

ESTTA Tracking number: **ESTTA741334**

Filing date: **04/20/2016**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	The Ohio State University
Granted to Date of previous extension	04/20/2016
Address	190 North Oval Mall Columbus, OH 43210 UNITED STATES

Attorney information	Samantha M. Quimby Frost Brown Todd LLC 10 West Broad Street, Suite 2300 Columbus, OH 43215 UNITED STATES fbtplitigation@fbtlaw.com, kcomella@fbtlaw.com, squimby@fbtlaw.com Phone:614.559.7282
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**Applicant Information**

Application No	86544434	Publication date	12/22/2015
Opposition Filing Date	04/20/2016	Opposition Period Ends	04/20/2016
Applicant	Abdullah Enterprises 7351 Skyline Dr E Columbus, OH 43235 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Retail discount store services in the field of general consumer merchandise
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1267035	Application Date	09/29/1982
Registration Date	02/14/1984	Foreign Priority Date	NONE

Word Mark	BUCKEYES
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 011. First use: First Use: 1980/01/00 First Use In Commerce: 1980/01/00 Electric Lamps</p> <p>Class 014. First use: First Use: 1976/05/00 First Use In Commerce: 1976/05/00 Jewelry-Namely, Rings, Pins, [ Belt Buckles ] and Key Chains, All Being Made of Precious Metal</p> <p>Class 016. First use: First Use: 1975/10/00 First Use In Commerce: 1975/10/00 Pens, Posters, Decals, and Paintings</p> <p>Class 018. First use: First Use: 1978/06/00 First Use In Commerce: 1978/06/00 Tote Bags</p> <p>Class 020. First use: First Use: 1961/12/00 First Use In Commerce: 1961/12/00 [ Hassocks, Bean Bag Leisure Furniture, Letter Holding Boxes, ] Mirrors, and Folding Seats for Use by Individuals in Athletic Stadiums and Plaques</p> <p>Class 021. First use: First Use: 1978/06/00 First Use In Commerce: 1978/06/00 Tumblers, Cups, Mugs, Glasses and Insulated Beverage Container Holders</p> <p>Class 024. First use: First Use: 1978/06/00 First Use In Commerce: 1978/06/00 Blankets, Textile Placemats, [ Handkerchiefs, ] Quilts and Pennants</p> <p>Class 025. First use: First Use: 1900/00/00 First Use In Commerce: 1900/00/00 Clothing-Namely, T-Shirts, [ Ties, ] Scarves, Bibs, Sweatshirts, Athletic Shorts, Hats, [ Aprons, ] Jogging Suits and Sweaters</p> <p>Class 028. First use: First Use: 1975/06/00 First Use In Commerce: 1975/06/00 Toy Stuffed Animals, Christmas Decorations, [ Bean Bags, ] Plastic Toys [, Foam Toys and Equipment Sold as a Unit for Playing a Stick Ball Game ]</p> <p>Class 041. First use: First Use: 1957/07/01 First Use In Commerce: 1957/07/01 Providing College Level Educational Programs, Sport Exhibition Events and Recreation Programs</p>

U.S. Registration No.	1152683	Application Date	01/29/1975
Registration Date	04/28/1981	Foreign Priority Date	NONE
Word Mark	BUCKEYES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1878/05/01 First Use In Commerce: 1878/05/01 Providing College Sport Exhibition Events and Recreation Programs		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BUCKEYE marks		
Goods/Services	Used in connection with retail services		

Attachments	Notice of Opposition BUCKEYE DOLLAR.pdf(1324063 bytes )
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	BUCKEYE DOLLAR Exhibit A.pdf(278859 bytes ) BUCKEYE DOLLAR Exhibit B.pdf(688259 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/samantha m quimby/
Name	Samantha M. Quimby
Date	04/20/2016

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

IN THE MATTER OF: Application Serial No. 86/544,434  
DATE OF PUBLICATION: December 22, 2015

