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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

mbm

Mailed: May 26, 2017

Opposition No. 91232409

The Ohio State University

v.

Major League Football, Inc.

By the Trademark Trial and Appeal Board:

This proceeding now comes before the Board for consideration of Applicant's motion (filed March 6, 2017) to dismiss Opposer's notice of opposition in its entirety pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim and pursuant to Fed. R. Civ. P. 19 for failure to join an indispensable party. Opposer filed a timely response to Applicant's motion to dismiss on March 27, 2017.¹

Applicant seeks registration of the mark OHIO UNION, in standard characters, for the following goods and services:²

International Class 18: Leather, imitations of leather, leather and nylon, cotton and leather combination back packs; leather, imitations of leather, leather and nylon, wallets and purses; leather, imitations of leather, leather and nylon, cotton and leather combination travel bags, and trunks for travel; luggage; shoulder bags; beach bags; duffle bags; all purpose sports bags; all purpose athletic bags; sports equipment bags; school bags; tote bags;

¹ The deadline for Opposer's response was March 26, 2017, which was a Sunday. Accordingly, Opposer's response, which was filed on the next business day, is considered timely. *See* Trademark Rule 2.196.

² Application Serial No. 86874507, filed January 13, 2016, based on a bona fide intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act.

knapsacks; wallets; umbrellas; luggage tags; waist packs; all the foregoing relating to football.

International Class 25: Men's and boy's wearing apparel made of leather, denim, wool, cotton, linen, nylon, rayon, polyester or other synthetics, or combinations of synthetics or natural and synthetic materials, namely, T-shirts, sweatshirts, tank tops, woven shirts, sweaters, jackets, jerseys, pants, sweatpants, shorts, hats, caps, coats, underwear and clothing belts; women's and girl's wearing apparel made of leather, denim, wool, cotton, linen, nylon, rayon, polyester or other synthetics, or combinations of synthetics or natural and synthetic materials, namely, T-shirts, sweatshirts, tank tops, woven shirts, sweaters, jackets, jerseys, pants, sweatpants, shorts, hats, caps, coats, underwear and clothing belts; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic footwear; bathing suits for men; bathing suits for women; beachwear; coats; gloves; headbands for clothing; headbands against sweating; headgear, namely, hats and caps; scarves; shoes; sneakers; socks; sports jerseys; tracksuits; training suits; uniforms; waist belts; gloves; wristbands; and warm up suits; all the foregoing relating to football.

International Class 28: Toys and sporting goods, namely, plush toys, stuffed animals, play figures, footballs, playing cards, and miniature helmets; arm and leg guards for athletic use; bobblehead dolls; cases specially adapted for sports equipment; dolls; and flying discs; all the foregoing relating to football.

International Class 41: Entertainment services in the nature of professional football games and exhibitions; providing sports and entertainment information via a global computer network or a commercial on-line computer service or by cable, satellite, television and radio; arranging and conducting athletic competitions, namely, professional football games and exhibitions; providing appearances by a costumed mascot for professional football teams; fan clubs; fan club services, namely, personal appearances by a costumed mascot for professional football teams; entertainment services, namely, musical and dance performances provided during intervals at sports events; production of radio and television programs; live shows featuring football games, exhibitions, competitions and musical and dance performances; Sporting and cultural activities in the nature of organizing community festivals featuring a variety of activities, namely, sporting events, art exhibitions, culinary events and musical performances; distribution of television programming to cable and satellite television systems; distribution of television programs for others; publication of texts other than publicity texts; and providing web sites featuring sports news and entertainment news; all the foregoing relating to football.

On January 23, 2017, Opposer filed a notice of opposition, opposing registration of Applicant's mark on the grounds of (1) likelihood of confusion pursuant to Section 2(d) of the Trademark Act, (2) dilution by blurring pursuant to Section 43(c) of the Trademark Act, (3) dilution by tarnishment pursuant to Section 43(c) of the Trademark Act, and (4) false suggestion of a connection pursuant to Section 2(a) of the Trademark Act.

In support of its asserted claims, Opposer has pleaded common law rights in the mark OHIO UNION for "the offering and provision of ... educational, entertainment, and recreational services." Notice of opposition at ¶ 15. In lieu of filing an answer, Applicant filed a motion to dismiss Opposer's claims on the grounds that (1) Opposer has failed to join an indispensable party, and (2) Opposer has failed to adequately plead standing and has failed to state a claim upon which relief can be granted.

