

This Opinion is not a  
Precedent of the TTAB

Oral Hearing: September 13, 2017

Mailed: October 20, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Hokie Objective Onomastics Society LLC*  
*v.*  
*Virginia Polytechnic Institute and State University*

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Opposition No. 91207895

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James R. Creekmore and Keith Finch of The Creekmore Law Firm PC for  
Hokie Objective Onomastics Society LLC.

Norm J. Rich, Robert S. Weisbein, Sara Suleiman, and Diane G. Elder of Foley &  
Lardner LLP for  
Virginia Polytechnic Institute and State University.

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Before Taylor, Wellington, and Coggins,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Virginia Polytechnic Institute and State University (“Applicant” or “Virginia  
Tech”) has filed an application for registration of the standard character mark  
HOKIE for:

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 in International Class 41.<sup>1</sup>

Hokie Objective Onomastics Society LLC (“Opposer” or “HOOS”) opposes registration of Applicant’s mark on the grounds of intentional misuse of the registration symbol, ®, in connection with the term HOKIE, under 15 U.S.C. §1111; genericness; and abandonment through naked licensing.<sup>2</sup>

Applicant, in its answer, admits that it “does not currently own any federal, state, or foreign trademark registrations for the term HOKIE”;<sup>3</sup> that it “has used the ® symbol in connection with the trademark HOKIE”;<sup>4</sup> that “Mr. Stephen Capaldo, Esq., [an employee of Applicant] received a letter dated March 30, 2010 from the Creekmore Law Firm”;<sup>5</sup> that “an email exchange took place between [Applicant’s employees] Mr. Locke White and Ms. Sharon Dudding on August 20, 2010”;<sup>6</sup> and that Applicant “was the plaintiff in the case titled *VPI&SU v. Hokie Real Estate, Inc.*, No. 7-10-cv-00466, filed in the U.S. District court for the Western District of Virginia ... [and] that a counterclaim was interposed by the defendant Hokie Real Estate, Inc. in

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<sup>1</sup> Application Serial No. 85531923, filed February 2, 2012, based on use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), stating 1901 as the date of first use anywhere and first use in commerce.

<sup>2</sup> 10 TTABVUE (Opposer’s amended Notice of Opposition).

<sup>3</sup> 11 TTABVUE 4, Answer ¶ 7.

<sup>4</sup> *Id.* at 5, ¶ 8.

<sup>5</sup> *Id.*, ¶ 12.

<sup>6</sup> *Id.* at 6, ¶ 13.

the aforementioned case, which counterclaim was dismissed.”<sup>7</sup> Applicant otherwise denies the remaining salient allegations in the Notice of Opposition.

The parties have briefed the opposition. An oral hearing was held on September 13, 2017.

Before determining Opposer’s standing and the merits of the claims in this opposition, we address a couple preliminary matters. First, the parties have argued whether certain grounds should be before us. Second, Applicant has raised several objections to evidence submitted by Opposer.

### **Grounds for Opposition**

As we have stated, the grounds for opposition that are properly before us include: misuse of the registration symbol, genericness, and abandonment through naked licensing. We note, however, that the parties have argued whether abandonment and certain other grounds should be addressed on final decision. We address these arguments:

#### *Opposer’s Abandonment Claim*

With respect to the abandonment through naked licensing ground, Applicant argues that this claim is not properly before the Board in this proceeding:<sup>8</sup>

For the first time in the case, [Opposer’s] trial brief asserts a claim of abandonment as a result of naked licensing. Although the amended notice of opposition contains a paragraph asserting that [Applicant] had engaged in naked licensing, the allegation in paragraph 26 of the amended notice was made as a part of [Opposer’s] claim that the mark HOKIE is generic, not as a separate claim for relief on the grounds of abandonment.

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<sup>7</sup> *Id.* at 6, ¶ 14.

<sup>8</sup> 92 TTABVUE 49. Internal citations omitted.

Applicant is correct that Opposer's sole allegation regarding abandonment in the notice of opposition, as amended, is contained under the subheading of "B. Generic and/or Descriptive Nature."<sup>9</sup> It reads as follows:

26. Applicant also has granted naked licenses to users of the alleged HOKIE mark. This has caused the abandonment of any trademark or service mark rights that Applicant might have had in its alleged HOKIE mark, so that the term HOKIE is generic or is merely descriptive.

