ESTTA Tracking number:

ESTTA1266216

Filing date:

02/15/2023

# 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	02/15/2023
Address	190 NORTH OVAL MALL COLUMBUS, OH 43210 UNITED STATES

Attorney information	SAMANTHA M. QUIMBY FROST BROWN TODD LLC 10 WEST BROAD STREET COLUMBUS, OH 43215 UNITED STATES Primary email: trademarks@fbtlaw.com Secondary email(s): squimby@fbtlaw.com, mclark@fbtlaw.com, tbullard@fbtlaw.com, fbtiplitigation@fbtlaw.com 6145597282
Docket no.	0537680

## Applicant information

Application no.	97155253	Publication date	10/18/2022
Opposition filing date	02/15/2023	Opposition period ends	02/15/2023
Applicant	1-Off Creative Concepts, Inc. 593 PRADO VERDE SAN MARCOS, CA 92069 UNITED STATES		

## Goods/services affected by opposition

Class 012. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: wheels

## Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols	Trademark Act Section 2(a)

# Mark cited by opposer as basis for opposition

U.S. registration no.	4458983	05/17/2013					
Register	Principal						
Registration date	12/31/2013	NONE					
Word mark	0						
Design mark							
Description of mark	The mark consists of a block						
Goods/services	Class 041. First use: First Use: 1898 First Use In Commerce: 1898 entertainment services, namely, providing college level sport exhibition events and recreation programs; educational services, namely, providing courses of instruction in sports, fitness and exercise; providing a website containing news and information relating to sports and recreation events, including game schedules and ticket sales						

Attachments	85935543#TMSN.png( bytes ) Notice of Opposition Exhibit 1 Creative O 1 Concepts.pdf(3179844 bytes ) Notice of Opposition Exhibit 2 Creative O 1 Concepts.pdf(3203371 bytes ) Notice of Opposition Exhibit 3 Creative O 1 Concepts.pdf(380794 bytes )
	Creative O 1 Concepts Notice of Opposition.pdf(181239 bytes)

Signature	/Samantha M. Quimby/
Name	SAMANTHA M. QUIMBY
Date	02/15/2023

# **EXHIBIT 1**

# THE MAKIO.

Volume XVIII.

PUBLISHED BY THE

# FRATERNITIES AND LITERARY SOCIETIES

OF THE

OHIO STATE UNIVERSITY,

COLUMBUS.

1899.

# Basket Ball Team.

	G.	M.	KARSHI	vær, Captain, .	Rig	ght	For	vard	l.		
C. R. HARRIS,			•	Left Forward. Center.	Bert Reed, C. W. Denney,					٠	Guard. Forward.
H. S. Houghton, L. Hager, .				Right Guard. Left Guard.	H. R. Jones, G. W. Stimson,						Guard. Center.
	C.	В.	Sayre,				Man	ageı	г.		

# SCORES FOR 1898-99.

#### HOME GAMES.

Dec. 2—O. S. U25	C. H. S 4
Dec. 9—O. S. U16	E. H. S o
Jan. 7-0. S. U25	Otterbein 2
Jan. 14—O. S. U18	Kenyon 2
Jan. 28—O. S. U17	Kenton 8
Feb. 4—O. S. U16	Springfield 4
Feb. 8—O. S. U47	Trinity o
10.00	
Total, 164	20



