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

Proceeding	92053509
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 3,735,435
For the mark UNIVERSITY OF CLEVELAND
Registered: January 5, 2010

Cleveland State University,)	
)	
Petitioner,)	
)	Cancellation No. 92053509
v.)	
)	
CampusEAI Consortium,)	
)	
Registrant.)	
_____)	

PETITIONER CLEVELAND STATE UNIVERSITY’S TRIAL BRIEF

Cleveland State University (“Petitioner” or “CSU”) respectfully requests that the Trademark Trial and Appeal Board (“Board” or “TTAB”) hold that CampusEAI Consortium’s (“Registrant” or “CampusEAI”) U.S. Trademark Registration No. 3,735,435 (the “ ‘435 Registration”) for the word mark UNIVERISTY OF CLEVELAND (“UNIVERSITY OF CLEVELAND Mark”) be cancelled on the Principal Register of the United States Patent and Trademark Office (“USPTO”).

TABLE OF CONTENTS

I.	DESCRIPTION OF THE RECORD	5
A.	Testimonial Depositions and Exhibits	5
B.	Petitioner’s Notice of Reliance Exhibits.....	5
C.	Trademark Registrations	5
II.	STATEMENT OF THE ISSUES.....	6
III.	RECITATION OF THE FACTS	6
A.	Petitioner’s Long-Term Use of Its Famous Marks Under U.S. Trademark Registration Nos. 3,671,697 and 3,694,718	6
B.	Registrant’s U.S. Registration No. 3,735,435.....	13
C.	Registrant Has Never Used the UNIVERSITY OF CLEVELAND Mark in the United States, or, Alternatively Has Abandoned the UNIVERSITY OF CLEVELAND Mark.....	13
IV.	ARGUMENT.....	16
A.	Abandonment – Legal Standards	16
B.	Registrant Has Never Used the UNIVERSITY OF CLEVELAND Mark, or Alternatively, Has Abandoned the Mark	17
1.	Prima Facie Abandonment – Three Years of Nonuse	17
a.	Registrant has no evidence of use of the UNIVERSITY OF CLEVELAND Mark in at least one three year period since October 15, 2005.....	17
b.	Registrant’s non-use and intent not to resume use.....	19
C.	There is Likelihood of Confusion Between the Petitioner’s CLEVELAND STATE UNIVERSITY Mark and Registrant’s UNIVERSITY OF CLEVELAND Mark.....	21
1.	The Similarity or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial Impression	21
2.	The Similarity or Dissimilarity and Nature of the Parties’ Services	22
3.	Trade Channels and Classes of Purchasers.....	24
4.	The Fame of the Prior Mark (Sales, Advertising, Length of Use).....	25
5.	Balance of the DuPont Factors Supports a Likelihood of Confusion of Registrant’s Mark with Petitioner’s Marks.....	32

V. SUMMARY 33

INDEX OF CASES

CASES

<i>Anosh Toufigh v. Persona Parfum Inc.</i> , 95 USPQ2d 1872 (TTAB 2010)	16
<i>Aycock Engineering v. Airflite Inc.</i> , 90 USPQ2d 1301 (Fed. Cir. 2009).....	20
<i>Bose Corp. v. QSC Audio Prods.</i> , 63 USPQ2d 1303 (Fed Cir. 2002).....	25
<i>Citigroup Inc. v. Capital City Bank Group., Inc.</i> , 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)	21, 24
<i>Coach Services Inc. v. Triumph Learning LLC</i> , 101 USPQ2d 1713 (Fed. Cir. 2012).....	25, 32
<i>Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.</i> , 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992)	24
<i>Hewlett-Packard Co. v. Packard Press, Inc.</i> , 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)	24
<i>Imperial Tobacco Ltd. v. Phillip Morris Inc.</i> , 14 USPQ2d 1390 (Fed. Cir. 1990).....	16, 17
<i>In re Dixie Restaurants Inc.</i> , 41 USPQ2d 1531 (Fed. Cir. 1997).....	21, 22
<i>In re E. I. du Pont de Nemours & Co.</i> , 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).....	21
<i>In re Majestic Distilling Co., Inc.</i> , 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003)	21
<i>In re Shell Oil</i> , 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993)	32
<i>Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC</i> , 82 USPQ2d 1901 (TTAB 2007)	25
<i>Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772</i> , 396 F.3d 1369 (Fed. Cir. 2005), 73 USPQ2d 1689	21
<i>Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods</i> , 90 USPQ2d 1389 (TTAB 2007)	16
<i>ShutEmDown Sports, Inc. v. Lacy</i> , 102 USPQ2d 1036 (TTAB 2012)	17, 20
<i>Toro Co. v. ToroHead, Inc.</i> , 61 USPQ2d 1164 (TTAB 2001)	21
<i>UMG Recordings Inc. v. Mattel Inc.</i> , 100 USPQ2d 1868 (TTAB 2011)	22

STATUTES

15 U.S.C. § 1127..... 16, 20
37 CFR § 2.122(d)(1) and (2) 5
Section 45 of the Lanham Act 19

INTRODUCTION

I. DESCRIPTION OF THE RECORD

Petitioner, CSU, has introduced the following evidence into the record.

A. Testimonial Depositions and Exhibits

The testimonial deposition of Robert Spademan, taken on March 14, 2013, including Exhibit Nos. 1 through 6 (“Spademan Tr.” (TTAB Doc. Nos. 19, 20, 21)).

B. Petitioner’s Notice of Reliance Exhibits

A. Registrant’s Responses to Petitioner’s First Set of Interrogatories Nos. 5, 11, 12, 13 and 15, as submitted by Registrant to Petitioner on February 10, 2012, together with the Verification submitted on February 21, 2012.

B. Registrant’s Responses to Petitioner’s First Request for Production of Documents and Things to Registrant, as submitted by Registrant to Petitioner on February 10, 2012, together with the Verification submitted on February 21, 2012.

C. Registrant’s Answers to Petitioner’s First Set of Requests for Admission Nos. 1, 2, 3, 4, 5, 7, 8, 9 and 11.

D1. New York Times article, dated November 21, 2008 found at <http://green.blogs.nytimes.com/2008/11/21/giving-turbines-a-boost-with-curves/>.

D2. New York Times article, dated March 21, 2009 found at http://www.nytimes.com/2009/03/21/sports/ncaabasketball/21wakeforest.html?_r=0.

