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

Proceeding	91187103
Party	Plaintiff The Board of Trustees of The University of Alabama and Mr. Paul W. Bryant Jr.
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Date	06/03/2014
Attachments	2014.06.03 Request to Reopen Vacate and Dismiss w_o Prejudice (TTAB).pdf(318734 bytes )

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

BOARD OF TRUSTEES OF THE )  
UNIVERSITY OF ALABAMA and )  
PAUL W. BRYANT, JR., )  
 )  
Opposers, )  
 )  
 )  
v. )  
 )  
 )  
WILLIAM PITTS, JR. and )  
CHRISTOPHER BLACKBURN, )  
 )  
 )  
Applicants. )

Opposition No. 91187103  
In the matter of Application  
Serial No. 77/342,852  
Mark: HOUNDSTOOTH MAFIA



**REQUEST TO REOPEN, VACATE AND DISMISS WITHOUT PREJUDICE**

Pursuant to 37 C.F.R. § 2.145(c)(4), Opposers Board of Trustees of the University of Alabama (the “University”) and Paul W. Bryant Jr. (“Opposers”) sought review of the Board’s July 23, 2013 decision (the “Board’s Order”) by means of a civil action filed pursuant to Section 21(b) of the Lanham Act, 15 U.S.C. § 1071(b). The civil action, styled *Board of Trustees of The University of Alabama and Paul W. Brynt Jr. v. Houndstooth Mafia Enterprises, LLC, William Pitts Jr. and Christopher Blackburn*, CV13-B-1736-W, was filed on September 19, 2013 in the U.S. District Court for the Northern District of Alabama, Western Division (the “Civil Action”).

On May 28, 2014, the Court entered final judgment for the University in the Civil Action, a copy of which is attached as **Exhibit 1** (the “Final Judgment”). Pursuant to the Final Judgment:

- (1) the Board’s Order has been “**VACATED**” (*See Ex. 1 at p. 3, emphasis in original*);
- and

(2) “Once the parties have properly recorded a copy of the Assignment with the U.S. Patent and Trademark Office, the Register of Trademarks is directed to permit the HOUNDSTOOTH MAFIA & Design Application (Serial No. 77/342,852) to be registered on the Principal Register with the University as its owner.” (*See id.*)

The parties have now properly recorded the assignment of the mark and application with the U.S. Patent and Trademark Office’s Assignment Division at Reel/Frame 5285/0635. Accordingly, pursuant to the Final Judgment, Opposers request that this proceeding be reopened, the Board’s Order be vacated, and application Serial No. 77/342,852 be registered on the Principal Register with the University as the owner.

Dated: June 3, 2014

/Nichole Davis Chollet/  
R. Charles Henn Jr.  
Alicia Grahn Jones  
Nichole Davis Chollet  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing was served on counsel for Applicants on June 3, 2014 via first class mail to:

Jerald L. Watts, Esq.  
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/Nichole Davis Chollet/  
Nichole Davis Chollet  
*Attorney for Opposers*

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true and correct copy of the is being filed electronically with the T.T.A.B. via ESTTA on this day, June 3, 2014.

/Nichole Davis Chollet/  
Nichole Davis Chollet  
*Attorney for Opposers*

# **Exhibit 1**

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ALABAMA  
WESTERN DIVISION**

**BOARD OF TRUSTEES OF THE )  
UNIVERSITY OF ALABAMA and PAUL W. )  
BRYANT JR., )**

**Plaintiffs, )**

v. )

**HOUNDSTOOTH MAFIA ENTERPRISES, )  
LLC, WILLIAM PITTS JR. and )  
CHRISTOPHER BLACKBURN, )**

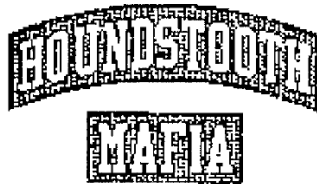
**Defendants. )**

**Civil Action No. 7:13-cv-01736-RDP**

**FINAL CONSENT JUDGMENT**

Plaintiffs Board of Trustees of the University of Alabama (“University”) and Paul W. Bryant Jr. (collectively, “Plaintiffs”) and Defendants Houndstooth Mafia Enterprises, LLC, William Pitts Jr. and Christopher Blackburn (collectively, “Defendants”), having resolved the matters in issue between them, consent to entry of final judgment in this matter as follows:

