU Marks.”

⁶ 12 TTABVUE 6 (N. of Opp. ¶ 4).

Opposer additionally pleaded a claim of dilution by blurring, under Section 43 of the Act, 15 U.S.C. § 1125. Specifically, Opposer alleges that “Applicant’s registration of Applicant’s Mark in connection with the goods (sic) identified in the Application will dilute by blurring Opposer’s famous NYU Marks.”⁷

Applicant denies the salient allegations of the Notice of Opposition in its Answer.⁸

The proceeding has been fully briefed.

I. The Record and Evidentiary Issues

The record comprises the pleadings, the file of the involved application under Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). The parties submitted evidence during their assigned trial periods.⁹

The Board has carefully reviewed all evidentiary submissions, and presumes the parties’ familiarity therewith. Relevant evidence is discussed only where necessary throughout this opinion. *See QuikTrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) (Board not obliged to expressly discuss every piece of evidence); *In re Miracle Tuesday LLC*, 695 F.3d 1339, 1348 (Fed. Cir. 2012) (“[T]he mere fact

⁷ 12 TTABVUE 10 (N. of Opp. ¶ 22).

⁸ 14 TTABVUE. Applicant also asserted, as “affirmative defenses,” that the Notice of Opposition fails to state a claim upon which relief can be granted and the Applicant’s use of NYCU constitutes “fair use.” 14 TTABVUE 4. Applicant did not pursue either putative affirmative defense and they are thus deemed waived. *Keystone Consol. Indus. v. Franklin Inv. Corp.*, No. 92066927, 2024 TTAB LEXIS 290, at *2 n.10 (“Affirmative defenses that were asserted in an answer but then not pursued at trial may be deemed impliedly waived, while affirmative defenses that were never asserted may be deemed forfeited.”).

⁹ The parties also stipulated that “[d]ocuments produced by a party in response to requests for production of documents and interrogatories will be deemed authentic business records” and that “[o]bjections to admissibility of such documents on grounds of authenticity or genuineness are waived,” but any other objections “are preserved.” 19 TTABVUE.

that the Board did not recite all of the evidence it considered does not mean the evidence was not, in fact, reviewed.”); *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1343 (Fed.Cir.2003) (“We presume that a fact finder reviews all the evidence presented unless he explicitly expresses otherwise.”).

With its trial brief, Applicant objects to “the consideration of evidence of Opposer’s attempts to prevent others from using its marks from prior to 2018” because “[i]n its opposition to Applicant’s motion to compel, Opposer refused to produce any information on enforcement from prior to 2018.”¹⁰ Applicant also objects “to any consideration of [Opposer’s] trademark usage outside of the United States to support an argument for likelihood of confusion.”¹¹ To the extent that any of these objections have merit and involve materials or information that we rely upon in making our decision, we address them in this decision. *Peterson v. Awshucks SC, LLC*, No. 92066957, 2020 TTAB LEXIS, at *11 (“the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence”) (citations omitted).

In sum, Applicant’s evidentiary objections are discussed only when necessary, including what weight, if any, is accorded to the objected-to materials.

¹⁰ 41 TTABVUE 20.

¹¹ 41 TTABVUE 31. Although we do not decide this particular objection in this decision, we hasten to add that we have not considered any evidence regarding any use of Opposer’s mark outside the United States.

II. Opposer's Statutory Entitlement to Bring the Opposition

A plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute and the plaintiff has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020). Effectively, this is the same as showing a real interest in the proceeding and a reasonable belief of damage. *Id.* Opposer's ownership of its pleaded registrations, and submission of copies showing their current status and title,¹² support its plausible likelihood of confusion claim against the involved application as to the services, and show its real interest in this proceeding and a reasonable basis for its belief of damage. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1377 (Fed. Cir. 2012).

Opposer has established its statutory entitlement to bring this opposition.¹³

III. Priority

Opposer's pleaded registrations are of record showing active status and Opposer's ownership, and Applicant has not filed any counterclaims to cancel the registrations. Accordingly, priority is not at issue with respect to the marks and services covered by the registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402 (CCPA 1974); *Nkanginieme v. Appleton*, No. 91256464, 2023 TTAB LEXIS 64,

¹² 21-22 TTABVUE 5 (Broderick Dec. ¶ 15); 23 TTABVUE 5-30 (Not. Of Reliance Exs. PX32-35).

¹³ We also note that Applicant, in its brief, does not contest Opposer's entitlement to the cause of action and admits that Opposer "has met its minimum standing requirement." 41 TTABVUE 16.

at *11-12 (“unless there is a counterclaim against the opposer’s pleaded and proven registration[s], priority is not at issue in a likelihood of confusion dispute”).

On the other hand, as to Opposer’s pleaded prior common law rights in its NYU and NEW YORK UNIVERSITY marks, Opposer bears the burden of proving by a preponderance of the evidence that these rights “were acquired before any date upon which applicant may rely.” *DowntownDC Bus. Improvement Dist. v. Clarke*, 2024 TTAB LEXIS 412, at *38 (citing *Araujo v. Framboise Holdings, Inc.*, 99 F.4th 1377, at 1380 (Fed. Cir. 2024)).