D3. Excerpt from NPR Internet article dated February 27, 2008 found at <http://www.npr.org/templates/story/story.php?storyId=54941288>.

D4. Harvard Crimson article dated March 23, 1979 found at <http://www.thecrimson.com/article/1979/3/23/scoring-in-cleveland-pcleveland-cleveland-my-friends/>.

D5. People Magazine article dated May 18, 1981 found at <http://www.people.com/people/archive/article/0,,20079307,00.html>.

D6. Columbia News article dated November 8, 2001 found at http://www.columbia.edu/cu/news/01/11/ditson_award.html.

C. Trademark Registrations

Pursuant to 37 CFR § 2.122(d)(1) and (2), Petitioner’s U.S. Trademark Reg. No. 3,671,697 for the word mark CLEVELAND STATE UNIVERSITY and U.S. Trademark Reg. No. 3,694,718 for the composite mark CLEVELAND STATE UNIVERSITY 1964 w/Design are deemed to be of record.

II. STATEMENT OF THE ISSUES

1. Whether Registrant has ever used the UNIVERSITY OF CLEVELAND Mark in connection with the services listed in U.S. Trademark Registration No. 3,735,435 or has abandoned use of the mark.

2. Whether there is a likelihood of confusion between Petitioner's CLEVELAND STATE UNIVERSITY Marks¹ and Registrant's UNIVERSITY OF CLEVELAND Mark.

III. RECITATION OF THE FACTS

A. Petitioner's Long-Term Use of Its Famous Marks Under U.S. Trademark Registration Nos. 3,671,697 and 3,694,718

Petitioner, for many years, and since long prior to any date of first use upon which Registrant can rely, adopted, used and is using the trademarks CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design in connection with, among other things, educational services at the undergraduate and graduate level as well as educational research. TTAB Doc. No. 20, Spademan Tr. at 7-17. This use has been continuous and uninterrupted up to and including the present time. *Id.* at 12-13, 16-17.

Petitioner is the owner of U.S. Trademark Registration No. 3,671,697 (“the ‘697 Registration”) issued August 25, 2009, for the trademark CLEVELAND STATE UNIVERSITY for lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational

¹ Petitioner's word mark CLEVELAND STATE UNIVERSITY and composite mark CLEVELAND STATE UNIVERSITY 1964 w/Design are referred to collectively as the “CLEVELAND STATE UNIVERSITY Marks.”

research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals in International Class 41. TTAB Doc. No. 20, Spademan Tr. Ex. 2.

This registration is valid, subsisting, unrevoked and uncanceled. TTAB Doc. No. 1, Petition to Cancel Ex. A. The following testimony of Robert Spademan, Assistant Vice-President, Marketing, Cleveland State University, evidences Petitioner's use of the CLEVELAND STATE UNIVERSITY Mark with respect to each of the registered services:

Q. So we're going to start with lending libraries

A. The university has several libraries on its campus, and these libraries are identified as Cleveland State University facilities

Q. And how are then identified as such?

A. There is signage both inside and outside the various facilities...

TTAB Doc. No. 19, Spademan Tr. at 8.

Q. The next service is publication of books. How does Cleveland State University use the Cleveland State University mark in connection with those services?

A. In terms of materials that are taken from the library, they're all identified as Property of Cleveland State University.

Q. The next service is publication of electronic books and journals on-line.

A. Again, anything that is published by our teachers, our professors, is identified as Cleveland State University material.

Q. And how is that done?

A. Through the use of our trademark logo and name, and depending on the publication, that can vary a little bit, but generally speaking, it's fairly prominent.

Q. The next services identified in Registration Number 3,671,697 are educational services, namely providing courses at the undergraduate and graduate university level and distributing course materials therewith. How is the Cleveland State University mark used in connection with these services?

A. So for these items, Cleveland State University is again labeled on all the materials, starting with the course catalogues that describe the individual courses as being Cleveland State University courses, and materials that might be used in the classrooms. For example, syllabus given out by the teacher would always identify that particular individual course as a Cleveland State University course...

Id. at 8-9.

- Q. There's also reference in these services to educational research. How does Cleveland State University use the Cleveland State University mark in connection with these services?
- A. So in the case of research materials, when a professor publishes an article on some research he or she has accomplished, those kinds of things are always identified as Cleveland State University in the various journals that they would appear in.
- Q. And there's also a reference in this statement of services to entertainment services, namely arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals. How is the Cleveland State University Mark used in connection with these services?
- A. Certainly all athletic events are identified as Cleveland State University events. It's the Cleveland State University basketball game that night, and on all of our – in the arts area where we have very vibrant programs, these productions are always identified as "Produced by and presented by Cleveland State University."
- Q. When you say "arts area," namely what are you referring to?
- A. Namely theater, dance and art itself are the three main components of that arts campus...

Id. at 11-12.

Petitioner is also the owner of U.S. Trademark Registration No. 3,694,718 ("718 Registration"), for the trademark CLEVELAND STATE UNIVERSITY 1964 w/Design for lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals in International Class 41. TTAB Doc. No. 20, Spademan Tr. Ex. 3.

This registration is valid, subsisting, unrevoked, and uncanceled. *See* TTAB Doc. No. 1
Petition to Cancel Ex. B. Mr. Spademan likewise testified concerning the use of Petitioner's
CLEVELAND STATE UNIVERSITY 1964 w/Design Mark in connection with each of the
delineated services:

- Q. Are these services used in connection with the seal used in the same manner as you've --
- A. Yes.
- Q. -- previously described?
- A. Yes.
- Q. And would you describe generally just how the seal is used by Cleveland State University in connection with its services?
- A. The seal is probably the most common identifier for the university on many materials and activities that it issues and publishes and presents for these kinds of activities.

TTAB Doc. No. 19, Spademan Tr. at 14-15.

Petitioner has continuously used its distinctive CLEVELAND STATE UNIVERSITY Mark in connection with the services covered by the '697 Registration since at least as early as 1964.

- Q. Do you see underneath that a First Use 1964?
- A. Yes
- Q. And In Commerce 1964?
- A. Yes.
- Q. Is that a correct First Use Date for the use of the Cleveland State University mark for these services?
- A. Yes.
- Q. And how do you know that?
- A. The university was established on the first day of 1964 by the State of Ohio, and I have personally seen the documents in our -- with our archivist in the library that are housed there that speak to that beginning of Cleveland State University.

Id. at 12-13.

