

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GCP

Mailed: August 27, 2015

Opposition No. 91207895

Hokie Objective Onomastics Society LLC

v.

*Virginia Polytechnic Institute and State
University*

**Before Kuhlke, Wellington, and Masiello,
Administrative Trademark Judges.**

By the Board:

Virginia Polytechnic Institute and State University (“Applicant”) seeks to register the mark HOKIE, in standard characters, for the following services in International Class 41:¹

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

On July 1, 2013, Hokie Objective Onomastics Society LLC (“Opposer”) filed an amended notice of opposition opposing the registration of Applicant’s HOKIE mark

¹ Application Serial No. 85531923, filed on February 2, 2012, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming the year 1901 as both the date of first use and the date of first use in commerce.

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on the following grounds: (1) genericness under Trademark Act § 14, 15 U.S.C. §1064(3) and/or mere descriptiveness under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1); (2) false dates of first use under Trademark Act §1(a); and (3) illegal use of the federal registration symbol under 15 U.S.C. §1111. In support of its asserted claims, Opposer alleges, *inter alia*, that it provides educational services and distributes educational materials under the service marks HOKIE OBJECTIVE ONOMASTICS SOCIETY and HOKIE FAN. Opposer also alleges that its educational services include lectures, symposia and presentations to classes, organizations, businesses and individuals on subjects such as history, sociology, etymology, linguistics and law, as well as the distribution of educational materials relating thereto.

On July 19, 2014, Applicant filed its answer to Opposer's amended notice of opposition denying the salient allegations asserted therein.

This proceeding now comes before the Board for consideration of Applicant's motion (filed October 21, 2014) for partial summary judgment on the basis that Opposer lacks standing to pursue this case. The motion is fully briefed.

In support of its motion for partial summary judgment, Applicant contends that there are no genuine disputes of material fact that Opposer lacks standing to pursue this matter. Specifically, Applicant argues that (1) Opposer did not even exist until three weeks after Applicant's involved application was published for opposition; (2) Opposer was formed solely for the purpose of improperly interfering with Applicant's registration of its subject HOKIE mark for educational and

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entertainment services; and (3) Opposer is not a competitor of Applicant and has no legitimate basis to claim damage by reason of Applicant's registration of the HOKIE mark.

In further support of its contention that Opposer is not a competitor of Applicant, Applicant maintains that it offers courses of instruction at the university level for credit under the HOKIE mark while Opposer's purported "educational services" are limited to breakfast or after-work presentations hosted by Opposer or local community groups such as the Blacksburg Lions Club and Torch Society, at which Opposer's sole member, director, officer and employee, Mr. James Creekmore, and Keith Finch, Mr. Creekmore's colleague at The Creekmore Law Firm and legal counsel to Opposer in this matter, talk solely about the etymology of the word HOKIE, what trademark rights Applicant may or may not have in the word HOKIE, and whether or not third parties are free to use the word HOKIE. Moreover, Applicant contends that, to the extent Opposer offers some manner of instruction in respect of the etymology of the word HOKIE, it does not do so under the purported trademarks HOKIE OBJECTIVE ONOMASTIC SOCIETY or HOKIE FAN nor does it offer "educational materials" under those marks.

Finally, Applicant contends that since Applicant has not objected to Opposer's use of the phrases HOKIE FAN or HOKIE OBJECTIVE ONOMASTIC SOCIETY used in connection with Opposer's purported educational services and because Opposer has not filed applications to register its purported trademarks, Opposer

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does not have a reasonable basis in fact for the belief that it will suffer damage if Applicant's involved application for the mark HOKIE matures into a registration.

In response, Opposer maintains that Applicant's argument that Opposer cannot be considered a competitor of Applicant because (1) Opposer does not provide instruction at the university level, (2) attendees at Opposer's lectures and presentations receive no credits toward a diploma, (3) Opposer's lectures are not approved by the state counsel for higher education, (4) Opposer is not accredited by the Southern Association of Colleges and Schools, and (5) opposer does not employ teachers or professors who provide regularly scheduled classes, is without merit. Specifically, Opposer argues that whether parties are "competitors" for standing purposes does not depend upon whether they actually are "direct" competitors; instead, Opposer contends that the question is whether their goods and services are similar enough for trademark law purposes. To the end, Opposer maintains that it provides services that are certainly part of the same broad category as the services provided by Applicant, in that they all involve education and instruction. In fact, Opposer contends that it has provided its alleged educational services at the "university level" when it was invited by the Virginia Tech Creative Learning Academy for Senior Scholars run by the Virginia Tech Department of Continuing and Professional Education to present one of its lectures.