Applicant filed its application on November 17, 2021 and this provides Applicant with a constructive use date that it may rely upon for priority. *See Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, No. 91263919, 2022 TTAB LEXIS 383, at *26 (finding application filing date to be the earliest date on which applicant could rely for priority where there was no testimony to establish an earlier date) (citing *Miss Universe, Inc. v. Drost*, No. 91055151, 1975 TTAB LEXIS 180, at *3). Applicant does not argue or point to any evidence of an earlier date of first use in the United States. Accordingly, Opposer must prove use of its marks prior to November 17, 2021.

In its brief, Opposer reiterated its allegation in the Notice of Opposition that Applicant’s services are “identical to services that have been offered [by Opposer] for many decades by NYU under the NYU Marks.”¹⁴ Opposer specifically states that “[n]ot only does NYU provide education under the NYU Marks, but it also provides information about education under the NYU Marks. For example, NYU regularly

¹⁴ 37 TTABVUE 35.

hosts virtual and in-person exhibitions, conferences, seminars, and symposia focusing on developments and trends in education for students at all ages—all under the NYU Marks.”¹⁵ In support, Opposer relies on the testimony of its Vice President of Marketing Communications, Deborah Broderick, who avers:¹⁶

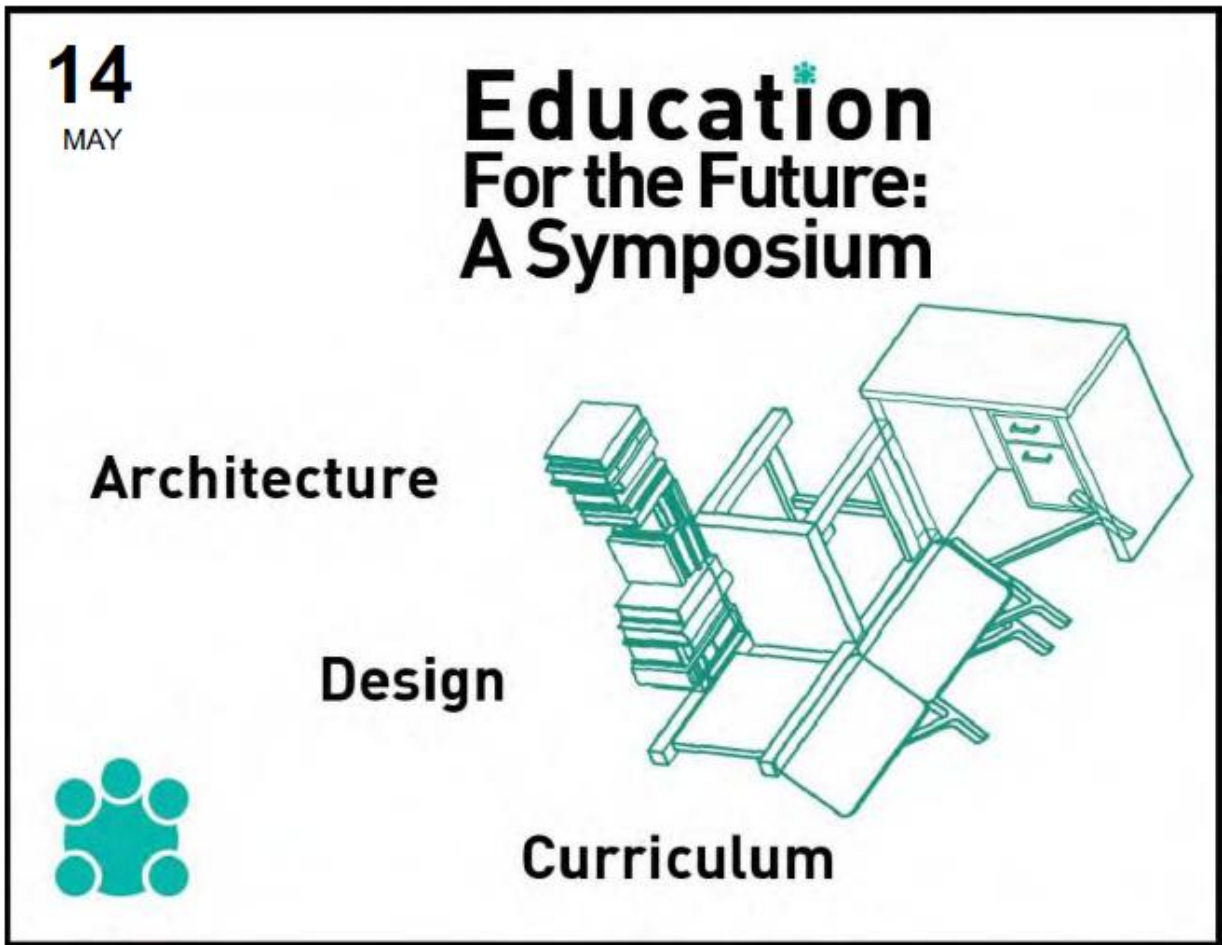
Attached hereto as Exhibit PX15 are true and correct copies of webpages from NYU’s website promoting exhibitions, conferences, seminars, and symposia sponsored by NYU concerning education, which show use of both of the NYU Marks in connection with such services. Of course, NYU’s exhibitions, conferences, seminars, and symposia do not solely focus on providing information about education—such programs also cover a wide range of other topics, including film, modern art, photography, architecture, immigration, economics, financial markets, legal institutions, comparative politics, international development, human rights, neuroscience, cardiology, public health, artificial intelligence, robotics, data science, and many more.

