

ESTTA Tracking number: **ESTTA1129095**

Filing date: **04/23/2021**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Ohio State University
Granted to Date of previous extension	04/25/2021
Address	190 NORTH OVAL MALL COLUMBUS, OH 43210 UNITED STATES
Attorney information	SAMANTHA M. QUIMBY FROST BROWN TODD LLC FROST BROWN TODD LLC 10 WEST BROAD STREET, SUITE 2300 COLUMBUS, OH 43215 UNITED STATES Primary Email: squimby@fbtlaw.com Secondary Email(s): mclark@fbtlaw.com, fbtiplitigation@fbtlaw.com, kshook@fbtlaw.com 6145597282
Docket Number	

Applicant Information

Application No.	88416806	Publication date	10/27/2020
Opposition Filing Date	04/23/2021	Opposition Period Ends	04/25/2021
Applicant	Marc Jacobs Trademarks, L.L.C. 72 SPRING STREET NEW YORK, NY 10012 UNITED STATES		


Goods/Services Affected by Opposition

<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Handbags; knapsacks; back packs; ruck-sacks; tote bags; beach bags; carry-all bags; satchels; clutch bags; shoulder bags; sling bags; purses; cosmetic bags sold empty; change purses; wallets; leather pouches; business card cases; credit card cases; toiletry cases sold empty; crossbody bags; traveling bags</p>
<p>Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, underwear, socks, hosiery, jerseys, shirts, t-shirts, blouses, sweaters, cardigan sweaters, pullovers, hoodies, sweatshirts, pants, jeans, shorts, dresses, skirts, blazers, jackets, coats, overcoats, waterproof clothing, namely, jackets and jumpsuits; bathing suits; belts; scarves; shawls; bandanas; waistcoats; pajamas; footwear, namely, shoes, boots, sandals and slippers; headwear, namely, hats and caps</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	88571984	Application Date	08/08/2019
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2005/08/00 First Use In Commerce: 2005/08/00 Clothing, namely, t-shirts, baseball caps and hats		

Attachments	88571984#TMSN.png(bytes) Notice of Opposition re THE Marc Jacobs.pdf(141572 bytes)
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Signature	/samantha m quimby/
Name	Samantha M. Quimby
Date	04/23/2021

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

IN THE MATTER OF: Application Serial No. 88/416,806
DATE OF PUBLICATION: October 27, 2020
Extensions totaling 150 Days Filed
Deadline to File Opposition: April 25, 2021

The Ohio State University,)	
)	
Opposer,)	
)	
v.)	Opposition Proceeding No. _____
)	
Marc Jacobs Trademarks, L.L.C.,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

THE OHIO STATE UNIVERSITY, an Ohio educational institution (i.e., state university) (hereinafter “Ohio State” or “Opposer”), with a principal place of business at 190 North Oval Mall, Columbus, Ohio 43210, believes it will be damaged by the issuance of a registration of the mark THE in standard characters (“MJT’s THE Mark” or “Opposed Mark”) shown in U.S. Application Serial No. 88/416,806 (“MJT’s THE Application” or “Opposed Application”) filed in the name of Marc Jacobs Trademarks, L.L.C. (hereinafter “MJT” or “Applicant”) and hereby opposes the same pursuant to Lanham Act § 13(a), 15 U.S.C. § 1063(a). As grounds for its opposition, Ohio State alleges as follows:

1. As one of the most well-respected institutions of higher learning in the country, Ohio State has provided college and graduate level educational courses, sponsored collegiate sporting events and recreation programs, and staged dramatic and musical entertainment events for over 150 years.

2. Ohio State's academic and athletic programs rank among the best in the nation. Its undergraduate program and graduate programs for law, medicine, business, engineering, and education are all currently ranked among the top 40 schools in the nation in their respective areas by U.S. News & World Report.

3. Ohio State's athletic programs have a long history of success. Ohio State is among only five universities with NCAA championships in baseball, basketball and football. Ohio State athletic teams have also won national championships in men's swimming and diving, men's outdoor track and field, men's golf, men's gymnastics, men's fencing, co-ed fencing, synchronized swimming, and men's volleyball.

Ohio State and the Evolution of THE

4. As further detailed below, the use and emphasis on the word "THE" in THE OHIO STATE UNIVERSITY has been a deliberate, integral, and important element of Ohio State's identity and history since its infancy.