I. Failure to Join an Indispensable Party

By way of its March 6, 2017 motion, Applicant moves to dismiss these proceedings on the ground that Opposer failed to join an indispensable party, namely, Ohio University. In support of its motion, Applicant attached a purported settlement agreement between Opposer and Ohio University, which Applicant contends requires that Ohio University be joined as a party plaintiff to this proceeding.

"[T]he fact that two or more parties may have an interest in a mark to be pleaded in a notice of opposition, or a petition for cancellation does not mean that each such party must be joined as opposer, or petitioner." TBMP § 303.06. While joint filing is permissible, it is not required. *See id.*; *Avia Group Int'l Inc. v. Faraut*, 25 USPQ2d

1625, 1627 (TTAB 1992) (denying motion to join petitioner's parent as real party in interest because proceeding involved "what rights petitioner had in its pleaded marks vis-à-vis the defendant, not what right anyone else may have in it and denying motion to dismiss for failure to disclose parent company."). In fact, the Board has held on at least one occasion that a requirement that all parties with an interest in a trademark be joined would be "contrary to the specific provisions of Sections 13 and 14 of the [Trademark Act] which provide that 'any person' who believes that he is or would be damaged by the registration of a mark is a proper party to file an opposition or a petition to cancel." *Sun Valley Co. Inc. v. Sun Valley Mfg Co.*, 167 USPQ 304, 309 (TTAB 1970).

Here, Opposer has alleged that it has prior rights in the OHIO UNION mark and that it will be damaged by Applicant's registration. It is not necessary that Ohio University be joined as a party plaintiff, even if Ohio University has an interest in the OHIO UNION mark. Accordingly, Applicant's motion to dismiss for failure to join an indispensable party is **DENIED**.³

II. Motion to Dismiss

To survive a motion to dismiss, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic v. Twombly*, 550 U.S. 544, 547, 127 S.Ct. 1955, 1974 (2007). A claim has facial

³ To the extent Applicant was moving, in the alternative, for Ohio University to be joined as a party plaintiff to this proceeding, that request is also denied for the same reasons stated above.

plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. *See Twombly*, 550 U.S. at 556-57. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case...”).

For purposes of determining such a motion, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 1161, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim. *See Stanspec Co. v. American Chain & Cable Co., Inc.*, 531 F.2d 563, 566, 189 USPQ 420, 422 (CCPA 1976).

In its motion to dismiss, Applicant argues Opposer has failed to allege standing because the settlement agreement between Opposer and Ohio University bars

Opposer's claims and/or Opposer's right to use its pleaded mark in connection with specific goods. Opposer alternatively argues that Opposer's pleading is insufficient because Opposer's alleged trademark rights "emanat[e] from the existence of a physical structure," namely, the "Ohio Union" building. As a result, Applicant contends that Opposer has failed to plead rights in a mark, let alone a famous mark, sufficient to support a cause of action under Sections 2(a), 2(d) or 43(c) of the Trademark Act. 4 TTABVUE at 2.

A. Standing

Section 13 of the Trademark Act provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor... ." Section 13 thus establishes a broad doctrine of standing; by its terms, the statute requires only that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, a plaintiff must have a "real interest" in the outcome of the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage by the registration of the mark. *See Empresa Cubana del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Applicant contends that Opposer does not have standing to bring this proceeding as a result of the purported settlement agreement between Opposer and Ohio

University. A motion to dismiss is *solely* a test of the sufficiency of the pleadings and “does not involve a determination of the merits of the case....” *Libertyville Saddle Shop Inc.*, 22 USPQ2d at 1597. Where a motion styled as one to dismiss relies on matter outside the pleadings, the Board may construe the motion as one for summary judgment. *See id.* Here, Applicant argues the merits of the claim and submits matter outside the pleadings to demonstrate that Opposer does not have standing to oppose.

In order to move for summary judgment, however, a party must have served its initial disclosures prior to its motion for summary judgment. Trademark Rule 2.127(e). Applicant has not yet filed an answer and the motion to dismiss was filed prior to the deadline for serving initial disclosures and there is no indication in Applicant’s motion that it has already served its initial disclosures upon Opposer. Accordingly, to the extent the Board had considered Applicant’s motion to dismiss for lack of standing as one for summary judgment, the Board would have denied the motion, without prejudice, as premature.