Although this allegation is partially intertwined with and falls under the caption of the genericness claim, it nonetheless sets forth a proper claim of abandonment through naked licensing, such that Applicant was given sufficient notice of that claim by the pleadings. See *Nestle Co. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1089 (TTAB 1987) (citing J. Gilson, *Trademark Protection and Practice*, § 6.01(6) (1984) and discussing, in general, abandonment through course of conduct which includes uncontrolled or "naked" licensing).

Even assuming, *arguendo*, that we were to find the ground is not clearly or sufficiently pleaded, it has been tried by implied consent. An unpleaded issue can be implicitly tried, under Fed. R. Civ. P. 15(a)(2), if the nonoffering party (1) raised no objection to the introduction of the evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. See TBMP § 507.03(b) (June 2017) and authorities cited therein. The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter. *Id.*; see

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<sup>9</sup> 10 TTABVUE 8.

also, *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009). Here, Applicant was well aware that Opposer was attempting to introduce naked licensing evidence for purposes of an abandonment claim. Indeed, on cross-examination, Mr. Weisbein, counsel for Applicant, questioned Opposer's Director, Mr. Creekmore, on the allegation and its meaning, as specified below (with emphasis added):<sup>10</sup>

**Q. And it is your position, is it not, "your" meaning HOOS's position, that because Virginia Tech has entered into one or more naked licenses, it has essentially abandoned its Hokie trademark, correct?**

A. That is one of the contributing factors, yes, sir.

...

**Q. So the Amended Notice for Opposition, Paragraph 26, states, "Applicant also has granted naked licenses to users of the alleged Hokie mark. This has caused the abandonment of any trademark or service mark rights that Applicant might have in its alleged Hokie mark, so that the term Hokie is generic or is merely descriptive," so your claim for abandonment is based on the fact that Virginia Tech has granted the naked licenses that are attached to the Locke White declaration, correct?**

A. That is one of the several reasons that are listed there in the Amended Notice of Opposition.

...

**Q. Other than granting of naked licenses and failing, allegedly granting naked licenses and allegedly failing to police its Hokie trademark, are there any other grounds upon which HOOS claims in its Amended Notice of Opposition that Hokie has abandoned -- that Virginia Tech has abandoned the Hokie trademark?**

A. Yes, sir.

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<sup>10</sup> 89 TTABVUE 132-135; Creekmore Dep. 129:9-14, 130:15-131:1, and 132:17-23.

Based on this cross-examination of Opposer's witness, it is evident that Applicant was clearly and fairly apprised of the nature of the abandonment claim and that it was separate from the genericness claim. Accordingly, we find not only was the abandonment claim pleaded, but that it also was tried; Applicant was on notice that this claim was being pursued by Opposer.

*Descriptiveness*

Opposer pleaded a mere descriptiveness claim, in the alternative, with the genericness claim.<sup>11</sup> However, Opposer did not pursue this claim. As Applicant pointed out in its trial brief, Opposer failed to argue this claim in Opposer's main brief.<sup>12</sup> In its reply brief, Opposer did not address Applicant's contention that the claim has been waived or otherwise indicate that it still had an interest in pursuing the claim. Accordingly, we find the merely descriptive claim to be waived.

*Opposer's "False First Use Dates" Claim and Request to "Rectify" the Register*

Opposer, citing to 15 U.S.C. §1068, pleaded a claim based on a purported "false first use date" being alleged in the involved application. However, as the Board informed Opposer on multiple occasions during this proceeding, fraud was not pleaded and a "mere assertion that an applicant's dates of use are incorrect does not state a ground for opposition to registration of a mark."<sup>13</sup> Moreover, Opposer's request

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<sup>11</sup> 10 TTABVUE 8-9 (Amended Not. of Opp. ¶ 21-26).

<sup>12</sup> See 92 TTABVUE 39-41 ("Opposer waived its claim that HOKIE is merely descriptive ...").

<sup>13</sup> See Board order at 9 TTABVUE 7, citing to *Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009); and *CarX Serv. Sys., Inc. v. Exxon Corp.*, 215 USPQ 345, 351 (TTAB 1982).

in its trial brief that, “if the application is granted, then pursuant to 15 U.S.C. § 1068 (which in opposition proceedings grants to the Director the power, as exercised through the Board, to ‘rectify with respect to the register the registration of a registered mark’), the application be rectified so that its asserted date of first use in commerce is no earlier than 1972,” (88 TTABVUE 24) is denied. Section 18 of the Trademark Act does not involve an application’s dates of first use, let alone give the Board the authority to amend them. Accordingly, Opposer failed to set forth a cognizable “false first use date” claim.