1. On December 3, 2007, Mr. Blackburn and Mr. Pitts filed application Serial No. 77/342,852 in the U.S. Patent and Trademark Office to register the HOUNDSTOOTH MAFIA & Design mark, depicted below (the “HOUNDSTOOTH MAFIA & Design Application”);



2. Coach Paul “Bear” Bryant regularly wore a Houndstooth-pattern hat while on the sidelines of the University’s football field for many years before his death in 1983. Because of the positive and widespread association of the Houndstooth pattern with the University, the University has used and licensed the Houndstooth pattern as a trademark in connection with a wide variety of goods, and the Houndstooth pattern has become a well-known source identifier for the University (the “Houndstooth Pattern Mark”).

3. Based on their rights in the Houndstooth Pattern Mark, Plaintiffs opposed registration of the HOUNDSTOOTH MAFIA & Design Application by filing a notice of opposition (Opp. No. 91187103, the “Opposition”) with the Trademark Trial and Appeal Board (the “Board”);

3. The Board issued an opinion in the Opposition on July 23, 2013, in which the Board, inter alia, concluded that the HOUNDSTOOTH MAFIA & Design Application could proceed to registration over Plaintiffs’ opposition (the “Board’s Order”);

4. Plaintiffs believe the Board’s Order is clearly erroneous in a number of material respects and, pursuant to 15 U.S.C. § 1071(b), have appealed the Board’s Order in this civil action and requested that this Court vacate the Board’s Order (the “Appeal”).

5. The parties acknowledge and agree that the Board’s Order should be vacated.

6. Defendants Pitts and Blackburn have executed an Assignment that assigns to the University all right, title, and interest in and to the HOUNDSTOOTH MAFIA mark, including the HOUNDSTOOTH MAFIA & Design Application (the “Assignment”). As such, the HOUNDSTOOTH MAFIA & Design Application should proceed to registration on the Principal Register with the University as its owner.

7. Counsel for all parties consent to the terms of, and agree to the form of and entry of, this Consent Judgment.

THEREFORE, IT IS HEREBY **ORDERED** THAT:

1. The Clerk is directed to enter **FINAL JUDGMENT** in favor of Plaintiffs.
2. The Board's Order is **VACATED**.
3. Once the parties have properly recorded a copy of the Assignment with the U.S.

Patent and Trademark Office, the Register of Trademarks is directed to permit the HOUNDSTOOTH MAFIA & Design Application (Serial No. 77/342,852) to be registered on the Principal Register with the University as its owner.<sup>1</sup>

4. Each party will bear its own costs and attorneys' fees.

**SO ORDERED,**


This 27th day of May, 2014.



**R. David Proctor**  
United States District Court Judge

CONSENTED TO ON THIS 23<sup>rd</sup> DAY OF MAY, 2014 BY:

  
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<sup>1</sup> It is within this Court's authority to approve an application for registration under 15 U.S.C. § 1071(b) that, but for the pending opposition, would otherwise be entitled to registration. See e.g. *Tillamook Country Smoker, Inc. v. Tillamook County Creamery Ass'n*, 333 F. Supp. 2d 975, 980 (D. Or. 2004) (ordering issuance of registration on ground that "there do not appear to be any objecting non-parties whose rights would be affected by the registration of [the disputed mark], which the PTO previously published for public opposition"), *aff'd*, 465 F.3d 1102 (9th Cir. 2006); see also *City of Carlsbad v. Shah*, 850 F. Supp. 2d 1087, 1117 n.24 (S.D. Cal. 2012) (referring to prior order requiring the USPTO to approve a series of applications filed by the lead plaintiff).



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