TTAB

KILPATRICK STOCKTON LLP
Attorneys at Law

Suite 2800 1100 Peachtree St.
Atlanta GA 30309-4528
t 404 815 6500 f 404 815 6555
www.KilpatrickStockton.com

direct dial 404 532 6967
direct fax 404 541 3325
lralls@kilpatrickstockton.com

October 9, 2009

VIA EXPRESS MAIL [EV374151108US]

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

#77383001

Re : *Oklahoma State University v. Super Bakery, Inc.*
Opposition No.: 91187908

Dear Madam or Sir:

We are enclosing for filing via Express Mail the following documents:

(1) Opposer's Motion for Summary Judgment;

(2) Opposer's Redacted Brief in Support of Motion for Summary Judgment;

(3) Opposer's Confidential Brief in Support of Motion for Summary Judgment Filed Under Seal;

(4) Declaration of Michael Drucker with Exhibit A;

(5) Declaration of Lauren Sullins Ralls with Exhibits A – F;

(6) Redacted Exhibit G to the Declaration of Lauren Sullins Ralls;

(7) Confidential Exhibit G to the Declaration of Lauren Sullins Ralls Filed Under Seal;

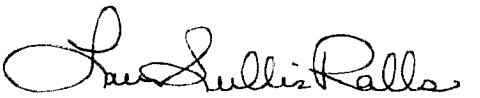
(8) Exhibits H – I to the Declaration of Lauren Sullins Ralls;

U.S. Patent & TMOfc TM Mail Rcpt Dt. #73

(9) Declaration of Kurtis Mason with Exhibits A - M.

Please let us know if you have any questions.

Sincerely,



Lauren Sullins Ralls

Enclosures

cc: John McIlvaine, Esq. (w/enclosures)

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

OKLAHOMA STATE UNIVERSITY,	)	
	)	
	)	
	)	
Opposer,	)	
v.	)	In the matter of Application
	)	Serial No. 77/383,001
	)	for the mark COWBOYADE
	)	Opposition No. 91187908
SUPER BAKERY, INC.,	)	
	)	
	)	
Applicant.	)	

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Rule 2.127(e)(1) of the Trademark Rules of Practice and Rule 56 of the Federal Rules of Civil Procedure, Opposer Oklahoma State University ("Opposer") moves for summary judgment on its claim that Applicant Super Bakery, Inc.'s mark should be refused registration because it is likely to be confused with Opposer's trademarks in violation of Section 2(d) of the Lanham Act. For the reasons set forth in its accompanying brief in support, Opposer respectfully requests the Board grant Opposer's motion for summary judgment in its entirety.

Dated: October 9, 2009.

R. Charles Henn Jr.
Alicia Grahn Jones
Lauren Sullins Ralls
Allison M. Scott
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500
Attorneys for Opposer

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

OKLAHOMA STATE UNIVERSITY,	)	
	)	
	)	
	)	
Opposer,	)	
v.	)	In the matter of Application
	)	Serial No. 77/383,001
	)	for the mark COWBOYADE
	)	Opposition No. 91187908
SUPER BAKERY, INC.,	)	
	)	
	)	
Applicant.	)	

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION FOR SUMMARY JUDGMENT was served on counsel for Applicant on October 9, 2009 via first class mail to:

John W. McIlvaine
The Webb Law Firm
436 Seventh Avenue
700 Koppers Building
Pittsburgh, PA 15219

Lauren Sullins Ralls
Attorney for Opposer

CERTIFICATE OF MAILING

I hereby certify that a true copy of the foregoing OPPOSER'S MOTION FOR SUMMARY JUDGMENT is being deposited with the United States Postal Service as Express Mail on October 9, 2009 in an envelope addressed to:

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

Lauren Sullins Ralls
Attorney for Opposer

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

OKLAHOMA STATE UNIVERSITY, Opposer, v. SUPER BAKERY, INC., Applicant.	)	In the matter of Application Serial No. 77/383,001 for the mark COWBOYADE Opposition No. 91187908

MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT

REDACTED

R. Charles Henn Jr.
Alicia Grahn Jones
Lauren Sullins Ralls
Allison M. Scott
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309
Phone: (404) 815-6500
Attorneys for Opposer

TABLE OF CONTENTS

		Page
I.	INTRODUCTION	1
II.	UNDISPUTED MATERIAL FACTS	3
	A. The University and Its Strong COWBOYS Marks	3
	B. Applicant and Applicant's COWBOYADE Mark	7
III.	ARGUMENT	9
	A. Summary Judgment Standard	9
	B. Applicant's COWBOYADE Mark Should Be Refused Registration As a Matter of Law	12
	1. The University's COWBOYS Marks Are Strong Marks	13
	2. Applicant's COWBOYADE Mark Incorporates the Dominant Portion of the University's COWBOYS Marks	23
	3. The Parties' Products Are Substantially Similar	33
	4. The Parties' Trade Channels and Customers are Identical	37
	5. Purchasers of the Parties' Inexpensive Goods Are Primarily Impulse Shoppers	39
	6. Evidence Of Actual Confusion Is Not Required	41
	7. Applicant's Bad Faith Intent to Trade Off the Goodwill of Numerous Schools Weighs In Favor of a Finding of Confusion	43
IV.	CONCLUSION	49

TABLE OF AUTHORITIES

Page

Cases

Am. Scientific Chem., Inc. v. Am. Hosp. Supply Corp.,
690 F.2d 791 (9th Cir. 1982) 7

AmBrit, Inc. v. Kraft, Inc.,
812 F.2d 1531 (11th Cir. 1986) 14

Anderson v. Liberty Lobby, Inc.,
477 U.S. 242 (1986) 5

Bd. of Supervisors of the La. State Univ. v. Smack Apparel Co.,
438 F. Supp. 2d 653 (E.D. La. 2006), *aff'd*, 550 F.3d 465 (5th Cir. 2008) 6, 8

CBS Inc. v. Morrow,
708 F.2d 1579 (Fed. Cir. 1983) 15

Chicago Bears Football Club, Inc. v. 12th Man/Tenn. LLC,
Opp. No. 911150925, 2007 WL 683778 (TTAB Feb. 28, 2007) 12, 13, 20

Clinton Detergent Co. v. Procter & Gamble Co.,
302 F.2d 745 (C.C.P.A. 1962) 11

CytoSport, Inc. v. Vital Pharms., Inc.,
617 F. Supp. 2d 1051 (E.D. Cal. 2009) 16

D.A.R.E. Am. v. Dare To Be Great, Inc.,
Opp. No. 92010, 1997 WL 688176 (TTAB Mar. 6, 1997) 8

Dan Robbins & Assocs., Inc. v. Questor Corp.,
599 F.2d 1009 (C.C.P.A. 1979) 14, 18, 19

