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

Proceeding	91207895
Party	Plaintiff Hokie Objective Onomastics Society LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HOKIE OBJECTIVE ONOMASTICS)	
SOCIETY LLC,)	
)	
Opposer,)	
v.)	Opposition No. 91207895
)	
VIRGINIA POLYTECHNIC INSTITUTE)	Serial No. 85-531,923
AND STATE UNIVERSITY,)	
)	
Applicant.)	

**OPPOSITION TO APPLICANT’S
SECOND MOTION FOR SUMMARY JUDGMENT**

Applicant Virginia Polytechnic Institute and State University (“VPI&SU”) argues that Opposer Hokie Objective Onomastics Society LLC (“Opposer”) lacks standing to bring this opposition proceeding because Opposer’s services are so different from those of VPI&SU that Opposer cannot be a “competitor” of VPI&SU. However, the differences identified by VPI&SU are impermissible after-the-fact rationalizations that ignore the actual language of VPI&SU’s application for registration in Class 41 of the term HOKIE (the “Application”). Furthermore, Opposer has made ample trademark use of the marks HOKIE OBJECTIVE ONOMASTICS SOCIETY and HOKIE FAN (the “Opposer’s Marks”) and reasonably fears that it will suffer harm if the Application is granted. Opposer therefore has standing to bring this proceeding and opposes VPI&SU’s Second Motion for Summary Judgment as follows.

BACKGROUND

Historical research has shown that the term HOKIE, when used to mean a student, athlete, alumnus or supporter of VPI&SU, or when used to refer to connections and relationships to VPI&SU, first arose organically around 1949. (Ex. A, Decl. of James Creekmore ¶ 6.) The public thus spontaneously gave the term HOKIE its present meaning and

made it part of the normal, everyday English language. (*Id.* ¶ 7.) At the time when the public created the term HOKIE, the main nicknames for VPI&SU students, athletes and supporters were GOBBLERS and TECHMEN. (*Id.* ¶ 8.) Not until the 1970s did HOKIE become the more popular nickname. During all this period, lasting for two or three decades, VPI&SU did not use the term HOKIE as a trademark. (*Id.* ¶ 9.) VPI&SU finally switched its official nickname from GOBBLERS to HOKIES around 1978. (*Id.* ¶ 10.) By the time when VPI&SU made its first trademark use of the term HOKIE, the term already had spent several decades in the public domain, having the everyday, ordinary meaning of a student, athlete, alumnus or supporter of VPI&SU, or else being used to refer to a connection or relationship to VPI&SU. (*Id.* ¶ 11.) Despite this, VPI&SU has for several years made a policy of intimidating, harassing and suing local businesses that continue to use the term HOKIE for its ordinary, everyday English meaning.

Since its formation, Opposer has offered and provided educational services, including lectures, symposia, and presentations, under the service marks HOKIE OBJECTIVE ONOMASTIC SOCIETY and HOKIE FAN. (*Id.* ¶ 15.) It is important to note that although such services might not necessarily have been performed coincident with Opposer's formation, they have been offered from that point forward. (Creekmore Dep'n, Ex. A. Attachment H, at 73.) VPI&SU argues that Opposer lacks standing because it is supposedly not a "competitor" of VPI&SU.

ARGUMENT

1. Opposer is a "Competitor" of VPI&SU Because the Parties' Services are Similar and/or Identical.

One way that Opposer can demonstrate standing to bring this Opposition is by showing that Opposer "is a present or potential competitor" of VPI&SU. *Plyboo Am. Inc. v. Smith & Fong Co.*, 51 U.S.P.Q.2d 1633, 1634 n. 5 (T.T.A.B. 1999) (quoting 3 J. McCarthy, *McCarthy*

on Trademarks & Unfair Competition § 20:11 (4th ed. 1998)). Here, Opposer uses the terms HOKIE FAN and HOKIE OBJECTIVE ONOMASTICS SOCIETY in connection with offering and providing educational services and materials that touch upon subjects such as history, sociology, etymology, linguistics and law, in examining whether VPI&SU has any right to prevent others from using the term HOKIE. (See Ex. A, Decl. of James Creekmore ¶¶ 15-18 and Attachments thereto.) As demonstrated below, these services are so similar to the services described in VPI&SU's Application that Opposer should be considered a "competitor" of VPI&SU.

a. VPI&SU Cannot Use After-the-Fact "Extrinsic Argument" to Narrow the Scope of its Application.