The Ohio State University,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition Proceeding # _____
	)	
Abdullah Enterprises,	)	
	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

THE OHIO STATE UNIVERSITY, an Ohio Educational Institution, having a principal place of business at 190 North Oval Mall, Columbus, Ohio 43210 believes it will be damaged by registration of Application Serial No. 86/544,434 for the Applied-for Mark—BUCKEYE DOLLAR—filed by Abdullah Enterprises (hereinafter the “Applicant”) and published for use in connection with “Retail discount store services in the field of general consumer merchandise” in Class 35, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of July 5, 1946, codified at 15 U.S.C. § 1063.

As grounds therefore, it is alleged:

1. Established in 1870, The Ohio State University (hereinafter “Ohio State” or “Opposer”), has developed into one of the most well-respected institutions of higher learning in the country.
2. For over 140 years, Ohio State has provided college and graduate level educational courses, sponsored collegiate sporting events and recreation programs, and staged dramatic and

musical entertainment events.

3. Ohio State's students and athletic teams have been known as "Buckeyes" since at least as early as 1920. Due to the long, extensive and continuous use of the term "Buckeye(s)" in association with Ohio State programs and events, consumers now associate the term "Buckeye(s)" with Ohio State.
4. Ohio State licenses and markets many items using the trademarks "Buckeyes" (the name designation for Ohio State's students, athletes and alumni), "Brutus Buckeye" (the name of Ohio State's beloved mascot), "Go Bucks", the distinctive colors of scarlet and gray, the signature "Buckeye Leaf," and a number of "Buckeye" variants that play off of the imagery of the buckeye nut, such as "Go Nuts!" and "the Nuthouse," just to name a few (collectively, the "Buckeye Marks").
5. Ohio State's academic and athletic programs rank among the best in the nation. It's undergraduate program and graduate programs for law, medicine, business, engineering, and education are all currently ranked among the top 40 schools in the nation in their respective areas by U.S. News & World Report.
6. Ohio State's athletic programs have a long history of success. Ohio State is among only five universities with NCAA championships in baseball, basketball and football. Ohio State athletic teams have also won national championships in men's swimming and diving, men's outdoor track and field, men's golf, men's gymnastics, men's fencing, co-ed fencing, synchronized swimming, and men's volleyball.
7. In January of 2015, the Ohio State Buckeyes football team won its eighth NCAA football championship, and the first football championship within the new and inaugural collegiate football playoff structure.

8. Ohio State alumni have an affinity for Ohio State that runs deep and these “Buckeyes” can be found in every corner of the country. When consumers throughout the nation hear the word “Buckeye” or see it used on certain products, they immediately associate it with Ohio State.
9. As a result of Ohio State’s fame and its extensive use, advertising, and sale of goods and services bearing the Buckeye Marks, the Buckeye Marks have acquired strong secondary meaning, have achieved favorable national recognition, and have become assets of significant value as symbols pointing only to Ohio State, its services, products and its goodwill.
10. Ohio State strictly controls the nature and quality of the goods and services bearing its marks and its trade dress to protect the tradition, prestige, and goodwill associated with these marks, and Ohio State makes systematic efforts to safeguard the quality and integrity of its marks.
11. For more than thirty (30) years, Ohio State has licensed third-parties to use its marks—including the Buckeye Marks—on various items and services, including but not limited to clothing apparel of all types, athletic uniforms, calendars, novelties, books, household goods, toys, sporting goods, home furnishings, glassware, collectibles, pens and watches, food products, restaurant services, and retail services.
12. Ohio State’s licensing program has become the most profitable collegiate licensing program in the United States. Ohio State’s licensing revenues are in the millions each year and continue to soar. To date, Ohio State’s licensing program has generated over \$130 million in royalty revenue from approximately \$1.3 billion in licensed retail sales. The past and current success of Ohio State’s academic and athletic programs has resulted in

extensive exposure of Ohio State's trademarks—including the Buckeye Marks—to a national audience and has created a large demand for products and services bearing Ohio State's trademarks throughout the United States.

