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

Proceeding	92058315
Party	Defendant M22, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

State of Michigan

Petitioner,

Proceeding No: 92058315

v.

M22, LLC,

Registrant.

REGISTRANT'S COMBINED MOTION AND BRIEF IN SUPPORT IN RESPONSE TO PETITIONER'S MOTION FOR PARTIAL SUMMARY JUDGMENT

Registrant, M22, LLC, hereby responds to Petitioner's Motion for Partial Summary Judgment and asserts that genuine issues of material fact remain for trial so as to preclude Petitioner's Motion.

INTRODUCTION

Registrant is M22, LLC ("M22"), a limited liability company organized under the laws of the State of Michigan, which was registered with the State of Michigan on May 19, 2003. M22, LLC is the owner of several registered trademarks[1]. At issue in this matter are the following two marks:

Mark: M 22 M22ONLINE.COM

International Class 025: Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops.

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[1] M22 for use in association with wine (Reg. No. 3427900), M22 for use in association with retail store services (Reg Nos. 3992151 and 3992159), M 22 M22ONLINE.COM for use in association with apparel (Reg. No. 3348635), and THE M-22 CHALLENGE for use in association with athletic competitions (Reg No. 3996410).

First Use In Commerce: January 1, 2004 ("M22 Apparel Mark")

Mark: M22

International Class 035: Retail store services featuring clothing, sporting goods, and novelty items.

First Use In Commerce: November 21, 2007 ("M22 Retail Mark")

(collectively, "M22 Marks" or "Registrant's Marks").

On May 29, 2012, Michigan's Attorney General issued an advisory opinion that stated that no entity could lawfully obtain trademark rights in or to the M-22 sign under trademark law. *See* Michigan Highway Route Marker Design As Trademark, Mich. Att'y Gen. Op. No. 7265, *available at* http://www.ag.state.mi.us/opinion/datafiles/2010s/op10344.htm. State Representative Frank D. Foster initiated the political process leading to this opinion, which began after Registrant discovered that a company within Mr. Foster's jurisdiction was producing counterfeit M22 products and selling them to tourists at her retail store. Subsequent to this discovery, Registrant sent the retail store a notice of infringement, and the retail store subsequently contacted Representative Foster, which ultimately led to the involvement of the Attorney General of Michigan.

On December 3, 2013, the State of Michigan (Petitioner) filed its first of many motions in this case. Petitioner sought to cancel Registrant's Marks under a variety of Lanham Act claims. It is now April of 2016, and both parties have had motions for summary judgment, motions to dismiss, and motions for judgment on the pleadings rejected by this Board on various grounds. Simply put, this proceeding is headed for trial if Petitioner would

let it. Instead, Petitioner has successfully avoided a full discovery process—including, most importantly, Registrant's deposing of Petitioner—by continuing to file motions for partial summary judgment when no facts or law have changed[2]. Registrant now responds to Petitioner's latest motion and asks this Board to, once again, conclude that there are many issues of material fact that need to be bolstered by further discovery and hashed out at trial.

STANDARD OF REVIEW

Like in federal court, the party bringing a motion for summary judgment before the Board has the burden of proving an absence of an issue of material fact, which under the substantive law, would entitle the moving party to judgment as a matter of law. *See Old Grantian Co. v. William Grant & Sons, Ltd.*, 50 U.S.P.Q. 58 (C.C.P.A. 1966). "In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine disputes of material fact to be tried." TBMP § 528 (citing *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994)). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the non-moving party. *See United States Steel Corp. v. Vasco Metals Corp.*, 157 U.S.P.Q. 627 (C.C.P.A. 1968); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992).

FACTS

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[2] Between August 27, 2015, the date on which Petitioner filed its last Motion for Summary Judgment, and March 18, 2016, the date on which Petitioner filed the instant Motion for Summary Judgment, Petitioner has not undertaken any discovery, has not disclosed any new documents, and has repeatedly delayed the deposition of its designee pursuant to Fed. R. Civ. P. 30(b)(6). All facts and evidence attached to Petitioner's Motion were within Petitioner's possession on August 27, 2015 and could have been filed within its initial Partial Motion for Summary Judgment. It is clear that Petitioner has filed this most recent Motion to again delay discovery and needlessly increase the costs of litigation, and Registrant reserves the right to raise this issue with the Board via a separate motion.

M-22 is a Michigan state trunkline highway that originates in the resort community of Traverse City, Michigan and travels the Lake Michigan coastline, including west Grand Traverse Bay and the Sleeping Bear Dunes National Lakeshore, until its termination 3 miles north of Manistee, Michigan. This area of Michigan has long served as a coastal retreat for Chicago and Detroit residents and was recently named "Most Beautiful Place in America" by ABC News. *See* "Sleeping Bear Dunes Voted 'Most Beautiful Place in America,'" ABC News (2011), *available at* http://abcnews.go.com/Travel/best_places_USA/sleeping-bear-dunes-michigan-voted-good-morning-americas/story?id=14319616. Additionally, this area is home to a variety of cultural and recreational activities, including sailing, surfing, fly-fishing, kayaking, skiing, kiteboarding, numerous wineries and microbreweries, Michael Moore's Traverse City Film Festival, and the National Cherry Festival.

Since as early as 2003, Registrant M22, through its predecessor in interest Broneah, Inc., has sold a variety of goods, including apparel and wine, bearing the M22 Marks. Registrant has become widely known across the United States for its M22 brand, which has achieved wide popularity and notoriety within the kiteboarding industry and with millions of tourists from across the world who have visited northwestern Michigan and consider the area one of scenic beauty and relaxation. In short, M22 is not just a road, it is a way of life.[3] *See* **Exhibit B**, Screenshots from M22's Facebook Page.

From 2003 to 2007, Registrant primarily sold its goods through retailers within the State of Michigan. In November of 2007, however, Registrant opened its first retail store

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[3] As expressed by Registrant's own website:

> The more people talked to us, the more we realized M22 wasn't just about our passion. For us, it meant kiting: wind, waves, uncrowded water. But for others, it could mean anything from a killer campsite, an unmarked trail, a childhood memory, or an escape. Everyone had a different story. It was then we realized that we were definitely part of something bigger than just us. M22 was a shared experience that belonged to everyone.

See "Our Story," M22.com (Last visited: April 4, 2016), *available at* http://www.m22.com/our-story-2/.

located at 125 E. Front Street in the primary tourist-shopping district of Traverse City, Michigan. Since opening its retail store in 2007, Registrant has expanded the sale of its apparel to over 50 distributors in major Michigan cities, including in college towns such as East Lansing, Michigan, home of Michigan State University. Registrant has become so well-known and respected within the State of Michigan that it was awarded the coveted "Michigan 50 Companies to Watch" award by Governor Rick Snyder in 2013. *See* "Michigan Celebrates Small Business," Michigan Small Business and Technology Development Center (2013), *available at* http://www.michigancelebrates.biz/past-winners/2013-mcsb-award-winners/. Registrant has also been recognized by the State of Michigan on its "Pure Michigan" website, which is a campaign intended to tout the benefits of doing business in the State of Michigan. *See* "Featured Michigan Businesses," Pure Michigan (Last Visited: April 10, 2016), *available at* http://www.michiganbusiness.org/home-slides/#906technologies.

ARGUMENT

As the movant for summary judgment, Petitioner has the burden to prove that there exist no issues of material fact relating to its two claims and that therefore it is entitled to judgment as a matter of law. Petitioner has failed to do so, and Registrant asks this Board to reject both of Petitioner's claims, deny its Motion for Summary Judgment in full, and allow this proceeding to continue through discovery.

I. The State of Michigan's state route highway marker is not an emblem of authority and is therefore not barred from registration by Section 2(b).

Petitioner first urges this Board to cancel Registrant's mark pursuant to Section 2(b) of the Lanham Act because the M22 highway route marker represents an "emblem of governmental authority" and is therefore considered "other insignia" under Section 2(b). But the State of Michigan's state route highway marker is not an emblem of authority because it

is primarily a functional device used to identify a facility of the State of Michigan, namely, the State's highway system. At the very least, there is a question of fact regarding how authoritative road signs are in conveying state authority.

Section 2(b) of the Lanham Act bars the registration of any mark that "[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." 15 U.S.C. § 1052. As analyzed in *In Re United States Dep't of the Interior*, the "other insignia" language of Section 2(b) should be read very narrowly. 142 U.S.P.Q. (BNA) ¶ 506 (P.T.O. Sept. 10, 1964). According to the Board, any mark that does not fit into the "general class" of flags or coats of arms is not barred by Section 2(b). *Id.* While the Board dictated that other "insignia of national authority" should be barred by Section 2(b), it limited that statement by providing three examples of marks that represent such expansive authority: (1) the Great Seal of the United States, (2) the Presidential Seal, and (3) seals of government departments. *Id.* All three of these marks are solely functional in that they only serve as indicators of governmental authority.

Using the Board's decision in *In re Dep't of the Interior* and other Section 2(b) cases, the Trademark Manual of Examining Procedure (TMEP) has created a list of marks that have been held *not* to represent "emblems of national authority" under Section 2(b). TMEP § 1204.02(c). These marks include the U.S. Army logo, the logo of the Los Angeles Police Department, and the Statute of Liberty. *Id.*; *see also In Re Brumberger Co., Inc.*, 200 U.S.P.Q. (BNA) ¶ 475 (P.T.O. Aug. 25, 1978) (holding that "an exact replica of an official United States mail depository box" could not be regarded as an insignia of the United States government under Section 2(b)).

Further, in *Heroes, Inc. v. Boomer Esiason Hero's Found., Inc.*, the United States District Court for the District of Columbia held that the United Sates Capitol Building was not

an emblem of governmental authority and thus not barred by Section 2(b). WL 335807, at *5 (D.D.C. June 6, 1997). The court stated that although "[t]he Capitol building may evoke certain sentiments among members of the public . . . such a message-conveying function—assuming one exists—is incidental to the building's primary function: to provide a place for the legislative branch to carry out its business." *Id.* The court recognized the Board's insistence that "other insignia" must be construed narrowly and to only encompass marks that simply serve to identify government authority, like seals.

Finally, the USPTO has already registered several road signs indicating that Section 2(b) does not consider road signs to represent "other insignia." ROUTE 66 (Reg. No. 4442767), ROUTE 66 TIRE AND RUBBER HOT ROD UHP (Reg. No. 4116123), ROUTE 66 WHEELS (Reg. No. 3959959), PRODUCTIONS 495 (Reg. No. 3989306), INTERSTATE IWS (Reg. No. 4065436), HWY 1 (Reg. No. 4372637), INTERLOCK (Reg. No. 4307988), US-1 (Reg No. 4158699), and HERITAGE ROUTE 23 (Reg. No. 4018569) are all federally registered trademarks featuring road signs. These registrations make clear that marks containing road signs and elements of road signs do not constitute insignia of governmental authority.

A. The state route highway marker is mainly functional

The State of Michigan's state route highway marker does not constitute "other insignia" under Section 2(b) because the marker is not an emblem of governmental authority. *See In Re United States Dep't of the Interior*, 142 U.S.P.Q. (BNA) ¶ 506. First, the state route highway marker functions primarily as route guidance, not as an indicator of state authority. The Board, TMEP, and existing case law make clear that the term "other insignia" must be construed narrowly. This has resulted in multiple decisions to the effect that marks that represent more than just an indication of state authority are not barred by

Section 2(b). *Id.*; *Heroes, Inc. v. Boomer Esiason Hero's Found., Inc.*, WL 335807, at *5; *In Re Brumberger Co., Inc.*, 200 U.S.P.Q. (BNA) ¶ 475.