5. Ohio State was founded in 1870 via a land-grant act called the Morrill Act under the name Ohio Agricultural & Mechanical College, also referred to as Ohio A&M.

6. In the early years after its founding, the name "Ohio Agricultural & Mechanical College" was thought by some as too narrow in scope and inadequate to represent the institution that was the only beneficiary of the Morrill Act in Ohio, and campaigned for a new name that could separate Ohio State from other Ohio colleges. To achieve that end, Applicant's name was changed to "The Ohio State University" in 1878, with legend having it that the use of "The" (as opposed to the addition of nothing – i.e., Ohio State University or "an" Ohio State University) was to make clear that Applicant was earmarked to be the leading educational institution in Ohio, both in size and financial support from the legislature.

7. Since Ohio State's deliberate inclusion of the term "THE" in its formal name, the term "THE", in and of itself, has evolved into an identifier of Ohio State. In support thereof, Ohio State has been continuously and consistently using THE as a trademark and in manners analogous to trademark use in connection with its athletic program since at least as early as the 1980's. Hence, a demand for apparel bearing the trademark THE ("Ohio State's THE Mark") has also evolved so that students, alumni, and fans of Ohio State and its athletic programs can demonstrate their affinity for Ohio State and wear apparel emblazoned with Ohio State's THE Mark as a source of pride.

Ohio State's Trademarks and Licensing Program

8. Ohio State owns numerous trademarks for its names, logos, and slogans used in connection with Ohio State and its athletic teams, including the "Block O" design, THE OHIO STATE UNIVERSITY, BUCKEYES, OSU, O-H-I-O, BRUTUS (the name of Ohio State's beloved school mascot), as well as trade dress for its colors and logos, including in connection with its football uniforms (collectively referred to hereafter, including with Ohio State's THE Mark, as "Ohio State Marks").

9. Ohio State licenses and markets many products bearing the Ohio State Marks that have come to symbolize the goodwill and reputation of Ohio State and its services.

10. The success of Ohio State as an academic and athletic powerhouse has cemented the presence of Ohio State and the Ohio State Marks on a national stage—making goods bearing Ohio State trademarks even more sought after and desired.

11. Ohio State's licensing revenues are consistently in the millions each year and continue to grow, averaging over \$12.5 million a year over the last 10 years.

12. Many fans and other supporters of Ohio State's athletic teams, and particularly

many of those fortunate enough to attend these games in person, demonstrate their support for Ohio State by wearing apparel bearing one or more of the Ohio State Marks and/or purchasing items bearing Ohio State Marks for family members, friends, and business associates, including apparel bearing Ohio State's THE Mark.

13. Indeed, since 2002 to date, Ohio State has earned over \$181 million in royalties from licensing Ohio State Marks—money that is then reinvested into numerous missives of Ohio State, including without limitation student scholarships, libraries, teaching, research, and athletics.

14. Since at least as early as the 1980's, Ohio State has used Ohio State's THE Mark as a trademark and in manners analogous to trademark use in connection with its athletic programs.

15. Since at least as early as 2005, Ohio State has used Ohio State's THE Mark as a trademark and in manners analogous to trademark use on clothing apparel, such as hats and t-shirts, so that students, alumni, and fans of Ohio State and its athletic programs can demonstrate their affinity for Ohio State by wearing apparel emblazoned with Ohio State's THE Mark as a source of pride.

16. Due to the long, extensive, and continuous use of Ohio State's THE Mark in association with and promotion of Ohio State's athletic programs and events, as well as on apparel sold as part of Ohio State's licensing program, Ohio State has significant common law interest and rights in Ohio State's THE Mark.

Ohio State's Trademark Application for Ohio State's THE Mark

17. In connection with its common law rights in Ohio State's THE Mark, Ohio State filed U.S. Trademark Application Serial No. 88/571,984 for Ohio State's THE Mark in standard

character format for use on “clothing, namely, t-shirts, baseball caps and hats” in Class 25 on August 8, 2019, claiming a first use in commerce and first use anywhere date of at least as early as August of 2005 (“Ohio State’s THE Application”).

18. On September 11, 2019, the assigned Examining Attorney reviewing Ohio State’s THE Application issued an Office Action citing MJT’s THE Application as a potential bar to registration of Ohio State’s THE Application despite Ohio State’s priority of use, given the earlier filing date of MJT’s THE Application.

