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

Proceeding	91206254
Party	Defendant The Civil Wars, LLC dba The Civil Wars
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In The Matter of Application Serial No. 85/361,068: THE CIVIL WARS

THE STATE OF OREGON ACTING BY AND  
THROUGH THE STATE BOARD OF HIGHER  
EDUCATION ON BEHALF OF THE  
UNIVERSITY OF OREGON AND OREGON  
STATE UNIVERSITY,

Opposers,

v.

THE CIVIL WARS, LLC D/B/A THE CIVIL  
WARS,

Applicant.

Opposition No. 91206254

**ANSWER**

Applicant, The Civil Wars, LLC d/b/a The Civil Wars (“Applicant”), by and through its undersigned counsel, files this Answer to the Notice of Opposition (“Opposition”) as filed by The State of Oregon acting by and through the State Board of Higher Education on behalf of the University of Oregon and on behalf of Oregon State University (collectively the “Oregon Universities”) on July 9, 2012, against Applicant’s U.S. Federal Trademark Application Serial No. 85/361,068 for the mark **THE CIVIL WARS** in International Class 25.

In answer to the allegations set forth by the Oregon Universities in the Opposition, Applicant states and avers as follows:

1. Briefly, the Oregon Universities' own the mark CIVIL WAR for apparel such as shorts, polo shirts, hats, headbands, wristbands, slippers, sweatshirts, sweatpants, boxers, t-shirts, jackets, and gloves. The Subject Application seeks to register a mark adding only the word "the" and an "s" to the Oregon Universities' mark CIVIL WAR for essentially the same apparel goods

(namely, THE CIVIL WARS for hats; hooded sweat shirts; jackets; sweat pants; t-shirts). The PTO has indicated that the marks CIVIL WAR and THE CIVIL WARS likely cannot be registered for the same goods since they are too similar. Since the Oregon Universities are the first user of CIVIL WAR, the Oregon Universities should prevail and the Patent and Trademark Office should not allow registration of the mark of the Subject Application.

**ANSWER:** Applicant denies the allegations set forth in Paragraph 1.

2. To provide some context for this matter, the Oregon Universities' have held a rivalry football game for over a hundred years that they offer under their mark CIVIL WAR. The Oregon Universities' CIVIL WAR branded athletic performance is one of the longest running rivalries in all of college sports. The success of their mark has allowed them to branch out into offering merchandise, such as apparel. The Civil Wars on the other hand are newcomers. According to the Subject application The Civil Wars began using THE CIVIL WARS less than two years ago and sought to register THE CIVIL WARS for apparel goods only last year (which is well after the Oregon Universities' began using CIVIL WAR on apparel).

**ANSWER:** Applicant denies The Civil Wars are newcomers. Applicant admits its first use of THE CIVIL WARS on goods in International Class 25 was on August 14, 2010. Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the remaining allegations set forth in Paragraph 2 and therefore denies the same.

3. Moreover, not only is the Oregon Universities' CIVIL WAR mark more than a century old, it is very well known. For example, in 2010, the incredibly popular ESPN college football program GAMEDAY broadcast nationwide from the Oregon Universities' CIVIL WAR

branded athletic competition before the CIVIL WAR branded game aired on the national television network ABC. 2010 was of course before Applicant filed the Subject Application.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the allegations set forth in Paragraph 3 and therefore denies the same.

4 In addition to branding their football rivalry under CIVIL WAR, many other competitions between the Oregon Universities are also branded under their CIVIL WAR mark.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the allegations set forth in Paragraph 4 and therefore denies the same.

5 Not surprising given the longevity and success of their CIVIL WAR brand, and as indicated above, the Oregon Universities also sell merchandise under their CIVIL WAR mark. This includes apparel such as shorts, polo shirts, hats, headbands, wristbands, slippers, sweatshirts, sweatpants, boxers, T-shirts, jackets, and gloves.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the allegations set forth in Paragraph 5 and therefore denies the same.

6 The Subject Application of course identifies the same goods as the Oregon Universities offer under CIVIL WAR, namely: hats; sweat shirts; jackets; sweat pants; and t-shirts.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the allegations set forth in Paragraph 6 and therefore denies the same.

7 It is clear that the Oregon Universities used CIVIL WAR in commerce in connection with identical and/or closely related merchandise to that is recited in the Subject Application, such as apparel, well before the filing date of the Subject Application.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the allegations set forth in Paragraph 7 and therefore denies the same.

8 Thus, if use of CIVIL WAR and THE CIVIL WARS on apparel goods is likely to cause confusion, then the Subject Application should be refused registration by the Patent and Trademark Office.

**ANSWER:** Applicant denies allegations set forth in Paragraph 8.

9 Confusion is likely between CIVIL WAR and THE CIVIL WARS for the same goods.

**ANSWER:** Applicant denies that the Subject Application violates 15 U.S.C. § 1052(d). Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the remaining allegations set forth in Paragraph 9 and therefore denies the same.

10. CIVIL WAR and THE CIVIL WARS are very close in appearance and sound. For example, THE CIVIL WARS entirely incorporates the phrase "CIVIL WAR". THE CIVIL WARS adds to the term CIVIL WAR only: the letter "S" on WAR; and the word "THE" before CIVIL WARS.

**ANSWER:** Applicant denies allegations set forth in Paragraph 10.

11. Buttrressing the conclusion that CIVIL WAR and THE CIVIL WARS look and sound similar, a search for "CIVIL WAR" on the ticket resale website StubHub returns a result for a concert by The Civil Wars (as can be seen in the screen capture copied below).

[IMAGE OMITTED]

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth or veracity of the allegations set forth in Paragraph 11 and therefore denies the same.

12. In addition, the Patent and Trademark Office has indicated that the marks likely conflict and cannot be registered together. More particularly, the Patent and Trademark Office stated (based on the filing dates not actual priority) that if the Subject Application registers, the Oregon Universities' later filed Application No. 85524256 for CIVIL WAR for apparel “may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks.”

**ANSWER:** The Office Action issued by the Patent and Trademark Office on May 1, 2012, for Application No. 85524256 speaks for itself. Applicant denies the remaining allegations set forth in Paragraph 12.

13. As the marks at issue look and sound alike, are for the same goods, and even the PTO has indicated that they are likely to conflict, the Subject Application conflicts with the Oregon Universities' prior trademark rights in their CIVIL WAR trademark. The Subject Application so resembles the Oregon Universities' senior mark, CIVIL WAR, as to be likely to cause confusion, or mistake, or to deceive consumers within the meaning of 15 U.S.C. § 1052(d) when used on or in connection with the goods identified therein.

**ANSWER:** Applicant denies allegations set forth in Paragraph 13.

Please debit our Deposit Account No. 502547 for any required filing fee and any additional necessary fees.

Please direct all correspondence to: Loeb & Loeb, LLP 1906 Acklen Avenue, Nashville, TN 37212, Attn: Tiffany A. Dunn.

Respectfully submitted,

Date: October 16, 2012

LOEB & LOEB LLP

By: /s/ Tiffany A. Dunn

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**CERTIFICATE OF SERVICE**

I, Tiffany A. Dunn, hereby certify that a copy of the foregoing Answer, has been served upon:

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via e-mail and first class mail, postage prepaid, on this 16th day of October 2012.

/s/ Tiffany A. Dunn