

HOGAN & HARTSON

Hogan & Hartson LLP
875 Third Avenue
New York, NY 10022
+1.212.918.3000 Tel
+1.212.918.3100 Fax

www.hhlaw.com

January 27, 2009

Dennis H. Tracey, III
Partner
+1.212.918.3524
dhtracey@hhlaw.com

*Via Federal Express and
Certified Mail – Return Receipt Requested*

Renee Seblatnigg
The Future of Newcomb College, Inc.
20 Welwyn Road
Riverside, CT 06878

Re: Cease-and-Desist Demand to The Future of Newcomb College, Inc.

Dear Ms. Seblatnigg:

This firm represents The Administrators of the Tulane Educational Fund ("Tulane"), the owner of several trademarks for merchandise bearing the name and logo of Newcomb College (the "Newcomb Marks"). It has come to our attention that The Future of Newcomb College, Inc. ("TFoNC"), by and through its web site, www.newcomblives.com, and other means is selling merchandise that directly infringes Tulane's trademarks. Specifically, the following products infringe Tulane's trademark rights: 1) the "Newcomb Lives" Flag; 2) the Canvas Tote; 3) the T-Shirts; 4) the Jersey Scarves; 5) the Silver Pendant; 6) the Cuff Bracelet; and 7) the Notecards (collectively the "Infringing Goods"). We are writing to put you on notice that TFoNC's confusingly similar use of the Newcomb Marks on these goods infringes on Tulane's senior use of that mark. The purpose of this letter is to demand that TFoNC put an immediate stop to its infringing activity and forever cease and desist from using the Newcomb Marks in commerce.

Tulane is the owner of the following trademarks, all of which are currently registered with the United States Patent & Trademark Office:

- a. Serial No. 78/182,672, Reg. No. 3,465,530, for the use of the name "Newcomb" on clothing, mainly T-shirts, sweatshirts, caps, shorts; and

- b. Serial No. 77/182,572, Reg No. 3465528, for the use of the name "Newcomb" on jewelry.

In addition, Tulane is the owner of the applications for the following trademarks.

- a. Serial No. 77/182,986, for use of the name "Newcomb" with an oak tree design on clothing, namely, T-shirts, sweatshirts, caps, shorts, socks, flip flops, baby body suits, scarves;
- b. Serial No. 77/182,967, for use of the name "Newcomb" with an oak tree design on jewelry;
- c. Serial No. 77/421,963, for use of the name "Newcomb" on tote bags;
- d. Serial No. 77/422,599, for use of the name "Newcomb" with an oak tree design on tote bags;
- e. Serial No. 77/422,439, for use of the name "Newcomb" on a banner;
- f. Serial No. 77/422,726, for use of the name Newcomb with an oak tree design on a banner;
- g. Serial No. 77/421,897, for use of the name "Newcomb" on notecards; and
- h. Serial No. 77/422,559, for use of the name "Newcomb" with an oak tree design on notecards.

Further, Tulane has acquired significant common law rights in the use of the name "Newcomb", the oak tree and the acorn. As you are aware, Newcomb College was founded as a department of Tulane University in 1886 and the Newcomb name has been associated with Tulane University since that time, and thus has acquired significant secondary meaning. In addition, the oak tree and the acorn symbols have also acquired secondary meaning for association with Tulane University.

In addition, as you are no doubt aware, Tulane sells merchandise emblazoned with the Newcomb name and the oak tree and the acorn. Notably for the purposes of this letter, Tulane sells jewelry, through its web site, www.newcomb.tulane.edu, including an Oak Tree Pin/Pendant, an Acorn Ring, a Pearl Necklace with an Acorn Pendant and Acorn Earrings.

It is quite clear that TFOnc's Infringing Goods infringe Tulane's rights as senior user. It is equally clear that you are willfully seeking to profit off the sale of the infringing goods, hoping that Newcomb alumnae will buy their merchandise from you rather than the competing, legal merchandise sold by Tulane. As such, TFOnc's use of a confusingly similar mark on identical products is damaging to Tulane and to the public and constitutes trademark infringement and unfair competition in violation of the federal Lanham Act, 15 U.S.C. § 1051, *et seq.*, the Louisiana Unfair Trade Practices and

Consumer Protection Act (LUTPA), La. Rev. Stat. § 51:1409a, and the Louisiana common law rules regarding trademark infringement and unfair competition. We call your attention to the recent decision of the United States Court of Appeals for the Fifth Circuit in *Board of Supervisors of Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.*, --- F.3d ---, 2008 WL 4981326 (5th Cir. Nov. 25, 2008), which discusses these questions in detail. See also, *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 185 U.S.P.Q. 364 (5th Cir. 1975).