DC Comics v. Pan Am. Grain Mfg. Co.,
77 U.S.P.Q. 2d 1220 (TTAB 2005) 15

Digi Int'l Inc. v. DigiPos Sys. Inc.,
Opp. No. 91163719, 2008 WL 2515105 (TTAB Jan. 10, 2008) 11, 13

Exxon Corp. v. Tex. Motor Exch.,
628 F.2d 500 (5th Cir. 1980) 10

Giant Food, Inc. v. Rosso & Mastracco, Inc.,
218 U.S.P.Q. 521 (TTAB 1982) 11

Greyhound Corp. v. Both Worlds, Inc.,
6 U.S.P.Q.2d 1635 (TTAB 1988) 5

Han Beauty, Inc. v. Alberto-Culver Co.,
236 F.3d 1333 (Fed. Cir. 2001) 10

TABLE OF AUTHORITIES
(continued)

Page

Hancock v. Am. Steel & Wire Co. of N.J.,
203 F.2d 737, 97 U.S.P.Q. 330 (C.C.P.A. 1953) 13

Hercules, Inc. v. Nat'l Starch & Chem. Corp.,
223 U.S.P.Q. 1244 (TTAB 1984) 10, 11

Hewlett-Packard Co. v. Packard Press, Inc.,
281 F.3d 1261 (Fed. Cir. 2002) 10, 14, 15, 17

Hillyard Enter., Inc. v. Indus. Steam Cleaning Inc.,
Opp. No. 91170650, 2008 WL 1741922 (TTAB Apr. 3, 2008) 5, 17

In re All Am. Beverage Inc.,
Serial No. 75/235,920, 1999 WL 1062810 (TTAB Nov. 17, 1999) 16

In re E.I. Du Pont de Nemours & Co.,
476 F.2d 1357 (C.C.P.A. 1973) 6

In re Energy Images, Inc.,
227 U.S.P.Q. 572 (TTAB 1985) 11

In re Majestic Distilling Co.,
315 F.3d 1311 (Fed. Cir. 2003) 15, 16, 17

In re Pommery S.A.,
Serial No. 78/367,268, 2005 WL 4255386 (TTAB June 22, 2005) 16

In re Saviah Rose Winery, LLC,
Serial No. 78/433,647, 2006 WL 2414518 (TTAB Aug. 4, 2006) 11, 13

In re Wilson,
Serial No. 75/285,881, 57 U.S.P.Q.2d 1863, 2001 WL 58395 (TTAB Jan. 19, 2001) 12

J & J Snack Foods Corp. v. McDonald's Corp.,
932 F.2d 1460 (Fed. Cir. 1991) 15

Kangol, Ltd. v. KangaROOS U.S.A., Inc.,
974 F.2d 161 (Fed. Cir. 1992) 10

Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.,
774 F.2d 1144 (Fed. Cir. 1985) 12, 20

Maine Savs. Bank v. First Bank Group,
220 U.S.P.Q. 736 (TTAB 1983) 10

Matsushita Elec. Indus. Co. v. Zenith Radio Corp.,
475 U.S. 574 (1986) 4, 5

TABLE OF AUTHORITIES
(continued)

Page

Nat'l Football League Prop's, Inc. v. N.J. Giants, Inc.,
637 F. Supp. 507 (D.N.J. 1986) 19

Procter & Gamble Co. v. Conway,
419 F.2d 1332 (C.C.P.A. 1970) 12

Schering-Plough Healthcare Prods., Inc. v. Ing-Jing Huang,
Opp. No. 91117558, 2007 WL 1751193 (TTAB June 18, 2007) 17

Starbucks U.S. Brands, LLC v. Ruben,
Opp. No. 91156879, 2006 WL 402564, 78 U.S.P.Q.2d 1741 (TTAB Feb. 9, 2006) 8

Stokely-Van Camp, Inc. v. Wooten,
Opp. No. 91183146, 2009 WL 1017294 (TTAB Mar. 24, 2009) 5

TBC Corp. v. Holsa, Inc.,
126 F.3d 1470 (Fed. Cir. 1997) 12, 17

Tex. Tech Univ. v. Spiegelberg,
461 F. Supp. 2d 510 (N.D. Tex. 2006) 6, 16

Uncle Ben's, Inc. v. Stubenberg Int'l, Inc.,
47 U.S.P.Q.2d 1310, 1998 WL 416760 (TTAB June 9, 1997) 11, 15

Univ. of Ga. Athletic Ass'n v. Laite,
756 F.2d 1535 (11th Cir. 1985) 7, 13, 14, 16, 20

Weiss Assocs., Inc. v. HRL Assocs., Inc.,
902 F.2d 1546 (Fed. Cir. 1990) 17

Wilson v. Delaunay,
245 F.2d 877 (C.C.P.A. 1957) 10

Statutes

15 U.S.C. § 1052(d) 5

15 U.S.C. § 1065 ..... 2, 9

15 U.S.C. § 1115(b) 9

Other Authorities

Fed. R. Civ. P. 56(c) 4

Fed. R. Civ. P. 56(e) 4

Opposer Oklahoma State University ("Opposer") respectfully submits this memorandum in support of its motion for summary judgment against Applicant Super Bakery, Inc. ("Applicant").

I. INTRODUCTION

This case involves Applicant Super Bakery's attempt to obtain federal trademark registrations for marks that trade off of the goodwill and reputation of well-known collegiate mascots and nicknames of over twenty universities, including Opposer. Oklahoma State University (the "University") is a highly-regarded educational institution located in Stillwater, Oklahoma, whose athletes and athletic teams dominate several fields of intercollegiate athletics, having won the fourth-most team NCAA National Championship titles, at 48, as well as 140 individual NCAA National Championship titles. The University's sports teams are widely known as the COWBOYS and the University's mascot is a Cowboy. Opposer governs the University, its athletic department, and its many teams and organizations that use the COWBOYS mark.

Applicant Super Bakery was founded and is managed by a former collegiate and professional football player, Franco Harris. Applicant intends to develop and launch a sports drink similar to GATORADE®, which was developed by scientists at the University of Florida and, with permission, incorporates the University of Florida's famous GATOR® trademark. Unlike the GATORADE sports drink, however, Applicant intends to register and use the University's COWBOYS marks *without* authorization or permission from the University.

Moreover, Applicant intentionally selected the University's iconic COWBOYS mark to draw on the goodwill and reputation of the University. Because Applicant's COWBOYADE mark incorporates the dominant portion of the University's COWBOYS mark and will be used on products nearly identical to those offered by the University and sold to University fans and customers, Applicant's mark is likely to cause consumer confusion and should be refused registration.