19. Ohio State’s THE Application is currently suspended pending the outcome of MJT’s THE Application, which published for opposition on October 27, 2020.

20. Ohio State has filed extensions of time to oppose MJT’s THE Application before the Trademark Trial and Appeal Board (“TTAB”), given Ohio State’s priority of use of Ohio State’s THE Mark. These filings occurred as follows: first 30-day extension filed on November 25, 2020; additional 60-day extension filed on December 23, 2020; final 60-day extension with consent filed on February 19, 2021¹. As such, the final deadline for Ohio State to oppose MJT’s THE Application is April 25, 2021.

MJT’s THE Application

21. MJT’s THE Application was filed on May 6, 2019 for use on “handbags; knapsacks; back packs; rucksacks; tote bags; beach bags; carry-all bags; satchels; clutch bags; shoulder bags; sling bags; purses; cosmetic bags sold empty; change purses; wallets; leather pouches; business card cases; credit card cases; toiletry cases sold empty; crossbody bags; traveling bags” in Class 18, and “clothing, namely, underwear, socks, hosiery, jerseys, shirts, t-shirts, blouses, sweaters, cardigan sweaters, pullovers, hoodies, sweatshirts, pants, jeans, shorts,

¹ Throughout this time frame, Ohio State and MJT were engaged in discussions as to their respective uses and applications for registration of THE.

dresses, skirts, blazers, jackets, coats, overcoats, waterproof clothing, namely, jackets and jumpsuits; bathing suits; belts; scarves; shawls; bandanas; waistcoats; pajamas; footwear, namely, shoes, boots, sandals and slippers; headwear, namely, hats and caps” in Class 25, all on an intent-to-use basis (Section 1(b)).

22. MJT subsequently filed an Amendment to Allege Use on June 26, 2019 claiming a first use date in commerce and a first use date anywhere of December 3, 2018 for all the goods listed in Classes 18 and 25.

23. MJT thereafter amended its filing basis for all the goods listed in Classes 18 and 25 back to an intent-to-use basis (Section 1(b)) on September 4, 2020.

24. Ohio State has, continuously and long prior to MJT’s constructive first use date of May 6, 2019, and prior to any first use date that has been or can be claimed by MJT, used Ohio State’s THE Mark in connection with and in promotion of its athletic programs and events as well as on and in connection with clothing.

25. MJT’s THE Mark, as identified in MJT’s THE Application, so resembles Ohio State’s THE Mark as to be likely, when used on or in connection with the applied-for goods, to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of MJT with Ohio State, or as to the origin, sponsorship or approval of the applied-for goods or commercial activities by Ohio State, all in violation of § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with consequent injury to the public and Ohio State’s trade and goodwill.²

² It must be noted that Ohio State and MJT have executed a Consent to Register Agreement and filed amendments to the identification of goods in their respective THE applications in connection thereto to address registration issues. The amendments to the identification of goods memorialize the fact that the respective goods bearing the respective THE mark exist within different marketplaces and are promoted to different consumers. Those amendments have not yet been reviewed by the assigned examining attorneys, however, and because no further extensions of time to oppose are available, Ohio State is filing this Notice of Opposition to preserve its rights as the senior user while these amendments are reviewed or in the event MJT’s THE Application is ultimately not withdrawn as a block to Ohio State’s THE Application. MJT is aware of Ohio State’s need to file this Notice of Opposition, and the parties have agreed to suspend the opposition proceeding while the amendments are reviewed.

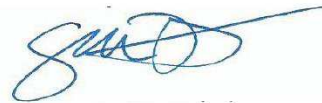
26. Moreover, because MJT's THE Application has already been cited as a potential block to Ohio State's THE Application should it register, registration of MJT's THE Application would damage Ohio State as Ohio State's THE Application will be denied registration despite Ohio State's priority of use in Ohio State's THE Mark.³

27. Given Ohio State's longstanding and prior trademark rights in Ohio State's THE Mark for use in connection with and in promotion of its athletic programs and on apparel sold through its licensing program to students, alumni, and fans of Ohio State, granting federal trademark registration for MJT's THE Mark, which would confer exclusive, nationwide rights, would be improper and would interfere with Ohio State's prior rights.

28. By reason of the foregoing, Opposer's opposition should be sustained and MJT's THE Application should be refused registration pursuant to Section 13 of the Trademark Act (15 U.S.C. § 1063).

Dated: April 23, 2021

Respectfully submitted,



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³ *Id.*