The State of Michigan's state route highway marker does much more than simply indicate the State of Michigan's authority. It identifies the road on which drivers drive, or prospective drivers hope to drive when looking at a map or directions. When drivers see the M22 road sign, they identify the sign with geopolitical guidance, not with state ownership of the road. This is further supported by the USPTO's repeated practice of registering road signs as marks.

At the very least, there is a genuine issue of material fact as to the authoritative versus functional components of the state route highway marker in this case. See **Exhibit E**, Declaration of Matt Myers (stating that Registrant has been consistently denied an opportunity to depose Petitioner's designee on this issue). Petitioner relies on a lengthy discussion of its "requirement" to create and use road signs pursuant to state and federal law[4] to argue that its route highway marker is, without dispute, an emblem of state authority. **Exhibit A**, at 3-5. But Section 2(b) does not bar marks that governments have the authority to use; it bars marks that solely represent governmental authority, such as seals. Just because Petitioner claims that the State has the authority to create and use road signs, does not make such signs emblems of state authority. This interpretation would substantially broaden what is to be a very narrow interpretation of Section 2(b).

B. The state route highway marker is a component of a government facility

Further, the State's highway system—including its markers—is akin to a facility, and marks representing state facilities are not barred by Section 2(b). *See In Re United States*

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[4] This argument has already been identified by the Board as consisting of a genuine factual dispute. *See* Board's Denial of Cross-Motions for Summary Judgment (March 9, 2016), dkt. No. 49, at 4 ("At a minimum, genuine disputes of material fact remain as to the legal effect, if any, of the Manual on Uniform Traffic Control Devices (MUTCD), as supplemented [and] whether the provisions of the supplemented MUTCD apply to Registrant.").

Dep't of the Interior, 142 U.S.P.Q. (BNA) ¶ 506 ("[D]epartment insignia which are merely used to identify a service or facility of the Government are not insignia of national authority and . . . do not fall within the general prohibitions of this [Section 2(b)]."). Facility is defined as "something (such as a building or large piece of equipment) that is built for a specific purpose" and "something that makes an action, operation, or activity easier." **Exhibit C**, Merriam Webster. The State's highway system is clearly "something . . . built for a specific purpose," and the state route highway marker itself is "something that makes an . . . activity easier," namely, navigating the State's highway system. In this way, a road sign is much more like a U.S.P.S. box or the Capitol building—it serves as a functional aspect of a state agency or facility, not as just an indication of governmental authority. *See Heroes, Inc. v. Boomer Esiason Hero's Found., Inc.*, WL 335807, at *5; *In Re Brumberger Co., Inc.*, 200 U.S.P.Q. (BNA) ¶ 475.

C. Petitioner has not shown that it is entitled to judgment as a matter of law on its Section 2(b) claim

Petitioner has failed to meet its burden to establish a lack of issues of material fact on its Section 2(b) claim. Petitioner argues that the M22 highway route marker is an "emblem of authority" and thus cannot be registered as a trademark because it constitutes "other insignia" under Section 2(b). This is not the case. The TTAB has consistently held that "other insignia" should be read extremely narrowly, and Petitioner's reading is quite broad. The M22 state highway marker is a functional aspect of a government facility—it is used by motorists and route planners to navigate the expansive state highway system. Such pervasive functionality removes state highway markers from the very narrow class of "other insignia," which features marks that serve the sole purpose of identifying state authority, like seals. At the very least, Petitioner has failed to show that there is no issue of material fact as to the authoritativeness of state highway markers. Its only evidence for such

a proposition is that it is "required" to create and use highway signs pursuant to state and federal regulatory law.

Because Petitioner has failed to show that there are no issues of material fact related to its Section 2(b) claim, this Board should deny Petitioner's Motion for Summary and refuse to cancel Registrant's registered marks at this juncture.

II. M22 is not the personality or persona of Petitioner, and M22 does not uniquely and unmistakably point to Petitioner's personality or persona; therefore, the M22 Marks are not barred by Section 2(a).

Petitioner next urges this Board to cancel Registrant's mark pursuant to Section 2(a) of the Lanham Act because Registrant's use of the M22 mark suggests a false connection with the persona or personality of the State of Michigan, an institution. But Petitioner has not shown a lack of issues of material fact regarding this claim because Registrant's M22 Marks are not the identity or persona of Petitioner or a close approximation thereof. Further, there exists a question of material fact concerning whether or not Registrant's Marks point "uniquely" and "unmistakably" to Petitioner's persona.

Section 2(a) of the Lanham Act prohibits the registration of a trademark where it,

> Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute. . . .

15 U.S.C. § 1052(a). In its seminal case on the "false suggestion of a connection" provision, the Federal Circuit made clear that a person or institution must show it has a "personality" or "persona." *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food, Imports Co., Inc.*, 703 F.2d 1372, 1376-77 (Fed Cir. 1983). The court noted that the "critical requirement" of a false suggestion of a connection claim is that the "name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated" with plaintiff's shown persona or

personality. *Id.*; *see also Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy*, 9204436, 2008 WL 1897568 (TTAB April 22, 2008). According to the Federal Circuit, this "unmistakable" requirement is a very high bar, and the court found against the University because

> "Notre Dame" is not a name *solely* associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus, it cannot be said that the *only* "person" which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.
>
> *Id.* (emphasis added).

Since *Notre Dame*, the Board has continually reaffirmed the height of that bar. *See In Re Wielinski*, 49 U.S.P.Q.2d 1754 (P.T.O. Sept. 24, 1998); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985) ("[a] party acquires a protectable interest in a name (or its equivalent) under Section 2(a) where the name claimed to be appropriated points uniquely and unmistakably to that party's personality or 'persona'"); *In re Kayser-Roth Corp.*, 29 U.S.P.Q.2d 1379, 1385 (T.T.A.B. 1993) (holding that OLYMPIC CHAMPION did not falsely suggest a connection with the persona or identity of the United States Olympic Committee); *In re Midwest Tennis & Track Co.*, 29 U.S.P.Q.2d 1386, 1389 (T.T.A.B. 1993) ("OLYMPIAN GOLDE does not violate § 2(a) because it does not point 'uniquely and unmistakably' to the U.S. Olympic Committee"); *Calvin Klein Indus. Inc.*, 8 U.S.P.Q.2d 1269 (P.T.O. July 21, 1988) ("While opposer has submitted a number of magazine and newspaper articles in which CALVINS and CALVIN are used to refer to opposer, these articles by themselves do not establish that either term is associated *solely* with opposer." (emphasis added)); *In Re White*, 73 U.S.P.Q.2d 1713 (P.T.O. Sept. 8, 2004) ("that the name or an equivalent thereof claimed to be appropriated must be unmistakably associated with a particular personality or

'persona'; and that given the context or circumstances of use, the name must point *uniquely* to the other personality or persona." (quoting *Notre Dame*, at 508-09) (emphasis added)).

A. M22 is not the persona or personality of Petitioner

As in *Notre Dame*, the M22 Marks are not names of the Petitioner and are not solely associated with the Petitioner. As admitted in ¶ 5 of Petitioner's Second Amended Consolidation Petition to Cancel, "the [M22] sign has come to represent and describe the culture of Northern Michigan. That culture is one of recreation and relaxation, vacations, cabins, lakes, Michigan wine, cherry orchards, sand dunes, water sports, skiing, hiking . . . " Dkt. No. 14, pg. 2. Petitioner thus itself admits that the M22 Marks are not a name or a persona solely associated with the State of Michigan. According to Petitioner's own admission, they serve to identify a way of life and, thus, it cannot be said that the only "persona" that the M22 Marks identifies is the State of Michigan. *See Notre Dame*, at 509 ("As the board noted, 'Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus, it cannot be said that the only 'person' which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.").

Petitioner argues that it is an institution with a protectable interest in M22; it does not argue, because it cannot do so legitimately, that it is in fact M22. Instead, Petitioner makes the conclusory claim that its right to use the M22 mark has been violated by Registrant's registration. Petitioner provides no evidence for this claim.[5] Much like its "other insignia" Section 2(a) argument, and without case law to support its proposition, Petitioner now asks this Board to greatly expand the false connection doctrine. *See* 3 McCarthy on Trademarks

[5] It should be noted that Registrant eagerly awaits the opportunity to depose representatives of the State to resolve many of these factual disputes, but the State's continued practice of suspending this proceeding for the past two and a half years has prevented such fact finding.

and Unfair Competition § 19:76 (4th ed.) ("to violate § 2(a), the mark must 'point *uniquely* and *unmistakably*' to that institution" (emphasis added)). Petitioner's argument would allow the State to cancel any mark that encompassed any of its road signs, any of its famous landmarks, and even the shape of the state itself, because all would tangentially suggest a connection with the State. Such an expansion of the doctrine is unwise and flies in the face of the *Notre Dame* decision.

B. M22 does not point uniquely and unmistakably to Petitioner

While purchasers of apparel do not recognize the M22 Marks as the persona or identity of Petitioner, they similarly do not presume that Registrant has a connection with Petitioner. *See Notre Dame*, at 509 ("the [mark] must point uniquely to the other personality or persona."); *In re Wm Distribution Inc.*, 78195284, 2005 WL 2769638 (TTAB Oct. 13, 2005) ("That is, we must determine whether the term SANDIA is of sufficient fame that a connection with the federally recognized tribe 'Pueblo of Sandia, New Mexico' would be presumed by consumers of cigarettes."). Petitioner does not sell apparel bearing the M22 Marks, nor has Petitioner provided evidence that it ever intends to do so. *Id.* ("Cigarettes are everyday consumer goods which are sold in every town and every state in the United States. The fact that tribes are sovereign entities with the power to tax (or allow 'tax-free') goods and/or services is not evidence that consumers presume a connection between this particular Pueblo tribe and cigarettes."); see also **Exhibit D**, P's Response to First Requests to Admit #1 (admitting that Petitioner has never sold goods or services under the M22 Marks).

Petitioner's evidence regarding the relevant connection, pulled from Registrant's Facebook page, itself creates a question of material fact. A reasonable fact finder could see many, even all, of those Facebook posts as signaling a connection between M22 and the culture the brand embodies, as opposed to a connection with the State of Michigan. *See*

M-22 is a Michigan state trunkline highway that originates in the resort community of Traverse City, Michigan and travels the Lake Michigan coastline, including west Grand Traverse Bay and the Sleeping Bear Dunes National Lakeshore, until its termination 3 miles north of Manistee, Michigan. This area of Michigan has long served as a coastal retreat for Chicago and Detroit residents and was recently named "Most Beautiful Place in America" by ABC News. *See* "Sleeping Bear Dunes Voted 'Most Beautiful Place in America,'" ABC News (2011), *available at* http://abcnews.go.com/Travel/best_places_USA/sleeping-bear-dunes-michigan-voted-good-morning-americas/story?id=14319616. Additionally, this area is home to a variety of cultural and recreational activities, including sailing, surfing, fly-fishing, kayaking, skiing, kiteboarding, numerous wineries and microbreweries, Michael Moore's Traverse City Film Festival, and the National Cherry Festival.