The following are sample excerpts from the exhibit referenced in the above testimony from Ms. Broderick:¹⁷

¹⁵ 37 TTABVUE 18.

¹⁶ 21-22 TTABVUE 10 (Broderick Dec. ¶ 33).

¹⁷ 22 TTABVUE 193 (Broderick Ex. PX15). In all the exhibit contains information regarding events occurring in 2008, 2016, 2018, 2022, and 2024.



📍 The Jerry H. Labowitz Theatre for the Performing Arts

🕒 May 14, 2018 | 2:00 PM-6:00 PM

EDUCATION FOR THE FUTURE: A SYMPOSIUM

What would a school designed for the future look like? Join Gallatin for a K-12 education symposium in which students from schools across NYU present their vision for a 21st-century education. With student-run booths on topics ranging from standardized testing to empowering women in STEM education and a showcase of architectural, program, and curriculum redesigns for a public high school created by teams of NYU student designers, the *Education for the Future Symposium* will be a public conversation on the importance of education reform and what thoughtfully designed schools could look like. To help lead us in this conversation, the Symposium will include a panel discussion with NYU Steinhardt Department Chairs **James Fraser** and **Catherine Milne**.

5/14

Schedule

2 pm - Expo Opens, featuring student-run booths on assessments and standardization, creative approaches to mathematics, cultivating global citizenship, educating entrepreneurs, empowering women in STEM, financial literacy, food systems education, the power of children's books, school funding, and sports education

NEWS RELEASE

NYU Panel Explores Potential and Future of Single Sex Schools, Friday, Feb. 22

Feb 19, 2008

Modified Feb 19, 2008

Tagged [Steinhardt School of Culture, Education, and Human Development](#),

[Events and Traditions](#)

The role of single sex schools is controversial. Do single sex schools provide academic advantages or no advantage to students? A breakfast session featuring a presentation by Cornelius Riordan, professor of sociology, Providence College, and a response by Emily J. Martin, American Civil Liberties Union Women's Rights Project, will address the issue. The second in a series of education policy breakfasts, the panel introduces policymakers, practitioners, and researchers to the complex questions of how gender may affect academic experience and outcomes, and how gender interacts with other factors.

In addition, Opposer submitted screenshots from its website that include information in the field of education, to wit:¹⁸



Applicant, in its brief, acknowledges that Opposer’s aforementioned exhibit “provides some examples of symposiums from 2008, 2024, 2022, 2018, and 2016,” but asserts that “Opposer does not argue that it made continuous and systematic use of the NYU Marks on information about education services such as to establish common law rights in that mark.”¹⁹ In sum, Applicant states that it “wishes to highlight for

¹⁸ 22 TTABVUE (Broderick Ex. PX15).

¹⁹ 41 TTABVUE 17.

the Board that there is not an allegation in the record of priority of use on the ‘information about education’ services offered by Applicant.”²⁰

We disagree with Applicant’s contention that there is no allegation of priority with respect to these services. Again, Opposer alleged in the Notice of Opposition that “the services identified in the Application are identical and/or closely related to services that Opposer has long offered under its NYU marks” and, indeed, that “[t]hrough years of use and the success of Opposer’s offerings under the NYU Marks, the NYU Marks have become famous ... prior to any date that Applicant can rely upon.”²¹

Moreover, at trial, Opposer’s witness, Ms. Broderick, testified that Opposer provides information services in the field of education and that these services are exemplified by Ex. PX15 containing “true and correct copies of webpages from NYU’s website promoting exhibitions, conferences, seminars, and symposia sponsored by NYU concerning education, which show use of both of the NYU Marks in connection with such services.”²² Applicant did not cross-examine Ms. Broderick or submit evidence to rebut that testimony or cast doubt as to its accuracy. Rather, as noted above, Applicant acknowledges Opposer’s evidence as showing “examples of symposiums from 2008, 2024, 2022, 2018, and 2016.” Although Ms. Broderick does not actually testify as to Opposer’s first use of the NYU mark in connection with the services, we must “look at the evidence as a whole, as if each piece of evidence were

²⁰ 41 TTABVUE 18.

²¹ 12 TTABVUE (N. of Opp. ¶ 4).

²² 22 TTABVUE (Broderick Dec. ¶ 33).

part of a puzzle which, when fitted together, establishes prior use.” *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 1125-26 (Fed. Cir. 1994). Here, taking Ms. Broderick’s testimony and the exhibits showing use of the NYU mark for events that occurred at least as early as 2008, this is long before Applicant’s constructive use date, November 17, 2021. When all evidence is viewed together, it is sufficient to establish prior use and acquisition of Opposer’s proprietary rights in the mark, NYU, for services involving the provision of information in the field of education.