II. UNDISPUTED MATERIAL FACTS

A. The University and Its Strong COWBOYS Marks

Oklahoma State University was founded in 1890 and is the flagship institution of the Oklahoma State University System. *See* Declaration of Kurtis Mason ("Mason Dec.") ¶ 2. The University consists of ten different colleges and offers over 350 undergraduate and graduate educational programs, in addition to athletic programs. *See id.* The University has offered educational and athletic goods and services for over a century and enrolls a total of 32,000 students between its main Stillwater, Oklahoma campus and its smaller satellite campuses. *See id.*

Since as early as 1923, the students and alumni of the University referred to themselves as the COWBOYS, which became the University's nickname. *See id.* ¶¶ 4-5. That year, students were inspired by U.S. deputy marshal Frank B. "Pistol Pete" Eaton's appearance in a local parade and adopted him and the COWBOYS identity as their new symbol and mascot. *See id.* ¶ 4. The COWBOYS nickname was adopted quickly by the University community, and in 1924, sports journalists that regularly covered college events began referring to the University's athletic teams as the COWBOYS. *See id.* ¶ 5. Until Frank "Pistol Pete" Eaton's death in 1958, he regularly appeared at University events as a living symbol of the University's COWBOYS identity and became a beloved member of the University community. *See id.* ¶ 6. In 1984, the University officially adopted "Pistol Pete" as the embodiment of its COWBOY mascot ("the COWBOY Mascot"). *See id.*

The University owns two federal registrations of the Pistol Pete caricature drawing of the University's COWBOY Mascot, including Reg. No. 1,602,422 for the mark OSU & Design, which has now become incontestable under 15 U.S.C. § 1065. *See id.* ¶ 3, Ex. A. The University's COWBOY Mascot, the University's COWBOYS nickname, and the University's COWBOYS marks collectively are referred to as the "COWBOYS Marks."

Through the University's athletic teams' successes, the COWBOYS Marks have been featured on television broadcasts and in print and online media nationwide for decades, exposing millions of viewers to the University's well-known COWBOYS Marks. *See id.* ¶ 9. Numerous unsolicited media sources use

the University's COWBOYS Marks to refer to the University. *See* Declaration of Lauren Sullins Ralls ("Ralls Dec."), Ex. H. Moreover, many books have been written about the history and success of the University's athletic teams. *See* Mason Dec. ¶ 13, Ex. K.

For decades, the University has used its COWBOYS Marks in connection with a plethora of goods and services commonly associated with a University. *See id.* ¶ 10. The University maintains an extensive licensing program and has licensed its COWBOYS Marks in connection with a wide variety of goods, including food and beverage items such as vitamin-enriched energy drinks, soft drinks, coffee, bottled water, lollipops, various sauces and seasonings, and tortilla chips. *See id.* ¶ 14, Ex. L; Declaration of Michael Drucker ("Drucker Dec.") ¶¶ 2-3, Ex. A. The University's licensees also sell food-related products bearing the COWBOYS Marks such as glassware, dishware, and sport and travel beverage bottles. *See* Mason Dec. ¶ 14l Ex. L; Drucker Dec. ¶ 3, Ex. A. Finally, food products are sold daily on the University's campus and at University events in close association with the University's Marks, including through OSU COWBOY DINING, which provides food and beverage service to the Club and Suite levels of the University's football stadium and to the University's Athletic Department for special events. *See* Mason Dec. ¶ 15, Ex. M. As a result of the University's longstanding and extensive use, the University's COWBOYS Marks have become well-known nationwide and particularly in the south-central United States.

B. Applicant and Applicant's COWBOYADE Mark

Applicant owns at least twenty pending applications to register marks for use in connection with sports drinks that incorporate two components: (1) the trademarks of well-known universities; and (2) the suffix "-ADE" (collectively, the "Applications"). *See* Ralls Dec. ¶ 2, Ex. A. Applicant's President, Mr. Harris, testified that he was well-aware of the mascots and nicknames of these various universities prior to filing the Applications, and he selected these mascots and nicknames to be the dominant element in his marks because they were "iconic." *See* Deposition of Franco Harris ("Harris Dep.") at 41:8-42:8; 50:21-

25; 54:15-20; 57:15-22; 59:8-60:3; 60:9-14; 61:19-62:5; 62:13-63:10; 63:11-64:3.[1] Indeed, Mr. Harris selected these marks to entice students, fans, and alumni of the universities to purchase Applicant's university-themed sports drinks. *See id.* at 41:8-14 and 42:2-8.

On January 29, 2008, Applicant filed an intent-to-use application to register the mark COWBOYADE (Serial No. 77/383,001) ("Applicant's Mark" or "COWBOYADE Mark") for use in connection with "sports drinks and performance drinks" in International Class 32. *See* Ralls Dec., Ex. B. The recitation of goods was amended by Applicant to "sports drinks" in International Class 32. *See id.* Ex. C.

Because Applicant seeks to register a mark that intentionally incorporates the dominant portion of the University's COWBOYS Marks for use on similar goods sold in identical channels to identical consumers, Applicant's COWBOYADE Mark is likely to be confused with the University's COWBOYS Marks. Opposer therefore timely filed a Notice of Opposition on December 5, 2008. *See* Docket No. 1; Ralls Dec. ¶ 5.

III. ARGUMENT

A. Summary Judgment Standard

Federal Rule of Civil Procedure 56(c) provides that summary judgment should be granted if the evidence shows "that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law." Once the moving party has shown that no genuine issue of fact exists, the burden shifts to the non-moving party to demonstrate the existence of a factual issue. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986) (finding that non-moving party had failed to show any genuine issue for trial).

The non-moving party cannot rest on mere allegations or denials of the pleadings but must present specific facts showing a genuine issue for trial. *See* Fed. R. Civ. P. 56(e). Disputed facts that do not resolve or affect the outcome of the litigation will not preclude the entry of summary judgment. *See*

[1] The relevant portions of the transcript of the deposition of Franco Harris, in his individual capacity and as the Rule 30(b)(6) witness for Applicant, are attached as Exhibit G to the Ralls Dec.

Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-48 (1986) (explaining "that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact."). The non-moving party "must do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita*, 475 U.S. at 586. "[W]here the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no 'genuine issue for trial,'" and the moving party must prevail as a matter of law. *Anderson*, 477 U.S. at 261.

Finally, summary judgment is appropriate on a claim of likelihood of confusion. *See, e.g., Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1639 (TTAB 1988) (granting summary judgment on a likelihood of confusion claim); *Stokely-Van Camp, Inc. v. Wooten*, Opp. No. 91183146, 2009 WL 1017294, at *5 (TTAB Mar. 24, 2009) (granting summary judgment on the basis of likelihood of confusion with the applicant's HATER-AID mark and the opposer's GATORADE mark); *Hillyard Enter., Inc. v. Indus. Steam Cleaning Inc.*, Opp. No. 91170650, 2008 WL 1741922, at *4 (TTAB Apr. 3, 2008) (granting summary judgment on the basis of a likelihood of confusion).