### **Evidentiary Objections**

In its trial brief, Applicant raised objections to evidence introduced by Opposer at trial.<sup>14</sup> Specifically, Applicant objects to three areas of evidence: (1) the testimony of Opposer’s trial witness, James Creekmore, involving documents and testimony from a civil matter involving Applicant and a third-party (hereinafter referred to as “HRE civil action”);<sup>15</sup> (2) Applicant’s business records produced under Fed. R. Civ. P. 34 and submitted as exhibits with the testimony of Mr. Creekmore;<sup>16</sup> and (3) other testimony

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<sup>14</sup> 92 TTABVUE 11-17.

<sup>15</sup> The proceeding is captioned *Virginia Tech Polytechnic Institute and State University v. Hokie Real Estate, Inc.* (No. 7:10-cv-00466-gec-mfu) (W.D. Virginia).

Applicant, in particular, objects to the Creekmore Deposition exhibits and related testimony (all found in 89 TTABVUE): Creekmore Exh. J (comprising Locke White testimony taken in HRE civil action and internal Virginia Tech email correspondence produced in HRE civil action) and Creekmore Dep. p. 76:3-13,20-24, 77:1-3; Creekmore Exh. V (comprising supplemental declaration of Locke White dated January 14, 2011 and submitted in the HRE civil action) and Creekmore Dep. 106:5-17; and Creekmore Exh. R (comprising Virginia Tech business records produced by Virginia Tech in HRE civil action) and Creekmore Dep. 92:21-24, 93, 11. 1-5, 15-22; 94:6-95:4, 95:8-20, 22-24; 96:1-98:1-17.

<sup>16</sup> Applicant identified the following materials, and related testimony (all found in 89 TTABVUE): Creekmore Exh. J (“HOOS-000329-334 ...000403-405 ... 000412-414 ... 000418-

from Mr. Creekmore, along with certain exhibits, involving the origin of the term “Hokie,” on the bases that the evidence constitutes hearsay, Mr. Creekmore lacks personal knowledge, and relevancy.<sup>17</sup> The objections have been asserted with respect to numerous materials. We do not address the objections with respect to each and every document or particular testimony passage; however, we make the following determinations.

*Testimony, and Exhibits, from the HRE Civil Action*

Trademark Rule 2.122(f), 37 C.F.R. § 2.122(f), provides:

By order of the Trademark Trial and Appeal Board, **on motion**, testimony taken in another proceeding, or testimony taken in a suit or action in a court, **between the same parties or those in privity** may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

[Emphasis added].

Here, Opposer did not file a motion nor has it shown that it stands in privity with Applicant’s opponent in the HRE civil action. Thus, the testimony, with exhibits, from that proceeding cannot be introduced by way of Rule 2.122(f). *See also* TBMP § 704.13 (Testimony from Another Proceeding) and authorities cited therein. As evidenced by

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419 ... 000432”) and related testimony, Creekmore Dep. 42:7- 21, 24; p. 43, 11. 1-3, 9-19; p. 44, 11. 7-8, 11-17, 22-24; p. 45, 11. 3-12; p. 72, 11. 14-22; p. 73, 11. 5- 19; p. 74, 11. 5-16; p. 76, 11. 7-13, 23-24; p. 77, 11. 1-3; p. 100, 11. 11-18; p. 101, 11. 4-14, 18, 20; and Creekmore Exh. O (“HOOS-000179-316”) with related testimony, Creekmore Dep. 88:3-10, 24 and 89:1-5, 8-10.

<sup>17</sup> Applicant identified the following materials and testimony as being subject to these objections (all found in 89 TTABVUE): Creekmore Exh. A (“HOOS-000041”); Creekmore Exh. J (“HOOS-000359-362”); and Creekmore Dep. 10:16-22, 11:16-12:7, 12:1-13:10, and 53:13-54:2.



Applicant's objections raised during Mr. Creekmore's testimony, and in its brief, it is clear that the parties did not otherwise stipulate to the introduction of this evidence. In its reply brief, Opposer generally responds to Applicant's objection by arguing that the testimony from the HRE civil action does not constitute hearsay because it was Applicant's representative testifying. However, Opposer does not specify a rule under which the testimony from the HRE civil action may be properly introduced. Accordingly, Applicant's objection to the materials, consisting of testimony and exhibits introduced in the HRE civil action, is sustained and, to the extent that these materials were not otherwise properly introduced, they are not given further consideration.<sup>18</sup>