1899 <u>Makio</u>, page 223

# THE MAKIO

VOLUME XIX



Fraternities and Literary Societies

Of the
Ohio State University
Columbus

1900

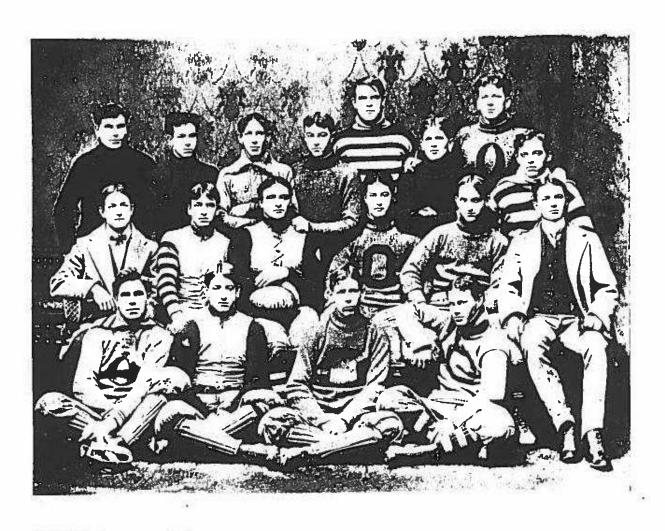
# Football Team

#### Season of 1899

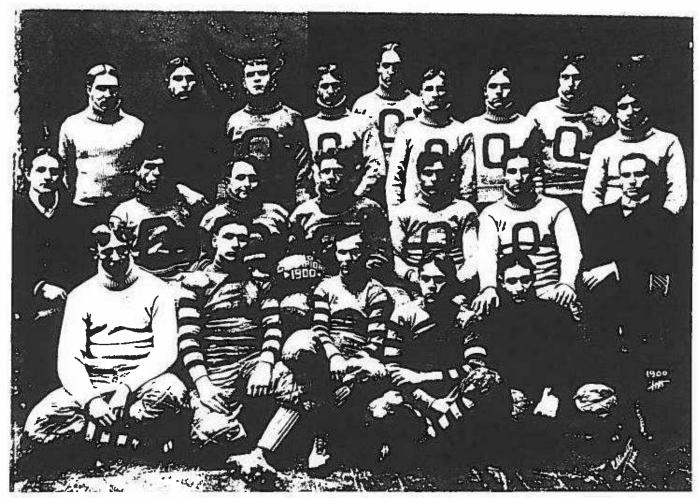
SAYERS, Captain Signist J.	w	B. C. ECKSTORM. R. SPRAGUE	Left Tackle Center Right Tackle	SCOTT HUDDLESON WRSTWATER	- -	Coach Manager 		Left End Left End Left Half-back
SIGRIST C WHARTON - TILTON - LLOYD - POOLE - HARDY -			Left Guard Right Guard Right End Right End Right End Quarter Back	HAGER -				Right Half-back Full-back Left Tackle Left Half-back Right Half-back
			Subst	ítutes				
	Breese, Center Davis Tangemann Hauk	Gi W	JLTON RAHAM RBER COWEN	Tildei Frech Johnst Jones	TLING		PEOPLES GALLOWA ALBOTT ORTON	¥Υ

#### Scores

Sept. 30, O. S. U. 30—Otterbein, 0
Oct. 7, O. S. U 29—Wittenberg 0
Oct. 14, O. S. U. 5—Case 5
Oct. 21, O. S. U. 41—O. U. 0
Oct. 28, O. S. U. 6—Oberlin 0
Nov. 4, O. S. U. 6—Adelbert 0
Nov. 11, O. S. U. 17—Marietta 0
Nov. 18, O. S. U. 12—O. M. U. 0
Nov. 25, O. S. U. 34—Muskingum 0
Thanksgiving, O. S. U. 5—Kenyon 0



1900 <u>Makio</u>, page 165



1900 Ohio State Football Team

Buck Row: St. John, Tangeman, Westwater, Coover, Kittle, Bulen, Howland, Hawk, Hager, Middle Row: J. C. B. Eckstrom, Coach; C. Siegrist, Wharton, Tilton, Capt.; J. Siegrist, Fave, Rightmire, Front Row: Lloyd, McClaren, Hardy, Herron, Boothman.