Applicant’s attack on Opposer’s priority based on a purported failure to show continuous use of the NYU mark for those services is unavailing because continuous use is not required to establish Opposer’s priority. *Kemi Organics, LLC v. Gupta*, No. 92065613, 2018 TTAB LEXIS 149, at *22 (quoting *W. Fla. Seafood*, 31 F.3d at 1128 (“Section 2(d) does not speak of ‘continuous use,’ but rather of whether the mark or trade name has been ‘previously used in the United States by another and not abandoned.’”)) (cleaned up). To the extent that Applicant is arguing Opposer abandoned any common law rights in its NYU mark in connection with the information services, it did not plead such a defense. *See Eng’g Plastics, Inc. v. Extrutech Plastics, Inc.*, No. 92028489, 2003 TTAB LEXIS 238, at *5-7 (“[s]uch defense was neither pleaded by respondent nor tried by the parties, and respondent may not raise the defense for the first time in its trial brief.”). *See also Sperry Rand Corp. v. Gruen Indus., Inc.*, 1975 TTAB LEXIS 201, at *8 (“applicant is in any event precluded from asserting abandonment since it failed to allege this charge as an affirmative defense in its pleadings as originally set forth” or amended).

We find the preponderance of the evidence establishes that Opposer acquired proprietary rights in the NYU mark through actual use in connection with services involving the provision of information in the field of education long before Applicant's constructive use date of November 17, 2021. *See* Trademark Act §§ 2(d) and 45, 15 U.S.C. §§ 1052(d) & 1127; *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 1375 (Fed. Cir. 1996); *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002); *Giersch v. Scripps Networks Inc.*, No. 92045576, 2009 TTAB LEXIS 72 at *7-8. That is, Opposer has proven its allegation that it has prior common law rights in the NYU mark in connection with services that are, in part, identical to those identified in the application, namely, "providing information about education."

In sum, as to priority, there is no issue with respect to Opposer's pleaded registrations vis-à-vis the application, and Opposer has demonstrated prior common law rights in its NYU mark for services that include the provision of information in the field of education.

IV. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont*

de Nemours & Co., 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). A likelihood of confusion analysis often particularly focuses on the similarities between the marks and between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortgage Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). Opposer ultimately bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951 (Fed. Cir. 2000).

Here, although Opposer pleaded ownership of several registrations, we make our likelihood of confusion determination focusing on Opposer’s pleaded registration, Reg. ’376 for the standard character NYU mark and services listed *supra*, as well as Opposer’s established prior common law rights in the NYU mark in connection with information services in the field of education. *See In re Max Cap. Grp. Ltd.*, No. 77186166, 2010 TTAB LEXIS, at *4-5 (Board may confine analysis to certain registered marks because “if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the [other marks], while if there is no likelihood of confusion between [the more similar registered marks], then there would be no likelihood of confusion with [the other registered marks]”). That is,

Opposer's NYU mark is more similar to Applicant's NYCU mark than Opposer's NEW YORK UNIVERSITY mark, and thus stands the best chance of supporting the likelihood of confusion claim.²³

A. The Same and Closely Related Services; Channels of Trade and Classes of Consumers

We first consider the “similarity or dissimilarity and nature of the goods or services”; “[t]he similarity or dissimilarity of established, likely-to-continue trade channels” for the services; and the classes of consumers to which the services are marketed. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1320 (Fed. Cir. 2014) (quoting *DuPont*, 476 F.2d at 1361).

Here, we make separate determinations: (1) an analysis comparing Opposer's services for which it has established prior common law rights in its NYU mark to the services listed in the application; and (2) an analysis comparing the services in Opposer's pleaded Reg. '376, to the services listed in the application.

1. Opposer's Prior Common Law Rights

As discussed, *supra*, Opposer has established prior common law rights in the NYU mark for services that include the provision of information in the field of education. These services are the same as Applicant's “providing information about education” services.

As to the trade channels for the parties' services, Opposer's witness testified that Opposer's services under the NYU mark are offered to “a very broad swath” of

²³ Except where necessary, we refer to Opposer's NYU mark in the singular form when referring to Opposer's rights in the mark deriving from common law or the pleaded Reg. '376.

consumers, “including high school students and their parents; high school teachers and guidance counselors; college students interested in pursuing graduate degrees; faculty and career counselors at colleges; educational institutions throughout the United States,” etc.²⁴ Opposer’s NYU mark “appear[s] on all manner of advertisements, press releases, webpages, social media, printed materials, emails, direct mail, signage, and merchandise used to promote NYU’s services.”²⁵

Because the trade channels and classes of consumers for Applicant’s “organization of exhibitions for cultural or educational purposes; providing information about education,” are unrestricted we must presume that these services are offered at all levels of education, including secondary and postsecondary, and to all classes of consumers for these services. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490 (Fed. Cir. 1987). The evidence discussed above shows that Opposer’s same services are also offered at the secondary and postsecondary levels and targets high school, college and graduate level students. *See, e.g., Bell’s Brewery, Inc.*, No. 91215896, 2017 TTAB LEXIS 452, at *12 (Board found applicant’s unrestricted identification for goods would move in all channels of trade normal for such goods, which included opposer’s common law trade channels for the same goods). Indeed, as Applicant’s president testified, Applicant distributes its branding and

²⁴ 22 TTABVUE 5 (Broderick Dec. ¶ 13).