B. Applicant's COWBOYADE Mark Should Be Refused Registration As a Matter of Law

Applicant's COWBOYADE Mark should be refused registration because Applicant's Mark is likely to cause confusion with the University's COWBOYS Marks. Under Section 2(d) of the Lanham Act, a mark shall be refused registration if it "[c]onsists of or comprises a mark which so resembles a mark ... previously used in the United States by another ... as to be likely ... to cause confusion." 15 U.S.C. § 1052(d). In determining whether there is a likelihood of confusion, the Board may consider the following non-exhaustive list of factors:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
(3) The similarity or dissimilarity of established, likely-to-continue trade channels;
(4) The conditions under which, and buyers to whom, sales are made, *i.e.*, "impulse" vs. careful, sophisticated purchasing;
(5) The fame of the prior mark (sales, advertising, length of use);

(6) The nature and extent of any actual confusion; and
(7) Any other established fact probative of the effect of use.

See In re E.I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). Here, the evidence is undisputed and compelling that Applicant's COWBOYADE Mark is likely to cause confusion with the University's COWBOYS Marks.

1. The University's COWBOYS Marks Are Strong Marks

The University's longstanding use of its COWBOYS Marks demonstrates their strength. *See Bd. of Supervisors of the La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 659 (E.D. La. 2006), *aff'd*, 550 F.3d 465 (5th Cir. 2008) (finding "the universities' color schemes, logos, and designs are extremely strong marks that have been used for decades"); *Tex. Tech Univ. v. Spiegelberg,* 461 F. Supp. 2d 510, 521 (N.D. Tex. 2006) (finding the strength of the Texas Tech Marks "undeniable" and entitled to "broad protection").

Since as early as 1923, the students and alumni of the University referred to themselves as the COWBOYS, which became the University's nickname. *See* Mason Dec. ¶¶ 4-5. The students, inspired by Frank B, "Pistol Pete" Eaton, adopted "Pistol Pete" and the COWBOYS identity as their new symbol and mascot. *See id.* ¶ 4. The University community quickly accepted the new COWBOYS nickname, and in 1924, sports journalists that regularly covered college events began referring to the University's athletic teams as the COWBOYS. *See id.* ¶ 5. Until his death in 1958, Frank "Pistol Pete" Eaton himself regularly appeared at University events and became a living symbol of the University's COWBOYS identity and a beloved member of the University community. *See id.* ¶ 6. In 1984, the University officially adopted "Pistol Pete" as the embodiment of its COWBOY Mascot, which it uses along with its other COWBOYS Marks in connection with a wide variety of educational and entertainment goods and services, including the University's athletic programs. *See id.* ¶¶ 6-7, 10.

Building on the reputation of the University's COWBOY Mascot, the University has used the name COWBOYS and COWGIRLS to refer to the University's athletic teams. *See id.* ¶ 7. The University's COWBOYS and COWGIRLS athletic teams have enjoyed tremendous success over the

years, having won 48 NCAA National Championship titles, ranking it the fourth-most in the country, as well as 140 individual NCAA National Championship titles. *See id.* ¶ 8. For almost a century, the University's wrestling program has dominated college wrestling. *See id.* The team's first wrestling coach, who is a distinguished member of the National Wrestling Hall of Fame, is credited with pioneering the sport of modern wrestling. *See id.* The University's wrestling team has won 34 NCAA National Championship titles, most recently for four consecutive years in 2003-2006, and holds the record for having the most championship titles collected by a school in any sport. *See id.* The University's COWBOYS basketball team has also had a very successful history, advancing to the Final Four of the NCAA Men's Basketball Championship six times and winning the title in two consecutive years. *See id.* The University's COWBOYS football team has established itself as a major college football contender, participating in 18 bowl games, with five appearances in the last six years, and winning ten conference championships. *See id.* Through the University's athletic teams' successes, the COWBOYS Marks have been featured on television broadcasts and in print and online media nationwide for decades, exposing millions of viewers to the University's well-known COWBOYS Marks. *See id.* ¶ 9.

The University has used its COWBOYS Marks in connection with a wide variety of goods and services commonly associated with a university as an educational institution and its athletic department. *See id.* ¶ 10. Some examples of the University's extensive use of its COWBOYS Marks include Internet websites (*see id.*, Ex. B), programs for sports events (*see id.*, Ex. C), athletics schedules (*see id.*, Ex. D), team rosters (*see id.*, Ex. E), media guides (*see id.*, Ex. F), fundraising (*see id.*, Ex. G), student publications (*see id.*, Ex. H), and camps and special events for students and fans (*see id.*, Ex.I). Through longstanding and extensive use, the University's well-known COWBOYS Marks have come to serve as source-identifiers of the goods and services offered by the University.

Second, substantial sales evidence the strength of the University's COWBOYS Marks. *See Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1545 (11th Cir. 1985) (finding extensive use of the University of Georgia's Bulldog Design Mark by licensees contributed to the strength of the mark); *Am. Scientific Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 793 (9th Cir. 1982) (finding secondary

meaning after only 149 purchase orders under claimed mark); *Smack,* 438 F. Supp. 2d at 658 ("The universities market scores of items bearing their color schemes, logos, and designs, and sales of these items exceed tens of millions of dollars."). For decades, the University has licensed use of its COWBOYS Marks through an extensive licensing program. *See* Mason Dec. ¶ 14; Drucker Dec. ¶ 2-3. The University has over 600 licensees who sell a wide variety of goods bearing the University's COWBOYS Marks, including food items such as lollipops, various sauces and seasonings, and tortilla chips, as well as food- and drink-related items such as glassware, dishware, and sport and travel beverage bottles. *See* Mason Dec. ¶ 14, Ex. L; Drucker Dec. ¶ 3, Ex. A. The University also has licensed use of the University's COWBOYS Marks for use in connection with drink items such as vitamin-enriched energy drinks, soft drinks, coffee, and bottled water. *See id.* In the past five years alone, licensed retail sales of University-related products, many of which bear the University's COWBOYS Marks, have totaled over $118 million dollars. *See* Drucker Dec. ¶ 6.

Finally, significant consumer recognition and unsolicited media attention to a mark are factors indicative of a strong mark. *See, e.g., Starbucks U.S. Brands, LLC v. Ruben*, Opp. No. 91156879, 2006 WL 402564, at *8, 78 U.S.P.Q.2d 1741 (TTAB Feb. 9, 2006) (finding widespread unsolicited media coverage of the opposer's STARBUCKS mark was indicative of the strength of the mark); *D.A.R.E. Am. v. Dare To Be Great, Inc.*, Opp. No. 92010, 1997 WL 688176, at *7 (TTAB Mar. 6, 1997) (finding extensive media publicity evidenced that the opposer's DARE marks were strong); *see also Smack*, 438 F. Supp. 2d at 658. Here, significant unsolicited media using the COWBOYS Marks to refer to the University reinforces the public's association of the COWBOYS Marks with the University. *See* Ralls Dec., Ex. H. Indeed, the University's COWBOY Mascot was featured twice this year on the cover of *Sports Illustrated* magazine within the span of a month. *See* Mason Dec. ¶ 12, Ex. J. Moreover, many books have been written about the COWBOYS discussing the history of the University, its athletic teams, and its iconic COWBOY Mascot. *See id.* ¶ 13, Ex. K.