*Documents Produced by Applicant under Fed. R. Civ. P. 34*

Section 704.11 of the TBMP discusses the possible ways for a party that has obtained documents under Fed. R. Civ. P. 34 to properly make the documents of record. These include: introducing them as exhibits during the cross-examination of its adversary's witness (only if the adversary takes testimony and the documents pertain to matters within the scope of the direct examination of the witness); taking the testimony of its adversary, during its own testimony period, and introducing the obtained documents as exhibits during direct examination; submitting them with a notice of reliance, under Trademark Rule 2.122(e), should the documents fall into the categories of "printed publications, such as books and periodicals, available to the

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<sup>18</sup> See footnote 15, *supra*, regarding objected-to testimony and materials from the HRE civil action.

general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue” and Internet materials; or making them of record by stipulation of the parties. *See* TBMP § 704.11.<sup>19</sup>

Opposer did none of the above. Opposer does not contend that the objected-to materials (identified in Note 14) are of the type that may be properly introduced under a notice of reliance and, indeed, has not submitted them by notice of reliance. In any event, given that the materials essentially comprise Applicant’s email correspondence, license agreements, and artwork design documents, all relating to use of the mark HOKIE and produced by Applicant in discovery under Fed. R. Civ. P. 34, these are not the types of materials that may be considered as self-authenticating or appropriate for submission under a notice of reliance. Opposer, instead, has sought to introduce the materials as exhibits to the testimony of its own witness, Mr. Creekmore, Opposer does not assert that Applicant has stipulated or admitted to the materials’ authenticity or that Mr. Creekmore was in a position or has the capacity to authenticate the materials. Because Opposer has not demonstrated the

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<sup>19</sup> TBMP § 704.11 currently explains Trademark Rule 2.120(k)(3)(ii), which at the time of Mr. Creekmore’s December 9, 2015 deposition was numbered as Rule 2.120(j)(3)(ii). *See* “Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice,” 81 Fed. Reg. 69950 (Oct. 7, 2016), renumbering and/or amending certain rules. The former rule stated that “[a] party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).” The amended rule adds the final wording “or the party has obtained an admission or stipulation from the producing party that authenticates the documents.”

authenticity of these materials, Applicant's objection on this basis is sustained and the materials are given no further consideration. Mr. Creekmore's testimony regarding the materials shall be considered for whatever value it has bearing in mind that the materials are not properly of record.

*Creekmore Testimony and Exhibits Involving Origin of Term "Hokie"*

Applicant objects to the portion of Mr. Creekmore's testimony, and related exhibits, that involve the origin of the term "Hokie," because Mr. Creekmore is "without personal knowledge regarding the content of the documents and was not qualified as an expert witness on the subject of the etymology of the term[,] ... [he] did not testify regarding the methodology used to conduct the purported research or provide underlying documentation related thereto ... [and he] did not identify who conducted the research or when it was conducted."<sup>20</sup> With respect to the objected-to testimony and exhibits, we are capable of weighing the relevance and strength or weakness of this evidence, including any inherent limitations, and this precludes the need to strike the challenged testimony and exhibits. Rather, we accord the testimony and materials involving the origins of the term "Hokie" whatever probative value it merits, keeping Applicant's objections in mind, and we comment as needed on its probative value elsewhere in the opinion. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd* 565 Fed. Appx. 900 (Fed. Cir. 2014); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007). *See also Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1907 (TTAB

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<sup>20</sup> 92 TTABVUE 16 (Brief, p. 8).

2005) (“Where we have relied on testimony to which respondent objected, it should be apparent to the parties that we have deemed the material both admissible and probative to the extent indicated in the opinion.”).

### **The Record**

The record includes the pleadings and, by way of Trademark Rule 2.122, the file of the involved application.

Opposer, during its trial period, took the testimonial deposition of James Creekmore.<sup>21</sup> In addition, Opposer filed a “Stipulation as to the Testimony of Dr. Wayne Massey,” wherein the parties agreed that “if Dr. Wayne Massey were called to testify in this proceeding, then he would testify as set forth in the attached Exhibit A.”<sup>22</sup> Opposer further filed notices of reliance on the following materials: Applicant’s responses to Opposer’s discovery requests<sup>23</sup> and printouts from Opposer’s yearbooks for years 1949-1973.<sup>24</sup>

Applicant has introduced copies of the testimonial deposition transcripts, with exhibits, of: Lawrence G. Hincker, Applicant’s Associate Vice President for University

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<sup>21</sup> 89 TTABVUE. As discussed, *supra*, portions of Mr. Creekmore’s testimony and exhibits were subject of sustained objections and are not being considered.