Since as early as 2003, Registrant M22, through its predecessor in interest Broneah, Inc., has sold a variety of goods, including apparel and wine, bearing the M22 Marks. Registrant has become widely known across the United States for its M22 brand, which has achieved wide popularity and notoriety within the kiteboarding industry and with millions of tourists from across the world who have visited northwestern Michigan and consider the area one of scenic beauty and relaxation. In short, M22 is not just a road, it is a way of life.[3] *See* **Exhibit B**, Screenshots from M22's Facebook Page.

From 2003 to 2007, Registrant primarily sold its goods through retailers within the State of Michigan. In November of 2007, however, Registrant opened its first retail store

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[3] As expressed by Registrant's own website:

> The more people talked to us, the more we realized M22 wasn't just about our passion. For us, it meant kiting: wind, waves, uncrowded water. But for others, it could mean anything from a killer campsite, an unmarked trail, a childhood memory, or an escape. Everyone had a different story. It was then we realized that we were definitely part of something bigger than just us. M22 was a shared experience that belonged to everyone.

See "Our Story," M22.com (Last visited: April 4, 2016), *available at* http://www.m22.com/our-story-2/.

Because Petitioner has failed to show that there are no issues of material facts related to its Section 2(a) claim, this Board should deny Petitioner's Motion for Summary Judgment and refuse to cancel Registrant's registered marks at this juncture.

III. The Board has the authority to grant summary judgment in favor of Registrant.

Pursuant to Fed. R. Civ. P. 56(f), after giving notice and a reasonable time to respond, the court may: (1) grant summary judgment for a nonmovant; (2) grant the motion on grounds not raised by a party; or (3) consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute. Registrant previously requested that the Board dismiss Petitioner's claims for cancellation under § 2(b) (insignia) and §2(a) (false suggestion of a connection) on December 23, 2013. See Dkt. #5. The Board denied Registrant's Motion on May 31, 2014, finding that Petitioner had adequately pled those claims. The Board has made clear that it believes that discovery should proceed in this matter and that genuine issues of material fact remain for trial.

When examining a Motion for Summary Judgment, all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party, in this case, Registrant. *See United States Steel Corp. v. Vasco Metals Corp.*, 157 U.S.P.Q. 627 (C.C.P.A. 1968). Registrant has submitted the Declaration of Matt Myers in support of its opposition to Petitioner's Motion. In his Declaration, Mr. Myers has affirmed that Petitioner has consistently delayed the litigation of this case and has denied Registrant the ability to conduct discovery on Petitioner's claims. This alone can serve as the basis for the Board's denial of Petitioner's Motion.

More importantly, however, even if Petitioner's allegations are taken in the light most favorable to Petitioner, it is clear that Petitioner has no evidence supporting its claim that the M22 sign is an insignia of the State of Michigan or that Registrant has falsely suggested a connection with the State of Michigan. In filing a Motion for Summary Judgment, Petitioner

asks the Board to review all of its evidence and find in its favor—in effect, its filing of such a motion makes a statement to the Board that it has all of the evidence it needs to win on its claims. But Petitioner has no evidence at all. Petitioner has no evidence supporting its position that third parties view the M22 sign as an emblem of governmental authority, and it has no evidence even remotely showing that Petitioner uses the M22 sign as its identity or persona. This evidence, if it were to exist, would be within Petitioner's possession. It simply does not exist.

Registrant respects the Board's decision of May 31, 2014, which denied Registrant's Motion to Dismiss on these issues. In the subsequent two years, however, Petitioner has been unable to identify any evidence supporting its claims. If this is the best Petitioner can do, the Board should carefully review Petitioner's evidence and grant summary judgment in favor of Registrant on these claims because no genuine issues of material fact remain. The Board has an opportunity to exercise its independent ability to limit Petitioner's claims before trial, and it should do so.

CONCLUSION

For the foregoing reasons, Petitioner's Motion for Summary Judgment must be denied.

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CERTIFICATE OF SERVICE

I, Nikki Sunlin, hereby certify that a true and correct copy of the foregoing Response to Petitioner's Motion for Partial Summary Judgment and Brief in Support has been served on counsel for Petitioner, via emailing said copy as the parties have agreed, on April 14, 2016.

/s/ Nikki Sunlin
Nikki Sunlin
REVISION LEGAL, PLLC

EXHIBIT A

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

State of Michigan Petitioner, v. M22, LLC Respondent.	)	Reg. Nos.: 3992159 3348635 Proceeding: 92058315

PETITIONER STATE OF MICHIGAN'S COMBINED MOTION FOR PARTIAL SUMMARY JUDGMENT AND BRIEF IN SUPPORT

Petitioner, State of Michigan (State), by and through its attorneys, Bill Schuette, Attorney General, and Toni L. Harris, Assistant Attorney General, hereby moves for partial summary judgment under Fed. R. Civ. P. 56 on its claims that Respondent's marks at issue in this Proceeding, which are virtually identical to the State's trunkline highway route marker, are not protectable as trademarks under 15 U.S.C. § 1052 because they are in all material respects identical to governmental insignia and falsely suggest a connection with the State of Michigan. Accordingly, Respondent's registrations must be canceled.

In support of its Motion, the State of Michigan states as follows:

INTRODUCTION

The State adopted its distinctive state route design nearly a century ago as an insignia of its authority over state trunkline highways. The State's authority over such highways is established under Michigan law, which, in accordance with federal law, adopts and mandates compliance with the national Manual on Uniform Traffic Control Devices as supplemented by the State with approval by the Federal Highway Administration (FHWA).

Since the early 1970s, the State has continuously used the current sign design, i.e., , which has been incorporated into the MUTCD since it was rewritten by the FHWA in 1971.

The State's sign is a traffic control device in compliance with state and federal law, and the insignia on the device guides travelers and evidences the State's authority over its trunkline highways, as opposed to interstates, U.S. routes, and county roads. The State's sign design does not represent a governmental agency, person, monument, building, or statue. Rather, it is an insignia of governmental authority and, as governmental insignia, it is not eligible for trademark registration under the Lanham Act.

Nevertheless, Respondent registered trademarks on the State's diamond state route design, e.g., and , which are virtually identical to the State's sign and which Respondent uses in the exact same manner that the State uses "M22" in its trunkline road sign design (Serial Nos. 78963038 and 85041051, respectively) (collectively "Marks").

In addition to being an emblem of governmental authority, the State's sign is famously known throughout Michigan and the country as a unique identifier of popular scenic regions and routes winding throughout the State. The regions and routes, commonly denoted by the State's sign design, are well-known and well-loved by inhabitants and visitors alike, and are heavily marketed to attract hundreds of thousands of visitors every year and during every season. Residents and tourists have made an inextricable connection between the State's route marker and their favorite regions of the State, and statements by Respondent and its customers demonstrate that the Marks falsely suggest a connection with the State. As such, the registrations should be canceled.

STANDARD OF REVIEW

In reviewing a motion for summary judgment under Fed. R. Civ. P. 56(c), the Board applies the same standard as the federal courts. *Campbell v. Bassani Mfg.*, 368 Fed. Appx. 133, 134 (Fed. Cir. 2010) (affirming the Board's entry of summary judgment that the mark

was generic and, therefore, not registrable). In other words, summary judgment is appropriate when, drawing all justifiable inferences in the nonmovant's favor, the pleadings, depositions, documents, electronically stored information, interrogatories, admissions, affidavits, or other materials in the record, demonstrate that there are no genuine disputes of material fact and the movant is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56; see also *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

FACTS

A. State and federal law establish the State's authority represented in its diamond design trunkline route marker.

State and federal law require the State to adopt a Manual on Uniform Traffic Control Devices (MUTCD), which has the force and effect of law vis-à-vis (i) incorporation by reference into the Code of Federal Regulations, and (ii) mandatory compliance with the MUTCD, as required under the Michigan Vehicle Code. 23 C.F.R. 655.601(d) , as explained in the State's Motion for Partial Summary Judgment, filed on August 28, 2015, at pp. 5-9; Michigan Compiled Law ("MCL") 257.1 *et seq.*

Section 608 of the Michigan Vehicle Code requires the State to adopt the MUTCD and specifications for a uniform system of traffic-control devices consistent with Michigan Law. MCL 257.608. (Ex. 1.) Under MCL 257.70 and the MUTCD as adopted and supplemented by Michigan, a traffic control device means "all signs, signals, markings, and devices placed or erected by *authority of a public body* or official having jurisdiction *for the purpose of regulating, warning or guiding traffic.*" MCL § 257.70 (emphasis added). (Ex. 2.) The term "traffic control device" includes signs that are advisory in nature, including the State's highway route markers that guide traffic. *See Gorelick v. Dept. of State Highways*, 127 Mich. App. 324, 329-330; 339 N.W.2d 635 (1983) (explaining that a "pass

with care" sign, even if "merely advisory in nature," comes within the definition of a "traffic control device."). (Ex. 3.)

According to the MUTCD adopted and supplemented by the State:

> Guide signs are essential to direct road users along streets and highways, to inform them of intersecting routes, to direct them to cities, towns, villages, or other important destinations, to identify nearby rivers and streams, parks, forests, and historical sites, and generally to give such information as will help them along their way in the most simple, direct manner possible.

(Ex. 4, p. 137, § 2D.02.)

Under MUTCD and Michigan law, the purpose of the State's distinctive diamond shape and stylized lettering is to maintain instant recognition by travelers of the State's authority:

> 12 *Where U.S. or State Route signs are used as components of guide signs, only the distinctive shape of the shield itself and the route numerals within should be used. The rectangular background upon which the distinctive shape of the shield is mounted, such as the black area around the outside of the shields . . . should not be included on the guide sign. Where U.S. or State Route signs are used as components of other signs of non-contrasting background colors, the rectangular background should be used to* [sic] ***so that the recognition of the distinctive shape of the shield can be maintained.***

(Ex. 4, p. 143, bold emphasis added.)

Section 609(a) of the Michigan Vehicle Code requires the State to "place or require to be placed and maintain or require to be maintained such traffic-control devices, *conforming to [the MUTCD]* and specifications, upon all state highways as it shall deem necessary *to indicate and to carry out the provisions* of this chapter or to regulate, warn or guide traffic." (Ex. 1, emphasis added.) Accordingly, the MUTCD has the force and effect of law in Michigan. *Nawrocki v. Macomb Co. Rd. Comm.*, 463 Mich. 143, 181, 615 N.W.2d 702 (2000). (Ex. 5.) Local authorities may not place or maintain any traffic control device on any trunkline highway under the jurisdiction of the State, except with permission by the

State. MCL § 257.609(b). (Ex. 1.) Local authorities and county road commissions must place and maintain traffic control devices on roads under their jurisdiction as they deem necessary and as required by law; however, all such devices must conform to the MUTCD. *Id.*; MCL § 257.610. (Ex. 1.) For example, where a Michigan municipal corporation posted weight restriction signs along a county road and issued traffic citations for violations of an ordinance pursuant to the signs, the Michigan Court of Appeals held that the municipality's posting of the signs was unauthorized and, therefore, violated Michigan law. *Trenton v. County Bd. Of Rd. Comm'rs of Wayne Co.*, 116 Mich. App. 212, 218; 323 N.W.2d 340 (1982). (Ex 6.)

Moreover, any person who, without lawful authority, attempts to or, in fact, does "alter, deface, injure, knock down, or remove any traffic control device . . . or any inscription, shield, *or insignia* thereon, or any part thereof," is in violation of Michigan law. MCL § 257.616. (Ex. 1, emphasis added.) Drivers in Michigan must obey traffic control devices unless otherwise instructed by a police officer. MCL § 257.611 ("The driver of a vehicle or operator of a street car shall not disobey the instructions of a traffic control device placed in accordance with this chapter unless at the time otherwise directed by a police officer.") (Ex. 1.)