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And the second second

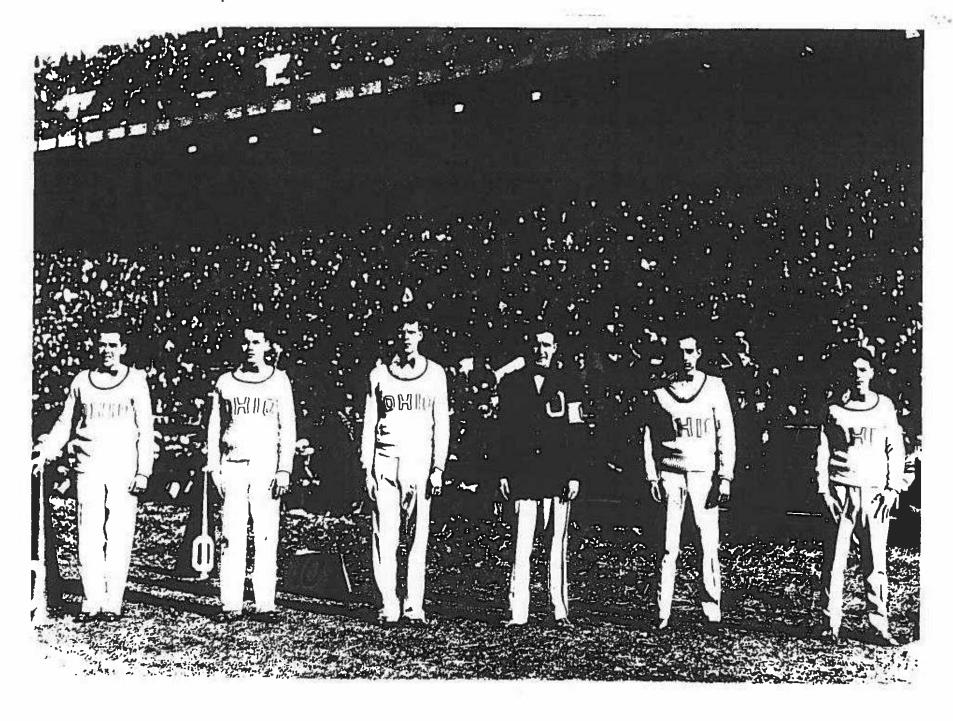
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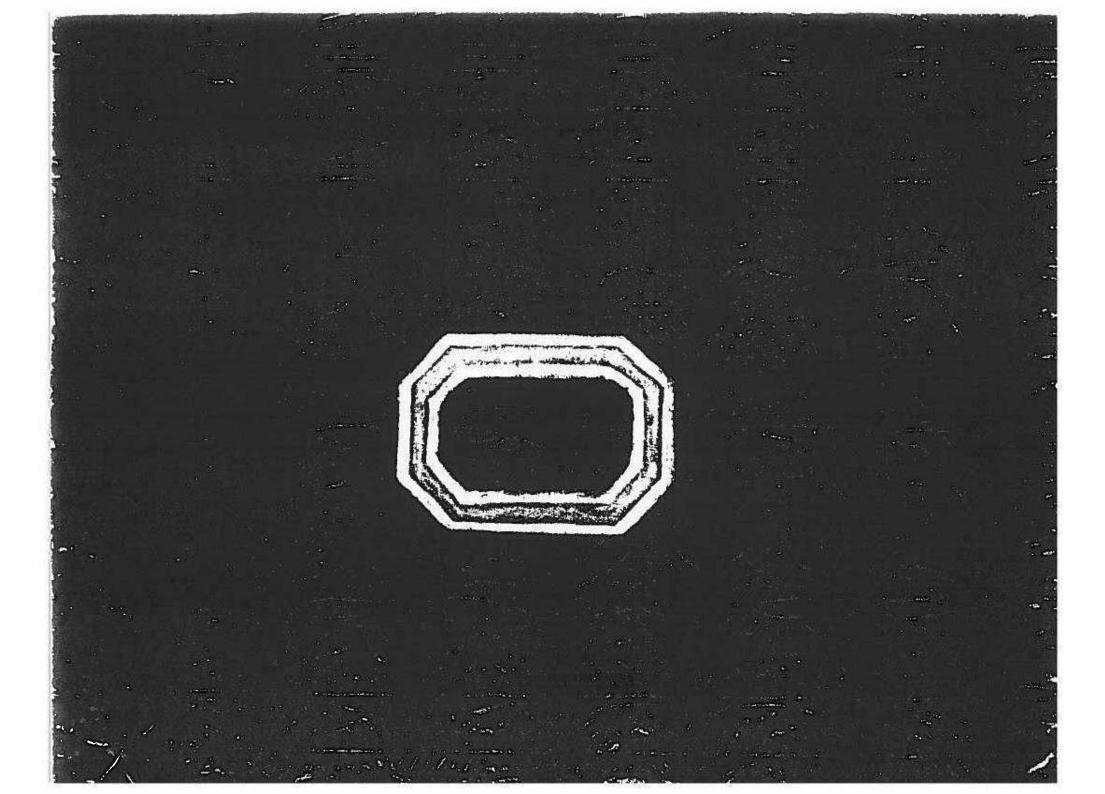
E