13. Ohio State is the owner of, among others, the following federal trademark registrations:

BUCKEYES—Registration No. 1,267,035, registered February 14, 1984, for electric lamps; jewelry—namely, rings, pins, and key chains, all being made of precious metal; pens, posters, decals, and paintings; tote bags; mirrors, and folding seats for use by individuals in athletic stadiums and plaques; tumblers, cups, mugs, glasses and insulated beverage container holders; blankets, textile placemats, quilts and pennants; clothing—namely, t-shirts, ties, scarves, bibs, sweatshirts, athletic shorts, hats, jogging suits and sweaters; toy stuffed animals, Christmas decorations, plastic toys; providing college level educational Programs, sport exhibition events and recreation programs; and

BUCKEYES—Registration No. 1,152,683, registered April 28, 1981, for providing college sport exhibition events and recreation programs;

(the “BUCKEYES Registered Marks”).

14. Pursuant to Trademark Rule 2.122(d)(1), Ohio State hereby provides proof of status and title of the BUCKEYES Registered Marks by filing a copy of the records from the USPTO electronic database attached hereto as Exhibit A.
15. The certificates of registration identified in paragraph 13 are valid and subsisting and prima facie evidence of the validity of the registrations, of Ohio State's ownership of the BUCKEYES Registered Marks, of Ohio State's exclusive right to use the BUCKEYES Registered Marks in commerce in connection with the services specified under the provisions of 15 U.S.C. § 1057(b), and constructive notice of Ohio State's claim of ownership under 15 U.S.C. § 1072. Moreover, these registrations are incontestable, which provides conclusive evidence of their validity, of Ohio State's ownership of the mark and

of Ohio State's exclusive right to use the BUCKEYES Registered Marks in commerce under 15 U.S.C. § 1115(b).

16. In addition to the BUCKEYES Registered Marks, Ohio State owns numerous federal trademark registrations for BUCKEYE and BUCKEYE—formative marks for use in connection with the vast array of associated services and licensed products as a result of the success of Ohio State Buckeyes athletic programs and subsequent expansion of Ohio State's licensing program.
17. In addition, Ohio State owns common law rights in a number of "Buckeye" variants, including for use in connection with retail store services, both brick and mortar and online, selling broad range of products and merchandise (the BUCKEYES Registered Marks and the common law "Buckeye" variant marks are collectively referred to as the "Buckeye Marks").
18. Specifically, Ohio State has operated BUCKEYE BARGAINS, a brick and mortar retail store that sells a vast array of consumer goods since at least as early as 1966 – the proceeds of which support Opposer's scholarship initiatives for its students. In addition, Opposer has operated BUCKEYE TARTAN, an online retail site that sells clothing, jewelry, golf accessories and home furnishings since at least as early as 2014.
19. The use of the words "Buckeye" and "Buckeyes" have become associated in the mind of the public with Ohio State and particularly with its athletic teams, events, and activities.
20. Ohio State approves and maintains quality control over all of the products and services it licenses and produces under the Buckeye Marks, and the public assumes that Ohio State has approved, sponsored or endorsed all products and services bearing its trademarks.
21. Applicant has applied for the mark BUCKEYE DOLLAR in standard character format for

use in connection with “retail discount store services in the field of general consumer merchandise.”