These federal and state laws establish the authority accorded to the State and emblemized in its trunkline highway route marker design. Long before Respondent put the route marker design on a t-shirt and other novelty items to espouse a "common passion" for the road and region in Northwest Michigan, the State's distinctive design was and remains widely known and instantly recognized as uniquely identifying the State, and as an insignia of the State and its authority over trunkline routes throughout Michigan.

B. The State developed and adopted its state trunkline route marker design in the early 1900s and has consistently used the diamond design for nearly 100 years to represent the State's authority.

Since the early 1900s, the State of Michigan's standard trunkline route marker design has been the shape of a diamond with a block letter "M" in the upper corner and the route number in the lower corner. (Ex. 7.) In 1913, the State's trunkline highway known as "M-22" was established as the first state trunkline passing through the Michigan counties of Benzie, Leelenau, and Manistee. (Ex. 8, p. 139.) In 1919, Michigan began designating and signing its state trunkline highways using the diamond-shaped design to guide traffic, i.e.,

. (Ex. 7.)

From the early 1970s, when the United States government updated the MUTCD to standardize road signs[1], through the present, the State, with FHWA's approval, has incorporated its diamond-shaped route marker design in the MUTCD by supplement. Over the last four decades, the sign has remained relatively unchanged. (Ex. 7; Ex. 9, 1973 MUTCD, as adopted and supplemented by the State.) Without question, Michigan's trunkline route marker design is unique and easily distinguishable from all other state highway marker designs used in the other 49 states. (Ex. 10.) Further, as explained more fully below, the State has continuously used the unique sign design as an emblem of its authority over state trunkline highways.

In the mid-1980s, the State of Michigan Department of Transportation, in conjunction with then-Michigan First Lady Paula Blanchard acting as an advisor to the Michigan Department of Commerce, devised a route that was designated as the Great Lakes Circle Tour, a scenic road system connecting all of the Great Lakes and the St.

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[1] In 1935, the first Manual on Uniform Traffic Control Devices (MUTCD) was published and approved as an American Standard. (Ex. 11, p. 3.) In 1971, the FHWA began administering the MUTCD and published a rewritten version of the manual. (Ex. 11, p. 3.)

Lawrence River. The M-22 trunkline route, and other trunkline routes demarcated by the same route marker design and applicable route number, were included in the Lake Michigan Circle Tour completed in 1986. (Ex. 12.) Great Lakes Circle Tour signs and Lake Michigan Circle Tour signs are displayed and advertised with the M-22 state trunkline route design. (Ex. 12.)

In 1993, the Michigan Heritage Route Program, created by Public Act 69 of 1993, was established to identify, inventory, protect, enhance, and promote state trunklines and adjacent land with distinctive or unique scenic, cultural, or historic qualities. (Ex. 13.) A Scenic Heritage Route is one with areas of "outstanding natural beauty whose features include, but are not limited to, significant natural features such as vegetation, land form, water, and open areas with exceptional vistas and views that singly or in combination make that area unique and distinct in character." (Ex. 13, MCL 247.951(f).)

By its terms, the intent of Public Act 69 is to provide the State with authority to maintain and enhance the scenic roadways and surrounding areas:[2]

> [E]stablish the state's responsibility for the enhancement and enjoyment of Michigan's scenic, recreational, and historic resources along its roadside by identifying and designating certain portions of the state trunk line highway system as a Pure Michigan byway . . . [and] to provide criteria for the location and length of Pure Michigan byways and adjacent areas requiring continuing and careful coordination of planning, design, construction, maintenance, land use, and development, by state and local agencies as appropriate, to encourage adjacent land use consistent with the intent of the designation.

(Ex. 13, MCL 247.952.)

Under the Act, a Heritage Route is one to which the old adage "getting there is half the fun" applies:

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[2] In 2014, the designation "Scenic Heritage Route" was rebranded as "Pure Michigan Byway." In accordance with MCL 247.957a, the State is in the process of replacing the Scenic Heritage Route signs posted along the M-22 route with a new marker identifying it as a Pure Michigan Byway. (Ex. 13, MCL 247.957a.)

> Certain portions of the state trunkline highway system are so uniquely endowed by natural aesthetic, ecological, environmental, and cultural amenities immediately adjacent to the roadside that their use by a larger percentage of the motoring public, particularly during the recreational season, is for the experience of traveling the road rather than as a route to a destination. . . . The improvement philosophy for these roads is to maintain the essential elements of the road and the area immediately surrounding the road that create its unique character.

(Ex. 13, MCL 247.953.)

In 2001, the State designated approximately 60 miles of the 116-mile M-22 state trunkline route as the M-22 Scenic Heritage Route. (Ex. 14.) In 2015, the M-22 route, denoted by the State's route sign design, was named by USA Today as the "#1 Best Scenic Autumn Drive in the Nation" based on a month-long poll of USA Today readers. (Ex. 15.)

C. Statements by Respondent and its customers confirm that the State's sign is inextricably linked to the State and that the Marks refer to Northwest Michigan.

On August 29, 2006, despite the State's consistent use of the its sign design over the last 100 years, Respondent applied to register a federal trademark on the State's diamond state route design - - with "M22online.com" below the sign in "tiny" print, as described by the Trademark Examiner (Serial No. 78963038). See May 2, 2007 Office Action. The mark was registered on December 4, 2007 without any reference to or consideration by Respondent of the indisputable fact that it is virtually identical to the State's known mark, which had been continuously used by the State as an emblem of its authority for 90 years prior and remained in use at time (Registration No. 3348635).

In May 2010, Respondent filed a second application for registration of a mark - - that the Trademark Examining Attorney determined was used in "exactly the way the Michigan Department of Transportation uses 'M22' in its road signs for this highway" (Serial No. 85041051). Respondent did not dispute the Examiner's finding, but rather made a new claim of acquired distinctiveness. The mark was registered on July 12, 2011, again

without reference to or consideration of the fact that it is identical to the State's known mark, which had been continuously used by the State as an emblem of its authority for nearly 95 years prior and remained in use at time (Registration No. 3992159).

By its own admission, Respondent began selling novelty items advertising the State's route sign design to communicate a "common passion" for Michigan and, in particular, the popular tourist region recognized and known throughout Michigan and the U.S. by reference to the State's route sign, i.e., . (Ex. 16.) According to Respondent, its founders "fell in love with M-22, literally while traveling along M-22 countless times" and "M-22 was created to express a common passion for Northern Michigan." (Ex. 16.) Moreover, comments and support by Respondent and its customers, as shared on Respondent's Facebook page attached at Exhibits 17-22, confirm this shared understanding and recognition that the State's sign design is inextricably linked to the State, and that the Marks are a direct reference to Northwest Michigan:

Exhibit 17 – Strictly Business Article (2011):

> For the brothers, M-22 is a way to express appreciation for the region through comfortable fashion.
>
> "It is easy for people to relate to the road because of its cool location and most People already have an attachment to it – M-22 is a special place for people, good memories."
>
> "The highway is the nicest, most beautiful stretch of road along any fresh water in the world."

Exhibit 18 - M22 Facebook Page (2011)

> "Founded by kiteboarders in search of epic wind and waves, M-22 was created to express a common passion for Northern Michigan."

Exhibit 19 - Comment on photo of M22 on military helmet patch

> Post by Nate Farran – "Great way to represent Michigan in many ways. M22. Thanks for your service."

Exhibit 20 – Facebook post by Lisa Lowery – "Hi Michigan! I just crossed the

Alps and wore my M22 jersey! Missing Michigan." (M22000469)

Exhibit 21 – Facebook post by Lauren Graves Kropf – "Repressing m22 at the Rock and Roll Half Marathon New Orleans. And yes I had someone stop me and tell me they had a house in Leeland."

Exhibit 22 - Comments on M22 Facebook page and wall photos of northern Michigan

(a) Post by Don Bandemer - "How cool ! I just wish he and all the rest of our men were back home to enjoy M22 and the holidays." (M22000493)

(b) Post by Vanessa Rogers-Bisard – "Where I grew up.....from Onekama to Sleeping Dunes...." (M22000494)

(c) Post by Jayme Sue – "Crazy to walk down the street of Flagstaff AZ to see someone wearing a M22 shirt and got it as a gift from his parents. Made my day brighter to see a piece of home:)" (M22000498)

(d) Post by M22 (Respondent) - "Can you help us write a caption for this Jason Hamelin photo shot off of M22?" (M22000499, see photo of area in Michigan)

(e) Post by M22 (Respondent) – "Video from our friends Leelanau Conservancy showing why M22 is just as good in the winter." (M22000499-500, see photo of area in Michigan; see also Response Post by Steven O'Connor – I will be back up north in 4 days.....i can't wait!!!)

(f) Post by Keenan Ke – "I saw an M22 sticker today in Belleview, Fl. It was the highlight of my day and I cannot wait to be back there in July!" (M22000500)

(g) Post by Sue Gizinski Katona – "A Fall Color Tour on M22" (M22000501, see photo of area in Michigan; see also (M22000503-504))

(h) Post by Danielle Russell – "Pierport near Arcadia" (M22000502, see photo of area in Michigan; see also (M22000503, Sleeping Bear Dunes))

(i) Post by M22 (Respondent) – "Does it get any better, anywhere? M22 SBP" (M22000503, see photo of area in Michigan)

(j) Post by Crystal River Outfitters announcing a new store – "This store will offer all the best of M22 merchandise and allow us to further promote Crystal River Outfitters mission of recreating outdoors in Northern Michigan." (M22000504)

(k) Post by Cindy Engdahl – "M22 – most beautiful views any where!" (M22000505)

(l) Post by Christie Luedders Overgaard – "There's no place like home." (M22000505-506, see photo of area in Michigan)

(m) Post by Megan P Kelly – "Oh how I miss the sites from M22! One of my favorite drives in the whole world!" (M22000506)

(n) Post by Carol Wilkerson Steward – "Luv it. Can't wait to come up." (M22000506)

(o) Post by Julie Heile Youmans – "Snows finally came to our Missouri hideout. Love M-22 snow memories." (M22000507)

(p) Post by Dave Westerfield – "A painting of one of my favorite places. Now available as a print." (M22000507, see post of painting of M22 sign along Michigan road) (M22000507)

(q) Post by Jenny L. Powell – "I see more M22 stickers in Cincinnati than when I lived Up North [northern Michigan]! Love it and miss M-22... looking forward to M-22 this spring/summer/fall!" (M22000507)

(r) Post by Zach Hansel – "It's Official!!!!!! 45th parallel pride gone world wide!!!!!!" ((M22000507, see photo of area in Michigan at 45th Parallel)

(s) Post by Jarrodd Case – "just came back from a ski trip to homestead and stayed in Northport... fell in love with M22 and the beautiful area!!" (M22000508)

(t) Post by M22 (Respondent) – "M22 Images" (M22000509; see photos of the M22 sign and areas in Michigan)

(u) Post by Mary Meilinger DeWitt – "We are a company on M-22! At the Narrows" (M22000510, see photo of an area in Michigan)

(v) Post by Monica Rose Schneider – "if you look close, My dad is wearing an M22 hat, he loves you guys too" (M22000510)