- Q. Now, going back to Petitioner Exhibit Number 2 and the Cleveland State University word mark registration, has the use of that mark been continuous since 1964?
- A. Yes.

Q. And how do you know that?

A. Again, the archivist maintains a library of materials and records, and this is everything from yearbooks to student newspapers, to documents from various Presidents and so forth over the history of the university, and so he's got materials that substantiate that use from the beginning of time onward.

Id. at 16.

Petitioner has continuously used its distinctive CLEVELAND STATE UNIVERSITY 1964 w/Design Mark in connection with the services covered by the '718 Registration since at least as early as 1965.

Q. And do you see on Exhibit Number 3 the reference to First Use 1965 and In Commerce 1965?

A. Yes.

Q. Is that a correct date of first use for the seal?

A. Yes.

Q. And how do you know that?

A. I would give you the same answer as before. I have seen artifacts in the archivists office that document the beginnings of the university.

Id. at 15-16.

Q. And looking at Exhibit Number 3, the federal registration for the seal, has the use of the seal registration been continuous since 1965?

A. Yes.

Q. How do you know that?

A. Again, I'd give the same answer, that there is documentation indicating, and I've seen much of this, that this seal has been in use since its original adoption in 1965.

Id. at 16-17.

Petitioner has extensively and prominently advertised and promoted the CLEVELAND STATE UNIVERSITY Marks and the goods and services provided under those Marks throughout the United States. TTAB Doc. No. 19, Spademan Tr. at 20-21, 38-39. Accordingly, the evidence of record aptly demonstrates that the Petitioner has developed substantial and exclusive goodwill and reputation in connection with the term CLEVELAND STATE UNIVERSITY and the goods and services with which the CLEVELAND STATE UNIVERSITY Marks are used.

- Q. And on the following page of that exhibit, up at the top there's a reference to A Campus Reborn. What is that?
- A. This section of the website talks about the physical transformation of our campus over the last decade that adds up to essentially half a billion dollars in investment in new infrastructure on our campus, and this particular photo here shows one of the new buildings that is part of that rebuilding of our campus.
- Q. How is the Cleveland State University Trademark used in connection with these buildings?
- A. All of these buildings are plainly identified as Cleveland State University Facilities
- Q. Are both the seal and the Cleveland State University word mark used in connection with these buildings?
- A. Yes...

TTAB Doc. No. 19, Spademan Tr. at 20-21.

- Q. Are the Cleveland State University word mark and seal subject to any licensing agreements?
- A. Yes.
- Q. Do you know approximately how many?
- A. Not a finite number, but I would have to say it's a lot. I would say it's more than 50 when you look at the number of people that are involved in that area.
- Q. Could you describe the various goods that are the subject of these licensing agreements?
- A. One of the biggest goods associated with us, of course, is apparel. People like to show their school spirit and their allegiance to their school. So our bookstore, for example, sells everything from scarves to gloves, to socks, to dress shirts, to jackets, to sweatshirts, to hoodies, t-shirts, running shorts and sweatpants and so forth, and other items would be desk office type items, school spirit items like pennants, those kind of things, materials, notepads, notebooks, those kind of things that are identified as Cleveland State University.

Id. at 38-39.

- Q. Skipping the next two pages, there's a reference to Alumni & Friends. Do you see that?
- A. Yes
- Q. What is that?
- A. This page is for our alumni. The university has over 100,000 graduates since its inception in 1965, and this page is a portal, if you will, for alumni of the university to connect with the university, to attend events, to look for a job, to find out what's going on, and ultimately, we hope they give use some money.

Id. at 35-36.

Petitioner's services under the CLEVELAND STATE UNIVERSITY Marks have received unsolicited national, regional, and local media attention. TTAB Doc. No. 18 Exs. D1-D6.

As a result of these efforts, combined with providing quality education services to hundreds of thousands of students under the CLEVELAND STATE UNIVERSITY Marks, the relevant consuming public has come to recognize CLEVELAND STATE UNIVERSITY as distinguishing Petitioner's services from those of others and the mark has become well-known and famous.

Q. Now, going to the next page of that exhibit, at the bottom of that page you'll see a reference to Enrollment. Would you describe the enrollment profile of Cleveland State University students?

A. The enrollment profile of Cleveland State University is 17,500 students, full-time students, of which, about 6,000 are graduate students and the rest are undergraduates, and in particular, the freshmen class, which is referenced here as being a record this past fall, is 1,550 students joined us in this past fall's incoming class.

TTAB Doc. No. 19, Spademan Tr. at 20.

Q. Mr. Spademan, where do the students from Cleveland State University come from?

A. The bulk of our students come from Cuyahoga County and the five counties surrounding it, but about 12 percent of our students come from out of state and another 10 percent come from outside the country.

Q. And what other countries do they come from?

A. The biggest country right now—the top two countries from which our students are coming right now are Saudi Arabia and India.

Q. How about China?

A. China is the third largest group of students.

Id. at 40.

Petitioner has acquired significant and exclusive trademark rights and interest in and to the CLEVELAND STATE UNIVERSITY Marks both under its federal registrations for such trademarks as well as at common law for rights in and to such marks in association with educational services at the undergraduate and graduate level, as well as educational research.

B. Registrant’s U.S. Registration No. 3,735,435

The UNIVERSITY OF CLEVELAND Mark filed with the U.S. Patent and Trademark Office on October 16, 2008, was registered on the Supplemental Register on January 5, 2010. Registrant’s U.S. Registration for the UNIVERSITY OF CLEVELAND Mark issued as the ‘435 Registration based on use in commerce at least as early as September 20, 2005. *See* Registration Certificate No. 3,735,435, TTAB Doc. No. 21, Spademan Tr. Ex. 5. The ‘435 Registration recites use of the UNIVERSITY OF CLEVELAND Mark in connection with “educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology” in International Class 41, having an express statement of use in commerce at least as early as September 20, 2005. *See Id.*

C. Registrant Has Never Used the UNIVERSITY OF CLEVELAND Mark in the United States, or, Alternatively Has Abandoned the UNIVERSITY OF CLEVELAND Mark

Registrant admitted in responses to interrogatories that it has never used the UNIVERSITY OF CLEVELAND Mark in the United States in connection with “certificate online and/or onsite programs for IT” or the services identified in the ‘435 Registration. Support for this proposition is found in Registrant’s own Responses to Petitioner’s First Set of Petitioner’s Interrogatories. TTAB Doc. No. 18, Petitioner’s Notice of Reliance, Ex. A. In particular, the following Responses to Petitioner’s First Set of Interrogatories show that Registrant does not provide the services identified in the ‘435 Registration in commerce in the United States in association with the UNIVERSITY OF CLEVELAND Mark:

INTERROGATORY NO. 5:

Please identify all Services offered by Registrant under Registrant’s Mark.