<sup>22</sup> 68 TTABVUE. Exhibit A is a copy of Dr. Massey’s testimony submitted in the HRE civil action, and Exhibit B is a documentary exhibit to Dr. Massey’s testimony. Essentially, pursuant to the stipulation and TBMP § 705, the parties agreed to allow this testimony, with exhibit, be introduced in this proceeding, subject to objections raised during the deposition of Dr. Massey.

<sup>23</sup> Notices of Reliance 1 (42 TTABVUE); 3 (60-62 TTABVUE); and 4 (63-67 TTABVUE). With respect to Applicant’s discovery responses, we note that the Board previously permitted Applicant to withdraw admissions (effectively admitted admission requests). 75 TTABVUE.

<sup>24</sup> Notice of Reliance 2 (43-59 TTABVUE).

Relations from 1996 to 2015;<sup>25</sup> and Bobbi J. Norris, Applicant's Special Assistant to the Senior Associate Vice President for University Relations.<sup>26</sup> Applicant also submitted, under notice of reliance, a printout from the Office's Trademark Electronic Search System ("TESS") for its registration (Reg. No. 2351364) for the mark HOKIES.<sup>27</sup>

### **Opposer's Standing**

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. Any person who believes it is or will be damaged by registration of a mark has standing to file a notice of opposition. Trademark Act Section 13, 15 U.S.C. § 1063. To establish standing in an opposition proceeding, a plaintiff must show "both a 'real interest' in the proceedings as well as a 'reasonable basis' for its belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing in Board proceedings. *Ritchie*, 50 USPQ2d at 1030.

To prove its standing to oppose the registration of an allegedly generic term, a

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<sup>25</sup> 78 TTABVUE 2-65.

<sup>26</sup> *Id.* at 69-241.

<sup>27</sup> 77 TTABVUE.

plaintiff may show that it has the right to use the term in a descriptive or generic manner. *See Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 23 USPQ2d 1878, 1879 (TTAB 1992), *aff'd*, 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993). *See also Nobell.com LLC v. Qwest Commc'ns Int'l, Inc.*, 66 USPQ2d 1300, 1304 (TTAB 2003); *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1010 (TTAB 1984). While such a “right to use the term” may be found when the plaintiff renders similar services or sells related goods as those listed in the defendant’s application, this is not a requirement and the plaintiff need not necessarily be a competitor of the defendant. *See, e.g., Tanners’ Council of Am., Inc. v. Gary Indus., Inc., d/b/a Acco Prods.*, 169 USPQ 608, 609 (CCPA 1971) (“It seems clear enough that registration of the mark as applied for could weaken the sales positions of appellants’ members and hence reduce the income of appellant. We think this last factor is alone sufficient to bring appellant within the category of ‘any person who believes he would be damaged’ by the registration.”); *The Scotch Whiskey Assoc. v. Consolidated Distilled Prods., Inc.*, 204 USPQ 57, 60 (TTAB 1979) (membership association found to have standing on behalf of its members). Moreover, the plaintiff need not assert proprietary rights in a term in order to have standing. *See Int’l Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492, 1496 (Fed. Cir. 2000).

For purposes of understanding Opposer, we reiterate its name is “Hokie Objective Onomastics Society.”<sup>28</sup> It is a single-member, Virginia LLC and also a not-for-profit

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<sup>28</sup> “Onomastics” is defined as “1a: the science or study of the origins and forms of words especially as used in a specialized field; b: the science or study of the origin and forms of proper names of persons or places.” *Merriam-Webster.com/dictionary/onomastics*. Merriam-Webster, © 2015 Web. 9 Oct. 2017. The Board may take judicial notice of dictionary

company, established on August 3, 2012, by Mr. Creekmore who is the manager, member, a director, and sole employee.<sup>29</sup> Opposer distributes goods containing written information, e.g., stickers and handheld fans, that Mr. Creekmore testified are “[f]or educational purposes to further the mission of [Opposer], to place into the public’s hands materials that show proper and historical use of the word [‘]Hokie,[‘] and demonstrating that the word is used by and available to the public, not just Virginia Tech.”<sup>30</sup> In November 2012, Opposer created a website related to this educational mission, containing photographs and information that Opposer believes “demonstrated both the historical development and origin of the word [‘]Hokie[‘] ... and also demonstrated statements by [Applicant] that were publicly available as to [Applicant’s] own identification of what the word [‘]Hokie[‘] meant....”<sup>31</sup> As early as March 5, 2013,<sup>32</sup> Opposer has presented lectures on the same topic, including a presentation that was “given twice in connection with an upper level elective law course at Liberty University School of Law.”<sup>33</sup> It has been Mr. Creekmore and his law partner, Keith Finch, who have made these presentations on behalf of Opposer.<sup>34</sup>

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definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

<sup>29</sup> Creekmore Dep. 5:11-6:2, 108:7-10, and 112:3-5 (89 TTABVUE 8-9, 111, 115).