(w) Post by M22 (Respondent) – "A flier from the opening of M22 on September 9, 1949." (M22000511, see photo of flier relating to M22 highway)

(x) Post by Mimi Ransick – "Kayaking on Big Glen" (M22000512, see photo of area in Michigan)

(y) Post by M22 (Respondent) – "What do you look forward to doing on M22 in 2011?" (M22000512, see photo of area in Michigan)

(z) Post by M22 (Respondent) – "Where is your favorite place for an M22 sunset?" (M22000513, see photo of area in Michigan)

(aa) Post by Kelly DePuy Bolin – "It's a great trip down memory lane. Glen Arbor to Frankfort. Beautiful!!!!" (M22000513)

(bb) Post by Hope Monroe – "M22 Yes, it's the way home.... friends, family, etc." (M22000513); followed by Response Post by Janine Winkler – "Are you driving it soon?" (M22000513))

(cc) Post by Matt Roush – "First time I was on M22 was between [Traverse City] and Suttons Bay in the summer of 1980 on my way to camp at Northport Stat Park. Only other place with water that color and a shoreline that pretty is US1 in the Florida Keys. . . ." (M22000514)

(dd) Post by Kathy Brigham-Baird – Beautiful Drive into Suttons Bay and Leland. Kathy. (M22000515)

(ee) Post by Betsy Baye – "I love to ride my Harley up and down M-22 during the spring, summer and fall seasons. The beauty and joy fills my heart and soul, every time!" (M22000516)

(ff) Post by CaptainArt Walker Art Talker – "I really dig M-21, the Bluewater Highway. It's like your brother road." (M22000516)

(gg) Post by Rita Wiseheart – "I love M22 so beautiful was there this summer, if you have never been you should go~~~" (M22000516)

ARGUMENT

I. The State of Michigan's distinctive state route highway marker is an emblem of authority, and has been an insignia of the State dating back to the early 1900s. Accordingly, Section 2(b) bars registration of the Marks.

Section 2(b) of the Lanham Act precludes trademark registration of "other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." 15 U.S.C. § 1052(b). Unlike registration under Section 2(a), elements such as disparagement or false suggestion of a connection are not required to preclude

registration under Section 2(b). TMEP § 1204. Moreover, because Section 2(b) operates as an absolute bar to registration, a disclaimer of the prohibited flag or insignia, or registration under Section 2(f) or the Supplemental Register, cannot overcome the prohibition on registration. TMEP § 1204.04(a). Furthermore, the absolute bar applies to all applicants, including the governmental entity that owns the insignia. *In re City of Houston*, 731 F.3d 1326, 1330; 108 U.S.P.Q.2d 1226 (Fed. Cir. 2013).

The test for determining whether a mark constitutes "other insignia" was set forth in *In re U.S. Dept. of the Interior*, 1964 WL 8039; 142 U.S.P.Q. 506 (T.T.A.B. 1964), where, under the "ejusdem generis" rule of construction applied to the language in Section 2(b), "other insignia" refers to emblems of authority in the same general class as "the flag or coat of arms." *Id.* at *2. "These types of insignia are pictorial in nature, they can be described, but cannot be pronounced." *U.S. Navy v. U.S. Mfg. Co.*, 1987 WL 123804, *3; 2 U.S.P.Q.2d 1254, 1256 (T.T.A.B. 1987) (finding that the initials of the United States Marine Corp, "USMC," was not an insignia because the "letters identify people and things associated with a particular agency within a department of the executive branch of the government, rather than function as an insignia of national significance representing the authority of the government or nation as a whole." (Note that, in 1984, Public Law 98 525 was enacted, which deemed the initials, seal and emblem of the U.S. Marine Corps to be insignia of the United States under 10 U.S.C. § 7881.))

Examples of insignia refused registration by the USPTO because they represent emblems of national authority include the Great Seal of the United States, the Presidential Seal, and seals of government agencies which represent the authority of the government. TMEP 1204.02(a). Conversely, registrations for flags and other insignia that have not been refused under Section 2(b) include words, initials, or designs that identify people or governmental departments, or monuments, statues and buildings associated with the

United States. See *In re U.S. Dep't of the Interior*, 1964 WL 8039; 142 U.S.P.Q. 506 (T.T.A.B. 1964) (insignia of the National Park Service is registrable); *Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Texas*, 185 F. Supp. 895, 908, 127 U.S.P.Q. 312, 323 (E.D. Ark. 1960) ("That the Statue of Liberty is not a part of the insignia of the United States' is too clear to require discussion."); and *U.S. Navy v. U.S. Mfg. Co , supra.*

A. Like the State's flag and coat of arms, the State's route marker design is unique to Michigan and signifies the State's authority.

Under TMEP 1204.02(a), "flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority." As explained *supra*, the State of Michigan's state highway route marker design has been emblematic of governmental authority for nearly 100 years. Michigan's sign design is unique and easily distinguishable from all other state highway marker designs used in the other 49 states. (Ex. 10.) It does not identify governmental agencies, persons, monuments, statues or buildings. Rather, the design represents the State's authority over trunkline highways under its jurisdiction, as opposed to interstates, U.S. routes, and county routes. As explained above, the State's authority is established under Michigan statutes that mandate compliance with the MUTCD and preclude altering the *insignia* on traffic devices. MCL 257.616. (Ex. 1.)

Accordingly, the State's diamond design constitutes an insignia on par with the State's flag or coat of arms and, therefore, is not eligible for registration as a trademark under the Lanham Act. *See In re U.S. Dept. of the Interior, supra* (overruling the examiner's refusal to register the emblem of the National Park Service because the insignia is used to identify a service or facility of the government). Unlike the National Park Service insignia, the State's route marker design does not represent an agency, department, or service, but rather denotes the State's authority. Because the Marks at issue are virtually

identical to the State's route marker design, or a simulation at a bare minimum, the registrations must be canceled.

B. The Marks registered by Respondent are virtually identical to the State's route marker design.

Any attempt by Respondent to distinguish the Marks from the State's sign design in an effort to maintain the registrations is futile. Its own actions confirm that the Marks, i.e., and , are identical to the State's sign, e.g., , in every material respect. In fact, Respondent failed to dispute the Examiner's finding that the Marks are used in "exactly" the way the State uses the road signs for its highway, i.e. as an indication of authority to regulate, warn, and guide travelers. (Serial No. 85041051.) On its Facebook page, Respondent admits that the "M22 road sign" is protected as a trademark. (Ex. 25.)

Respondent purports to have made "creative" modifications to the State's sign. However, by its own admission, Respondent's "creativity" is limited to a white border, imperceptibly thicker letters within and rounder corners on the diamond, and the addition of "M22ONLINE.COM" below the State's sign. However, the allegedly "creative" white border around the sign in the Marks is the same as the border that appears on signs erected along Michigan's roads. See Ex. 23, p. 2 and Ex. 26. Moreover, a white border added to the sign to set it apart from the dark color of a t-shirt is not even remotely creative. Clearly, Respondent's creativity is as indiscernible as the thickness changes and rounded corners that it self-servingly claims make the Marks readily distinguishable from the State's sign design. In fact, Respondent has admitted that its feigned "creative" differences are of no moment by threatening to sue those who duplicate the State's sign on grounds that such signs, including the M-22 sign, i.e., without thickness changes and rounded corners, are identical to and infringe the unlawfully registered Marks. (Exs. 35-44.) For example, Respondent threatened to sue users of the State's sign with M-25, M-26,

M-28, M-37, and M-119 in the diamond, on the basis that each applicant's mark was "identical" to the Marks at issue here. (Exs. 35-44.)

Respondent cannot have it both ways. Its admission that third party uses of the State's sign infringe and are confusingly similar to the Marks constitutes an admission by Respondent that the Marks are not creatively different from the sign. Moreover, Respondent has admitted that identicalness of its Marks to the State's sign is not required, especially where the "substantial and distinctive portion" of the State's sign are copied. (Exs. 36 and 37.)

C. The Marks need not be identical to be barred from registration; at a minimum, they are simulations of the State's insignia and, therefore, precluded from registration.

Section 2(b) of the Lanham Act bars registration of marks that "consist of or comprise any simulation of such symbols." *In re Peter S. Herrick, P.A.*, 2009 WL 174898, *5; 91 U.S.P.Q.2d 1505 (T.T.A.B. 2009). As set forth in Section 2(b), marks must be refused trademark registration where it "consists of or comprises . . . other insignia . . . or any simulation thereof." "The word 'simulation' in the context of Section 2(b) is used in its usual and generally understood meaning, namely, 'an assumption or imitation of a particular appearance or form.'" *Id.* (finding the Department of the Treasury seal represented the authority of the government, and registration of a mark constituting a simulation of the seal was prohibited under Section 2(b)):

> The determination of whether applicant's mark is a simulation of an insignia of the United States is made "without a careful analysis and side-by-side comparison" with the government insignia because "purchasers normally retain but a general or overall rather than a specific recollection of the various elements or characteristics of design marks."

In re Peter S. Herrick, P.A., at 5 (citations omitted) (in comparing the applicant's mark to the government seal at issue, with the exception of the words "U.S. Customs Service" in place of "The Department of the Treasury," the challenged mark was identical to the seal,

and "the average person upon seeing applicant's mark would associate it with the Department of Treasury seal." Therefore, because the applicant's mark was not readily distinguishable from the Department of Treasury seal, it "consists of or comprises a simulation of an insignia of the United States, thereby prohibiting registration.") See also *In re Waltham Watch Co.*, 1973 WL 19968; 179 U.S.P.Q. 59 (T.T.A.B. 1973) (stating that whether a mark comprises a simulation must be determined from a visual comparison of the proposed mark vis-à-vis replicas of the flag, coat of arms, or other insignia in question); *In re Advance Indus. Sec., Inc.*, 1977 WL 22511; 194 U.S.P.Q. 344 (T.T.A.B. 1977) (explaining that, in deciding whether a mark is a simulation, the focus must be on the general recollection of the flag or insignia by purchasers, "without a careful analysis and side-by-side comparison.")

Clearly, any notion that the Marks must be identical to the State's highway route marker, or that identicalness must be determined by a careful analysis and side-by-side comparison to determine whether they are readily distinguishable, is misguided because purchasers retain only an *overall* recollection of design marks. Here, as explained *supra*, Respondent's own actions confirm that the Marks are identical or, at a minimum, simulations that imitate the appearance and form of the State's road sign design.

D. Summary disposition in favor of the State under 15 U.S.C. 1052(b) is warranted.

As explained *supra*, the State's highway route marker design was formally adopted in accordance with state and federal law to serve as an emblem of governmental authority. The route marker sign represents the authority of the State, rather than a county, city, or other municipality. It is not an emblem used to identify a service, facility, or department of the State. *See In re Peter S. Herrick, P.A., supra*; see also *Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc.*, 1997 WL 335807; 43 U.S.P.Q.2d 1193 (D.D.C. 1997) (finding no

evidence that the United States Capitol building was "formally adopted to serve as an emblem of governmental authority" and thus, a depiction of the building was not an insignia prohibited from being registered as a trademark). A visual comparison of the Marks with the State's design leaves no room for doubt that the Marks are identical to or, minimally, simulations of the State's design, as evidenced by the same white diamond on a black square with a stylized "M" in the top corner of the diamond and a stylized "22" in the bottom corner of the diamond. In fact, the Trademark Examiner reached this same conclusion, which Respondent failed to dispute.