The University owns a federal registration of the mark OSU & Design which covers goods in International Class 16 and International Class 41. *See id.* ¶ 3, Ex. A. The registration was filed on April

12, 2006 and claims a date of first use of June 30, 1930 in Class 16 and a date of first use of November 30, 2000 in Class 41. *See id.* This registration, which issued on December 19, 2006, is valid and in full force and effect. *See id.* The University also owns a federal registration of the mark OSU & Design in Class 25, which was filed on October 6, 1989 and claims a date of first use of June 1930. *See id.* This registration, which issued on June 19, 1990, is also valid and in full force and effect. *See id.* A chart depicting these marks is included below.

Mark	Reg. No.	Filing Date/ Reg. Date	Goods/Services
OSU & Design	1,602,422	10/6/1989 6/19/1990	Clothing, namely men's and women's shirts, in Class 25.
OSU & Design	3,187,429	4/12/2006 12/19/2006	Paper nametags, stickers, pencils, and notebooks, in Class 16; and Education and entertainment services, namely, providing course of instruction at the university level; educational research, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals, in Class 41.

See id. For Reg. No. 1,602,422, affidavits have been filed and accepted pursuant to Sections 8 and 15 of the Lanham Act, rendering the registration incontestable under 15 U.S.C. § 1065. An incontestable registration is "conclusive 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." 15 U.S.C. § 1115(b).

The University's COWBOYS Marks are incredibly strong nationwide and particularly in the south-central United States. Accordingly, the University's COWBOYS Marks are undeniably strong marks and this factor weighs in favor of Opposer.

2. Applicant's COWBOYADE Mark Incorporates the Dominant Portion of the University's COWBOYS Marks

Similarity of the marks is one of the most probative and critical elements in the likelihood of confusion analysis. *See, e.g., Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001). An applicant need not adopt a mark identical to that of the opposer to support a finding of likelihood of confusion. *See, e.g., Hercules, Inc. v. Nat'l Starch & Chem. Corp.*, 223 U.S.P.Q. 1244, 1246 (TTAB 1984) ("[I]t is a fundamental tenant of our trademark law that exact similitude is not required to conclude that two marks are confusingly similar."). Nevertheless, the "greater the similarity in the design of the trademarks, the greater the likelihood of confusion." *Exxon Corp. v. Tex. Motor Exch.*, 628 F.2d 500, 505 (5th Cir. 1980). Here, Applicant's COWBOYADE Mark is confusingly similar to the University's COWBOYS Marks in sight, sound, meaning, and commercial impression.

First, the dominant element of Applicant's COWBOYADE Mark is the term COWBOY, which incorporates the dominant element of the University's COWBOYS Marks.[2] The dominant element of a mark generally is entitled to greater weight in determining likelihood of confusion. *See, e.g., Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163 (Fed. Cir. 1992). Where the dominant feature of the marks is the same or similar, the likelihood of confusion increases. *See, e.g., Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1266 (Fed. Cir. 2002). Here, the dominant element of Applicant's COWBOYADE Mark incorporates the dominant element of the University's COWBOYS Marks and is likely to cause confusion. *See, e.g., Maine Savs. Bank v. First Bank Group*, 220 U.S.P.Q. 736 (TTAB 1983) (finding a likelihood of confusion on the basis of similarity between the dominant elements of the

[2] The Board has stated that there is no trademark significance between the plural and singular form of a word. *See Wilson v. Delaunay*, 245 F.2d 877, 878 (C.C.P.A. 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark."). Thus, the fact that Applicant's Mark incorporates the singular term COWBOY rather than the plural term COWBOYS is immaterial. *See id.* (finding a likelihood of confusion between the singular and plural forms of the word ZOMBIE).

marks); *see also In re Energy Images, Inc.*, 227 U.S.P.Q. 572 (TTAB 1985) (SMARTSCAN confusingly similar to SMART); *Hercules*, 223 U.S.P.Q. at 1246 (NATROL confusingly similar to NATROSOL); *Giant Food, Inc. v. Rosso & Mastracco, Inc.*, 218 U.S.P.Q. 521 (TTAB 1982) (finding a likelihood of confusion between GIANT and GIANT OPEN AIR MARKET).

The letter string "ADE" fails to distinguish Applicant's COWBOYADE Mark from the University's COWBOYS Marks, since "ADE" is merely a generic suffix. Mr. Harris concedes that the generic letter string "ADE" is a "common ending" for drinks. *See* Harris Dep. at 25:12-18. Moreover, the *Merriam-Webster Dictionary* defines the suffix "ADE" as a generic word for drinks:

> 1: an act: action <block*ade*>; or
> 2: a product; *especially*: sweet drink <lime*ade*>.

See Ralls Dec., Ex. I (definitions from *Merriam-Webster Dictionary*). Generic terms, such as "ADE" for drinks, are incapable of distinguishing a mark and are entitled to less weight in the likelihood of confusion analysis. *See, e.g., Digi Int'l Inc. v. DigiPos Sys. Inc.*, Opp. No. 91163719, 2008 WL 2515105, at *13 (TTAB Jan. 10, 2008) (finding the generic suffix "POS" for "point-of-sale" did not distinguish the mark DIGIPOS from the mark DIGI); *In re Saviah Rose Winery, LLC*, Serial No. 78/433,647, 2006 WL 2414518, at *2 (TTAB Aug. 4, 2006) (finding the generic word "CUVÉE" in the applied-for mark BIG SKY CUVÉE was entitled to less weight in the likelihood of confusion analysis); *Uncle Ben's, Inc. v. Stubenberg Int'l, Inc.*, 47 U.S.P.Q.2d 1310, 1998 WL 416760, at *3 (TTAB June 9, 1997) (finding that the generic word BREAD did not distinguish the applicant's BEN'S BREAD mark from the opposer's UNCLE BEN'S mark). Accordingly, the generic suffix "ADE" fails to distinguish Applicant's Mark from the University's nearly identical COWBOYS Marks. *See, e.g., Digi Int'l*, 2008 WL 2515105, at *13 (finding a likelihood of confusion between DIGI and DIGIPOS where "POS" was merely a generic suffix).

Second, Applicant's COWBOYADE Mark is unquestionably similar to the University's COWBOYS Mark in appearance. Where the applicant's mark incorporates the opposer's mark, as here, the similarity in appearance of the marks weighs in favor of a finding of confusion. *See, e.g., Clinton*

Detergent Co. v. Procter & Gamble Co., 302 F.2d 745, 749 (C.C.P.A. 1962) (finding a likelihood of confusion between the applicant's mark CARJOY and the opposer's mark JOY); *In re Wilson*, Serial No. 75/285,881, 57 U.S.P.Q.2d 1863, 2001 WL 58395, at *2 (TTAB Jan. 19, 2001) (finding a likelihood of confusion between the applicant's mark PINE CONE BRAND and the opposer's mark PINE CONE);.