<sup>30</sup> *Id.* 10:8-12.

<sup>31</sup> *Id.* 16:24-17:4.

<sup>32</sup> *Id.* 124.

<sup>33</sup> *Id.* 78:15-17; 124:11-13.

<sup>34</sup> *Id.* 125:5-8.

Applying the liberal standard set forth by the Federal Circuit, our primary reviewing court, we find that Opposer has demonstrated that it has standing to bring the opposition. We make this finding in spite of the fact that Opposer's services, namely, its endeavors to educate the public regarding the origin of the term HOKIE are very recent; indeed, Opposer was only formed during the period of time allowed for filing a notice of opposition against the involved application. We are further cognizant of the extent of Opposer's activities which can best be characterized as minimal. Nevertheless, we find that Opposer at least has a 'real interest' in this proceeding, inasmuch as it uses the term HOKIE as part of its name in rendering educational services and the essence of these services are to demonstrate the purported generic background of the same term. While Opposer has not established that it is necessarily a competitor within the realm of Applicant's "providing courses of instruction at the university level," Opposer has demonstrated that it renders services that may be related to Applicant's "educational research ... [and] conducting educational conferences" services. Thus, we find that Opposer has a 'reasonable basis' in fact for its belief of damage should the mark be registered.

While our finding of Opposer's standing in this opposition has been addressed mainly in the context of the genericness claim, we need not make a finding of standing with respect to the other grounds before us. That is, if a plaintiff can show standing on one ground, the plaintiff has the right to assert any other grounds in an opposition or cancellation proceeding. *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011).



### **Misuse of the Federal Registration Symbol**

Section 29 of the Trademark Act, 15 U.S.C. §1111, provides that “a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying ... the letter R enclosed within a circle, thus ®.” The Office has clarified that “the registration symbol should be used only on or in connection with the goods/services/collective membership organization listed in the registration” and that the “symbol may not be used with marks that are not actually registered in the USPTO.” TMEP § 906 (October 2017).

In *Copeland’s Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991), the Federal Circuit held “improper use of a registration notice in connection with an unregistered mark, if done with intent to deceive the purchasing public or others in the trade into believing that the mark is registered, is a ground for denying the registration of an otherwise registrable mark.” The Court further noted that “continuing to use [the registration symbol] after being specifically notified of the impropriety of such use” is a factor that “raises serious questions as to the [user’s] purpose and intent.” *Id.* at 1299. The Board has maintained the availability of this ground in Board proceedings. *See, e.g., NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1034 n.8 (TTAB 2014); *see also*, TBMP §309.03(c) (“Grounds ... (16) That defendant has misused the federal registration symbol with intent to deceive the purchasing public or others in the trade into believing that the mark is registered”) and cases cited therein at Note 32.

In this case, we find that Opposer has not proven that Applicant had the requisite intent to deceive the purchasing public, or anyone else, and thus cannot find in Opposer's favor on the ground of misuse of the registration symbol. There is no dispute that Applicant, through its licensees, used the registration symbol "®" after the term HOKIE on a variety of goods, both before and after receiving a letter from Opposer's law firm in 2010 asserting that such use of the symbol was improper.<sup>35</sup> However, Applicant has set forth a plausible explanation for its use prior to receiving the letter from Opposer's counsel. Specifically, Applicant points out that it has owned Reg. No. 2351364<sup>36</sup> for the mark HOKIES since 2000 and that it viewed "no material difference, in a trademark sense, between the singular and plural forms of the mark HOKIE," citing to a long string of Board cases supporting the proposition that the singular and plural versions of the same term are legal equivalents.<sup>37</sup> In addition, Applicant states that even though it did not believe it was misusing the registration symbol, it instituted a series of remedial actions to discontinue the use of the

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<sup>35</sup> See 89 TTABVUE 386-498: Creekmore Exh. M (copy of letter); Creekmore Exh. N (photographs of goods containing the registration symbol following the term HOKIE); and 92 TTABVUE 44 wherein Applicant acknowledges its prior "policy to allow its licensees to use the registration symbol in connection with both the singular and plural forms of the mark HOKIE.").

<sup>36</sup> 77 TTABVUE.