²⁵ 22 TTABVUE 5 (Broderick Dec. ¶ 14).

materials “to students in the United States,”²⁶ and, as noted, this is one class of consumers to whom Opposer advertises its services.

2. Opposer’s Pleaded Reg. ’376

The services, as listed in Opposer’s pleaded Reg. ’376, include:

- “educational services, namely, providing courses, lecture series, and seminars at the undergraduate and graduate level” and
- “offering classes, lecture series, and seminars on various topics of interest to the public in diverse educational disciplines, including ... education, [and] culture ...”

And Applicant’s services are:

- “organization of exhibitions for cultural or educational purposes” and
- “providing information about education.”

On their face, we find the parties’ services to be encompassing of one another, at least in part, and thus legally identical with respect to the overlapping services. On the face of the recitations of services, Applicant’s “exhibitions for cultural or educational purposes” would cover, or be covered by, Opposer’s “offering classes, lecture series, and seminars on various topics of interest to the public in diverse educational disciplines, including ... education [and] culture.” An educational exhibition is for practical purposes one manner of instruction or teaching and fundamentally the same as giving lectures, seminars, and courses in the same fields.

In short, the parties’ services are legally identical in part. *See In re St. Julian Wine Co.*, No. 87834973, 2020 TTAB LEXIS 196; *In re Info. Builders Inc.*, No. 87753964,

²⁶ 30 TTABVUE 6 (Dr. Lin Dec. ¶ 23).

2020 TTAB LEXIS 20 (finding services legally identical in part where registrant's services encompassed by applicant's services); *In re Country Oven, Inc.*, No. 87354443, 2019 TTAB LEXIS 381 (quoting *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, No. 94002242, 2015 TTAB LEXIS 176 (where the identification of services is broad, the Board "presume[s] that the services encompass all services of the type identified")). And, again, because neither Opposer nor Applicant have limited their channels of trade for their services, these services may be found in the some of the same customary trade channels for these services. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1308 (Fed. Cir. 2018) (when there are no restrictions on channels of trade or classes of consumers in the identifications of an application or registration, it is presumed that the goods or services are sold in "all normal trade channels to all the normal classes of purchasers").

The record also demonstrates that Applicant's "providing information about education" services are very closely related to Opposer's "educational services, namely, providing courses, lecture series, and seminars at the undergraduate and graduate level." Opposer submitted copies of 21 live, use-based, third-party registrations owned by universities, like Opposer, for services that include both education at the university level and "providing information about education."²⁷ "[U]se-based, third-party registrations . . . have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark." *Joel Gott Wines, LLC v. Rehoboth Von*

²⁷ 27 TTABVUE 7-90.

Gott, Inc., Opp. No. 91197659, 2013 TTAB LEXIS 314, at *27-28. “Evidence of relatedness may include . . . copies of prior use-based registrations of the same mark for both applicant’s goods and the goods listed in [opposer’s] registration.” *In re Embiid*, No. 88202890, 2021 TTAB LEXIS 168, at *30 (citation omitted)).

2. Conclusion: The Services, Their Trade Channels and Classes of Consumers

In view of the above, the second *DuPont* factor weighs heavily in favor of finding a likelihood of confusion with respect to Opposer’s services, for which it has prior common law rights in the mark NYU and as covered by its pleaded Reg. ’376, vis-à-vis Applicant’s services, and particularly so where we find the services to be the same.

Similarly, the third *DuPont* factor also weighs heavily in favor of finding a likelihood of confusion because the record shows that the parties’ same services are offered in the same trade channels to the same classes of consumers.

A. Strength or Weakness of Opposer’s NYU Mark

“Two of the *DuPont* factors (the fifth and sixth) consider strength.” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). The fifth *DuPont* factor enables Opposer to prove that its pleaded mark is entitled to an expanded scope of protection by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use),” whereas the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods [or services].” *DuPont*, 476 F.2d at 1361.

The determination of strength under the fifth *DuPont* factor “is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*,

343 F.3d 1340, 1345 (Fed. Cir. 2003). In this regard, we assess “the extent to which the relevant public recognizes a mark as denoting a single source.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1324-1325 (Fed. Cir. 2017). Commercial strength, or fame, may be measured by consumer polls, “by the volume of sales and advertising expenditures of the [goods and/or services] traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1319 (Fed. Cir. 2018) (quoting *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (internal citations omitted)). Commercial strength may also be measured by “widespread critical assessments; notice by independent sources of the goods or services identified by the marks; the general reputation of the goods or services; and social media presence.” See *Heil Co. v. Tripleye GmbH*, No. 91277359, 2024 TTAB LEXIS 494, at *51.

Opposer argues that its NYU mark is “unquestionably strong and famous” owing to its “enormous marketplace strength”²⁸ based on the length of use of the mark, commercial success, advertising and promotion, and attention the mark has received through third-party recognition and awards. In support, Opposer relies primarily on the testimony of Ms. Broderick, and related exhibits, including the following:

- “In 1896, the university changed its name to “New York University.” Concurrently with this renaming, the university began referring to and promoting itself by its new initials—NYU.”²⁹

²⁸ 37 TTABVUE 30, 31.

²⁹ 22 TTABVUE (Broderick Dec. ¶ 6).