Opposer further contends that although Applicant may point to various minor differences between the services identified in Applicant's involved application and the services provided by Opposer, the parties' respective educational services are so

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fundamentally related that they are identical for trademark purposes. Indeed, Opposer maintains that it provides one of the services specifically identified in Applicant's involved application, namely, educational research. In particular, Opposer contends that it conducts research into the 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 Applicant and by the community around Applicant, all of which Opposer argues would be included in a broad definition of educational research.

Furthermore, Opposer argues that it has made actual trademark use of the phrases HOKIE FAN and HOKIE OBJECTIVE ONOMASTIC SOCIETY in connection with its alleged educational services. Specifically, Opposer contends that (1) when it provides lectures, the phrase "Brought to You by HOKIE FAN" appears on the lecture slides during the presentation; (2) its advertisements for its presentations/lectures clearly employ the phrase HOKIE FAN in very large letters, (3) its website is clearly branded HOKIE FAN, and states that "Hokie Fan is an educational project of the Hokie Objective Onomastics Society LLC; (4) marketing stickers for its alleged educational services employ the phrase "The Hokie Fan Project" and "Hokie Objective Onomastics Society LLC;" and (5) Opposer's full corporate name was used as a trademark in connection with a charity event.

Finally, Opposer maintains that it has a sincere fear that Applicant may take action against it in the future because of Applicant's alleged policy of intimidating, harassing and suing local business that employ the term HOKIE and, in light of

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such fear of retaliation by Applicant, Opposer contends that it has standing to pursue this matter.

In reply, Applicant essentially reiterates its argument that (1) Opposer lacks a real interest in the opposition because Opposer's purported educational services are not competitive with those identified by Applicant in its involved application; and (2) Opposer is a mere intermeddler and will not be damaged by the registration of Applicant's HOKIE mark.

Decision

Summary judgment is an appropriate method of disposing of cases in which there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(a). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. V. Catrett*, 477 U.S. 317, 322-324 (1986). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). If the party moving for summary judgment carries its initial burden, and the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. See Fed. R. Civ. P. 56(a); *Fram Trak Industries Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2004 (TTAB 2006) (citing *Celotex Corp, supra*).

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Because standing is a threshold issue that must be proven by a plaintiff in every inter partes case, *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), we must determine whether Applicant has shown that there is no genuine dispute of material fact as to Opposer's lack of standing to bring this opposition proceeding.

Section 13 of the Trademark Act permits “[a]ny person who believes that he would be damaged by the registration of a mark” to file an opposition thereto. To establish standing, it must be shown that a plaintiff has a “real interest” in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the opposition. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Where registration is opposed on the ground of descriptiveness or genericness, (as is the case here) an opposer “... need only assert an equal right to use the mark for the goods. Proprietary rights in opposer are not required.” *See Jeweler's Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987), on remand, 5 USPQ2d 1622 (TTAB 1992), rev'd, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (opposition was sustained on its merits).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of the Opposer as the nonmoving party, we find that Applicant has not demonstrated the absence of a genuine dispute of material fact for trial. At a minimum, the Board

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finds that genuine disputes of material fact exist as to whether (1) the purported educational services provided by Opposer would render Opposer a competitor of Applicant that has an interest in using the term HOKIE to describe its services; and (2) Opposer is using the monikers HOKIE FAN and HOKIE OBJECTIVE ONOMASTIC SOCIETY as source indicators for its purported educational services.

In view thereof, Applicant's motion for partial summary judgment on the issue of Opposer's standing is hereby **DENIED**.²

The Board notes that it has now entertained three motions for summary judgment in this case. Inasmuch as the Board highly discourages piecemeal litigation, the parties are hereby precluded from filing any further motions for summary judgment in this proceeding.

Trial Schedule

Proceedings are hereby resumed. Trial dates are reset as follows:

Discovery Closes	9/18/2015
Plaintiff's Pretrial Disclosures Due	11/2/2015
Plaintiff's 30-day Trial Period Ends	12/17/2015
Defendant's Pretrial Disclosures Due	1/1/2016
Defendant's 30-day Trial Period Ends	2/15/2016
Plaintiff's Rebuttal Disclosures Due	3/1/2016
Plaintiff's 15-day Rebuttal Period Ends	3/31/2016

² The parties should note that the evidence submitted in connection with Applicant's motion for partial summary judgment and response thereto is of record only for consideration of the motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1983)). Furthermore, the fact that we have identified certain genuine disputes as to material fact sufficient to deny Applicant's motion should not be construed as a finding that these are necessarily the only disputes which remain for trial.

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In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.