Despite your willful infringing activity, Tulane is prepared to resolve this matter without litigation, provided you promptly: (1) agree to cease and desist from using or facilitating the use in commerce of the term Newcomb, the Oak Tree or the Acorn, or any other term likely to cause confusion therewith, as a trademark, service mark, and/or trade name, without authorization from Tulane; (2) remove all references to the Infringing Goods from your web site, catalogues, or other materials; (3) surrender all Infringing Goods to the undersigned; (4) take delivery of all existing orders for the Infringing Goods so that the products can be immediately surrendered to us, thereby ensuring that they will not be sold elsewhere; (5) refrain from causing the further manufacture or sale of the Infringing Goods; (6) confirm in writing and under oath that the foregoing has been accomplished; (7) account to Tulane for all revenues from the sale of the Infringing Goods; and (8) pay Tulane a sum sufficient to make it whole for the damages it has suffered and continues to suffer, including its attorneys' fees.

If you agree to these requests in writing within five (5) days from the date of this letter, further action by Tulane may not be necessary. If you do not agree to the requests within the designated time period, this firm is authorized to commence legal proceedings against TFOnc and/or responsible individuals for trademark infringement and related relief, including without limitation, seeking preliminary and permanent injunctive relief, compensatory damages, costs, and attorneys' fees.

We look forward to hearing from you or your counsel promptly. The foregoing is without prejudice to Tulane's rights and remedies, all of which are expressly reserved.

Very truly yours,

A handwritten signature in black ink, appearing to read "DHT III", written over a circular scribble.

Dennis H. Tracey III

DHT/glf



Hogan & Hartson LLP
875 Third Avenue
New York, NY 10022
+1.212.918.3000 Tel
+1.212.918.3100 Fax

www.hhlaw.com

February 13, 2009

Dennis H. Tracey, III
Partner
+1.212.918.3524
dhtracey@hhlaw.com

Renee Seblatnigg
The Future of Newcomb College, Inc.
20 Welwyn Road
Riverside, CT 06878

Dear Ms. Seblatnigg:

I write in response to your letter to me dated February 9, 2009 (the "February 9, 2009 Letter"), and to follow-up on my letter to you dated January 27, 2009 (the "January 27, 2009 Letter").

As outlined in the January 27, 2009 Letter, Tulane owns the trademarks for Serial Number 77/182,672,¹ Reg. Number 3,465,530 and Serial Number 77/182,572, Reg. Number 3,465,528. It also owns applications for trademarks for Serial Numbers 77/182,986, 77/182,967, 77/421,963, 77/422,599, 77/422,439, 77/422,726, 77/421,897, and 77/422,559. The Lanham Act specifically provides that the registration on the Principal Register "*shall be prima facie evidence of the validity of the registered mark and of the registration of the mark*, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein". Lanham Act § 33(a), 15 U.S.C.A. § 1115(a) (emphasis added).

The defenses you assert to Tulane's rights are without merit. First, your letter reveals a fundamental misunderstanding of trademark law. Tulane's ownership of the Newcomb marks derives from its use of those marks and the association of the marks with Tulane, not from the registrations. Tulane has been using the Newcomb name for over 100 years, and its registrations identify use of the name on merchandise as early as January 1, 1910. As a result of the extensive use of the name "Newcomb" over many decades, Tulane has developed significant secondary meaning in the Newcomb name and mark, and therefore Tulane has strong and undeniable trademark rights. As you know, the registrations provide additional protections for such trademark rights.

¹ The January 27, 2009 Letter mistakenly referred to Serial Number 78/182,672, not 77/182,672.

Second, you state that you are “unaware” that Tulane sells merchandise using the Newcomb trademarks. We would direct your attention to Tulane’s website, <http://newcomb.tulane.edu/alumnae-about-us-gift-shop>, where Tulane sells jewelry, notecards and glassware emblazoned with the Newcomb name and the oak tree and the acorn. Your claim to be “unaware” of such use is not supportable.

Third, you claim without any substantiation that “Tulane had no intent to use these marks when it filed for such trademark applications.” In fact, as noted above, Tulane absolutely had and has a good faith intent to use these marks as trademarks, as it has been doing for over a century. Tulane began a concerted effort to formalize its registration of marks in 2002, and as a part of this ongoing effort, has filed applications for these trademarks in recent years.

Fourth, the February 9, 2009 Letter makes the claim that TFoNC’s use of the Newcomb Marks is “fair use and/or protected by the First Amendment”. In fact, TFoNC is not commenting on the marks or otherwise engaging in protected speech – instead, it is blatantly trading off Tulane’s name and logo in order to raise money. This is clearly not fair use. *See, e.g., Board of Supervisors of Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.*, 550 F.3d 465, 489, 89 U.S.P.Q.2d 1338 (5th Cir. 2008) (finding that there was no fair use defense where the defendant “used the Universities’ colors and indicia in more than a nominative sense”).

We remain prepared to resolve this matter without litigation, provided that you meet the requirements outlined in the January 27, 2009 Letter. If we are unable to resolve this matter in the next seven business days, however, this firm is authorized to commence legal action.

We look forward to hearing from you or your counsel promptly. The foregoing is without prejudice to Tulane’s rights and remedies, all of which are expressly reserved.

Sincerely,

A handwritten signature in black ink, appearing to read "Dennis H. Tracey, III". The signature is written in a cursive style with a large, looping initial "D".

Dennis H. Tracey, III