- “For over 120 years, NYU has continuously provided higher education services at the undergraduate and graduate level in the United States under the NYU Marks, offering undergraduate degrees in virtually every possible discipline and a wide variety of graduate degrees, including in business, law, technology, and dentistry.”³⁰
- “NYU has enjoyed considerable commercial success and has been repeatedly ranked as one of the top universities in the United States by both industry publications and consumers. By way of example only, in 2023, the *Princeton Review* ranked NYU among the Top 5 ‘dream’ colleges amongst both prospective students and their parents. By way of another example, in the 2024 *U.S. News & World Report* the NYU Stern School of Business was ranked as the #7 best business school in the United States and the NYU School of Law was ranked as the #9 best law school in the United States.”³¹
- “Today, the NYU Marks are used on every conceivable piece of material promoting or providing NYU’s educational services, including but not limited to admissions communications and brochures, course catalogs, degree program manuals, conference and seminar presentations, alumni magazines, and press releases, which are distributed to consumers.”³²
- “NYU also uses social media to advertise and promote NYU’s services and to interact with consumers. For example, the NYU Facebook account ... has 976,000 followers. The NYU Instagram account ... has 531,000 followers. The NYU X/Twitter page ... has 203,300 followers. NYU’s LinkedIn account ... has 902,000 followers. NYU’s YouTube account ... has 106,000 subscribers, and NYU’s TikTok account ... has 47,200 followers.”³³

Opposer’s promotion and marketing expenditures for its educational services are significant and impressive.³⁴ Opposer’s NYU mark also frequently appears in major

³⁰ 22 TTABVUE (Broderick Dec. ¶ 8).

³¹ 22 TTABVUE 4 (Broderick Dec. ¶ 10, and ¶ 24 attesting to Exs. PX7-9).

³² 22 TTABVUE 6 (Broderick Dec. ¶ 18).

³³ 22 TTABVUE 15-16 (Broderick Dec. ¶ 55).

³⁴ 22 TTABVUE 14-15 (Broderick Dec. ¶¶ 49-53). The expenditures on advertising and promotion have been designated “confidential” (see 21 TTABVUE -- confidential version).

publications such as the New York Times and The Washington Post, including a report on Taylor Swift's 2022 commencement address at NYU.³⁵

Applicant does not dispute the strength of Opposer's NYU mark and even labels it "famous."³⁶ Nevertheless, Applicant asserts that "the fame of NYU Mark[] weighs against likelihood of confusion."³⁷ In support, Applicant cites to the Federal Circuit decision *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727 (Fed. Cir. 1988).³⁸ In that decision, the Federal Circuit held that "[t]he fame of a mark cuts both ways with respect to likelihood of confusion. The better known it is, the more readily the public becomes aware of even a small difference." *Id.* at 729.

As the Federal Circuit made very clear in *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 354 (Fed. Cir. 1992), four years after and in direct response to the *B.V.D. Licensing* decision, "[f]amous or strong marks enjoy a wide latitude of legal protection" and "[t]he holding of *B.V.D.*, to the extent it treats fame as a liability, is confined to the facts of that case." The Federal Circuit reiterated strongly the principle that "[f]amous or strong marks enjoy a wide latitude of legal protection" and thus the fifth *DuPont* factor "plays a dominant role" in cases where such a mark is present. *Id.* at 352. Thus, Applicant's attempt to use the renown of Opposer's mark as a liability fails.

³⁵ 22 TTABVUE 16 (Broderick Dec. ¶¶ 56-58; Broderick Exs. 28-29).

³⁶ 41 TTABVUE 24 (Applicant argues, "The differences in the mark NYCU make it less likely that anyone would confuse it with the famous mark NYU.")

³⁷ 41 TTABVUE 18.

³⁸ 41 TTABVUE 19.

Applicant also argues that Opposer’s renown as a university with its primary campus in New York City somehow limits its protection. Specifically, Applicant asserts that because Opposer “is a well-known provider of education services, and is very well known for the provision of services in its campus in New York ... the public is highly unlikely to be confused with services provided by Applicant based in Taiwan.”³⁹ This argument lacks merit because it ignores the fact that Applicant’s application and Opposer’s registrations are unrestricted geographically, but involve nationwide rights in scope. It is thus irrelevant that the parties may have their main campuses or are based in different cities or countries. We must assume that Applicant will offer and advertise its services in the same geographic region as Opposer, including New York.

Applicant also highlights testimony showing two other higher education institutions from New York using the initials NY—the State University of New York (SUNY) and the City University of New York (CUNY).⁴⁰ These two third-party uses are not only few in number, but the university initialisms, SUNY and CUNY, do not approximate Opposer’s NYU mark in the same manner as does Applicant’s mark, NYCU. That is, neither begins with the letters NY followed by the letter U. As a result, and to the extent that Applicant is invoking the sixth *DuPont* factor to attempt to limit the scope of protection for Opposer’s NYU mark based on “the number and nature of similar marks in use on similar goods [or services],” *DuPont*, 476 F.2d at

³⁹ 41 TTABVUE 18-19.

⁴⁰ 41 TTABVUE 21; referencing 22 TTABVUE (Brock Dec. ¶ 8) and 30 TTABVUE (Dr. Lin Dec. ¶ 18).

