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

Proceeding	92053509
Party	Defendant CampusEAI Consortium
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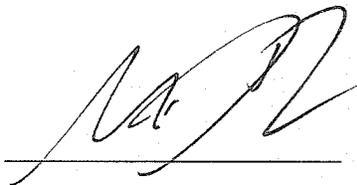
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

Cleveland State University, )  
 )  
 Petitioner, )  
 )  
 v. )  
 )  
 CampusEAI Consortium, )  
 )  
 )  
 Registrant )  
\_\_\_\_\_ )

Cancellation No. 92053509

Commissioner for Trademarks  
ATTN: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451



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Dated: November 05, 2013

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### *Cases*

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*Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373

*Kellog Co. v. Pack 'em Enters.*, 951 F.2d 330,332 - 33,31 U.S.P.Q. 2d 1142, 1144-45  
(Fed. Cir. 1991);

*Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1388, 9 U.S.P.Q.2d 1736, 1739 (Fed.  
Cir.1989).

*Chips 'N Twigs, Inc. v. Chip-Chip, Ltd.*, 190 US.P.Q. 361, 374 (E.D. Pa. 1976)

*American Steel Foundries v. Robertson*, 269 U.S. 372, 46 S. Ct. 160, 70 L. Ed. 317 (1926)

### *Statutes*

15 U.S.C. § 1051(a)(1)

15 U.S.C. § 1127

Trademark Act Section 2(d)

### *Other Authorities*

McCarthy on Trademarks §23:41 (1999)

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

**LEAVE TO FILE REGISTRANT'S REPLY**  
**TO PETITIONER'S TRIAL BRIEF, INSTANTER**

Registrant, CampusEAI Consortium, hereby requests this extension to file Reply to the Petitioner's Trial Brief. Registrant has sought and received ZERO extensions for ZERO days in this matter to date. This request is made in the interest of justice and is not intended for delay.

Further to the Board's decision (mailed on December 20, 2012), the Plaintiff's 15-day Rebuttal Period ended on 7/3/2013. Petitioner filed the Trial Brief on August 30, 2013. Registrant is hereby filing its Reply to the Petitioner's Trial Brief.

Registrant believes that there is good cause established for this request:

- The Registrant's counsel was delayed in meeting and being able to respond to Petitioner's Brief because Arun Kumar Chopra (CFO) had to unexpectedly go to India for work purposes and is still there as of the date of this filing. In addition, Ash Bard (the

other main contact person for Registrant) who is also located in India permanently was traveling and preparing for the EDUCAUSE Annual Conference which happens once in a year. The delay was beyond the reasonable control of the Registrant and would not prejudice the Petitioner in any way. The Registrant is not guilty of negligence or bad faith and has not abused the privilege of extensions.

### **REGISTRANT'S REPLY TO THE PETITIONER'S TRIAL BRIEF**

Registrant hereby replies to the Petitioner's Trial Brief.

#### **Registrant has used the University of Cleveland Mark in commerce and has not abandoned use of the mark.**

Under Section 1(a) of the Trademark Act, a mark may not be registered unless it is "used in commerce." 15 U.S.C. § 1051(a)(1). "The term 'use in commerce' means the *bonafide* use of a mark in the ordinary course of trade ... 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 with the services." 15 U.S.C. § 1127.

The UNIVERSITY OF CLEVELAND Mark was filed with the U.S. Patent and Trademark Office on October 16, 2008 although the First Use date was September 20, 2005. The mark was Published for opposition on November 30, 2009 and was registered on the Supplemental Register on January 5, 2010. The Petitioner has filed Cancellation on January, 2011 (i.e. after more than 2 years of the filing date).

UNIVERSITY OF CLEVELAND Mark has been used 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. The Specimen dated September 20, 2005 filed by the Registrant clearly identifies use of Registrant's mark in the educational services (Appendix 1). Registrant has also produced two documents (LSR and

JDMC) (Dkt # 15, P 14-29) that identifies that University of Cleveland mark has been used in educational services between a U.S. entity and a foreign country.