RESPONSE:

Certificate online and/or onsite programs for IT.

INTERROGATORY NO. 11:

Identify all documents that bear Registrant’s Mark which are viewed by customers or prospective customers of Registrant’s Services, Goods, or Products.

RESPONSE:

None.

INTERROGATORY NO. 12:

Identify the types of consumers to whom Registrant's Services, Goods, or Products are offered under Registrant's Mark.

RESPONSE:

Persons seeking education or training in the IT space.

INTERROGATORY NO. 13:

For each of the Services identified in response to Interrogatory No. 5, please state the total revenue derived from providing such Services.

RESPONSE:

0.

INTERROGATORY NO. 15:

For each of the Services identified in response to Interrogatory No. 5, please identify the geographic area (by city and/or state) in which such Services have been offered, provided, and/or sold.

RESPONSE:

India.

Registrant's responses to the above identified Interrogatories were verified on February 21, 2012, in the Verification signed by Registrant. TTAB Doc. No. 18, Petitioner's Notice of Reliance Ex. A.

Registrant's non-use of the UNIVERSITY OF CLEVELAND Mark is further evidenced by its Responses to Petitioner's First Request for Production of Documents and Things, as submitted by Registrant to Petitioner on February 10, 2012, along with the Verification submitted on February 21, 2012. TTAB Doc. No. 18, Petitioner's Notice of Reliance, Ex. B. Petitioner requested documents from Registrant, including all documents or things referring to, relating to and/or concerning the services offered by Registrant under its UNIVERSITY OF CLEVELAND Mark, including evidence of dates of first use for each such service, sales records, and documents relating to the federal registration of the mark. Registrant's responses to those requests - and all of the requests contained in Petitioner's requests for documents for that matter—were “[t]here are no responsive documents.” Registrant has, therefore, proffered no evidence of any actual use of the UNIVERSITY OF CLEVELAND Mark as demonstrated below:

DOCUMENT REQUEST NO. 2:

All documents, things and ESI related to the marketing, advertising, offer of sale, use, and/or promotion of the Services, Goods, or Products under Registrant's Mark by or on behalf of Registrant.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 3:

Representative samples of advertisements, promotional materials, packaging, labeling or other materials or documents, things and ESI bearing Registrant's Mark.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 5:

Representative invoices for sales of each Product, Good or Service for each year Registrant's Mark has been used in connection therewith

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 8:

Copies of all documents that bear Registrant's Mark which are viewed by customers or prospective customers of Registrant.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 12:

All documents related to the use of Registrant's Mark in association with Registrant's Services, Goods, or Products.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 13:

All documents that report on, describe, refer to, and/or relate to Registrant's use of Registrant's Mark.

RESPONSE:

There are no responsive documents

DOCUMENT REQUEST NO. 16:

All documents which Registrant will rely upon to establish that Registrant's Mark is currently being used in the United States, including any and all documents showing the Products, Goods, or Services for which the Registrant's Mark is being used by or on behalf of the Registrant.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 18:

All documents that describe, discuss, state, refer to, and/or relate to actual or intended channels of distribution and/or trade for Registrant's Products or Services bearing Registrant's Mark.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 19:

All documents showing Registrant's annual advertising, marketing, and promotional expenses for each Product, Good, or Service related to Registrant's Mark for each year from the date of first use to the present date.

RESPONSE:

There are no responsive documents.

DOCUMENT REQUEST NO. 20:

Representative samples of advertising, marketing, or promotional materials bearing Registrant's Mark.

RESPONSE:

There are no responsive documents.

IV. ARGUMENT

A. Abandonment – Legal Standards

Registered marks enjoy a presumption of validity under the law, therefore a petitioner seeking cancellation on the ground of abandonment “bears the burden of proving a prima facie case of abandonment by a preponderance of the evidence standard.” *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1393 (TTAB 2007).

To prove an abandonment claim, petitioner must prove two elements: “non-use and an intent not to resume use.” *Anosh Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1875 (TTAB 2010). *See also* 15 U.S.C. § 1127 (defining abandonment of a mark as “When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances.”). “The terms ‘use’ and ‘nonuse’ *mean use and nonuse in the United States.*” *Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990). Furthermore, “‘use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and made not merely to reserve a right in a mark.” 15 U.S.C. § 1127.

However, if a petitioner can show three years of nonuse, *prima facie* abandonment is presumed and “the burden shifts to the defendant to show either that it has used the mark, or that it has an intent to resume use.” *Toufigh*, 95 USPQ2d at 1875. *See also* 15 U.S.C. § 1127 (“Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.”).

The Registrant can rely on the filing date of the application to establish use of its mark, and Registrant's filing date also starts the three-year period for Petitioner to make a *prima facie* showing of abandonment. *See ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1042 (TTAB 2012).

B. Registrant Has Never Used the UNIVERSITY OF CLEVELAND Mark, or Alternatively, Has Abandoned the Mark

1. Prima Facie Abandonment – Three Years of Nonuse

Registrant filed its application on October 16, 2008, which is the date Registrant may rely on to establish use of the UNIVERSITY OF CLEVELAND Mark. This filing date also starts the three year period for Petitioner to make its *prima facie* showing of abandonment. If Petitioner can show *prima facie* abandonment, "in effect, the presumption eliminates the [petitioner's] burden to establish the intent element of abandonment as an initial part of its case." *Imperial Tobacco Ltd.*, 14 USPQ2d 1390 at 1393.

a. Registrant has no evidence of use of the UNIVERSITY OF CLEVELAND Mark in at least one three year period since October 15, 2005

Registrant's Verification submitted on February 21, 2012, verified the responses to Petitioner's Interrogatories and Requests for Documents. Verification of these responses serves as an admission thereto. Accordingly, Registrant has admitted that it has never used or, at the very least, has no evidence of use of the UNIVERSITY OF CLEVELAND Mark in connection with any service in the United States.

For example, Petitioner's Interrogatory No. 5 requested identification of "all Services offered by Registrant under Registrant's Mark" to which Registrant replied "Certificate online and/or onsite programs for IT."