1361, we are not persuaded. The evidence is minimal and does not show that consumers are conditioned to overlook the shared characteristics that bring Opposer's NYU mark and Applicant's NYCU mark together.

In sum, the record shows that Opposer's NYU mark is extremely strong and broadly so in connection undergraduate and post-graduate educational services. While Opposer's mark, NYU, is admittedly an abbreviation for "New York University," it retains this strength and has no demonstrated weakness. Accordingly, the fifth *DuPont* factor weighs heavily in Opposer's favor and a conclusion that confusion is likely. The sixth factor is neutral.

B. Similarity of the Marks NYU and NYCU

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Opposer's and Applicant's marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361.

"The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *i.am.symbolic*, 866 F.3d at 1323 (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (internal quotation marks omitted)). The focus is on the recollection of the average purchaser, bearing in mind that it is not perfect and consumers may retain a general rather than a specific impression of trademarks. *See In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir.

2014) (“marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison”) (cleaned up; citation omitted); *see also*, *Mini Melts, Inc. v. Reckitt Benckiser LLC*, No. 91173963, 2016 TTAB LEXIS 151, at *14; *In re Mr. Recipe, LLC*, No. 86040643, 2016 TTAB LEXIS 80, at *18.

Here, Opposer’s NYU registered and common law mark and Applicant’s NYCU mark is very similar in appearance and sound, differing only by the addition of the third letter C in Applicant’s mark. Given the marks share the same first two letters NY and end with U, the marks are visually alike and consumers may overlook the insertion of the letter C in Applicant’s mark. Because the marks are initialisms, they are very likely to be pronounced by speaking out the individual letters: “N-Y-U” and “N-Y-C-U,” and, as such, will sound alike.

In terms of meaning, there is no dispute that Opposer’s registered and common law mark, NYU, stands for “New York University,” and the parties agree that consumers are well-aware of this significance.⁴¹ The underlying significance of the NYU mark helps reinforce the fact that Opposer’s main campus is located in New York City.

As to Applicant’s NYCU mark, its president, Dr. Lin, testified that this mark represents the following first letters in Applicant’s name: “National Yang Ming Chiao

⁴¹ Applicant argues “The meaning of the acronym far from being unknown to purchasers, is the best-known element of the Opposer’s brand.” 41 TTABVUE 24. Opposer readily acknowledges that its NYU mark derives from “New York University,” and “consumers use NYU and NEW YORK UNIVERSITY interchangeably to refer to NYU [Opposer, New York University].” 37 TTABVUE 41.

Tung University, a compilation of the two names of [Applicant's] predecessors.”⁴² However, there is very little evidence showing that U.S. consumers are aware of this intended meaning.⁴³ Rather, as Opposer points out, the initial three letters in Applicant's mark, NYC, is a common, well-recognized and defined abbreviation for “New York City,” as is “NY” for “New York” (referring to the city or the state).⁴⁴ It is therefore likely consumers will understand the first three letters in this manner and, in the context of educational information services, the involved marks are likely to impart a connection with New York or New York City.

In sum, Applicant's NYCU mark and Opposer's registered and common law mark, NYU, are very similar in appearance, sound and likely to project a similar commercial impression and connotation as well. We find these mark overall similar and this factor also weighs in favor of finding a likelihood of confusion.

⁴² 30 TTABVUE (Dr. Lin Dec. ¶ 17).

⁴³ Dr. Lin testified that Applicant “has never, and has no intention to offer university classes in the United States” and is “a Taiwanese university, and only offers classes in that country.” Dr. Lin Dec. ¶ 24. While Dr. Lin did testify that Applicant “contracts with partner institutions in the United States ... to facilitate students from those institutions to visit NYCU short term, promoting the internationalization and level of teaching and research of the two institutions through the short-term exchange of students,” listing 14 such U.S. partner universities. 18 TTABVUE; Dong Dec. ¶ 15. However, there is no further information to determine the scope or impact these partnerships have made on U.S. consumers in terms of awareness of Applicant's mark, particularly whether consumers recognized or associate the mark as an initialism for “National Yang Ming Chiao Tung University.”

⁴⁴ We take judicial notice of the following definition: “NYC” MERRIAM-WEBSTER.COM DICTIONARY, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/NYC>. Accessed 1 Dec. 2025; and “NY” COLLINS ENGLISH DICTIONARY — COMPLETE & UNABRIDGED, 2012 Digital Edition, William Collins Sons & Co. Ltd. 1979, 1986 © HarperCollins Publishers accessed 1 Dec. 2025. *See Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, No. 91061847, 1982 TTAB LEXIS 146, at *7 (“[T]he Board may take judicial notice of use of a term in dictionaries.”). *See also B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 728 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”). *See also In re Zuma Array Ltd.*, No. 79288888, 2022 TTAB LEXIS 281, at *15 n.18.

C. Concurrent Use Without Evidence of Confusion

The seventh and eighth *DuPont* factors relate, respectively, to the nature and extent of any actual confusion and the extent of the opportunity for actual confusion. *See DuPont*, 476 F.2d at 1361. These “factors are interrelated; the absence of evidence of actual confusion, under the seventh *DuPont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *DuPont* factor, that there has been a significant opportunity for actual confusion to have occurred.” *Keystone Consol. Indus.*, No. 92066927, 2024 TTAB LEXIS 290, at *75-76 (citations omitted). Put differently, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer and its mark. *Barbara’s Bakery, Inc. v. Landesman*, No. 91157982, 2007 TTAB LEXIS 9, at *14.