22. Applicant is using the mark BUCKEYE DOLLAR on its attached store signage in the color red, and on detached signs in the color combination of red and gray. *See* Exhibit B. The scarlet and gray color scheme has been noted by the 5<sup>th</sup> Circuit Court of Appeals to be a trademark that is strongly associated with The Ohio State University. *See Bd. of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co*, 550 F.3d 465, 486 (5th Cir. 2008).
23. Ohio State has, continuously and long prior to Applicant’s constructive first use date of February 24, 2015, used “Buckeye(s)” as a trademark and service mark in connection with a broad range of products and services, including retail services.
24. Applicant’s BUCKEYE DOLLAR mark is identical to Opposer’s Buckeye Marks such that confusion is likely. Indeed, “Buckeye” is the dominant portion of the Applied-for Mark, and the addition of the descriptive term “dollar” to the Applied-for Mark does nothing to obviate confusion.
25. In the case at hand, overlap of, among, and between the respective services exists as Ohio State already offers retail services using its BUCKEYE BARGAINS and BUCKEYE TARTAN marks. Further, Applicant’s proposed services are very broad and such that they could include the sale of products that are identical to Opposer’s licensed products. Indeed, consumers are likely to be confused as to source of Applicant’s services, especially given the color combinations Applicant has chosen to use in order to showcase its BUCKEYE DOLLAR mark.
26. Applicant’s Applied-for Mark is confusingly similar to Opposer’s Buckeye Marks such

that one would reasonably expect the BUCKEYE DOLLAR retail services to emanate from Ohio State, and the contemporaneous use thereof is likely to cause confusion, mistake, or deception in that the purchasing public is likely to believe that Applicant or Applicant's goods emanate from, or are in some way associated or connected with, or sponsored, licensed, or authorized by Ohio State, all to the damage of Opposer and should be refused registration under Section 2(d) of the Lanham Act.

27. Opposer is not connected to the services performed by Applicant under the Applied-for Mark, nor is Applicant related to Opposer in any manner. The Applied-for Mark is used at a single brick and mortar location in the Central Ohio area in the colors of red and gray, advertising and rendering retail store services to the same consuming public that Ohio State's products and services are advertised, offered, and sold to under the Buckeye Marks—namely the students, alumni, fans and supporters of Ohio State. As a result, the Applied-for Mark would be recognized as uniquely and unmistakably pointing to Opposer. Given the fame of Opposer's Buckeye Marks in connection with its educational and athletic programs and the vast array of licensed products sold in connection therewith, Applicant's mark creates a false sense of connection with Opposer under Section 2(a).
28. Given Ohio State's use of the Buckeye Marks for decades in connection with its educational and athletic programs, and its subsequent expansion of the Buckeye Marks for use in connection with the vast array of licensed products sold in connection therewith, including retail store services, the Buckeye Marks became famous long before Applicant's constructive first use date. As such, the Applied-for Mark dilutes the distinctiveness of Opposer's Buckeye Marks under Section 43(c).
29. By reason of the foregoing, Opposer's opposition should be sustained and Applicant's

application refused registration pursuant to Section 13 of the Trademark Act (15 U.S.C. § 1063).

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that Application Serial No. 86/544,434 for BUCKEYE DOLLAR be refused registration.

The fee of \$300 as provided by Sections 13 and 31 of the Trademark Act of 1946 is paid by credit card upon electronic filing of this Notice of Opposition. Please recognize Samantha M. Quimby and Kathryn A. Comella, both members of the Bar of the State of Ohio, as its attorneys to prosecute this Notice of Opposition and to transact all business in the Patent and Trademark Office in connection herewith. Please address all communications and correspondence to: Samantha M. Quimby, Frost Brown Todd LLC, 10 West Broad Street, Suite 2300, Columbus, Ohio 43215, Telephone 614.559.7282, Facsimile 614.464.1737, e-mail squimby@fbtlaw.com.

Date: April 20, 2016

Respectfully submitted,



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Samantha M. Quimby  
Kathryn A. Comella  
FROST BROWN TODD LLC  
One Columbus, Suite 2300  
10 West Broad Street  
Columbus, Ohio 43215-3484  
Telephone: (614) 559-7282  
Facsimile: (614) 464-1737

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Notice of Opposition was served on the Applicant via First Class mail, postage prepaid, at the correspondence address of record on this 20<sup>th</sup> day of April, 2016:

ABDULLAH ENTERPRISES  
7351 Skyline Dr E Apt 315  
Columbus, OHIO UNITED STATES 43235-5738