Third, Applicant's COWBOYADE Mark and the University's COWBOYS Marks are phonetically similar. The word COWBOY in Applicant's COWBOYADE Mark is pronounced exactly the same as the word COWBOY in the University's COWBOYS Marks. The Board has found that the addition of a generic term (*e.g.*, "ADE") does not affect the similarities in the pronunciation, particularly where the dominant element of the marks (*i.e.*, "COWBOY") is pronounced the same. *See, e.g.*, *Chicago Bears Football Club, Inc. v. 12th Man/Tenn. LLC*, Opp. No. 911150925, 2007 WL 683778, at *5 (TTAB Feb. 28, 2007) ("[T]he addition of the term 12TH does not result in the marks having significantly different appearances or pronunciation inasmuch as these marks are dominated by the term 'BEAR....'"). Thus, the phonetic similarity of the marks weighs in favor of a likelihood of confusion. *See, e.g.*, *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1472 (Fed. Cir. 1997) (finding a likelihood of confusion between the marks GRAND SLAM and GRAND AM because of the close similarity in sound); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1146 (Fed. Cir. 1985) (finding a likelihood of confusion between the marks HUGGIES and DOUGIES because of the phonetic similarity).

Fourth, Applicant's Mark conveys the same meaning as the University's Marks in that it refers to the University, the University's athletic teams, and the University's COWBOY Mascot. "A designation may well be likely to cause purchaser confusion as to the origin of goods because it conveys, as used, the same idea, or stimulates the same mental reaction, or in the ultimate has the same meaning." *Procter & Gamble Co. v. Conway*, 419 F.2d 1332, 1336 (C.C.P.A. 1970). Mr. Harris concedes that Applicant's COWBOYADE Mark incorporates the University's "iconic" COWBOY Mascot. *See* Ralls Dec., Ex. E, at p. 11 (Applicant's Interrogatory Response No. 4); *see* Harris Dep. at 41:8-14. Applicant selected the COWBOYADE Mark in part because of the University's well-known COWBOY Mascot (*see* Harris Dep. at 41:8-14) and to appeal to students, fans, and alumni of the University (*see id.* at 41:8-14, 42:2-8;

61:10-14). Because Applicant's Mark conveys the same meaning as the University's COWBOYS Marks, this factor weighs in favor of a finding of confusion. *See, e.g.*, *Hancock v. Am. Steel & Wire Co. of N.J.*, 203 F.2d 737, 740, 97 U.S.P.Q. 330, 332 (C.C.P.A. 1953) (finding a likelihood of confusion between the mark TORNADO and CYCLONE because of the similarity in meaning to purchasers and prospective purchasers of the goods); *In re Saviah Rose Windery*, 2006 WL 2414518, at *2 (finding a likelihood of confusion between the mark BIG SKY CUVÉE and the mark BIG SKY BREWING COMPANY because of the similarity in meaning);.

Finally, Applicant's Mark creates the same commercial impression as the University's COWBOYS Marks. Consumers will perceive Applicant's COWBOYADE Mark as referring to a drink associated with, endorsed or approved by the University because it incorporates the University's COWBOY Mascot in its entirety and the dominant portion of the University's COWBOYS Marks.

The fact that Applicant's COWBOYADE Mark contains the generic suffix "ADE" does not significantly change the commercial impression created by Applicant's use of the University's COWBOY Mark. *See Digi Int'l*, 2008 WL 2515105, at *13 (finding the addition of the generic suffix "POS" did not significantly change the commercial impression created by the word DIGI alone). Accordingly, the commercial impressions of the marks are identical. *See, e.g.*, *Chicago Bears*, 2007 WL 683778, at *5 (finding the commercial impressions of the applicant's mark 12TH BEAR and the opposer's mark CHICAGO BEARS to be confusingly similar).

Indeed, the facts of this case are virtually identical to the facts in *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535 (11th Cir. 1985). In *Laite*, Bill Laite Distributing Co. marketed and sold "Battlin' Bulldog Beer." *Id.* at 1537. The Court found that the University of Georgia's BULLDOG marks were strong and the defendant's mark was visually similar to the University of Georgia's BULLDOG mascot. *Id.* at 1544-45. Just as in *Laite*, here, the TTAB should find that Applicant's COWBOYADE Mark is likely to cause confusion with the University's COWBOYS Marks.

3. The Parties' Products Are Substantially Similar

Confusion is likely because the parties' products are nearly identical. The similarity or relatedness of the goods weighs in favor of a likelihood of confusion. *See, e.g.*, *Hewlett-Packard*, 281 F.3d at 1265-66. The marks need not be used on identical goods since "any relation likely to lead purchasers into assuming a common source" is sufficient. *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1013 (C.C.P.A. 1979). Here, it is undisputed that Applicant's products are nearly identical and directly competitive to goods bearing the University's COWBOYS Marks.

For decades, and prior to Applicant's adoption of the COWBOYADE Mark, the University used (and continues to use) its COWBOYS Marks in connection with educational and athletic goods and services. *See* Mason Dec. ¶ 10. The University has an extensive licensing program through which it sells a plethora of licensed goods, including food and beverage products. *See* Mason Dec. ¶ 14, Ex. L; Drucker Dec. ¶¶ 2-3, Ex. A. Some examples of the licensed beverage products bearing the University's COWBOYS Marks include vitamin-enriched energy drinks, soft drinks, coffee, and bottled water. *See* Mason Dec. ¶ 14, Ex. L at pp. 1-9; Drucker Dec. ¶ 3, Ex. A. at pp. 1-3. The University's licensees also sell beverage-related products bearing the COWBOYS Marks such as glassware, dishware, and sport and travel beverage bottles. *See* Mason Dec. ¶ 14, Ex. L at pp. 14-20, 25-30; Drucker Dec. ¶ 3, Ex. A. at pp. 5-7, 10. Moreover, food and beverage products are sold daily on the University's campus and at University events in close association with the University's COWBOYS Marks, including through OSU COWBOY DINING, which provides food and beverage service to the Club and Suite levels of the University's football stadium and to the University's Athletic Department for special events. *See* Mason Dec. ¶ 15, Ex. M.