Respondent cannot deny that the Marks are simulations, if not identical, given its threats to sue anyone who uses the State's route marker design, with any number below the stylized "M," on grounds of trademark infringement and likelihood of confusion. (Exs. 35-44.) Comments on Respondent's Facebook page, by Respondent and others, confirm that the public associates the Marks with the State and its route marker design. (Exs. 17-22.) Such was Respondent's intent, as it has admitted that it intended to replicate the State's route marker design because it has been widely recognized and respected for decades. (Exs. 16-18.)

Federal and state laws establish the authority accorded to the State and emblemized in the trunkline highway route marker design used continuously for nearly a century. Long before Respondent put the route marker design on a t-shirt and other novelty items to espouse a common passion for the road and region in Northwest Michigan, and then commandeered the design as to all Michigan trunkline highways, the State's distinctive design was and remains widely known and instantly recognized as an insignia of the State and its authority over trunkline routes throughout the State. Accordingly, the trunkline route marker design constitutes an insignia of governmental authority that is barred from

trademark registration under 15 U.S.C. § 1052(b). Consequently, the trademark registrations issued for the Marks must be canceled.

II. The Marks consist of elements and symbols indicative of and used by the State of Michigan, and falsely suggest a connection with the State of Michigan, thereby precluding registration under 15 U.S.C. § 1052(a).

Section 2(a) of the Lanham Act prohibits registration on either the Principal or Supplemental Register if the mark "consists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute." 15 U.S.C. § 1052(a); *In re Brumberger Co., Inc.*, 1978 WL 21556, *2; 200 U.S.P.Q. 475 (T.T.A.B. 1978) (affirming the refusal to register a pictorial representation of an exact replica of an official United States mail depository box, including the word "MAIL," the official eagle design and the words "U.S. Mail" as used by the U.S. Postal Service).

The protection afforded under Section 2(a) is intended to preclude the unauthorized use of the persona or symbol of an institution. *Bridgestone/Firestone Research Inc. v. Auto. Club De L'Quest De La France*, 245 F.3d 1359, 11363; 58 U.S.P.Q.2d 1460 (Fed. Cir. 2001); TMEP § 1203.03. A party acquires a protectable interest in such a designation that is "unmistakably associated with, and points uniquely to, that party's persona," and does not depend on adoption and use of the designation as a technical trademark or tradename. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports, Co., Inc.*, 703 F.2d 1372, 1375-1377; 217 U.S.P.Q. 505 (Fed. Cir. 1983); *Buffett v. Chi-Chi's, Inc.*, 1985 WL 73060, *2; 226 U.S.P.Q. 428 (T.T.A.B. 1985).

A. The State is an "institution," for purposes of Section 2(a), and a prior user with a protectable interest in its trunkline route marker design.

There can be no reasonable dispute that the State is an "institution" for purposes of Section 2(a). See *In re Peter S. Herrick P.A.*, 91 U.S.P.Q.2d at 1506 (under Section 2(a),

"institutions" include government agencies and instrumentalities); *Gavel Club v. Toastmasters Int'l*, 127 U.S.P.Q. 88, 94 (T.T.A.B. 1960) (institutions do not need to be "national" to be protected from the registration of a mark that falsely suggests a connection with them). Nor can Respondent reasonably dispute that the State, given its use of the diamond route marker design for nearly 100 years, including more than 40 years using the current design adopted in 1973, is the prior user of its trunkline route marker design. *In re Mohawk Air Servs. Inc.*, 196 U.S.P.Q. 851, 854-55 (T.T.A.B. 1977) (a refusal based on false suggestion of a connection requires that the institution be the prior user of the name or design).

Further, although Respondent has alleged that the State has not used the route marker design as a trademark, which the State disputes, the State is not required to have ever commercially exploited the design or used it in a manner analogous with trademark use. *In re Pedersen*, 2013 WL 6926518, *7; 109 U.S.P.Q.2d 1185 (T.T.A.B. 2013). False suggestion of a connection exists because the State's right to control the use of its route marker design is violated as a result of the Marks being registered, even in circumstances where the State may have no authority to authorize use of the design. *Id.*

Thus, as explained above, the State has acquired a protectable interest in its trunkline route marker design. Its design has become "unmistakably associated with, and points uniquely to" the State of Michigan, including regions such as Northwest Michigan that, based on geographical appeal, have become widely known by the scenic trunkline route marker, e.g.,

, erected on roads passing through them.

B. The Marks falsely suggest a connection with the State of Michigan.

"A false suggestion of a connection may be found when one's right to control the use of its identity is violated, even if the name claimed to be appropriated was never commercially exploited as a trademark or in a manner analogous to trademark use." *In re*

Pedersen, supra at *7. As explained by the Federal Circuit in *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports, Co., Inc., supra,* "the drafters of the Lanham Act were concerned with protecting the name of an individual or institution which was not a technical trademark or trade name upon which an objection under 2(d) could be made." *In re Cotter & Co.*, 1985 WL 71963, *1; 228 U.S.P.Q. 202 (T.T.A.B. 1985). The Court further explained that the drafters sought by Section 2(a) to embrace concepts of the right to privacy, that the elements of a claim on invasion of privacy have emerged as distinctly different from those of trademark" and "while there may be no likelihood of source confusion even under a theory of 'sponsorship' or 'endorsement,' one's right of privacy or the related right of publicity may be violated." *Id.* Under this concept of identity protection, the critical requirement is that the State's sign design, as appropriated by Respondent, is unmistakably associated with the State of Michigan. *Id.*

The test for whether a mark comprises matter that may falsely suggest a connection with an institution is explained in *In re Cotter & Co., supra* (refusing registration of WESTPOINT for firearms because the mark falsely suggested a connection with the U.S. Military Academy). The four-factor test requires a showing that:

1. The mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;

2. The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;

3. The person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and

4. The fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

Id. at *2; see also *In re Pedersen, supra* at *2 (refusing to register LAKOTA because the mark as used by the applicant falsely suggested a connection with persons or institutions known as the Lakota).

In this case, with regard to the first and third factors, as explained *supra*, the irrefutable facts in this case establish that the Marks are virtually identical to the State's route marker design, and Respondent has conceded as much. Further, the parties do not dispute that the State is not connected with Respondent's sale of novelty items bearing the State's route marker design.

Regarding the second factor, the requirement that the Marks would be recognized as pointing uniquely and unmistakably to the State asks whether consumers of Respondent's products would view the mark as pointing uniquely to the State or perceive it to have another meaning. *Hornby v. TJX Cos., Inc.*, 2008 WL 1808555, *16; 87 U.S.P.Q.2d 1411 (T.T.A.B. 2008) (canceling the mark TWIGGY on children's clothing because it would be recognized as pointing uniquely and unmistakably to the petitioner, a recognized and famous British model, and because consumers would presume an association with the model); *In re Pedersen, supra* at *9-*11. Notably, Respondent's use of the State's trunkline sign design does not establish that the term points uniquely to Respondent. *Hornby, supra* at *16 (finding third party registration of the mark "TWIGGY" on goods unrelated to children's clothing to have "no probative value"); *In re Pedersen, supra* at *10-*11 (finding consumer exposure to third party use of LAKOTA on products and services unrelated to the applicant's insufficient to show that the applicant's use of LAKOTA does not point uniquely to the Lakota people).

That M-22 is nationally known and recognized as pointing uniquely and unmistakable to the State is incontestable. In fact, during prosecution, Respondent conceded that it uses the Marks in exactly the way the State uses 'M22' in its road signs.

Furthermore, the State's consistent use of the route marker design over the last 100 years, its use in connection with Great Lakes Circle Tours, Scenic Heritage Routes, and numerous campaigns to market and develop tourism in Northwest Michigan and throughout the State, there can be no reasonable dispute that the route marker design points uniquely and unmistakably to the State. (Exs. 23-34) Most recently, in 2015, the M-22 route, denoted by the State's route sign design, was named by USA Today as the "#1 Best Scenic Autumn Drive in the Nation" based on a month-long poll of USA Today readers. (Ex. 15.) In addition, Statements by Respondent and its customers and supporters, overwhelmingly demonstrate their clear and unmistakable recognition that the design points uniquely to the State, confirm as much. (Exs. 17-22.)

Respondent's intent to identify the State or trade on its goodwill is not a required element of a Section 2(a) claim of false suggestion of an association. *S&L Acquisition Co. v. Helene Arpels, Inc.*, 9 U.S.P.Q.2d 1221, 1224 (T.T.A.B. 1987); *Univ. of Notre Dame du Lac*, 703 F.2d at 1377. Nevertheless, Respondent's unequivocal statements associating the Marks with the State, on Respondent's website and Facebook page, as well as in interviews, make clear its intent to draw a connection to the State. Respondent's statements constitute admissions of suggested association, and those of its customers evidence the public's false association. Without question, Respondent's incorporation into and use of the State's trunkline sign in the Marks is further evidence that it intended to reference the State. *See Bd. Of Trustees of Univ. of Ala. v. Pitts*, 2013 WL 4397047; 107 U.S.P.Q.2d 2001 (T.T.A.B. 2013) (because the applicants did not use the exact image in their mark, their admission that they intended the mark to reference the person was diminished).

As to the fourth prong – the likelihood of a presumed connection between the goods and the State – the issue is whether the fame of Michigan vis-à-vis its route marker design is significant enough that a connection between the State and the Marks is presumed. *In re*

Pedersen, supra at *15. However, the State is not required to prove that its reputation is closely related to Respondent's goods. *Id.* Here, the undisputed facts leave no room for doubt that the State is well-known with Michiganders, including Respondent and its founders and customers, and others around the country, for its wildly popular scenic regions, tours, and routes commonly known by reference to the State's route sign design, e.g.,

. (Exs. 17-22.) As the applicant in *Pedersen* intended to identify with Native Americans in general, and the Lakota people in particular, here Respondent's conduct and statements confirm that it intended to identify with the State, in general, and Northwest Michigan, in particular, by its use of the State's road sign design and the M-22 route number. *Id.* at 18. In fact, when others have used the State's route marker in connection with the region, Respondent has stopped them in their tracks with threats of claims under the Lanham Act. (Exs. 35-44.) Notably, in one such threat, Respondent again conceded that the Marks refer to the State, admitting it "created the M22 brand to pay tribute to the northern Michigan road of the same name and the natural beauty of its surrounding areas." (Ex. 28.)

Respondent adopted the State's route sign design to trade on the goodwill and publicity that the design has acquired over the past century as a result of its association with the State. Because Respondent adopted the Marks with the intent of communicating a shared love of Northwest Michigan, it is axiomatic that, when the Marks are used with the Respondent's goods or services, a connection with the State is presumed. This connection is unmistakable based on Respondent's use of the Marks in "exactly" the same way the State uses the signs, and Respondent's statements, as well as statements by its customers, that the Marks point uniquely to the State and express a "common passion" for the State, the road, and the region. Indeed, there can be no other reason for Respondent's using the State's sign design and route number except to draw the connection to the State and the

popularity of the scenic tourist region, and to sell novelty items that display a love for the State and the region. *See Pedersen* at *18. *See also Bd. of Tr. of Univ. of Ala. v. BAMA-Werke Curt Baumann,* 1986 WL 83709; 231 U.S.P.Q. 408 (T.T.A.B. 1986) (finding that BAMA points uniquely to the University of Alabama and, therefore, falsely suggests a connection with the University, and canceling the registration of BAMA, for shoes, slippers, stockings, socks, and insoles); *In re Sloppy Joe's Int'l Inc.,* 1997 WL 424966; 43 U.S.P.Q.2d 1350 (T.T.A.B. 1997) (denying registration because use of the mark SLOPPY JOE'S with a design that includes the portrait of Ernest Hemingway falsely suggests a connection with deceased writer.)