  
\_\_\_\_\_  
Samantha M. Quimby

0104751.0537680 4837-6163-1024v2

# Exhibit A

# Exhibit A


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# Typed Drawing

**Word Mark**

BUCKEYES

**Goods and Services**

IC 011. US 021. G &amp; S: Electric Lamps. FIRST USE: 19800100. FIRST USE IN COMMERCE: 19800100

IC 014. US 002 027 028 050. G &amp; S: Jewelry-Namely, Rings, Pins, [ Belt Buckles ] and Key Chains, All Being Made of Precious Metal. FIRST USE: 19760500. FIRST USE IN COMMERCE: 19760500

IC 016. US 037 038. G &amp; S: Pens, Posters, Decals, and Paintings. FIRST USE: 19751000. FIRST USE IN COMMERCE: 19751000

IC 018. US 003. G &amp; S: Tote Bags. FIRST USE: 19780600. FIRST USE IN COMMERCE: 19780600

IC 020. US 002 013 022 025 032 050. G &amp; S: [ Hassocks, Bean Bag Leisure Furniture, Letter Holding Boxes, ] Mirrors, and Folding Seats for Use by Individuals in Athletic Stadiums and Plaques. FIRST USE: 19611200. FIRST USE IN COMMERCE: 19611200

IC 021. US 002 050. G &amp; S: Tumblers, Cups, Mugs, Glasses and Insulated Beverage Container Holders. FIRST USE: 19780600. FIRST USE IN COMMERCE: 19780600

IC 024. US 042 050. G &amp; S: Blankets, Textile Placemats, [ Handkerchiefs, ] Quilts and Pennants. FIRST USE: 19780600. FIRST USE IN COMMERCE: 19780600

IC 025. US 022 039. G &amp; S: Clothing-Namely, T-Shirts, [ Ties, ] Scarves, Bibs, Sweatshirts, Athletic Shorts, Hats, [ Aprons, ] Jogging Suits and Sweaters. FIRST USE: 19000000. FIRST USE IN COMMERCE: 19000000

IC 028. US 022 023 038 050. G &amp; S: Toy Stuffed Animals, Christmas Decorations, [ Bean Bags, ] Plastic Toys [, Foam Toys and Equipment Sold as a Unit for Playing a Stick Ball Game ]. FIRST USE: 19750600. FIRST USE IN COMMERCE: 19750600

IC 041. US 107. G &amp; S: Providing College Level Educational Programs, Sport Exhibition Events

and Recreation Programs. FIRST USE: 19570701. FIRST USE IN COMMERCE: 19570701

**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 73394200  
**Filing Date** September 29, 1982  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** November 22, 1983  
**Registration Number** 1267035  
**Registration Date** February 14, 1984  
**Owner** (REGISTRANT) Ohio State University; The institution OHIO 190 N. Oval Mall Columbus OHIO 43210  
**Attorney of Record** Samantha M. Quimby  
**Prior Registrations** 1152683  
**Type of Mark** TRADEMARK. SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20140228.  
**Renewal** 2ND RENEWAL 20140228  
**Live/Dead Indicator** LIVE

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**Typed Drawing**

**Word Mark** BUCKEYES  
**Goods and Services** IC 041. US 107. G & S: Providing College Sport Exhibition Events and Recreation Programs. FIRST USE: 18780501. FIRST USE IN COMMERCE: 18780501  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 73042963  
**Filing Date** January 29, 1975  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** September 2, 1975  
**Registration Number** 1152683  
**Registration Date** April 28, 1981  
**Owner** (REGISTRANT) Ohio State University, The institution OHIO 190 N. Oval Dr. Columbus OHIO 43210  
**Attorney of Record** Samantha M. Quimby  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110517.  
**Renewal** 2ND RENEWAL 20110517  
**Live/Dead Indicator** LIVE

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# **EXHIBIT B**



**Buckeye Dollar**

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