Straining to define the services in its Application as narrowly as possible, VPI&SU argues that Opposer and VPI&SU are not competitors because Opposer's lectures and presentations do not constitute "instruction at the university level" (Mot. Summ. J. at 3), because attendees at Opposer's lectures and presentations "receive no credits toward a diploma" (*id.* at 10), because Opposer's lectures and presentations are not "approved by the State Council [*sic*] for Higher Education" (*id.* at 9), because Opposer is not "accredited by the Southern Association of Colleges and Schools" (*id.* at 10), and because Opposer does not "employ teachers or professors" to give "regularly-scheduled classes" (*id.* at 16). In short, VPI&SU appears to contend that it cannot have any competitors who are not (a) universities that are (b) approved by the State Council for Higher Education and that offer (c) regularly-scheduled (d) accredited courses (e) taught by employee teachers (f) for credit (g) that can lead to the award of a diploma. Anyone who does not fit this detailed description, VPI&SU seems to argue, cannot possibly be a competitor.

However, this extremely narrow description ignores the text of VPI&SU's own Application for registration of the term HOKIE, which is extremely broad. That text reads as follows (clauses have been numbered for ease of reference):

Education and entertainment services, namely, [1] providing courses of instruction at the university level; [2] educational research; [3] arranging and conducting athletic competitions, [4] organizing exhibitions for educational purposes in the nature of scientific shows and school fairs, [5] conducting educational conferences in the field of math, politics, sociology, physics, chemistry and science and distributing course materials in connection therewith; [6] live performances by a musical band and festivals featuring a variety of activities, namely, arts, music, dance, drama, sports and athletics.

Although this description does refer to "courses of instruction at the university level," this phrase occurs only in clause 1 above. The Application describes several other types of services, such as "educational research" (clause 2), "exhibitions for educational purposes" (clause 4) and "educational conferences" (clause 5) which are very similar, if not identical in at least some respects, to the services provided by Opposer, and which are not stated in the Application to be "at the university level."

Furthermore, the Application contains none of the other limitations that VPI&SU has identified in attempting to define its services as narrowly as possible. The Application does not limit itself only to university-level courses that are "regularly scheduled" or taught by "employee teachers." It is not restricted only to educational conferences given "for credit toward a diploma." It does not restrict its coverage only to exhibitions "approved by the State Council for Higher Education." It does not seek to register the term HOKIE solely for courses of instruction that are "accredited by the Southern Association of Colleges and Schools." All of these limitations are after-the-fact additions made by VPI&SU's counsel, and they are irrelevant.

In short, VPI&SU is attempting to bluster and bluff the Board into deciding this issue based upon the services *that VPI&SU actually provides* rather than based upon the services *as*

described in its Application. This is improper. As stated succinctly in the Trademark Manual of Examining Procedure:

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. If the cited registration describes goods or services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. . . . An applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence, for example, as to the quality or price of the goods.

TMEP § 1207.01(a)(iii) (citations omitted); *see also In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1638 (T.T.A.B. 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Having staked out a huge territory by using such broad language in its application for registration, VPI&SU’s counsel cannot now, “by extrinsic argument,” attempt to claim that Opposer’s services somehow do not, after all, fall within that huge territory. If VPI&SU had wanted to claim narrower rights in the HOKIE term, then it should have narrowed the language of its application. Now is too late.

b. Opposer is a “Competitor” Because its Services and the Services in VPI&SU’s Application Are “Identical so Far as Trademark Law is Concerned.”

Comparing Opposer’s services with the services actually described in VPI&SU’s Application (as opposed to those identified after-the-fact as a part of “extrinsic argument” by VPI&SU’s counsel), it is clear that they are so closely related that for trademark law purposes, they are essentially identical. In this regard, it is important to note that there is no requirement that Opposer’s services be *exactly* identical to those described in the Application for Opposer to be considered a “competitor.” Rather:

It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person’s business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to

use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses.