Registrant admitted in responses that it does not use the UNIVERSITY OF CLEVELAND Mark in connection with any of these goods or services. Petitioner's Interrogatory No. 11 requested identification of "all documents that bear Registrant's Mark which are viewed by customers or prospective customers of Registrant's Services, Goods, or Products" to which Registrant responded

“None.” Petitioner’s Document Request No. 8 similarly requested “all documents that bear Registrant’s Mark which are viewed by its customers or prospective customers” to which Registrant responded “[t]here are no responsive documents.” Thus, Registrant has admitted that no documents exist on which consumers view its marks.

Petitioner’s Interrogatory No. 12 requested identification of “the types of consumers to whom Registrant’s Services, Goods, or Products are offered under Registrant’s Mark” to which Registrant responded “None.” Petitioner’s Document Request No. 12 similarly requested “[a]ll documents related to the use of Registrant’s Mark in association with Registrant’s Services, Goods or Products” to which Registrant responded “[t]here are no responsive documents.” Thus, Registrant has admitted no consumers view the UNIVERSITY OF CLEVELAND Mark and that there are no documents showing use of the UNIVERSITY OF CLEVELAND Mark on any services, goods or products.

Petitioner’s Interrogatory No. 13 requested “the total revenue derived [by registrant] from providing Services” identified in response to Interrogatory No. 5, to which Registrant responded “0.” Petitioner’s Document Request No. 5 similarly requested “invoices for sales of each Product, Good, or Service for each year Registrant’s Mark has been used in connection therewith” to which Registrant responded “[t]here are no responsive documents.” Thus, Registrant has admitted that there have been no sales of services under the UNIVERSITY OF CLEVELAND Mark in commerce.

Petitioner’s Interrogatory No. 15 requested identification for each service identified in response to Interrogatory No. 5 “the geographic area (by city and/or state) in which such Services have been offered, provided, and/or sold” to which Registrant replied “India.” Petitioner’s Document Request No. 16 similarly requested “All documents which Registrant will rely upon to establish that Registrant’s Mark is currently being used in the United States...” to which Registrant responded “[t]here are no responsive documents.” Thus, Registrant has admitted that there has been *no use of the UNIVERSITY OF CLEVELAND Mark in the United States.*

Furthermore, Registrant has admitted that it does not market, advertise, offer for sale, use and/or promote its services, goods or products allegedly bearing its mark. *See* responses to Petitioner’s Document Request Nos. 2-3. Similarly, Registrant has admitted that it has no evidence of expenses in connection with annual advertising, marketing, or promotional expenses for each product, good, or service related to its mark for each year from the date of first use to the present, nor did Registrant produce any samples of advertising, marketing, or promotional materials bearing its UNIVERSITY OF CLEVELAND mark. *See* responses to Petitioner’s Document Request Nos. 19-20.

Registrant has utterly failed to proffer evidence showing any use of its UNIVERSITY OF CLEVELAND Mark, whether starting from Registrant’s alleged first use in commerce of September 20, 2005 or from the filing date of Registrant’s application on October 16, 2008, or for any period of time thereafter. *See* Petitioner’s Document Request No. 13, requesting “[a]ll documents that report on, describe, refer to, and/or relate to Registrant’s use of Registrant’s Mark” to which Registrant responded “[t]here are no responsive documents.” *See* also Petitioner’s Document Request No. 18, requesting “[a]ll documents that describe, discuss, state, refer to, and/or relate to actual or intended channels of distribution and/or trade for Registrant’s Products or services bearing Registrant’s Mark” to which Registrant responded “[t]here are no responsive documents.” Relying on Registrant’s own admissions and failure to produce evidence, Petitioner has shown at least a three year period of non-use by Registrant, and has thereby rebutted the validity of the ‘435 Registration and has shown abandonment by a preponderance of the evidence.

b. Registrant’s non-use and intent not to resume use

Petitioner has shown based on the aforementioned facts and the entire record, that Registrant has not demonstrated that it has ever used UNIVERSITY OF CLEVELAND as a mark in commerce in connection with the recited services. Section 45 of the Lanham Act defines “use in commerce” as

“the *bona fide* use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be

in use in commerce...on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection the services.”

15 U.S.C. § 1127. Registrant has admitted that it has no documents related to the marketing, advertising, offer for sale, use, and/or promotion of its services. *See* responses to Petitioner’s Document Request Nos. 2-3, 19-20. Furthermore, Registrant has admitted it has not rendered any of its services in commerce as described by Registrant’s application. *See, e.g.*, responses to Petitioner’s Interrogatory Nos. 5, 11-13, 15 and Petitioner’s Request for Documents Nos. 5, 8, 12-13, 16, 18. Therefore, Registrant has not shown use of the UNIVERSITY OF CLEVELAND Mark in commerce. *See Aycock Engineering v. Airflite Inc.*, 90 USPQ2d 1301, 1308 (Fed. Cir. 2009) (stating “the language of [15 U.S.C. § 1127] makes plain that advertisement and actual use of the mark in commerce are required...The mark must be actually used in conjunction with the services described in the application for the mark.”).

Registrant has similarly shown that it has no intent to resume use of the UNIVERSITY OF CLEVELAND Mark. Registrant has failed to provide any evidence to corroborate its alleged use of the UNIVERSITY OF CLEVELAND Mark in commerce. This lack of evidence alone is enough to show that Registrant has no intent to resume use. *See ShutEmDown Sports Inc.*, 102 USPQ2d at 1044 (Board left with no choice but to find no use in commerce and no intention to resume use when respondent failed “to produce any evidence corroborating his responses to petitioner’s discovery requests seeking such evidence.”). Registrant has failed to make use of the UNIVERSITY OF CLEVELAND Mark in association with the services identified in its registration and has shown no intent to resume use of the mark. Therefore, Registrant has abandoned use of the UNIVERSITY OF CLEVELAND Mark with respect to the ‘435 Registration. The ‘435 Registration should thereby be cancelled in its entirety on the ground of abandonment.

C. There is Likelihood of Confusion Between the Petitioner’s CLEVELAND STATE UNIVERSITY Mark and Registrant’s UNIVERSITY OF CLEVELAND Mark

The Board’s determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Group., Inc.*, 637 F.3d 1344 (Fed. Cir. 2011), 98 USPQ2d 1253; *In re Majestic Distilling Co.*, 315 F.3d at 1315; *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1362, 177 USPQ at 567.