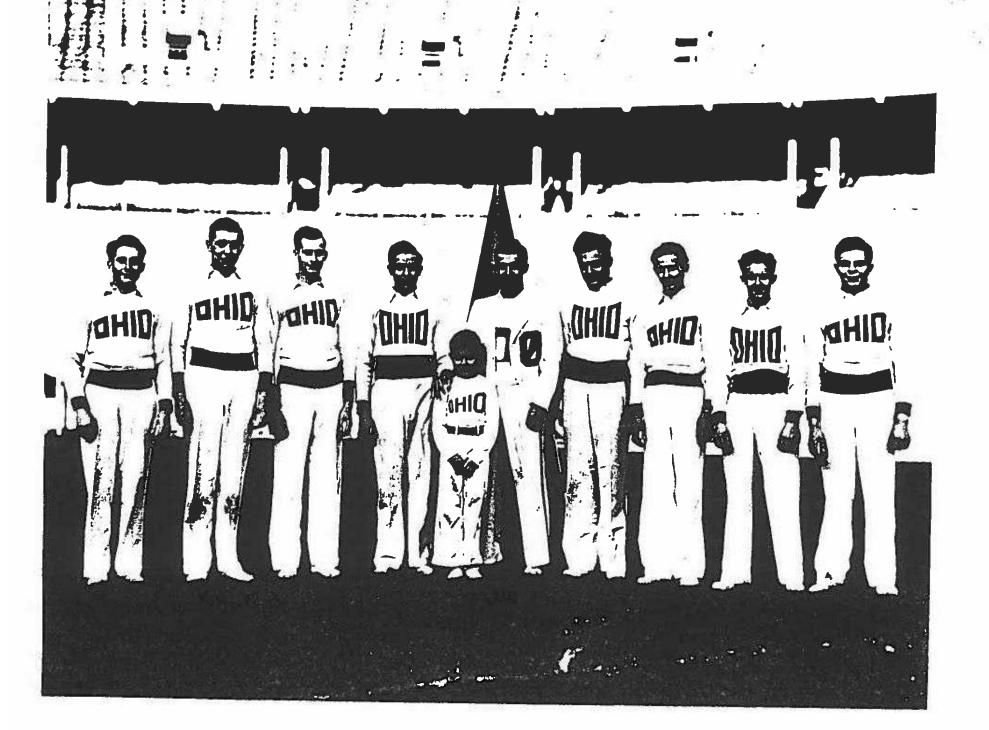
1

Photo Archives picture: Cheerleaders: 1925 (35-49b)



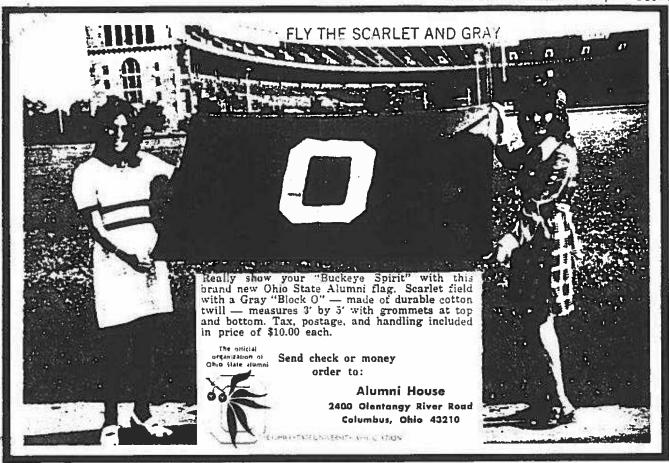
Attached is the cover of this yearbook with Block "O" on it.





ASSIGNMENT



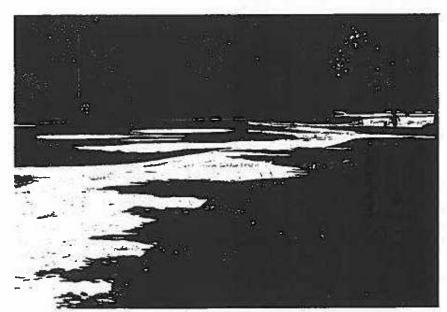






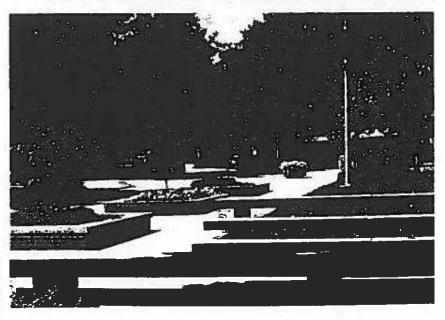
Kiosk on north side of Oval between Derby Hall and Administration Building now offers soft drinks and ice cream to students for between-class breaks, or rest period on the Oval.





South Oval Drive has given way to a mall on section of street east of the Faculty Club. No traffic can pass through the walks and bench area (right) which eventually will be filled with plantings to match the present mall area built in old North Oval Drive (right, below) in front of Hopkins. Derby and Administration.





The Obje State University Monthly

Septembe 1975



JAMES BODMAN 1952-1953

as beginning to realize I his lifelong ambition grammar school days, and was able to hold at Celina High School, so far was an alternate e assistant drum major he field was in 1949 for

came suddenly when st part of September. )th, 1950, "York Realizes all, thin figure in the o State Marching Band substitute who made

ss as a leader came not rit and cooperation of

when the ent to me for those fore flag the field,

urning to the assistant te drum major in 1951. istant drum major, Jim lers. any of the drum major candidates in the early 1950s were veterans of frustrating tryout attempts. Jimmy Spencer, from Miamisburg, Ohio, was one of those Band members who refused to give up.