Clearly, there is no genuine issue of material fact that the four elements of the false suggestion of a connection test have been met. Thus, summary judgment in favor of the State is warranted and the Marks should be canceled.

RELIEF REQUESTED

The State's route marker design is an insignia that denotes governmental authority over trunklines throughout the State. Such governmental insignia are ineligible for trademark registration. Furthermore, the Marks falsely suggest a connection with the State and are barred from registration. Accordingly, the State respectfully requests that this Board grant its Motion for Partial Summary Judgment and cancel the registrations at issue.

Respectfully submitted,

By: /s/Toni L. Harris
Date: March 18, 2016

Toni L. Harris, Assistant Attorney General
Transportation Division
Van Wagoner Building
425 W. Ottawa, 4th Floor
Lansing, MI 48913
Tel: 517-373-1470

PROOF OF SERVICE

I, Susan Lubitz, legal secretary to Assistant Attorney General Toni L. Harris, certify that on March 18, 2016, I served a true and correct copy of Petitioner's Combined Motion for Partial Summary Judgment and Brief in Support, in electronic format, on Respondent's counsel of record.

/s/ Susan Lubitz
Susan Lubitz

EXHIBIT B

●●●●○ AT&T 4G 6:19 AM

PHOTO

luccarpenter
Traverse City, Michigan

12h

58 likes

luccarpenter Its more than a road, it's a way of life #M22life #TraverseCity #BeActive #DowntownTC #M22

M22
February 3 ·

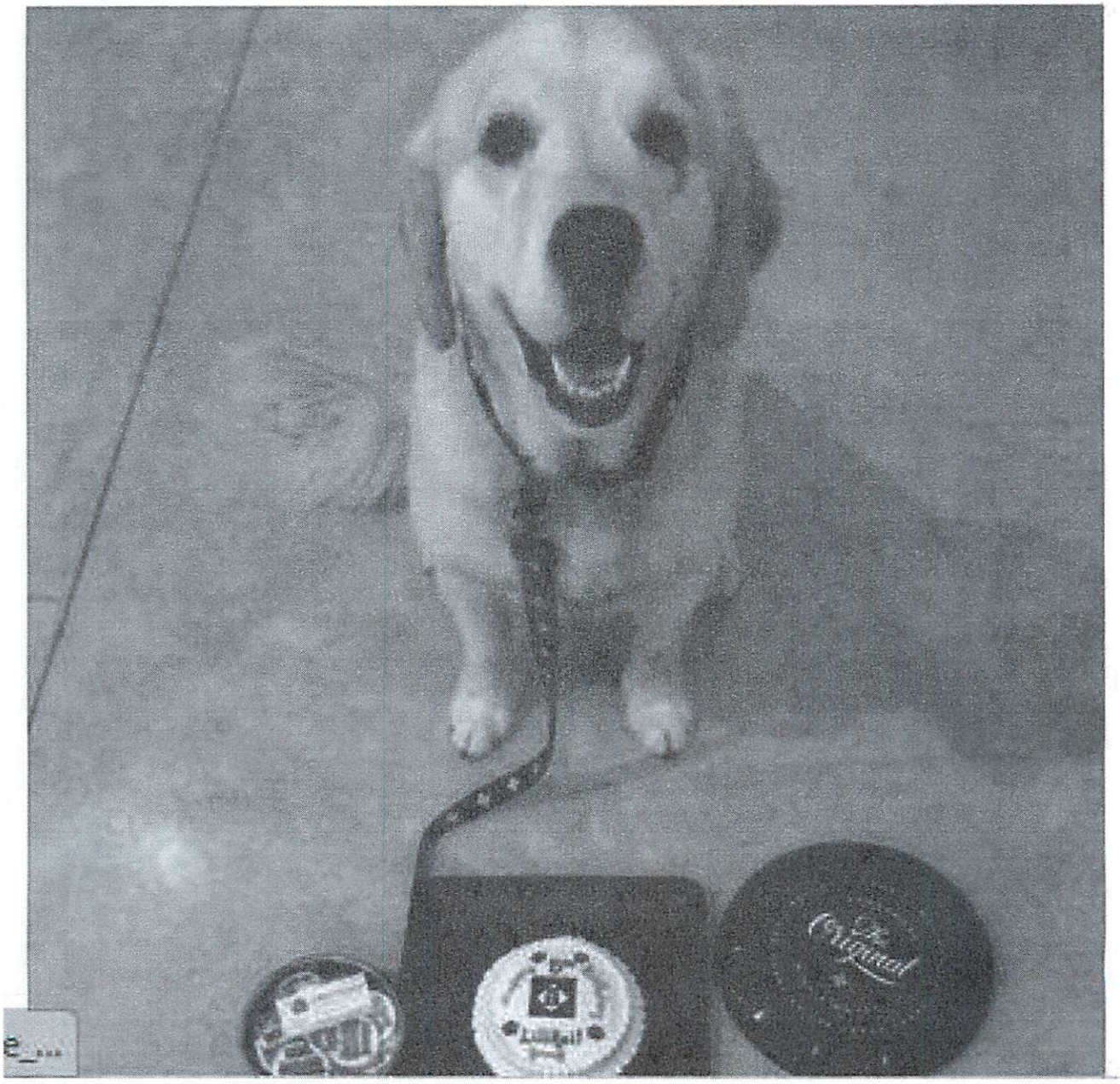
If you're craving a dose of adventure, but operating on a shoestring budget, prepare to be inspired by M22 Pro Advocate, Grant Piering. With just $300 to burn, he mapped out a microadventure from MI to Cali, and back. He got the ticket and made the drive. The proof is in his video, the tips are at our blog: m22.com/blog/ #m22life #m22microadventure #m22advocate

M22
October 8, 2015 ·

M22 shop dog, Lilikoi, turns 5 tomorrow!

Our friends @dogbakeryonline made her this special cake to celebrate! Tomorrow through Sunday, save 30% on our M22 dog leashes, collars, and frisbees using promo code mansbestfriend. Stop in the M22 Traverse City location to pick up D.O.G. Bakery treats for your pooch and a coupon for some free goodies at the D.O.G. Bakery!

#m22life #downtowntc #dogbakeryonline #dogtreats #mansbestfriend @lilikoithedog



Steve Kennedy Shared with: Public

March 22 at 4:38pm

Ready for Summer.

5

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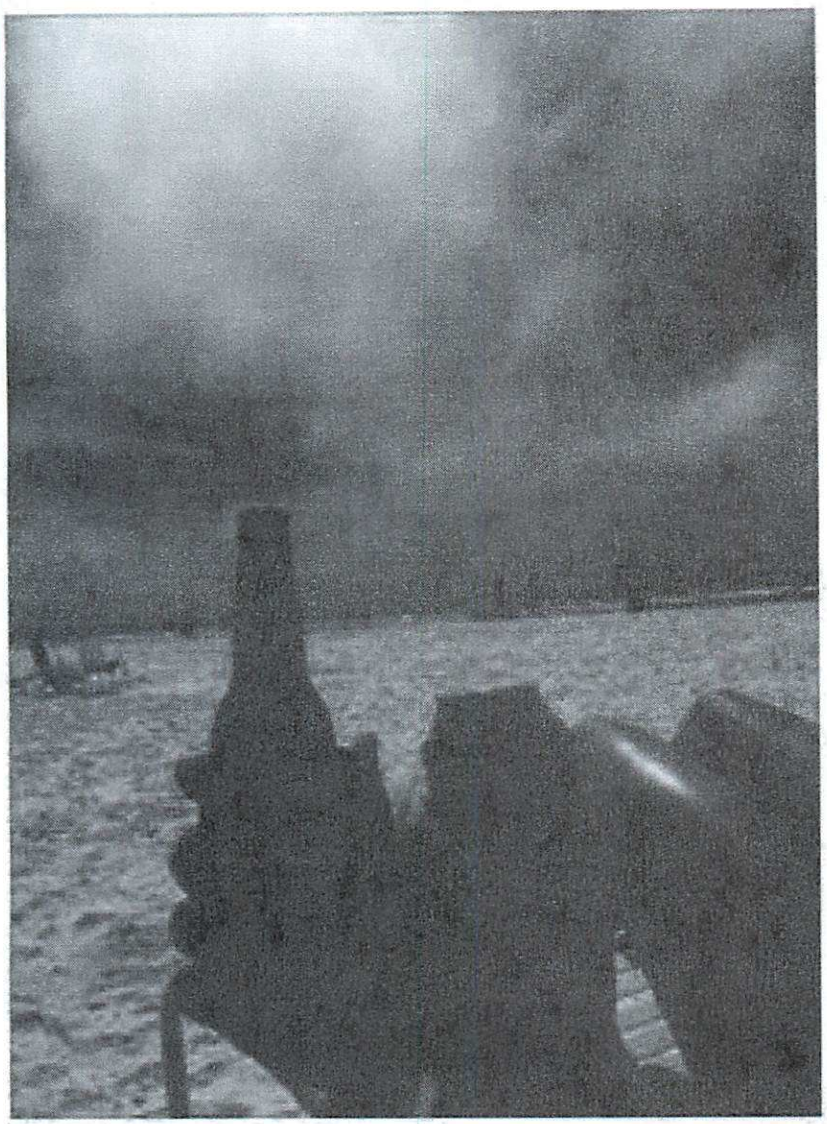
Nick Hawkins ▸ **M22**
March 18 at 8:22am

Reppin' M22 all the way in Siesta Key, FL!



16

3 Comments

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kenzyjnelson 37w

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EXHIBIT C

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noun fa·cil·i·ty \fə-ˈsi-lə-tē\
Popularity: Top 30% of words

Simple Definition of *facility*

- : something (such as a building or large piece of equipment) that is built for a specific purpose
- : something that makes an action, operation, or activity easier
- : skill and ease in doing something

Examples: *facility* in a sentence

- -
- -
- -
- -
-

Full Definition of *facility*

plural **fa·cil·i·ties**

1. *1* : the quality of being easily performed
2. *2* : ease in performance : aptitude
3. *3* : readiness of compliance

EXHIBIT D

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

State of Michigan

Petitioner,

v.

M22, LLC,

Respondent.

Proceeding No: 92058315

Registrations: 3992159
3348635

PETITIONER'S RESPONSES TO RESPONDENT'S FIRST REQUESTS FOR ADMISSION

Petitioner, State of Michigan, by and through its attorneys, hereby submit the following responses and objections to Respondent M22, LLC's First Requests for Admissions:

GENERAL OBJECTIONS

The State of Michigan objects to the instructions as set forth in Respondent's First Requests for Admission, and each request, to the extent they purport to place obligations or require conduct by the State of Michigan contrary to, or in excess of, that required by the Federal Rules of Civil Procedure or the Trademark Rules of Practice, 37 C.F.R. §§ 1 *et seq.*

RESPONSES TO REQUESTS FOR ADMISSION

Request to Admit 1: Admit that the State of Michigan has never used the M22 Sign in association with the sale or offering for sale of goods or services.