1. The Similarity or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial Impression

The Board addresses the *du Pont* factor involving the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *See Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005), 73 USPQ2d 1689; *see also In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567.

Even where the marks at issue are not identical, the Board has found that more weight can be given to the common, dominant portion of the mark. *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1168 (TTAB 2001) (finding the marks “Toro” and “ToroMR” similar in sound and appearance, thus supporting likelihood of confusion, even though use of the marks may have different meanings); *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (finding that because the dominant portion “Delta” of the mark THE DELTA CAFE for restaurants services was identical to the mark DELTA for hotel, motel and restaurant services, the two marks were likely to cause confusion).

Registrant admitted in response to Petitioner's Request for Admission No. 5 that the common portion of Registrant's mark is UNIVERSITY and CLEVELAND. TTAB Doc. No. 18., Petitioner's Notice of Reliance, Ex. C. Petitioner's marks similarly contain both CLEVELAND and UNIVERSITY. Therefore, the common portions of both marks are identical and offer the same appearance, sound, connotation and commercial impression. Moreover, the marks are used in connection with the same services. *See In re Dixie*, 41 USPQ2d at 1534 (citations omitted) (stating that "if the services are identical, 'the degree of similarity necessary to support a conclusion of likely confusion declines.'").

The similarities in appearance, sound, connotation, and commercial impression of the marks supports a finding of likelihood of confusion in favor of the Petitioner.

2. *The Similarity or Dissimilarity and Nature of the Parties' Services*

The Board's likelihood of confusion determination is confined to the identification of the services set forth in the opposed application, as well as those services which Petitioner has identified in Petitioner's pleaded registration(s). *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1884 (TTAB 2011) (citations omitted). Furthermore, "the second *DuPont* factor expressly mandates consideration of the similarity or dissimilarity of the services 'as described in an application or registration.'" *In re Dixie*, 41 USPQ2d at 1534 (citations omitted).

Registrant has admitted in Petitioner's Request for Admission No. 7 that its services "identified in Registration No. 3,735,435 are educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology in International Class 41." TTAB Doc. No. 18, Petitioner's Notice of Reliance, Ex. C.

Petitioner's pleaded registrations identify its services as "lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith;

extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals in International Class 41. TTAB Doc. No. 20, Spademan Tr. Ex. 2, 3. Registrant has admitted in Petitioner's Request for Admission Nos. 8-9 that these are the services identified in Petitioner's Registrations Nos. 3,671,697 and 3,694,718. TTAB Doc. No. 18, Petitioner's Notice of Reliance, Ex. C.

Petitioner provides the same services as those identified in the '435 Registration:

Q. And do you see on that exhibit I've just handed you the services described, the statement of services?

A. Yes.

Q. Would you read those for the record, please?

A. "For educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology in International Class 41."

Q. Does Cleveland State University offer those services?

Mr. DeJohn: Objection.

A. Yes.

Q. And how do you know that?

A. I'm familiar with our programs and we certainly offer both postsecondary and higher education in a number of fields, and particularly one noted here, information technology.

Q. What about seminars, workshops, classes and lectures?

A. Ongoing all the time at the university.

TTAB Doc. No. 19, Spademan Tr. at 41-42. This *DuPont* factor supports a finding of a likelihood of confusion.

3. Trade Channels and Classes of Purchasers.

Absent any limitations in the descriptions of the services in the opposed application, the Board presumes that services travel in the normal trade channels and are offered to the usual classes of purchasers for the respective goods and services. *Citigroup Inc.*, 637 F.3d 1356, 98 USPQ2d 1261; *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

Registrant admitted in response to Petitioner's Requests for Admission Nos. 7-9, 11 that its services identified in the '435 Registration travel in the same channels of trade as those identical services offered by Petitioner under the CLEVELAND STATE UNIVERSITY Marks:

REQUEST NO. 7

Admit that the Services identified in Registration No. 3,735,435 are educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology in International Class 41.

RESPONSE:

Admit

REQUEST NO. 8

Admit that the services identified in Registration No. 3,671,697 for the mark CLEVELAND STATE UNIVERSITY are lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals in International Class 41.

RESPONSE:

Admit

REQUEST NO. 9

Admit that the services identified in Registration No. 3,694,718 for the mark CLEVELAND STATE UNIVERSITY 1964 w/Design are lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the

fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals in International Class 41.

RESPONSE:

Admit

REQUEST NO. 11

Admit that the Services identified in Registration Nos. 3,735,435, 3,671,697, and 3,694,718 travel in the same channels of trade.

RESPONSE:

Addmit (sic)

The record shows that Registrant has not proffered evidence of any actual use of the UNIVERSITY OF CLEVELAND Mark, nor does it show that Registrant sells or provides any services in commerce bearing the UNIVERSITY OF CLEVELAND Mark. However, Registrant has admitted in Petitioner's Request for Admission No. 11 that "the Services identified in Registration Nos. 3,735,435, 3,671,697, and 3,694,718 travel in the same channels of trade." TTAB Doc. No. 18, Petitioner's Notice of Reliance, Ex. C.

This factor favors Petitioner and supports a finding of likelihood of confusion.

4. *The Fame of the Prior Mark (Sales, Advertising, Length of Use)*

The party asserting that its mark is famous has the burden of proof. *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Fame may be inferred by indirect evidence such as the volume of sales, advertising, length of use of the mark, brand awareness, licensing activities, variety of goods/services bearing the mark, and the general reputation of the services. *Bose Corp. v. QSC Audio Prods.*, 63 USPQ2d 1303, 1305 (Fed Cir. 2002); *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012).

Registrant's Answers to Petitioner's First Set of Requests for Admission support the fame of Petitioner's marks for purposes of this *DuPont* factor. TTAB Doc. No. 18, Petitioner's Notice of Reliance, Ex. C. Specifically, Petitioner's Request for Admission Nos. 1-4 show that Registrant

sought registration of the UNIVERSITY OF CLEVELAND Mark with knowledge of Petitioner's CLEVELAND STATE UNIVERSITY Marks.

REQUEST NO. 1

Admit that Registrant filed U.S. Trademark application Serial No. 77/594,292 for the mark UNIVERSITY OF CLEVELAND on October 16, 2008.