Tryouts can be difficult things to assess, because the mental pressures, as most drum majors will attest, far exceed the physical exertion. Spencer was the nervous type, mildmannered, with a quiet disposition. He could do the most difficult stage routines under hard lights on a small stage, executing his performance in a flawless manner with an artist's perfection. On the field in tryouts, however, he would lose all sense of confidence, dropping the stick many times, and would virtually hang his head in shame. After four years of defeat and a lot of coaching, he won the post in 1950 over nine other contestants. But his luck seemed to be against him again. A few weeks before football season began; he broke his thumb while practicing, and was out of action for the whole season. Assistant Drum Major Dale York was promoted to drum major. The following year Spencer was given the post he deserved.

Every drum major would like to be remembered for some significant contribution that might add to the OSUMB tradition. James E. Bodman left with the Band some of his artistic talent in the uniform he wore. When he was drum major, the fine arts student designed his own uniform for an art project and had it made by Fechheimer, Inc. of Cincinnati, Ohio.

Many influences have determined the style of uniform wom by the drum majors. The first drum majors' uniforms in the 1920s were influenced by other marching band units across the country and Europe. Ohio State adhered to the universal patterns of the day with large Busby hats, long frock coats, riding pants, Wellington boots and heavy braid. They were not made to be functional but were exciting to look at. The long tail coats were fashionable attire and worn by many drum majors in the Western Conference.

When Bodman designed his uniform, he took a look at the past and eliminated many of the frills. He incorporated the new Buckeye monogram, designed in 1950 as a shoulder patch for the bandsmen. Bodman's uniform must have met with approval, for it has outlasted every other style of uniform at OSU and has been worn by 38 different drum majors since its creation.



# EXHIBIT 2





#### **OHIO STATE WRESTLING CAMPS**

#### 2022

After receiving State and University guidelines for hosting summer camps we will be able to host in person camps this summer. Based on the information provided, we will only be able to host day camps (no overnights). Each camp or clinic will have limited capacity and be required to follow our health and safety protocols. Despite our new health and safety protocols we are confident you will have an enjoyable Buckeye Sports Camp experience!

Stay tuned as we update our webpage for upcoming camps and clinics.



#### **UPCOMING CAMP DATES**

MULTIPLE DATES 2022 SUMMER CAMPS MORE INFO >

1/30/23, 12:15 PM Block O

IT SECTION OF **ABOUT US GET INVOLVED EVENTS EXEC BOARD PHOTOS** SECTION

# **BLOCK O**

#### THE OFFICIAL STUDENT SECTION OF OHIO STATE ATHLETICS

FOOTBALL · NUTHOUSE · VOLLEYBALL · SOCCER · GYMNASTICS · HOCKEY · WRESTLING WOMEN'S BASKETBALL · LACROSSE · BASEBALL

# WHO **ARE WE**

#### WE FOSTER BUCKEYE PRIDE

WITHIN STUDENTS, ALUMNI, AND FANS EVERYWHERE.

Our mission is to actively strive to support our studentathletes on the field and our members off it by upholding the spirit and tradition of The Ohio State University, building community, and making lasting memories.

MORE ABOUT US -

# WHAT WE DO

## WE CREATE AN UNPARALLELED ATMOSPHERE

AT OUR TEN DIFFERENT SPORTS SECTIONS.

The primary purpose of Block O shall be to establish and maintain a cheering section for the purpose of fostering spirit and sportsmanship, through the use of card stunts and other means, at any sporting event attended by the Block O organization. Block O strives to honor traditions and build community around Ohio State Athletics, contributing to campus culture and enabling lifelong friendship with timeless memories.

MEMBERS DIRECTORS

https://www.blocko.org 1/2 1/30/23, 12:15 PM Block O





https://www.blocko.org

1/30/23, 12:16 PM About Us Block O

IT SECTION OF

**ABOUT US** 

**GET INVOLVED** 

**EVENTS** 

**EXEC BOARD** 

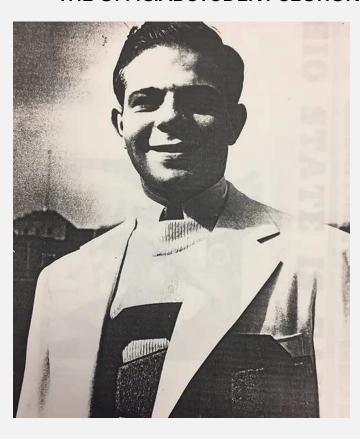
**PHOTOS** 

SECTION

# WHAT IS BLOCK O?

Block C

#### THE OFFICIAL STUDENT SECTION OF OHIO STATE ATHLETICS



Founded in 1938 by Clancy Isaac, Block O was formed with the idea of amplifying Buckeye spirit inside The Shoe. The official cheering section was started on October 1, 1938 at the Homecoming game, and the card stunt tradition was born. Clancy was praised for his spirit that came from the heart, and now we remember him as the man behind our most treasured

While our organization has endured many hardships and changes over the past 83 years, the core purpose has remained constant: to provide Buckeye spirit at every home football game. Time and change have surely shown, and Block O has shown firm friendship like no one else.