<sup>37</sup> 92 TTABVUE 44. Although we do not repeat the cases cited by Applicant, we note that the Federal Circuit has previously affirmed a Board decision holding that the singular versus the plural form of the same word (i.e., DURANGO and DURANGOS) constitutes a "minor difference," and a registration for the plural term may be used to help show acquired distinctiveness of the same term in singular form. See, e.g., *In re Loew's Theatres, Inc.*, 223 USPQ 513, 514 n.5 (TTAB 1984), *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). Indeed, the Federal Circuit went further in its affirmance, stating the plural form is "virtually the identical mark" as the singular form. *Id.*, 226 USPQ at 869.

registration notice symbol with the singular form of the mark HOKIE. These include: instructing licensees regarding the proper use of the registration symbol; providing an “artwork page” with guidance on proper use of Applicant’s marks, including use of the “TM” symbol; sending letters to licensees; responding to licensee inquiries regarding proper use of Applicant’s marks; providing a “spreadsheet tool” identifying Applicant’s marks and the appropriate corresponding symbols to be used; and revising Applicant’s “policies and procedures” to include a new policy to use “TM” for the term HOKIE, as opposed to the registration symbol.<sup>38</sup> Applicant acknowledges that these measures have not been foolproof and that certain licensees continued to use the registration symbol; however, Applicant has been diligent in reminding its licensees as to proper trademark use and has suspended at least one company’s license when it failed to adhere to Applicant’s policy.<sup>39</sup>

Applicant’s belief that it could use the registration symbol for the term HOKIE falls within the ambit of the types of misunderstandings that the Office lists in the TMEP as “common reasons for improper use ... that do not indicate fraud.” TMEP 906.02.<sup>40</sup> Given Applicant’s reasoning for using the registration symbol in the first

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<sup>38</sup> 78 TTABVUE; *see* Norris Exh.’s 5A, 5B, 6-8, 10-12 and corresponding testimony; and Hincker Dep. 11.

<sup>39</sup> *Id.*; *see* Norris dep. 34:6-13 and Exh. 13 (letter to licensee).

<sup>40</sup> Specifically, TMEP §906.02 lists common reasons along with a corresponding Board or court decision that held the misuse did not constitute fraud, which requires an intent to deceive. The examples of “common reasons” include: mistake as to the requirements for giving notice; inadvertence in not giving instructions (or adequate instructions) to the printer, or misunderstanding or voluntary action by the printer; mistaken belief that registration in a state or foreign country gives a right to use the registration symbol; registration of a portion of the mark; registration of the mark for other goods; recently expired or cancelled registration of the subject mark; and another mark to which the symbol relates

place and its earnest attempts to prevent improper future use of the symbol, we do not find Applicant's actions rise to the level of intending to deceive prospective purchasers or anyone else. Accordingly, Opposer's claim based on Applicant's improper use of the registration symbol is dismissed.

### **Abandonment through Naked Licensing**

Opposer's argument in its main brief with respect to this claim, in its entirety, reads as follows:<sup>41</sup>

Applicant has entered into at least four naked licenses with local businesses for use of the HOKIE trademark. (Creekmore Testimony at 129 & Ex. V.) These licenses contain no provision permitting Applicant to monitor the quality of the goods and services of the licensees and thus are "naked" licenses. (Creekmore Testimony Ex. V.) The granting of a naked license "will generally result in abandonment." *Woodstock's Enters. (Cal.) v. Woodstock's Enters. (Or.)*, No. 97-1580, 1998 U.S. App. LEXIS 3777 at \*6 (Fed. Cir. Mar. 5, 1998) (citing 2 J. Thomas McCarthy, *McCarthy on Trademarks* § 18.48 (1996)). For this reason, the granting of a naked license justifies refusal of registration. *See, e.g., Naclox, Inc. vs. Lee*, 231 U.S.P.Q. 395, 400 (T.T.A.B. 1986) (holding that applicant's granting of an invalid naked license caused applicant to abandon any rights in the mark and denying registration). Accordingly, if Applicant ever did possess any trademark rights in the HOKIE term, then these naked licenses have caused Applicant to abandon those rights and accordingly its application for registration should be denied.

The evidence involving purported naked licensing and referenced by Opposer is found in Creekmore Exhibit V, and, as discussed *supra*, this is the subject of a sustained objection. Exhibit V has been stricken from the record and is not given consideration, and Mr. Creekmore's testimony regarding the exhibit has very little probative value. As a result, Opposer has failed to carry its burden to prove by a

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on the same label.