Here, Applicant argues that “Opposer is not able to identify any instances of actual confusion” and this factor thus “weighs against likelihood of confusion.”⁴⁵ Applicant also makes the curious argument that the lack of instances of actual confusion “is not surprising in that a customer would be unlikely to confuse the two source provider institutions, one in New York, and one in Taiwan.”⁴⁶

Again, the involved application is based on Applicant’s allegation of an intent to use the NYCU mark in commerce in the U.S., and there is scant evidence that U.S.

⁴⁵ 41 TTABVUE 33.

⁴⁶ 41 TTABVUE 33.

consumers have been exposed to use of this mark in the marketplace.⁴⁷ Given this void of evidence, we cannot conclude that the “circumstances have been such that [actual confusion] could be expected to have happened.” *Gillette Canada Inc. v. Ranir Corp.*, No. 91082769, 1992 TTAB LEXIS 24, at *19.

Accordingly, the seventh and eighth *DuPont* factors are neutral.

D. Level of Purchasing Care

Under the fourth *DuPont* factor, we consider “[t]he conditions under which ... sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. As a general matter, “we must make our determination based on the least sophisticated consumer.” *In re Guild Mortg. Co.*, No. 86709944, 2020 TTAB LEXIS 17, at *17 (citing *Stone Lion*, 746 F.3d at 1325); *In re FCA US LLC*, No. 85650654, 2018 TTAB LEXIS 116, at *29.

Applicant argues that “[w]here, as here, Opposer provides an expensive service that students compete to attend, it is highly unlikely they will be confused with another service provider.”⁴⁸ Applicant also points to Opposer’s acceptance rate and asserts that “Opposer’s customers are undoubtedly sophisticated, they are admitted at a rate of only 12%.”⁴⁹ Applicant also cites to cases holding that consumers of university-level education services are likely to exercise more care in their purchasing decisions, including *Fla. Int’l Univ. Bd. of Trs. v. Fla. Nat’l Univ., Inc.*, 830 F.3d 1242,

⁴⁷ See Note 39.

⁴⁸ 41 TTABVUE 31.

⁴⁹ 41 TTABVUE 32.

at 1256, 1265 (11th Cir. 2016) (noting the “nature, importance, and size of the investment in a college education” and finding “potential college students are relatively sophisticated consumers who are unlikely to be easily or meaningfully confused by similar-sounding university names.”).

While Opposer’s low acceptance rate of admission may show that it is a very selective institution and consumers’ decisions regarding four-year college educations will inherently involve a higher degree of care, these are not the type of services Applicant describes in its application. That is, the application describes the “organization of exhibitions for cultural or educational purposes” and “providing information about education.” Likewise, while Opposer provides full undergraduate and post-graduate educations, it also provides the same or very closely related services as those of Applicant. In other words, the parties’ services may involve single cultural or educational exhibition, lecture, seminar or the provision of educational information, without these services being part of a larger undergraduate or post-graduate degree. Thus, we cannot assume that consumers of these services will necessarily exercise more care in registering for these exhibitions or educational information services.

The fourth *DuPont* factor is neutral.

E. Conclusion: Balancing of Factors

We must “weigh the *DuPont* factors used in [our] analysis and explain the results of that weighing.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1383-84 (Fed. Cir. 2023). “In any given case, different *DuPont* factors may play a dominant role,” and

the “weight given to each factor depends on the circumstances of each case.” *Id.* (citation omitted).

As discussed, *supra*, Applicant’s mark, NYCU, is very similar to Opposer’s registered and common law mark, NYU. Applicant’s services, as described in its application, are also to the same as Opposer’s services for which it has common law rights in the mark NYU, as well as some of Opposer’s services recited in its pleaded Reg. ’376. Applicant’s services are otherwise closely related, in part, to Opposer’s services. The record shows that the parties’ services may be offered in the same trade channels to the same classes of consumers.

Lastly, we have concluded on the record that Opposer’s NYU mark is very strong, without any demonstrated weakness. Again, Applicant refers to Opposer’s “famous mark NYU.”⁵⁰ We are mindful of the Federal Circuit’s guidance that in these situations, “the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.” *Kenner Parker*, 963 F.2d 353.

There are no factors that weigh against finding a likelihood of confusion and, as to the other factors argued, we find them neutral in our analysis.

On balance, we have no difficulty concluding on this record that there is a likelihood of confusion between Applicant’s mark, NYCU, and Opposer’s mark, NYU, as registered and for which it has common law rights.

⁵⁰ 41 TTABVUE 24.

Decision: The Notice of Opposition is sustained under Section 2(d) of the Act.⁵¹

⁵¹ Because we sustain the opposition on the likelihood of confusion claim, we need not reach Opposer's dilution by blurring ground for opposition. *See Azeka Bldg. Corp. v. Azeka*, No. 91218679, 2017 TTAB LEXIS 123, at *4.