Fed. Glass Co. v. Corning Glass Works, 162 U.S.P.Q. 279, 282 (T.T.A.B. 1969). Thus, for example, in *Federal Glass* the opposer sold a wide variety of glassware, tableware and cookware, and the applicant's goods were identified as "coffee percolators" that were "formed of a crystalline material produced from glass by heat treatment thereof." *Id.* at 280. Opposer alleged that applicant's mark was a common ornamental design. *Id.* at 281. Applicant argued that "since opposer does not sell coffee makers of any kind, it has, in effect, no standing to challenge applicant's right of registration," and the opposer also did not make products of glass-ceramic such as those made by the applicant. *Id.* at 281-82. The Board nevertheless concluded that the parties were "competitors" and that opposer had standing to challenge the application. *Id.* at 282.

Similarly, in *Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d 1676 (T.T.A.B. 2002), the applicant sought to register the mark ULTIMATE POLO for "sun protective clothing" and argued that opposer lacked standing because it did not also sell sun protective clothing. *Id.* at 1679. The Board, citing *Federal Glass*, nevertheless found that the opposer had standing to protect its "right . . . to the unfettered use of the language in describing" its non-sun protective polo shirts. *Id.*; see also 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:11 (4th ed. 2004) ("Standing is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business"). Thus, whether parties are "competitors" for standing purposes does not depend upon whether they actually are *direct* competitors. Rather, the question is whether their goods or services are similar enough for trademark law purposes.

Like the opposers in *Federal Glass* and *Target Brands*, here Opposer merely seeks to preserve its right to use the term HOKIE in a descriptive or generic sense. (*See Am. Not.*

Opp'n ¶¶ 21-26.) Furthermore, Opposer provides services that are certainly part of the same broad category as the services provided by VPI&SU, in that they all involve education and instruction. It is easy to imagine Opposer providing its lectures and/or presentations at an "exhibition for educational purposes . . . in the nature of [a] school fair" or at an "educational conference[] in the field of . . . politics [or] sociology" as described in the Application. Indeed, Opposer would be glad to provide its lectures and presentations at such an "educational conference" or "exhibition," and doing so would be a natural expansion of Opposer's services. (Ex. A., Creekmore Decl. ¶ 17.) Opposer therefore is in the same position as the opposer in *Federal Glass*, who manufactured "related goods" while "the product in question [was] one that could be produced in the normal expansion of [opposer's] business." *Fed. Glass*, 162 U.S.P.Q. at 282.

As succinct phrase applicable to the present situation was provided by the Court in *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656 (C.C.P.A. 1960). In that case, the applicant sought to register POWER SHOP for single-purpose woodworking saws, and the opposer sought to preserve its right to use the phrase in connection with its multiple-purpose power tools. *Id.* at 912. Even though the parties' goods differed in several respects, the Court held that the parties' goods were "identical so far as trademark law is concerned." *Id.* at 916. That is the case here. VPI&SU may point to various minor differences between the services in the Application and the services provided by Opposer, but fundamentally they are so closely related that they are identical for trademark law purposes.

c. Opposer's Course is "University Level" Because It Actually Has Been Provided as a Part of a VPI&SU University Academy

As noted above, one of VPI&SU's main arguments is that Opposer cannot be a "competitor" of VPI&SU because the Application seeks to register the term HOKIE for

“courses of instruction at the university level.” (*See, e.g.*, Mot. Summ. J. at 3.) However, nothing in the Application defines the term “university level.” VPI&SU has attempted to provide its own definition, stating that “university level” means “for college credit.” (*See id.*; *see also* Creekmore Dep’n, Ex. A. Attachment H, at 164 (statement of VPI&SU counsel).) Of course, the Application itself says nothing about “college credit.” It certainly is possible to envision many definitions of “university level” that do not include receiving college credit. For example, Opposer’s programs are at the “university level” in the sense that Opposer provides its programs to university-level participants, several of whom have been university professors, university employees, and university students. (Creekmore Dep’n, Ex. A. Attachment H, at 163.)