Further the Board in its decision (mailed on December 20, 2012) (Dkt # 15, P 8 - 9) noted that Registrant has two (2) documents each of which consists of a Memorandum of Understanding between a college located in India and CampusEAI, the exclusive vendor of Respondent, for the provision of information technology training on different short term courses and information technology related programs to be delivered by the faculty appointed by Registrant. The Board further observed that the two memoranda of understanding demonstrates use of Registrant's mark in commerce, i.e., the provision of educational services between a U.S. entity and a foreign country by way of an exclusive vendor. In addition, the following testimony (Registrant's responses to Petitioner's Interrogatories) evidences that Registrant has used the mark in commerce and has not abandoned it (Dkt # 13, P 25 - 43).

**INTERROGATORY NO. 1:**

Please identify each officer and director of the Registrant and describe their respective responsibilities or duties.

**RESPONSE:**

Arun Kumar – CFO. He is responsible for the strategic mission and offerings of the registrant.

**INTERROGATORY NO. 2:**

Please identify each natural person currently or previously employed by Registrant or who works for or has worked for or on behalf of Registrant, who is or was responsible for decisions involving the use, application for registration, protection, or enforcement of the Registrant's Mark by Registrant and describe that person's responsibilities relating to the use, application for registration, protection, or enforcement of the mark.

**RESPONSE:**

Ash Bard – involved in promoting the services and offering of the Registrant

Arun Chopra - involved in promoting the services and offering of the Registrant

**INTERROGATORY NO. 3:**

Please identify all state and federal registrations, applications for registration, trademarks, service marks, trade names, and uses by Registrant that include Registrant's Mark.

**RESPONSE:**

Federal Trademark – The University of Cleveland.

**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. 7:**

For each Service offered by Registrant under Registrant's Mark, please describe in detail the trade channel(s) through which the Services are provided.

**RESPONSE:**

Direct marketing via phone and/or e-mail.

**INTERROGATORY NO. 9:**

Please state all reasons why Registrant selected Registrant's Mark.

**RESPONSE:**

Because the registrant is located in the city of Cleveland.

**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:**

Agreements with the Institutions of Higher Education that provide the offerings of the Registrant.

**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:**

Rs. 2089883/ Lac. (INR)

**INTERROGATORY NO. 14:**

For each of the Services identified in response to Interrogatory No. 5, please state the date of first use in commerce of Registrant's Mark by or on behalf of Registrant on or in association with such Services.

**RESPONSE:**

9/20/05

**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.

**INTERROGATORY NO. 19:**

For each Service, Good, or Product offered by Registrant under Registrant's Mark, please identify all documents upon which Registrant will rely to establish the first use date.

**RESPONSE:**

All documents submitted to the USPTO when applying to for the Mark (see attached) and agreements with LSR and JDMC in India (attached).

**INTERROGATORY NO. 27:**

For each Service, Good, and Product associated with Registrant's Mark, please state the amount expended by Registrant in the United States in connection with the sale, advertising, marketing, promotion, and/or distribution of the Service, Good, or Product for each calendar year since commencement of use of Registrant's Mark.

**RESPONSE:**

The exact number is unable to be calculated. Registrant has employees on staff who also spend time working on other things. Mr. Chopra has an annual salary of 120k a year and spends roughly 20% of his time on this venture. Mr. Bard has an annual salary of INR 10 Lac. and spends approximately 25% of his time on this venture. In addition to these salaries, Registrant has the expenses listed in the LSR and JDMC agreements attached hereto. Other expenses for the cost of the trainers/lecturers have also been attached hereto.

**INTERROGATORY NO. 28:**

For each Service, Good, and Product associated with Registrant's Mark, please state the gross amount of sales by Registrant in the United States for each calendar year since commencement of use of Registrant's Mark.

**RESPONSE:**

Financial Year 2006-7 Rs.133010/

Financial Year 2007-8 Rs.209723/

Financial Year 2008-9 Rs.393750/

Financial Year 2009-10 Rs.499000/

Financial Year- 2010-2011 – Rs. 282200/

Financial Year- 2011-2012 – Rs .571900/

The money derived is paid to CampusEAI subsidiary in India.