The Board finds that Opposer has pleaded its standing to maintain this opposition proceeding based on its assertion of common law rights in the mark OHIO UNION. *See Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009). In view thereof, Applicant’s motion to dismiss for lack of standing is **DENIED**.

B. Likelihood of Confusion

To allege a valid ground for opposition under Section 2(d) of the Trademark Act, Opposer need only allege that it has valid rights that are prior to those of Applicant and that Applicant’s mark so resembles Opposer’s mark as to be likely to cause

confusion. See 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). In support of its likelihood of confusion claim, Opposer has pleaded the following: (1) Opposer has used the mark OHIO UNION prior to Applicant's filing date and constructive first use date of its mark (Notice of opposition at ¶¶ 15, 20); (2) Applicant's mark is identical to Opposer's mark and is likely to cause confusion (*Id.* at ¶ 21); (3) the goods and services are closely related (*Id.* at ¶ 23). We find that Opposer's claim of likelihood of confusion is sufficiently pleaded.

Applicant argues that Opposer has failed to state a claim of likelihood of confusion, because Applicant contends that "Ohio Union" refers only to a physical structure or a trade name, neither of which is sufficient to confer trademark rights in the mark to support a claim of likelihood of confusion.

Although Opposer explains in detail the history of the "Ohio Union" building, Opposer's allegations do not rest entirely on the existence of a physical structure. Rather, Opposer specifically alleges that it "has used the mark OHIO UNION in connection with the offering and provision of these educational, entertainment, and recreational services" and that as a result of its "long, extensive, and continuous use of the OHIO UNION mark in association with Ohio State programs and events, Ohio State has significant common law interest and rights in and to OHIO UNION... ." Notice of Opposition at ¶ 15. Opposer also specifically alleges that "Ohio State has, continuously and long prior to January 13, 2016, the filing date and constructive first use date associated with the Applied-for Mark, used OHIO UNION as a trade name,

trademark, and service mark ... or made use in a manner analogous to trademark use.” *Id.* at ¶ 20. Opposer has therefore pleaded common law rights in the OHIO UNION mark, not merely use of a building.

In fact, Applicant acknowledges in its motion to dismiss that Opposer has “undeniably claimed legal rights, as well as the lawful ability to use, the wholly unregistered designation OHIO UNION for at least “educational, entertainment, and recreational services, including promotion activities and products related thereto; retail services” against Applicant and has asserted such rights to Oppose Applicant’s mark for all of its goods and services...” 4 TTABVUE at 7. Thus it is clear that Opposer has alleged common law rights in the OHIO UNION as a service mark, in addition to use of a physical structure known as the “Ohio Union.”

Applicant also argues at length that Opposer’s allegations fall short because Opposer does not allege trademark rights in the OHIO UNION mark, but rather use as a trade name. First, for the reasons stated above, we find that Opposer has alleged common law rights in the OHIO UNION mark. Second, it is not necessary for a plaintiff to assert prior trademark rights in order to oppose an application under Section 2(d) of the Trademark Act. A plaintiff’s allegations of prior use of a trade name or corporate name are sufficient to bring a claim of likelihood of confusion or false suggestion of a connection. *See TuTorTape Laboratories, Inc. v. Halvorson*, 155 USPQ 268, 270 (TTAB 1967); *see also U.S. West, Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.3 (TTAB 1990). Additionally, use as a trade name or use analogous to trademark use (which Opposer has also specifically alleged) may be used to establish

priority. See *Dyneer Corp. v. Automotive Products PLC*, 37 USPQ2d 1251 (TTAB 1995). Whether Opposer is able to successfully prove its ownership of valid, superior common law rights in the OHIO UNION mark, or the fame of the OHIO UNION mark, is a matter for final decision or summary judgment.

In view thereof, Applicant's motion to dismiss for failure to state a claim of likelihood of confusion is **DENIED**.

C. False Suggestion of a Connection

In order to state a claim of false suggestion of a connection, a plaintiff must plead that: (1) the mark is the same as, or a close approximation of, the name of or identity previously used by another person; (2) the mark would be recognized as such because it points uniquely and unmistakably to that person; (3) the person named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods. *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012) (citing *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982).