This question nevertheless has been settled, because VPI&SU has itself offered one of Opposer’s courses through one of VPI&SU’s academies. Specifically, Opposer was invited to make a presentation to the Virginia Tech Creative Learning Academy for Senior Scholars (“VT CLASS”) run by the Virginia Tech Department of Continuing and Professional Education, on April 18, 2015. (Ex. A, Creekmore Decl. ¶ 17.) Opposer did in fact provide the presentation and photographs of the event are attached. (*Id.* & Attachment C.) According to the web page for VT CLASS, courses offered by VPI&SU through VT CLASS require the payment of a fee and are part of a VPI&SU “project to promote lifelong learning” and include “distinguished and talented speakers.” (*See* VT CLASS web page at Ex. A, Attachment D.)

VPI&SU hardly can argue that a course provided by VPI&SU University itself, through an Academy established by its Department of Continuing and Professional Education, is not a “course of instruction at the university level.” Opposer’s inclusion in the VT CLASS Academy thus conclusively demonstrates that Opposer’s services include education “at the university

level” and that Opposer’s instruction services are identical to those described in the Application. Opposer therefore is a “competitor” of VPI&SU for standing purposes.

d. Opposer Performs “Educational Research”

One of the services identified in the Application is “educational research.” Opposer performs this service. Specifically, Opposer conducts research into “[t]he etymology of the word Hokie, historical underpinnings of how that word became incorporated into the English language and the historical use of that word by Virginia Tech and by the community around Virginia Tech, all of which would be included in a broad definition of educational research.” (Creekmore Dep’n, Ex. A. Attachment H, at 164.) VPI&SU has not made any argument or pointed to any fact contradicting this. Thus in this respect the services of Opposer and VPI&SU are undeniably identical, and so for this reason alone summary judgment is not appropriate.

2. Opposer’s Small Size and Tax-Exempt Purpose Should Not Deprive it of Standing.

Much of VPI&SU’s argument seems to be devoted to attempting to heap scorn upon Opposer’s activities as too small, too minor, and too trifling. VPI&SU attacks Opposer as having “no working capital, no bank account, no credit cards, no other employees” and points out that it “earns no revenues, rents no office space.” (Mot. Summ. J. at 8.) It criticizes Opposer for having no employees, no professors, and no regularly scheduled classes. (*Id.* at 16.) It emphasizes that Opposer’s lectures / presentations “thus far have been limited to four breakfast or after-work presentations” (there now have been five, *see* Ex. A ¶ 16).

This is not remotely fair. It may be true that Opposer is small, has limited activities, and lacks funds. But VPI&SU essentially is arguing that only organizations with ample funds and resources should be able to possess trademark rights. This principle has long since been

rejected. “[T]he mere fact that a business is small and its trade modest does not necessarily militate against its being an established business capable of acquiring goodwill and rights in a trademark.” *Sheila’s Shine Prods., Inc. v. Sheila Shine, Inc.*, 486 F.2d 114, 123 (5th Cir. 1973). *See also Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1474 (Fed. Cir. 1987) (recognizing that single bona fide shipment in commerce may support registration); *E. I. Du Pont De Nemours & Co. v. Big Bear Stores, Inc.*, 161 U.S.P.Q. 50, 51 (T.T.A.B. 1969) (finding that small volume of sales as part of test marketing plan were “sufficient to show a continuous use of the mark in question”).

VPI&SU’s argument that Opposer has no rights because it has “no revenues” is especially galling, because it implies that no not-for-profit or political organization can have trademark rights. This is however undeniably incorrect. *See, e.g., SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281, 287 (S.D.N.Y. 2006) (organization’s circulation of leaflets to educate the public about restaurant labor practices was a “service” under the Lanham Act); *see also United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89-90 (2d Cir.1997) (political activities constitute “services in commerce”); *Committee for Idaho’s High Desert v. Yost*, 881 F. Supp. 1457, 1470–71 (D. Idaho 1995), *aff’d*, 92 F.3d 814 (9th Cir. 1996) (non-profit organization engaged in dissemination of information about environmental causes via news releases, newsletters, and public advocacy was entitled to Lanham Act protection for its trade name even if it did not “place products into the stream of commerce”).