RESPONSE:

Admit

REQUEST NO. 2

Admit that Registrant amended application Serial No. 77/594,292 April 1, 2009 to seek registration of the mark UNIVERSITY OF CLEVELAND on the Supplemental Register.

RESPONSE:

Admit

REQUEST NO. 3

Admit that on January 5, 2010, Registration 3,735,435 issued as a U.S. Trademark Registration on the Supplemental Register for the mark UNIVERSITY OF CLEVELAND.

RESPONSE:

Admit

REQUEST NO. 4

Admit that prior to its filing of U.S. Trademark Application Serial No. 77/594,29 October 16, 2008 Registrant was aware of Petitioner's U.S. Trademark Registration Nos. 3,671,697 and 3,694,718 for the marks CLEVELAND STATE UNIVERSITY and CLEVELAND STATE UNIVERSITY 1964 w/Design, respectively.

RESPONSE:

Admit

Moreover, Petitioner has continuously used its mark in connection with the services covered by the '697 Registration since at least as early as 1964:

Q. Do you see underneath that a First Use 1964?

A. Yes

Q. And In Commerce 1964?

A. Yes.

Q. Is that a correct First Use Date for the use of the Cleveland State University mark for these services?

A. Yes.

Q. And how do you know that?

A. The university was established on the first day of 1964 by the State of Ohio, and I have personally seen the documents in our – with our archivist in the

library that are housed there that speak to that beginning of Cleveland State University.

TTAB Doc. No. 19, Spademan Tr. at 12-13

Q. Now, going back to Petitioner Exhibit Number 2 and the Cleveland State University word mark registration, has the use of that mark been continuous since 1964?

A. Yes.

Q. And how do you know that?

A. Again, the archivist maintains a library of materials and records, and this is everything from yearbooks to student newspapers, to documents from various Presidents and so forth over the history of the university, and so he's got materials that substantiate that use from the beginning of time onward.

Id. at 16.

Furthermore, Petitioner has used its mark in connection covered with the services covered by the '718 Registrations since at least as early as 1965:

Q. And do you see on Exhibit Number 3 the reference to First Use 1965 and In Commerce 1965?

A. Yes.

Q. Is that a correct date of first use for the seal?

A. Yes.

Q. And how do you know that?

A. I would give you the same answer as before. I have seen artifacts in the archivists office that document the beginnings of the university.

Id. at 15-16.

Q. And looking at Exhibit Number 3, the federal registration for the seal, has the use of the seal registration been continuous since 1965?

A. Yes.

Q. How do you know that?

A. Again, I'd give the same answer, that there is documentation indicating, and I've seen much of this, that this seal has been in use since its original adoption in 1965.

Id. at 16-17.

Accordingly, the evidence of record establishes that Petitioner has used the CLEVELAND STATE UNIVERSITY Marks for a period of nearly 50 years.

Indeed, throughout this period, Petitioner has extensively and prominently advertised and promoted its marks:

Q. And there's also reference in this statement of services to entertainment services, namely arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals. How is the Cleveland State University mark used in connection with these services?

A. Certainly all athletic events are identified as Cleveland State University events. It's the Cleveland State University basketball game that night, and, on all of our – in the arts area where we have very vibrant programs, these productions are always identified as “Produced by and presented by Cleveland State University.”

Id. at 11-12.

Q. ...There's also reference on that page to Athletics. What is that?

A. This speaks to the fact that Cleveland State University plays Division I sports, and we have a number of men's and women's teams, of course, and that their seasons run throughout the school year and even into the summer in some cases, and in fact, our men's and women's swimming and diving team just won the Horizon League Championship, which is the athletic league that we play in.

Id. at 29.

Q. And on the following page of that exhibit, up at the top there's a reference to A Campus Reborn. What is that?

A. This section of the website talks about the physical transformation of our campus over the last decade that adds up to essentially half a billion dollars in investment in new infrastructure on our campus, and this particular photo here shows one of the new buildings that is part of that rebuilding of our campus.

Q. How is the Cleveland State University Trademark used in connection with these buildings?

A. All of these buildings are plainly identified as Cleveland State University Facilities

Q. Are both the seal and the Cleveland State University word mark used in connection with these buildings?

A. Yes.

Id. at 20-21

Q. There's also reference here to Arts Campus. What is that?

A. The Arts Campus at Cleveland State University is one of the more recent investments we've made and includes a project with the Allen Theatre that we did with both Playhouse Square and Cleveland Playhouse to renovate the

Allen Theatre and break it into three different theater units, and we share the 52 weeks of the year with those two other organizations for producing productions by our theater department at Cleveland State University...

Id. at 22-23.

- Q. Turning to the next page of that exhibit, do you see the photo at the top of that page?
- A. ...This is the permanent marquis at the entrance to the Allen Theatre, and again, we share this facility with the Cleveland Playhouse, so their trademark is on the top and our seal and name is on the bottom.
- Q. And on this page there's also a reference to NEOMED campus at CSU. What is that?
- A. NEOMED is a medical school down in Rootstown, and we have partnered with them and developed a program for students at Cleveland State who can stay at Cleveland State and go on and become doctors, and this is done through establishing a physical campus of NEOMED at Cleveland State University. So it remains their name on the program, but our students attend it in our facilities.

Id. at 23-24.

- Q. Would you describe the various recruiting activities that you have at the university?
- A. Our admissions team works both out and in the precincts, if you will, by visiting high schools. Starting in the fall, there's a lot of travel out there. We attend college fairs, we produce specific college nights at high schools that would have a lot of Cleveland State University interested students who could be admitted on the spot. We produce a number of events on the campus, including one coming up on April 6th called our Spring Open House. Last year that event drew 2,500 visitors to the campus to sample Cleveland State University and all of its offerings and departments to talk to, and then, of course, there's a lot of one-on-one activity with our admissions counselors after they learn of somebody's interest to talk to them, maybe have them come in a visit us and attend a class, talk to an advisor, someone in the academic end of things to learn more about the university.
- Q. How is the Cleveland State University mark and seal used in connection with these recruiting activities?
- A. The university's mark is on all of the materials that we use when doing these activities, including our admissions counselors wear apparel items that identify themselves as Cleveland State University, and everyone wears in that group a name badge that has the seal on it and their name on it every single day.

Id. at 32-34.

- Q. And going to the next page, Office of Technology Transfer, what is that?