**INTERROGATORY NO. 32:**

Please identify representative documents that Registrant presents to customers or potential customers in promoting its Products, Goods, and Services under Registrant's Mark, and describe the circumstances of such presentations.

**RESPONSE:**

See attached (LSR and JDMC contracts). These are the types of documents shared with potential customers.

**INTERROGATORY NO. 35:**

Please state whether or not Registrant currently uses Registrant's Mark.

**RESPONSE:**

Yes.

**INTERROGATORY NO. 37:**

For each interrogatory, please identify all documents which were used (a) to provide the response to the interrogatory or (b) to provide proof of each fact in the response to the interrogatory.

**RESPONSE:**

All documents that were used are attached hereto.

**There is no likelihood of confusion between Petitioner's CLEVELAND STATE UNIVERSITY Marks and Registrant's UNIVERSITY OF CLEVELAND Mark.**

**Likelihood-of-Confusion Factors - *In re E. L DuPont de Nemours & Co.***

The factors to be considered in determining whether there is a likelihood of confusion between two marks include: the similarity or dissimilarity of the marks as to appearance, sound and

commercial impression; the number and nature of similar marks in use on similar goods or services; the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; and the extent of potential confusion, i.e., whether *de minimis* or substantial. *In re E. I DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The application of each of these determinative factors to the present case/cancellation is discussed below.

#### **A. The Similarity or Dissimilarity of the Marks**

In order to evaluate the similarity or dissimilarity of the marks in the present case, it is important to consider the relevant factors of sound, appearance and commercial impression set forth in *In re E. I DuPont de Nemours & Co.*, supra. (i) Sound: There are significant differences in the aural impression of the marks in this case. The marks "University of Cleveland" and "Cleveland State University" are distinctly different with respect to pronunciation as well as appearance. The dissimilarity of the parties' marks by itself justifies a holding that there is no likelihood of confusion. *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374 (Fed. Cir. 1988). It is a cardinal rule that in the comparative analysis, the marks must be compared in their entirety; commonalities should not be dissected out. *See e.g. McCarthy on Trademarks* §23:41 (1999). One factor alone may be dispositive in a likelihood of confusion analysis especially when that single factor is the dissimilarity of the mark. *See, e.g. Kellogg Co. v. Pack 'em Enters.*, 951 F.2d 330, 332- 33, 31 U.S.P.Q. 2d 1142, 1144-45 (Fed. Cir. 1991); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1388, 9 U.S.P.Q.2d 1736, 1739 (Fed. Cir.1989). "[T]here is no rule that confusion is automatically likely if a junior user has a mark that contains in part or whole of another's mark." McCarthy, §23:41.

#### (ii) Meaning/connotation and Commercial Impression:

The marks not only appear and sound different; they also convey different meanings and connotations. The word "State" in the Petitioner's mark is more likely to be remembered by prospective consumers given Petitioner's association and long history with the Cleveland State.

However, the services under Registrant's mark are provided in a foreign country (India), and do not form a sufficient similarity to result in a likelihood of confusion. The differences in the sound and appearance of prospective students of the marks combine to make the overall commercial impression of each mark are very different. Also, the geographical difference in connection to services creates very distinct commercial impressions.

### **B. The Number and Nature of Similar Marks in Use on Similar Goods or Services**

The words "Cleveland" and "University" utilized by the Registrant and Petitioner mark, are widely used in other marks in relevant channels of trade and do not form a sufficient similarity to result in a likelihood of confusion. Also, Petitioner should not be allowed to monopolize the descriptive words in its mark. There are several universities with identical names without any confusion. Some examples of such universities are Miami University and University of Miami; University of Michigan and Michigan State University; Ohio University and the Ohio State University; University of Oklahoma and Oklahoma State University. That list goes on and on.

Courts have held that the "greater the number of identical or more or less similar trademarks already in use on different kinds of goods, the less is the likelihood of confusion." *Chips 'N Twigs, Inc. v. Chip-Chip, Ltd.*, 190 US.P.Q. 361, 374 (E.D. Pa. 1976). Given the widespread and varied use of the letter "Cleveland" and "University" in connection with various types of services in Class 41, it is unlikely that consumers would be confused as to the source of the parties' respective services.