Applicant seeks to register Applicant's Mark for sports drinks. Applicant's sports drinks are similar to and closely associated with the food and drink-related products offered under the University's COWBOYS Marks and, therefore, likely to cause confusion. "That the products involved are similar is evidence tending to prove the existence of a likelihood of confusion." *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1541 (11th Cir. 1986); *accord Laite*, 756 F.2d at 1547 (defendant's sale of beer under the

name "Battlin' Bulldog Beer" and bulldog design was likely to cause confusion with licensed goods offered by the University); *Uncle Ben's*, 1998 WL 416760, at *3 (finding the applicant's bread mixes sold under the BEN'S BREADS mark were similar to the goods, namely, rice, rice mixes, soup mixes, stuffing mixes and sauces, sold under the opposer's UNCLE BEN'S mark). "Even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods." *DC Comics v. Pan Am. Grain Mfg. Co.*, 77 U.S.P.Q. 2d 1220, 1226 (TTAB 2005) (finding the applicant's prepared alcoholic fruit cocktails sold under the KRIPTONITA mark were similar to the wide variety of goods sold under the opposer's KRIPTONITE mark). This factor clearly weighs in favor of Opposer.

4. The Parties' Trade Channels and Customers are Identical

It is undisputed that the parties' channels of trade and customers will overlap. Likelihood of confusion increases in cases where the parties' respective products are sold in similar channels of trade. *See, e.g., In re Majestic Distilling Co.*, 315 F.3d 1311, 1316 (Fed. Cir. 2003) (finding a likelihood of confusion where the applicant's goods are marketed in many of the same channels of trade to many of the same consumers). Here, the University and its licensees sell products bearing the University's COWBOYS Marks in virtually every channel of trade, including but not limited to wholesale outlets, retail stores, specialty stores, sporting-goods stores, and via retail websites on the Internet. *See* Mason Dec. ¶ 16; Drucker Dec. ¶ 5.

Applicant's recitation of goods is not limited to any particular channel of trade, and, therefore, it is presumed that the goods will travel through the normal channels of trade for such goods and will reach the usual classes of purchasers of the goods. *See, e.g., Hewlett-Packard*, 281 F.3d at 1268 (stating "absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers"); *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983) (stating that in the absence of specific limitations in the application and registration, the "normal and usual channels of trade and methods of distribution" are presumed); *see also J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991) (rejecting arguments that the

parties' alleged channels of trade were different where the goods recited in the application were unlimited). Thus, the parties' channels of trade are presumed to be identical.

It is undisputed that Applicant intends to target the University's customer base: fans, students, and alumni of the University. *See* Harris Dep. at 41:8-14, 61:10-14. [redacted] *See id.* at 8:9-17; 33:4-11. The University sells to consumers of all kinds, including students, fans, and alumni of the University. *See* Mason Dec. ¶ 17; Drucker Dec. ¶ 4. Indeed, these customers "would prefer an officially sponsored or licensed product to an identical non-licensed product" and "at least some ... assume that products bearing the mark of a school or sports team are sponsored or licensed by the school or team." *Laite*, 756 F.2d at 1547 n.28; *see Tex. Tech*, 461 F. Supp. 2d at 521. Accordingly, the parties' channels of trade and customers will be identical.

5. Purchasers of the Parties' Inexpensive Goods Are Primarily Impulse Shoppers

Confusion is more likely if the products in question are inexpensive or impulse items. *See, e.g., In re Majestic*, 315 F.3d at 1319 (finding malt liquor and tequila both fairly inexpensive and likely to be purchased on impulse, thus weighing in favor of a likelihood of confusion). The goods at issue in this proceeding are inexpensive sports drinks. The Board has found that similar beverages are inexpensive and the "subjects of impulse purchases." *In re All Am. Beverage Inc.*, Serial No. 75/235,920, 1999 WL 1062810, at *1 (TTAB Nov. 17, 1999) (finding soft drinks are inexpensive goods subject to impulse shopping). Indeed, purchasers of sports drinks are not discriminating and would not exercise careful thought before making a purchase. *See CytoSport, Inc. v. Vital Pharms., Inc.*, 617 F. Supp. 2d 1051, 1076-77 (E.D. Cal. 2009) (finding protein drinks are inexpensive goods bought by non-discriminating purchasers); *accord In re Pommery S.A.*, Serial No. 78/367,268, 2005 WL 4255386, at *5 (TTAB June 22, 2005) (finding beer and wine are inexpensive goods and hence "these consumers are not discriminating and would not have to exercise careful thought or expertise"). Here, the parties'

consumers are not likely to exercise care in purchasing and, therefore, this factor weighs in favor of Opposer.

6. Evidence Of Actual Confusion Is Not Required

Evidence of actual confusion is not required for a finding of likelihood of confusion. *See, e.g., In re Majestic*, 315 F.3d 1311, 1317 (Fed. Cir. 2003); *Hewlett-Packard*, 281 F.3d at 1267. This is especially true when, as here, the applicant has not yet sold any products under the mark, because evidence of actual confusion is impossible. *See, e.g., Schering-Plough Healthcare Prods., Inc. v. Ing-Jing Huang*, Opp. No. 91117558, 2007 WL 1751193, at *6 (TTAB June 18, 2007) ("to state the obvious, there has not been any opportunity for actual confusion in the marketplace"). Summary judgment may still be granted on the issue of likelihood of confusion even in the absence of evidence of actual confusion. *See, e.g., Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990) (affirming summary judgment despite no evidence of actual confusion); *Hillyard*, 2008 WL 1741922, at *4 (granting summary judgment, noting "[o]f course, opposer is not required to prove actual confusion in order to make out a prima facie showing of likelihood of confusion") (internal citations omitted).

Applicant filed an intent-to-use application to register the COWBOYADE Mark and has not yet advertised, offered for sale, or sold any products bearing Applicant's COWBOYADE Mark. *See* Ralls Dec., Ex. E at pp. 5, 7 (Applicant's Interrogatory Responses Nos. 8, 10 & 15). [redacted] *See* Harris Dep. at 29:12-23. Therefore, there cannot be any evidence of actual confusion and this factor does not weigh in favor of Applicant.

7. Applicant's Bad Faith Intent to Trade Off the Goodwill of Numerous Schools Weighs In Favor of a Finding of Confusion

The intent of the party adopting the mark is an important factor in determining whether there is a likelihood of confusion. *See, e.g., TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1473 (Fed. Cir. 1997). Evidence that an applicant adopted its mark with the intent to trade on the goodwill of the prior user is probative of a likelihood of confusion and weighs against allowing registration of the mark. *See, e.g.,*

Dan·Robbins, 599 F.2d at 1013. Indeed, "[a] mark designed to maximize association between entities, as here, is likely to lead to confusion." *Id.* As evidenced by Applicant's numerous applications to register collegiate mascot and nicknames with the generic letter string "ADE" and the testimony of Mr. Harris, it is undisputed that Applicant adopted its COWBOYADE Mark with a bad faith intent to trade off the goodwill of the University's COWBOYS Marks.