Response: The State of Michigan admits it has never used the M22 sign in association with the sale or offering for sale of goods and services because the State does not sell goods or services. In further answer, the State has used and continues to use the M22 Sign since 1919 as an approved traffic control device and designation under the Manual on Uniform Traffic Control Devices to designate a highway provided and maintained as part of its state highway system.

Request to Admit 2: Admit that the State of Michigan has never displayed the M22 Sign on clothing sold by the State of Michigan.

Response: Admitted.

Request to Admit 3: Admit that the State of Michigan has never displayed the M22 Sign on a retail store.

Response: Admitted.

Request to Admit 4: Admit that the M22 Retail Mark is not identical to the M22 Sign.

Response: Denied. A comparison of the M22 Retail Mark to the M22 Sign indicates that the M22 Retail Mark is designed to be identical to the M22 Sign, using the same design with a white diamond on a black background with black lettering and the "M" and "22" in the same configuration. Further, as set forth in

the May 2, 2007 Office Action pertaining to Serial No. 85041051 (M22 Retail Mark), the Trademark Examining Attorney stated:

> Attached evidence shows that "M22" refers to a highway in Michigan. This attached evidence shows that applicant's usage of the mark in a design consisting of a white diamond on a black square with the "M" in black above the "22" is exactly the way the Michigan Department of Transportation uses "M22" in its road signs for this highway.

In its Response to the Office Action, Respondent did not dispute the Examiner's findings.

Regarding Serial No. 79863038 (M22 Apparel Mark), the same white diamond on a black square with the "M" in black above the "22" in exactly the way the Michigan Department of Transportation uses "M22" in its road signs for this highway appears, with "the very tiny wording M22online.com at the bottom" as described by the Trademark Examining Attorney in the January 26, 2007 Office Action.

Request to Admit 5: Admit that the M22 Apparel Mark is not identical to the M22 Sign.

Response: Admitted in part and denied in part. Admitted to the extent that M22ONLINE.COM, in virtually imperceptible lettering, surrounded by a black border, is part of the M22 Apparel Mark. Denied for the reasons set forth in Response to Request to Admit 4.

Request to Admit 6: Admit that the State of Michigan has never used the M22 Mark except as a traffic control device.

Response: Denied for the reason that the M22 Sign is used on the state road map as well as to designate portions of the state's Great Lake Circle Tour and the Scenic Heritage Drive Route. In addition, the M22 Sign is used to market and promote northwest Michigan.

Request to Admit 7: Admit that the State of Michigan has never enforced the intellectual property statements contained within the Manual of Uniform Traffic Control Devices against any third party other than Registrant.

Response: The State objects to this Request as vague and ambiguous in its reference to "intellectual property statements." To the extent that Respondent's Request to Admit 7 is directed to the State's enforcement of the provision in the Manual prohibiting trademark protection for traffic control devices, the Request is denied for the reason that the State has notified applicants of the Manual's prohibition on trademark protection for traffic control devices.

Request to Admit 8: Admit that Attorney General Bill Schuette was previously an attorney at the law firm of Warner, Norcross, and Judd.

Response: Admitted.

Request to Admit 9: Admit that Attorney General Bill Schuette appointed James Scott, an attorney at Warner, Norcross, and Judd, as a special attorney general to file this cancellation proceeding.

Response: Admitted.

Request to Admit 10: Admit that You have no evidence supporting your allegation that "Registrant stopped use of the mark in the M22 Online Registration in association with the goods identified in the M22 Online Registration with no intent to resume such use" as alleged in Paragraph 30 of Your Second Amended Petition to Cancel.

Response: Denied for the reason that (i) although Respondent alleged first use back to January 1, 2004, WHOIS records show that M22online.com was not registered until August 8, 2006; (ii) products appearing on a January 26, 2007 version of Respondent's website are shown without the "M22ONLINE.COM" lettering below the M22 Sign.

Request to Admit 11: Admit that You have no evidence supporting your allegation that "The fame or reputation of Petitioner is such that, when the M-22 Sign is used with Registrant's goods or services, a connection with Petitioner is presumed" as alleged in Paragraph 43 of Your Second Amended Petition to Cancel.

Response: Denied. That a connection with Petitioner is presumed is demonstrated, in part, by postings via social media confirming consumers'

understanding that the M-22 Sign used with Registrant's goods and services refers to northwest Michigan. In further answer, theft of the M22 Sign along the M22 state highway route have increased dramatically since Respondent began selling products incorporating the M22 Sign as its brand. Also, see Responses to Request Nos. 12 and 15.

Request to Admit 12: Admit that You have no evidence supporting your allegation that "consumers purchase goods decorated with the M-22 Sign, because the M-22 Sign points to Petitioner as the source" as alleged in Paragraph 55 of Your Second Amended Petition to Cancel.

Response: Denied for the reasons stated in the State's Responses to Request Nos. 11 and 15. In further response, theft of the M22 Sign along the M22 state highway route have increased dramatically since Respondent began selling products incorporating the M22 Sign as its brand.

Request to Admit 13: Admit that the State of Michigan has never used the M22 Sign as its flag or coat of arms.

Response: Admitted. In further answer, the State of Michigan states that the M22 sign is alternatively an "insignia" of the State of Michigan.

Request to Admit 14: Admit that the State of Michigan has never used the M22 Sign as the seal of a department.

Response: Admitted.

Request to Admit 15: Admit that You have no evidence supporting your allegation that "Registrant knew, or at least had no reasonable basis for believing otherwise, that its use of the M-22 Sign would create a likelihood of confusion as to the source of the associated goods and services" as alleged in Paragraph 62 of Your Second Amended Petition to Cancel.

Response: Denied because Respondent adopted the M22 Sign to "express a common passion for Northern Michigan" that Respondent and third parties have expressed for the area and the M22 state highway route as evidenced by its recognition and designation by the Michigan Legislature as a Scenic Heritage Route, its inclusion in the Great Lakes Circle Tour, and use of the sign in marketing and promoting northern Michigan. In further answer, see Responses to Request Nos. 11 and 12.

Request to Admit 16: Admit that You have no evidence supporting your allegation that "Registrant was not using the mark M22 M22ONLINE.COM on all the goods identified in the application Serial No. 78963038 when it filed the application, and upon information and belief, is not currently using the mark on all the goods identified in the application" as alleged in Paragraph 66 of Your Second Amended Petition to Cancel.

Response: Denied because, *inter alia*, products available for purchase on a January 26, 2007 version of the M22ONLINE.COM website, as well as later versions, do not include the lettering M22ONLINE.COM as shown in the M22 Apparel Mark, and the products available for purchase as of January 26, 2007 do not include underwear, long sleeve shirts, pants or shorts.

Request to Admit 17: Admit that the State of Michigan has never used the M22 Sign to indicate the origin or source of its goods or services.

Response: Denied for the reason that M22 Sign is used as an approved traffic control device under the Manual UTCD to designate a highway provided and maintained as part of Michigan's state highway system. Further, the M22 Sign is used on the state road map and to designate portions of the State's Great Lake Circle Tour. Further, M22 was designated as a Scenic Heritage Route in 2001 and has been used to promote and market northwest Michigan.

Request to Admit 18: Admit that the State of Michigan does not provide color tours.

Response: Admitted.

Request to Admit 19: Admit that the State of Michigan does not provide real estate services under the M22 Sign.

Response: Admitted.

Respectfully submitted,

As to objections:

By: _____ Date: August 17, 2015

BILL SCHUETTE, Attorney General
Toni L. Harris (P63111)
Assistant Attorney General/Transportation Division
Van Wagoner Building
425 W. Ottawa, 4th Floor
Lansing, MI 48913
Tel: 517-373-1470
Fax: 517-335-6586

As to responses to Requests for Admissions:

_____

Brad Wieferich, P.E.
MDOT Design Division

PROOF OF SERVICE

I, Susan Lubitz, legal secretary to Assistant Attorney General Toni L. Harris, certify that on August 17, 2015, I served a true and correct copy of Petitioner's Responses to Respondent's First Requests for Admissions on Respondent's counsel of record by mail and first-class postage fully prepaid thereon and causing same to be deposited in the United States mail service.

Susan Lubitz

Susan Lubitz

EXHIBIT E

DocuSign Envelope ID: 9F50D502-DB08-4C35-A024-21F2538BCF3B

Declaration of Matt Myers

I, Matt Myers, declare:

1. I am Matt Myers, a resident of the State of Michigan, and I have personal knowledge of the facts contained herein and, if called as a witness, could and would competently testify thereto.

2. I am the co-owner of M22, LLC.

3. M22 has never received or fielded a complaint from any individual who believed that M22 or the M22 Marks were associated with the State of Michigan.

4. As a resident of the State of Michigan for the entirety of my life, I have never seen the State of Michigan use the M22 sign as an emblem of authority or to denote an official correspondence or service of the State.

5. M22's efforts to conduct discovery in this matter have been consistently frustrated by the State of Michigan.

6. On March 9, 2016, the day on which proceedings were continued in this matter, our attorney requested that the State of Michigan provide dates for the deposition of its designee. The State of Michigan previously complained to the Board, prior to the filing of its previous Motion for Summary Judgment, that M22 had not worked with it in setting the date, time, and location for the deposition, so our attorney attempted to obtain dates that would be acceptable for a deposition.

7. Our attorney sent this request on March 9, 2016 because it has become clear that the State of Michigan intends to delay the resolution of this case for as long as possible.

8. On March 10, 2016, the State of Michigan declined to provide dates and, instead, requested that our attorney notice the deposition of the State's designee. At this time, our attorney reminded the State of Michigan of its previous request for concurrence on deposition dates.

9. On March 10, 2016, M22 provided the State of Michigan with a notice of deposition consistent with Fed. R. Civ. P. 30(b)(6).

10. Between March 10, 2016 and March 24, 2016, M22 did not receive any objections from the State of Michigan or any alternative dates for the deposition.

11. On March 18, 2016, the State of Michigan filed the instant Partial Motion for Summary Judgment. We believe that this Motion, which was filed after no new evidence was collected, was filed to further delay discovery in this matter.

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12. On March 25, 2016, the State of Michigan stated that the deposition "will need to be rescheduled to a later date."

13. On March 26, 2016, our attorney explained to opposing counsel why the deposition would continue as noticed unless the Board issued a suspension order.

14. On March 28, 2016, eighteen days after receiving the deposition notice, the State of Michigan laid its first objection the notice of deposition. At this time, the State of Michigan attorney's stated, "If, for some reason, the case is not suspended, we can discuss dates on a weekday toward the latter part of April." The State of Michigan did not provide alternative dates for the deposition.

15. Between August 27, 2015, the date on which Petitioner filed its last Motion for Summary Judgment, and March 18, 2016, the date on which Petitioner filed the instant Motion for Summary Judgment, Petitioner has not undertaken any discovery, has not disclosed any new documents, and has repeatedly delayed the deposition of its designee.

16. Despite M22's consistent attempts to proceed with discovery, the State of Michigan has taken actions to delay this case and needlessly increase the costs of litigation for M22.

17. M22 has had no opportunity to take discovery on whether the State of Michigan has ever used the M22 sign as an insignia or as its identity or persona.

18. In fact, despite receiving Petitioner's most recent discovery requests on March 10, 2016, Petitioner has failed to produce any documents responsive to those requests, which were due on April 10, 2016.

19. The State of Michigan's continual bad faith delay of this case, which has been ongoing for almost three years, has financially harmed M22.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Date: 4/11/2016

DocuSigned by:
Matt Myers
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Matt Myers