<sup>41</sup> 88 TTABVUE 23-24

preponderance of the evidence that Applicant has abandoned any trademark rights in the HOKIE term through naked licensing. Accordingly, the claim of abandonment through naked licensing is dismissed.

### **Genericness**

There is a two-part test used to determine whether a proposed mark is generic: (1) what is the genus of services at issue? and (2) does the relevant public understand the designation primarily to refer to that genus of services? *H. Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986); *see also Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015). The public's perception is the primary consideration in determining whether a term is generic. *Id.* Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Id.*, citing *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559, [227 USPQ 961, 963] (Fed. Cir. 1985). It is Opposer's burden to establish that HOKIE is generic by a preponderance of the evidence. *Princeton Vanguard*, 114 USPQ2d at 1830 n. 2.

With respect to the first part of the genericness test, Opposer does not actually assert in its main brief what it believes is the relevant genus of services. Notwithstanding this, we begin the analysis by noting that the genus is often defined by the services recited in the application. *See In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d

638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration). In this case and based on the services identified in the involved application, we find that the relevant genus of services can best be described as educational and entertainment services. Applicant appears to agree, referring in its brief to the “educational and entertainment services identified in [its involved a]pplication.”<sup>42</sup>

As to the second part of the genericness test involving whether the relevant public perceives the designation as primarily referring to educational and entertainment services, this question also appears to be ignored by Opposer. Rather, Opposer’s argument regarding HOKIE and genericness can best be summed up by the following paragraph from Opposer’s main brief:

Accordingly, when the term HOKIE is used to refer to a supporter of [Applicant], it is a generic term ... because by definition anyone who decides to support [Applicant] is a “Hokie,” any person or business can become a “Hokie” by making the decision to support [Applicant]. In short, *anyone* can be a Hokie, so long as that person is a supporter of [Applicant]. (Or perhaps it is enough just to buy a shirt or hat that says “I Am A Hokie.”) In any event, Opposer, like any other supporter of [Applicant], is entitled to use the term HOKIE in this generic sense to describe itself and its business, and so the term HOKIE “may not be appropriated as exclusive property” by [Applicant].

[internal citation omitted].<sup>43</sup>

Opposer does not argue that HOKIE is generic in the context of the relevant genus of services. Rather, Opposer essentially argues that a “Hokie” is a person who supports Applicant. In the same vein, Opposer’s argument and evidence regarding

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<sup>42</sup> Brief, p. 27 (92 TTABVUE 35).

<sup>43</sup> 88 TTABVUE 14.

the origin of the term “Hokie” is largely irrelevant to the question of whether it is generic for the identified services.

Most importantly, the record does not demonstrate how the term “Hokie” is understood by the relevant consuming public in the context of educational and entertainment services. Even if, *arguendo*, we accept Opposer’s contention that “Hokie” is a generic reference meaning a supporter of Applicant and such supporter or “Hokie” may also be a consumer of Applicant’s services, the evidence does not establish that the consuming public uses this term as a generic reference for educational and entertainment services. Pointedly, there is no evidence showing third parties using the term in connection with any educational and entertainment services that are not being rendered by Applicant or that a need even exists for others to use the term as a generic reference in connection with their own services. Indeed, to the extent that any correlation may be drawn between “Hokie” and the relevant genus of services, it is that HOKIE identifies Applicant as the source of the services.

Finally, we point out that Opposer’s reliance upon the Second Circuit decision, *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 49 USPQ2d 1458 (2d Cir. 1999) is misplaced. The facts in *Harley-Davidson* are inapposite to the relevant circumstances of this proceeding. Specifically, the Second Circuit found “‘hog’ was a generic term in the language as applied to large motorcycles before the public (or at least some segments of it) began using the word to refer to Harley-Davidson motorcycles.” *Id.* at 1462. That is, the court held that the term “hog” was a generic reference in connection with respect the relevant genus of goods, namely large motorcycles, before ruling that

the motorcycle manufacturer could not prohibit the opposing party from using “hog” to identify his motorcycle parts and services. In contrast and as discussed *supra*, Opposer has not argued, or proven, that the term HOKIE is generic for the relevant genus of services, namely, educational or entertainment services.

We have carefully considered all of the evidence of record and arguments submitted by the parties on the issue of genericness, including those that we have not specifically discussed. Ultimately, Opposer has not demonstrated, by a preponderance of the evidence, that HOKIE is the generic name of the relevant genus of services. Accordingly, the claim of genericness is dismissed.

**Decision:** The opposition, based on the grounds of improper use of the registration symbol, genericness, and abandonment through naked licensing, is dismissed.