### **C. There Is No Evidence Of Actual Confusion.**

Petitioner also fails to show that there is any evidence of actual confusion between its marks and Registrant's mark. No evidence in the form of a surveyor research into similarity of the looks of the two marks was made in the record.

#### **D. Duration of Concurrent Use Without Any Evidence Of Actual Confusion**

The Registrant's mark University of Cleveland, has been registered for more than 2 years. During this period, Petitioner has never come across a single instance when a person or entity has confused "University of Cleveland " mark. This establishes that the two marks have coexisted long enough without any confusion.

#### **E. Conditions under which and Buyers to whom Sales Are Made**

A factor that is particularly important to consider in the present case is the degree of care exercised by consumers in the relevant channels of trade. In this case, a very high degree of care would be exercised by consumers seeking education services. Given the conditions under which the services would be selected and obtained, it would be highly unlikely that sophisticated consumers or prospective students would have difficulty distinguishing between the two marks. Moreover, the consumers for the Registrant mark are located in entirely different geography (i.e. India).

#### **F. Extent of Potential Confusion**

As stated above, it is most unlikely that consumers in the relevant channels of trade would be confused as to the source of the Petitioner's or the Registrant's services, since the services are of the nature that they would be selected with a great deal of care and typically would be subject to substantial supervision and oversight.

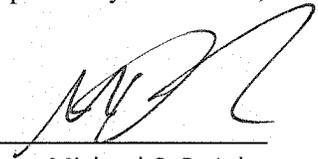
Moreover, it would be virtually impossible for any such confusion - in the unlikely event that any such confusion were to occur - to take place to any meaningful extent. Consumers of the services would have numerous opportunities to review their decisions, and education services, by their very nature, involve a direct and ongoing relationship with the provider of the services that would result in a situation in which anything more than *de minimis* confusion as to the source of the services would be highly unlikely. For this reason, there is no likelihood of any significant confusion for purposes of Trademark Act Section 2(d).

## G. Analysis

Applying the factors set forth above and the requirements of Trademark Act Section 2(d) to the present case, Registrant has established that there is no likelihood of confusion among consumers regarding the source of the respective services to be provided in connection with the registered mark and the Petitioner's mark. There are significant differences between the marks themselves, a crowded field of similar marks used in connection with related and disparate services, conditions in which consumers would consistently exercise a high degree of care in purchasing decisions, and conditions that would minimize the extent of any potential confusion, if it were to occur.

The statutory standard for determining the applicability of Section 2(d) is a likelihood of confusion. 15 U.S.C. § 1052(d). It is well founded principle that likelihood of confusion is equivalent to "probability" of confusion, rather than merely a possibility thereof. *American Steel Foundries v. Robertson*, 269 U.S. 372, 46 S. Ct. 160, 70 L. Ed. 317 (1926). Accordingly, and based on the facts in the present case and the application of the *Dupont* factors to those facts and Registrant's use of the mark in commerce as set forth above, the Registrant's respectfully requests that this Cancellation request be denied.

Respectfully submitted,



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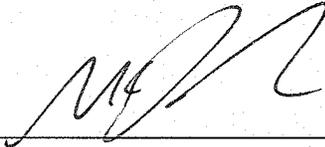
Fax: (216) 589\_9639

*Counsel for Registrant*

Dated: November 6, 2013

**CERTIFICATE OF SERVICE**

I hereby certify that on November 6, 2013, the foregoing **Leave to File Registrant's Reply to Petitioner's Trial Brief, *Instante*** was served via e-mail on counsel for Registrant at [cfgoss@faysharpe.com](mailto:cfgoss@faysharpe.com).



---

Michael C. DeJohn  
*Counsel for Registrant*

# APPENDIX 1

This

# Certificate of Completion

is awarded to

**Tony DiPesa**

for having successfully completed the course

**Building Enterprise Portals**

September 20, 2005



University of Cleveland  
in association with  
CampusEAI Consortium

*Betzi Bateman*  
Betzi Bateman, MLIS