VPI&SU even goes so far as to question Opposer’s status as a tax-exempt not-for-profit organization, erroneously asserting that Opposer “is not a not-for-profit organization” because it “has not submitted to the Internal Revenue Service the required forms to obtain 501(c)(4) status.” (Mot. Summ. J. at 7.) Clearly VPI&SU does not understand the law of tax-exempt

organizations. “Unlike section 501(c)(3) organizations, [section 501(c)(4)] social welfare organizations are not required to file with the IRS seeking recognition of their exempt status. Social welfare organizations may seek recognition by filing a Form 1024, but such recognition is not required.” Donald B. Tobin, *The Internal Revenue Service and a Crisis of Confidence: A New Regulatory Approach for a New Era*, 16 Fla. Tax. Rev. 429. 438 (2014) (citing Internal Revenue Regulation Reg. § 1.6033-1(e)). (See also Ex. A, Attachment A, at 6 (Part IV) (Form 1024 reflects that deadline for filing the form applies only to organizations seeking exemption under Sections 501(c)(9) or 501(c)(17).) For this reason Opposer previously did not file a Form 1024. (Ex. A ¶ 4.) Nevertheless, Opposer has now filed a Form 1024. (*Id.* ¶ 5 & Attachment.)

3. Opposer Has Made Ample Trademark Use of Opposer’s Marks

Next VPI&SU inexplicably argues that Opposer has failed to make actual trademark use of Opposer’s Marks. (Mot. Summ. J. at 17.) However, the record contains many examples conclusively demonstrating Opposer’s trademark use of Opposer’s Marks in connection with Opposer’s services. Specifically:

- When Opposer gives a lecture / presentation, the phrase “Brought to You by HOKIE FAN” appears clearly and prominently at the beginning and end of the lecture. (See Ex. A, Attachment C; this is especially visible for example at pages HOOS-000029 and HOOS-000480; see also Attachment E.) On the same slide, the next line clearly states that HOKIE FAN is “a Project of the Hokie Objective Onomastics Society LLC.” (*Id.*)
- Opposer’s advertisement for its first meeting / presentation clearly identified Opposer as HOKIE FAN in very large letters in the middle of the page. (See Ex. A, Attachment F, page HOOS-000053.)
- Opposer’s web site is clearly branded HOKIE FAN, and states that “Hokie Fan is an educational project of the Hokie Objective Onomastics Society LLC.” (Ex. A, Attachment F, final pages.)

- Opposer’s current sticker clearly identifies its source as being “The Hokie Fan Project” and “Hokie Objective Onomastics Society LLC.” (See Ex. A, Attachment F, page HOOS-000620.)
- Opposer’s full corporate name was used as a trademark in connection with a charity event. (See Ex. A, ¶ 25 & Attachment G.)

In short, it is hard to see why VPI&SU does not consider these many clear and obvious source identifications to constitute trademark use.

4. Opposer Reasonably Fears Damage from a Granting of the Application.

VPI&SU next argues that Opposer “lacks a reasonable belief of damage.” (Mot. Summ. J. at 20.) However, the Court of Appeals for the Federal Circuit “has explicitly said that there is no requirement that damage be proved in order to establish standing.” *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1092 (Fed. Cir. 1984). Rather, the issue in determining standing is not necessarily whether the opposer is entitled to a registration or owns the mark, but rather whether the presumptions flowing from the registration at issue are damaging to the opposer’s legal and continuous use of that term. See J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*, § 20:11 (4th ed. 2011); see also *Harjo v. Pro Football*, 30 U.S.P.Q.2d 1828, 1832 (T.T.A.B. 1994) (party may establish standing by showing it has personal interest beyond that of general public with no requirement that actual damage be pleaded and proved). Standing to assert that a term is generic, for example, may be shown where an opposer has a real interest in the proceeding because it is one who has a present or prospective right to use the term descriptively or generically. See *Nobell.com LLC v. Qwest Communications Int’l, Inc.*, 66 U.S.P.Q.2d 1300, 1304 (T.T.A.B. 2003).

Thus, for example, in the *Lindeburg* case cited above, in which the owner of a registration argued that the petitioner seeking cancellation had failed to prove that it would be “damaged” by the continuance of the registration, the Court of Appeals for the Federal Circuit

held that the legal presumptions flowing from the registration were sufficient to give the petitioner standing to seek the registration's cancellation:

[Petitioner] has an equal right with that of [Respondent]-approved-jewelers to use the [registered] emblem on its jewelry. Continued federal registration of the mark is inconsistent with that right. Registration accords [Respondent], should it file another infringement suit against [Petitioner], *prima facie* proof of an exclusive right to use the [registered] emblem in commerce, a right which it should not have. In these circumstances, [Petitioner] cannot be considered a "mere intermeddler" whom the standing requirements would bar from initiating cancellation proceedings.