In support of its claim of a false suggestion of a connection, Opposer pleads that Applicant's mark is the same as the name or identity previously used by Opposer (Notice of opposition ¶ 25), that Applicant's mark will be recognized as uniquely and unmistakably pointing to Opposer (*Id.* at ¶ 26), that Opposer is not connected to Applicant's goods offered under the mark (*Id.* at ¶ 27), and that Opposer's name is

famous such that a connection with Opposer would be presumed (*Id.* at ¶ 29). The Board therefore finds that Opposer’s claim of false suggestion of a connection is sufficiently pleaded.

Accordingly, Applicant’s motion to dismiss Opposer’s claim of false suggestion of a connection is **DENIED**.

A. Dilution

In order to properly plead a claim of dilution, a plaintiff must plead that it owns a famous mark that became famous prior to the applicant’s first use and that applicant’s use is likely to cause blurring or tarnishing of the plaintiff’s mark if registration is granted. *See* 15 U.S.C. § 1125(c)(1); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011).

Here, Opposer has pleaded that its OHIO UNION mark is famous (Notice of opposition ¶¶ 29-30), that Opposer’s OHIO UNION mark became famous prior to Applicant’s filing date and constructive first use of its mark (*Id.* at ¶ 30), and that registration of Applicant’s mark is likely to dilute the distinctiveness of Opposer’s mark (*Id.* at ¶ 30). The Board therefore finds that Opposer’s claim of dilution by blurring is sufficiently pleaded.

The Board finds, however, that Opposer has not adequately pleaded dilution by tarnishment. Although the ESTTA cover sheet for Opposer’s notice of opposition lists “dilution by tarnishment” as a ground for opposition, the notice of opposition is completely devoid of any allegation of tarnishment. Although the content of the ESTTA cover sheet is read in conjunction with the notice of opposition, (*PPG*

Industries Inc. v. Guardian Industries Corp., 73 USPQ2d 1926, 1928 (TTAB 2005)), the mere mention of a ground on the cover sheet is insufficient to constitute a claim. *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013). Moreover, Opposer argues the sufficiency of the pleading of each of its other claims in its brief in opposition to the motion to dismiss, but argument regarding dilution by tarnishment is absent. In view thereof, the reference to the dilution by tarnishment claim in the ESTTA cover sheet is hereby stricken.

Accordingly, Applicant's motion to dismiss Opposer's claim of dilution by blurring is **DENIED** and Applicant's motion to dismiss Opposer's claim of dilution by tarnishment is **GRANTED**.

Notwithstanding the foregoing, the Board freely grants leave to amend pleadings found to be insufficient upon challenge under Fed. R. Civ. P. 12(b)(6), as is the case here. In view thereof, Opposer is allowed until **June 15, 2017** in which to file and serve an amended notice of opposition that properly states a claim of dilution by tarnishment, failing which Opposer's dilution by tarnishment claim will be dismissed with prejudice and will be given no further consideration.⁴

In turn, Applicant is allowed until **thirty days** from the date of service of the amended notice of opposition in which to file and serve an answer or otherwise respond to the amended pleading.⁵

⁴ To the extent Opposer does file and serve an amended pleading, Opposer should reassert its allegations regarding its standing, as well as the allegations to support its claims of likelihood of confusion, false suggestion of a connection, and dilution by blurring.

⁵ In the event Opposer fails to file and serve an amended notice of opposition, Applicant is allowed until **July 15, 2017** in which to file and serve an answer to Opposer's originally-filed notice of opposition, as restricted by this order.

III. Trial Schedule

Proceedings herein are resumed. Remaining dates are reset as follows:

Deadline for Discovery Conference	August 14, 2017
Discovery Opens	August 14, 2017
Initial Disclosures Due	September 13, 2017
Expert Disclosures Due	January 11, 2018
Discovery Closes	February 10, 2018
Plaintiff's Pretrial Disclosures Due	March 27, 2018
Plaintiff's 30-day Trial Period Ends	May 11, 2018
Defendant's Pretrial Disclosures Due	May 26, 2018
Defendant's 30-day Trial Period Ends	July 10, 2018
Plaintiff's Rebuttal Disclosures Due	July 25, 2018
Plaintiff's 15-day Rebuttal Period Ends	August 24, 2018
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	October 23, 2018
Defendant's Main Brief Due	November 22, 2018
Plaintiff's Reply Brief Due	December 7, 2018

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).