Through the decades, we have instituted 10 sections, which includes 2500+ students at every home football game. Our mission has expanded to reach more sports, more students, and more opportunities all around. Block O offers philanthropy opportunities throughout the year and encourages our members to get involved.

Block O will always be about more than just a football team (though we care a whole lot about that too) it's about the friendships to last a lifetime, and the memories you will never forget. Go Bucks!

# BLOCK O'S GOALS

01

Facilitate a welcoming and diverse environment for all members by actively promoting inclusivity during sport, philanthropic and social events.





Educate and expand knowledge of the fundamentals of Block O's mission and purpose to the community.

https://www.blocko.org/about 1/2

1/30/23, 12:16 PM About Us Block O

Increase consistently engaged active membership through all Block O events.



04

Establish and maintain an unparalleled atmosphere at Block O sports sections that captivate all Block O members and attendees.



05

Collaborate with other student organizations as well as external entities to cultivate a positive effect on Ohio State and the community.



# WANT TO HEAR MORE ABOUT HOW BLOCK O OPERATES? CLICK THE BUTTON BELOW FOR OUR CONSTITUTION!

**BLOCK O CONSTITUTION** 



1739 N High St Columbus, OH 43210 St.3092E

https://www.blocko.org/about 2/2



Home > Academics > Motorsports Student Projects

# **Motorsports Student Projects**

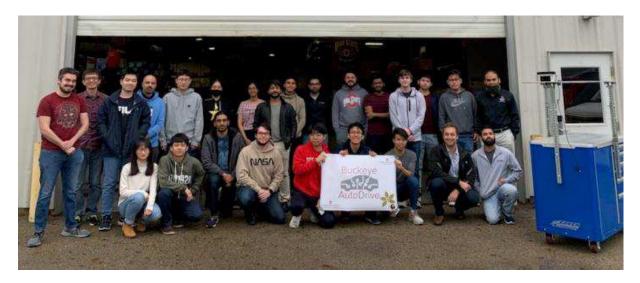
Students at The Ohio State University have the opportunity to participate in Motorsports Student Projects. This program challenges students of all majors, backgrounds, skill levels and degrees of experience to compete on one of six student teams.

Applying research and classroom concepts, this experiential learning project teaches skills for designing, fabricating, racing, managing and marketing competition vehicles. This experience includes machining, engine testing, battery testing and computer aided design.

# Support Motorsports Student Projects

## **Buckeye AutoDrive**

Buckeye AutoDrive will join nine other universities in the AutoDrive Challenge™ Il Competition! The teams will take on the challenge of developing and demonstrating an autonomous vehicle (AV) that can navigate urban driving courses as described by SAE J3016™ Standard Level 4 automation.



## Venturi Buckeye Bullet

The mission of the Venturi Buckeye Bullet 3 team is to provide unique engineering challenges for students—valuable, hands-on experience—creating some of the best new engineers in the world. This student team pushes the envelope of electric vehicle technology and in so doing aims to change public perception of electric vehicles. Mission: prove that green technologies of the future will be both fun to drive and fast! Watch a video from September, 2017 at the Bonneville Salt Flats in Wendover, Utah. Support the team.



Credit: Venturi 2016 Shivraj Gohil / Spacesuit Media

#### Ohio State EcoCAR

The EcoCAR Mobility Challenge is the latest Advanced Vehicle Technology Competition. The U.S. Department of Energy, General Motors and Mathworks are challenging 12 North American universities, including the Ohio State-Wilberforce team, to redesign a 2019 Chevrolet Blazer into a hybrid-electric, semi-autonomous and connected vehicle that has a reduced environmental impact, while maintaining or improving the practicality, styling and performance of the original design. Learn more. Support the team.



## **Buckeye Current**

Buckeye Current was founded by students in 2010 as the Buckeye Electric Motorcycle Race Team. The team's goal is to provide students experience with electric vehicles and to construct a fully operable electric motorcycle to compete in races on both the national and international level. Learn more. Support the team here.