Well-aware of the drawing power of the collegiate mascots and nicknames, Applicant decided to launch a line of sports drinks similar to GATORADE, which incorporates the University of Florida's GATOR mark, for universities across the country. *See* Harris Dep. at 38:16-39:15. Applicant's first product, which he sold in limited quantities, was a sports drink under the mark LIONADE. *See* Ralls Dec., Ex. F at pp. 18-19 (Applicant's Responses to Requests for Admission Nos. 67-69); Harris Dep. at 28:17-25. Mr. Harris selected the LIONADE mark because his alma mater, Penn State University, has the NITTANY LIONS as its nickname. *See* Harris Dep. at 6:7-13; 24:12-14. The labels for the drinks offered under the LIONADE mark even incorporate Penn State University's Blue-and-White Color Scheme. *See id.* at 35:11-36:1.

Applicant sought registration of marks incorporating the mascots and nicknames of numerous colleges, including the University. *See* Harris Dep. at 41:8-14; 42:2-8; 50:21-25; 54:15-20; 57:15-22; 59:8-60:3; 60:9-14; 61:19-62:5; 62:13-63:10; 63:11-64:3. With the intent to trade off the goodwill of the schools' mascots and nicknames, Applicant filed a plethora of applications, including the following:

University	**Trademark**	**Applicant's application (Serial No.)**
University of Notre Dame	IRISH	IRISHADE (Serial No. 77/382,991)
University of Tennessee	VOLUNTEERS	VOLUNTEERADE (Serial No. 77/384,000)
University of Oklahoma	SOONERS	SOONERADE (Serial No. 77/383,960)
University of Kansas	JAYHAWKS	JAYHAWKADE (Serial No. 77/383,006)
Boise State University	BRONCOS	BRONCOADE (Serial No. 77/382,281)
University of Michigan	WOLVERINES	WOLVERINEADE (Serial No. 77/384,032)
University of Washington	HUSKIES	HUSKIEADE (Serial No. 77/384,238)
Texas Tech University	RAIDERS	RAIDERADE (Serial No. 77/383,853)
University of Georgia	BULLDOGS	BULLDOGADE (Serial No. 77/382,118)
University of Wyoming	COWBOYS	COWBOYADE (Serial No. 77/383,001)
University of Wisconsin	BADGERS	BADGERADE (Serial No. 77/382,271)

University of Miami	HURRICANES/ MIAMI	HURRICANEADE (Serial No. 77/382,960) MIAMIADE (Serial No. 77/574,565)
Kansas State University	WILDCATS	CATADE (Serial No. 77/382,985)
Air Force Academy	FALCONS	FALCONADE (Serial No. 77/384,233)
University of Pittsburgh	PITTSBURGH PANTHERS PANTHERS	PITTSBURGHADE (Serial No. 77/574,589) PANTHERADE (Serial No. 77/383,064)
Washington State University	COUGARS	COUGARADE (Serial No. 77/382,996)
University of Central Florida	KNIGHTS	KNIGHTADE (Serial No. 77/383,021)
West Virginia University	MOUNTAINEERS	MOUNTAINEERADE (Serial No. 77/383,048)
University of Nebraska	CORNHUSKERS	CORNHUSKERADE (Serial No. 77/384,196)
The University of Texas at Austin	LONGHORNS	LONGHORNADE (Serial No. 77/383,038)
University of Mississippi	REBELS	REBELADE (Serial No. 77/383,860)
Michigan State Spartans	SPARTANS	SPARTANADE (Serial No. 77/383,891)

[redacted] Harris Dep. at 31:13-32:11. Just as Applicant intended to trade off of the goodwill and reputation of the schools listed above, Applicant was well-aware of the University's "iconic" COWBOY Mascot prior to filing the application to register the COWBOYADE Mark. *See* Ralls Dec., Ex. E at p. 11 (Applicant's Interrogatory Response No. 4); *see* Harris Dep. 60:9-14.

Applicant's intent to trade on the goodwill of the University's COWBOYS Marks is strong evidence of a likelihood of confusion. *See, e.g.*, *Dan Robbins*, 559 F.2d at 1013 (finding the applicant's awareness of the opposer's mark when it adopted its mark and its intent to create an association with the opposer's mark is strong evidence of a likelihood of confusion); *Nat'l Football League Prop's, Inc. v. N.J. Giants, Inc.*, 637 F. Supp. 507, 518 (D.N.J. 1986) ("defendant Giants' bad faith in adopting the mark 'New Jersey Giants' is evidenced by the admitted intention of its principals to have consumers associate its mark with the football Giants thereby breaching its duty to select a mark as far afield as possible from well known existing marks such as 'New York Giants' and 'Giants'"). The Board has found evidence of bad faith in similar cases where the applicants attempted to register the trademarks of well-known sports teams:

> While [the] applicant may not have intended to mislead purchasers, it is not clear how the selection of numerous marks that are each based on the name of one of twenty NFL teams could have been done in good faith. Furthermore, it is not clear how the fact that

- 'it will not seek an allegiance with any specific team,' will eliminate the likelihood of confusion.

Chicago Bears, 2007 WL 683778, at *12 (finding the applicant's 12TH BEAR mark was adopted in bad faith and confusingly similar to the opposer's CHIGAGO BEARS mark). The Federal Circuit is "not loath to" find likelihood of confusion given that there is "no excuse for ever approaching the well-known trademark of a competitor." *Kimberly-Clark*, 774 F.2d at 1147 (finding likelihood of confusion where the applicant adopted its mark with the intent to associate its mark with the opposer). Just as the defendant in *Laite* intended to "catch the attention of University of Georgia football fans," Applicant intends to trade on the goodwill and reputation of the University. *Laite*, 756 F.2d at 1545 (holding "Battlin' Bulldog Beer" likely to cause confusion with University's BULLDOGS Marks). Accordingly, this factor weighs in favor of Opposer.

IV. CONCLUSION

Because the *DuPont* factors weigh in favor of the University, summary judgment is appropriate on the University's claim under Section 2(d) of the Lanham Act.

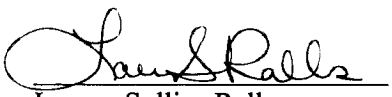
Dated: October 9, 2009.

R. Charles Henn Jr.
Alicia Grahn Jones
Lauren Sullins Ralls
Allison M. Scott
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MEMORANDUM IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT was served on counsel for Applicant on October 9, 2009 via first class mail to:

John W. McIlvaine
The Webb Law Firm
436 Seventh Avenue
700 Koppers Building
Pittsburgh, PA 15219

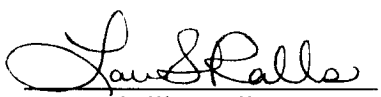


Lauren Sullins Ralls
Attorney for Opposer

CERTIFICATE OF MAILING

I hereby certify that a true copy of the foregoing OPPOSER'S MEMORANDUM IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT is being deposited with the United States Postal Service as Express Mail on October 9, 2009 in an envelope addressed to:

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451:



Lauren Sullins Ralls
Attorney for Opposer