- A. This page deals with – just as it says, the transfer a technology that is developed by our professors to the real world, and a great example of this is Texas Instruments bought some motion control technology that one of our engineering professors developed that adjusts the motion of different machinery during the manufacturing process to keep everything running smoothly. So this office deals with marrying those two items up and producing – ultimately producing revenue for the university.
- Q. How is the Cleveland State University mark and seal used in connection with these types of services?
- A. All of these materials used in this office are identified as Cleveland State University.

Id. at 36-37.

- Q. How does Cleveland State University market the Cleveland State University mark and seal?
- A. We have two campaigns that we run. One is focused on recruitment, and that, of course, is recruiting students to the university, so that's a specific target demographic, and then the other campaign we run is what we call our brand campaign, and that particular campaign is targeted to a broader audience but with interest focused on potential donors, opinion leaders, community leaders, politicians and that group of people that we want to be aware of what Cleveland State is doing and where we're headed and some of our accomplishments.

Id. at 39-40.

Petitioner has also extensively licensed its marks for use on a variety of goods throughout the period of use of its marks:

- Q. Are the Cleveland State University word mark and seal subject to any licensing agreements?
- A. Yes.
- Q. Do you know approximately how many?
- A. Not a finite number, but I would have to say it's a lot. I would say it's more than 50 when you look at the number of people that are involved in that area.
- Q. Could you describe the various goods that are the subject of these licensing agreements?
- A. One of the biggest goods associated with us, of course, is apparel. People like to show their school spirit and their allegiance to their school. So our bookstore, for example, sells everything from scarves to gloves, to socks, to dress shirts, to jackets, to sweatshirts, to hoodies, t-shirts, running shorts and sweatpants and so forth, and other items would be desk office type items, school spirit items like pennants, those kind of things, materials, notepads, notebooks, those kind of things that are identified as Cleveland State University.

Id. at 38-39.

Petitioner's use of its marks has fostered awareness of the CLEVELAND STATE UNIVERSITY brand:

- Q. Now, going to the next page of that exhibit, at the bottom of that page you'll see a reference to Enrollment. Would you describe the enrollment profile of Cleveland State University students?
- A. The enrollment profile of Cleveland State University is 17,500 students, full-time students, of which, about 6,000 are graduate students and the rest are undergraduates, and in particular, the freshmen class, which is referenced here as being a record this past fall, is 1,550 students joined us in this past fall's incoming class.

Id. at 20.

- Q. Mr. Spademan, where do the students from Cleveland State University come from?
- A. The bulk of our students come from Cuyahoga County and the five counties surrounding it, but about 12 percent of our students come from out of state and another 10 percent come from outside the country.
- Q. And what other countries do they come from?
- A. The biggest country right now -- the top two countries from which our students are coming right now are Saudi Arabia and India.
- Q. How about China?
- A. China is the third largest group of students...

Id. at 40.

- Q. Skipping the next two pages, there's a reference to Alumni & Friends. Do you see that?
- A. Yes
- Q. What is that?
- A. This page is for our alumni. The university has over 100,000 graduates since its inception in 1965, and this page is a portal, if you will, for alumni of the university to connect with the university, to attend events, to look for a job, to find out what's going on, and ultimately, we hope they give use some money.

Id. at 35-36.

Moreover, Petitioner's marks have received unsolicited media attention throughout the period of use of its marks, shown by various internet articles which demonstrate that the mark

CLEVELAND STATE UNIVERSITY is famous and well known through academics, research, arts, athletics and community involvement:

D1 – New York Times article, dated November 21, 2008 found at <http://green.blogs.nytimes.com/2008/11/21/giving-turbines-a-boost-with-curves/>

D2 – New York Times article, dated March 21, 2009 found at http://www.nytimes.com/2009/03/21/sports/ncaabasketball/21wakeforest.html?_r=0

D3 – Excerpt from NPR Internet article dated February 27, 2008 found at <http://www.npr.org/templates/story/story.php?storyId=54941288>

D4 – Harvard Crimson article dated March 23, 1979 found at <http://www.thecrimson.com/article/1979/3/23/scoring-in-cleveland-pcleveland-cleveland-my-friends/>

D5 – People Magazine article dated May 18, 1981 found at <http://www.people.com/people/archive/article/0,,20079307,00.html>

D6 – Columbia News article dated November 8, 2001 found at http://www.columbia.edu/cu/news/01/11/ditson_award.html

TTAB Doc. No. 18. Petitioner’s Notice of Reliance, Exs. D1-D6.

Fame alone cannot establish a likelihood of confusion; however, it “deserves its full measure of weight in assessing likelihood of confusion.” *Coach Services Inc.*, 101 USPQ2d at 1720 (citations omitted). This *DuPont* factor weighs heavily in Petitioner’s favor. *See In re Shell Oil*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (the various *du Pont* factors “may play more or less weighty roles in any particular determination.”).

5. *Balance of the DuPont Factors Supports a Likelihood of Confusion of Registrant’s Mark with Petitioner’s Marks*

Upon consideration of the relevant *DuPont* factors, continued registration of the UNIVERSITY OF CLEVELAND Mark for Registrant’s services will create a likelihood of confusion with Petitioner’s CLEVELAND STATE UNIVERSITY Marks. Not all the factors are necessarily relevant or of equal weight. However, the probative, relevant facts of record in the case at hand support a likelihood of confusion in favor of the Petitioner. The dominant portion of both Petitioner’s and Registrant’s mark(s)—“Cleveland” and “University”—have the same sight, sound, meaning and is/are used in connection with the same services. Furthermore, Registrant has admitted

that Registrant's and Petitioner's services travel in the same channels of trade. Finally, the fame of Petitioner's CLEVELAND STATE UNIVERSITY Marks weighs heavily in favor of Petitioner. Thus, the Board should find that there is likelihood of confusion between Petitioner's CLEVELAND STATE UNIVERSITY Marks and Registrant's UNIVERSITY OF CLEVELAND Mark, and cancel the '345 Registration.

V. SUMMARY

For the foregoing reasons, Petitioner respectfully requests that the Board cancel registration U.S. Registration No. 3,735,435.

Dated: August 30, 2013

Respectfully submitted,

FAY SHARPE LLP

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CERTIFICATE OF SERVICE

I hereby certify that on August 30, 2013, the foregoing **PETITIONER CLEVELAND STATE UNIVERSITY'S TRIAL BRIEF** was filed electronically. Notice of this filing was served by electronic mail on counsel for the Registrant per the agreement of the parties:

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