#### Formula Buckeyes SAE

Formula Buckeyes is a volunteer student organization tasked with building a race car to compete nationally and internationally. The team operates out of the Center for Automotive research at The Ohio State University. Support the team here.

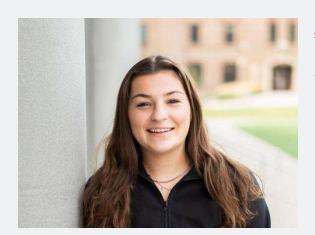


## Baja Buckeyes SAE

Baja Buckeyes SAE team is a student organization built to develop members' understanding of the automotive and motorsports businesses, as well as provide hands-on experiences that expand knowledge of engineering and fabrication practices. As a student-managed off-road race team, the group strives to present challenges to members, enabling them to learn the important elements of project management, business management and engineering design. Learn more. Support the team here.



# >> Related Stories



September 22, 2022
Friedmann brings fresh perspective to Buckeye
Current team



June 16, 2022

Buckeye AutoDrive Places Second Overall in Inaugural Competition



May 3, 2022 Ground or Air, Max Wright has a Passion for Things



April 26, 2022 Motorsports Gear Up for 2022 Season



March 22, 2022 Student Spotlight on Pantelis Anton

June 3, 2021

Despite challenges, Baja competition a success

#### June 1, 2021

Ohio State to Compete in SAE AutoDrive Challenge

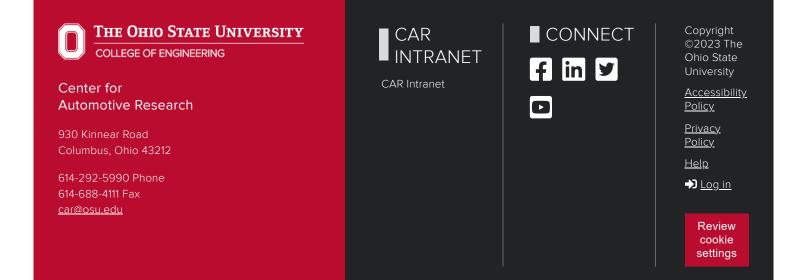
#### May 26, 2021

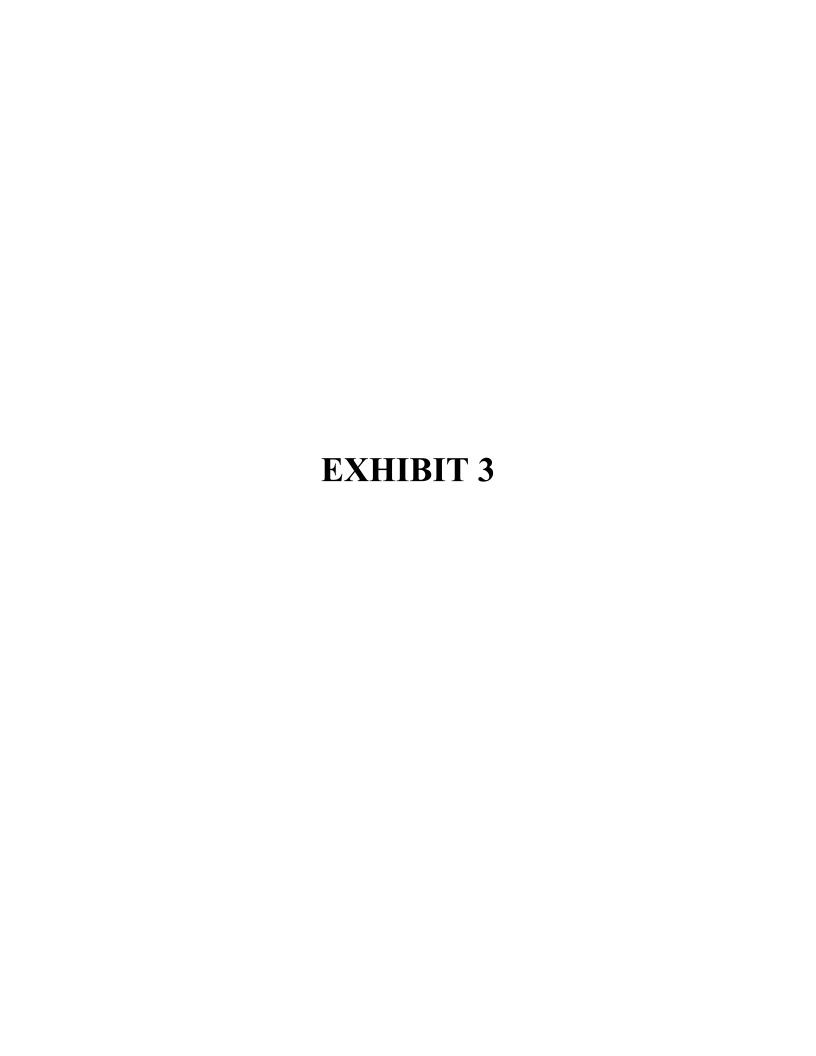
Underwater Robotics moves beyond competition to robotics education

More News

#### MEDIA CONTACT

All media inquiries should be directed to Marketing and Communication Specialist, Colleen Herr at herr.40@osu.edu.