Lindenburg, 727 F.2d at 1092.

Here, Opposer has opposed VPI&SU's registration of the term HOKIE on the ground that the term is generic and/or descriptive. Specifically, Opposer alleges that the term HOKIE arose organically around 1949 and was used by the public at large for two or three decades before VPI&SU began using the term HOKIE as a trademark. (*See* Am. Not. Opp'n ¶¶ 21-26.) Because the term HOKIE "had become generic . . . before [VPI&SU] began to make trademark use [of it, VPI&SU's] attempt to withdraw this use of the word from the public domain cannot succeed." *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 808 (2d Cir. 1999). However, if VPI&SU's application for registration of the term HOKIE were granted, then VPI&SU would receive several statutory benefits, such as a presumption of validity, *see* 15 U.S.C. § 1115(a), and a heightened ability to prevail on a dilution claim, *see* 15 U.S.C. § 1125(c)(2)(A)(iv). These benefits could make it harder for Opposer to defend against an infringement suit by VPI&SU. If, after the passage of five years, VPI&SU's HOKIE registration were to become incontestable under 15 U.S.C. § 1065, then Opposer's defense against such a suit would be even more difficult, because Opposer no longer would be able to defend on the basis that the term HOKIE previously had been generic and/or descriptive. The "damage" which Opposer would suffer from VPI&SU's registration of HOKIE is clear, and for this reason, when an opposer asserts a right to use a term descriptively or generically, "the mere existence of a federal registration is regarded as potent enough to give the opposer standing to

challenge registration.” J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*, § 20:11 (4th ed. 2011).

Of course, in this case, in addition to such legal damage, Opposer has a sincere fear that VPI&SU may take action against it in the future, because of VPI&SU’s policy of intimidating, harassing and suing local businesses, even when they use the term HOKIE and its derivatives in a purely generic and/or descriptive sense. (*See* Ex. A, Decl. of James Creekmore, ¶¶ 12-14 & Attachments.)

5. VPI&SU’s own Inaction is Irrelevant

VPI&SU complains that because VPI&SU “has not objected to [Opposer’s] purported educational services,” Opposer has nothing to fear. (Mot. Summ. J. at 20-21.) This argument is frivolous. If an applicant could deprive potential opposers of standing just by refraining from suing them, then there would be no need for the opposition process. In such a world, VPI&SU could just obtain its registration and then sit quietly — at least until five years had passed and its registration became incontestable, at which point it would become able to strike out with a vengeance, immune from claims that the term HOKIE is generic and/or descriptive. Fortunately, Opposer “has standing to raise the genericness of a term in an opposition proceeding, rather than be forced to wait for registration, an infringement suit, and only then raise as an affirmative defense, the alleged generic nature of the term.” J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*, § 20:11 (4th ed. 2011).

6. Opposer’s Lack of a Registration or Application is Irrelevant

Finally, VPI&SU complains that Opposer “has not filed applications to register its purported trademarks.” (Mot. Summ. J. at 21.) This is irrelevant to the standing inquiry, for “registration does not create trademarks.” *Formica Corp. v. Lefkowitz*, 590 F.2d 915, 918 n.4 (C.C.P.A. 1979). Rather, “trademark ownership and attendant rights are acquired in the

marketplace by use.” *In re ECCS, Inc.*, 94 F.3d 1578, 1579 (Fed. Cir. 1996). Accordingly, an opposer need not own a registration, or have filed an application for registration, in order to have standing to bring an opposition. Rather, “[s]tanding will usually be found in an opposition . . . when the opposer establishes its registration *or* use of a trademark, which right might be plausibly harmed by registration of applicant’s mark.” *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, No. 91175091, at 12-13 (T.T.A.B. Mar. 12, 2009) (citable as precedent) (emphasis added).

CONCLUSION

For the reasons set forth above, Opposer requests that the Motion for Summary Judgment be denied.

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CERTIFICATE OF SERVICE

I hereby certify that on May 4, 2015, I served the foregoing by first-class mail upon the following:

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