#### **United States Patent and Trademark Office**

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#### **Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Mon Jan 30 03:17:21 EST 2023

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG BOTTOM HELP

Logout | Please logout when you are done to release system resources allocated for you.

#### Record 1 out of 1

TSDR ASSIGN Status TTAB Status

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return to TESS)



Word Mark O

Goods and Services

IC 041. US 100 101 107. G & S: entertainment services, namely, providing college level sport exhibition events and recreation programs; educational services, namely, providing courses of instruction in sports, fitness and exercise; providing a website containing news and information relating to sports and recreation events, including game schedules and ticket sales. FIRST USE:

18980000. FIRST USE IN COMMERCE: 18980000

**Mark Drawing** 

Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 85935543 Filing Date May 17, 2013

Current Basis 1A
Original Filing
Basis

Published for Opposition

October 15, 2013

Registration Number

4458983

Registration

Date

December 31, 2013

**Owner** (REGISTRANT) THE OHIO STATE UNIVERSITY state university OHIO 190 North Oval Mall

Columbus OHIO 43210

Attorney of Record

Samantha M. Quimby

Prior

Registrations

s 2064906;2657665;2689612

**Description of** 

Mark

Color is not claimed as a feature of the mark. The mark consists of a block letter "O".

Type of Mark SERVICE MARK Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead LIVE Indicator

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG TOP HELP

|.HOME | SITE INDEX| SEARCH | eBUSINESS | HELP | PRIVACY POLICY

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

In the Matter of Application Serial No. 97/15	55,253	
Publication Date: October 18, 2022		
30-Day and 60-Day Extension Filed		
Deadline to File Opposition: February 15, 20	023	
The Ohio State University,	)	
Opposer,	)	
V.	)	Opposition Proceeding No
1-Off Creative Concepts, Inc.,	)	
Applicant.	)	

### **NOTICE OF OPPOSITION**

THE OHIO STATE UNIVERSITY, an Ohio Educational Institution (state university), having a principal place of business at 190 North Oval Mall, Columbus, Ohio 43210 ("Ohio State" or "Opposer"), believes it will be damaged by registration of U.S. Application Serial No. 97/155,253 (the "1-Off Application") filed by California corporation 1-Off Creative Concepts, Inc. (the "Applicant"), for the design mark shown below, intended for use in connection with "wheels" in international class 12 (the "Applied-for Goods"):



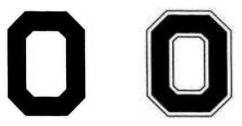
(the "1-Off Mark"). Ohio State opposes the 1-Off Application pursuant to Lanham Act § 13(a), 15 U.S.C. § 1063(a). As grounds for opposition, Ohio State alleges as follows:

- 1. Established in 1870, Ohio State has developed into one of the most well-respected institutions of higher learning in the country.
- For over 150 years, Ohio State has provided college and graduate level educational courses, collegiate sporting events and recreation programs, and dramatic and musical entertainment events.
- 3. Ohio State has a long tradition of academic excellence, and its reputation is nationally known. Ohio State is currently ranked among the top 20 public universities in the United States and sixteen of Ohio State's graduate and professional programs are ranked in the top 10 in their fields in the nation according to U.S. News & World Report.
- 4. In addition to its academic achievements, 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's 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.
- 5. In the last twenty years, the Ohio State football team has won eleven (11) Big Ten Football Championships<sup>1</sup> as well as the National Championship in 2014<sup>2</sup> its eighth NCAA football championship. In addition, the Ohio State basketball team has enjoyed seventeen (17) twenty-win seasons in the last twenty years.

<sup>&</sup>lt;sup>1</sup> Ohio State vacated its 2010 Big Ten Football Championship.

<sup>&</sup>lt;sup>2</sup> Ohio State has appeared in the College Football Playoff structure five (5) times since its inception in 2014.

- 6. Ohio State's athletic teams receive substantial coverage by local, regional and national media, including the national broadcast of certain Buckeye football and basketball games. In the modern era of online media sites, smartphones and mobile apps, the coverage of Ohio State athletics reaches an even wider audience. The successful seasons noted above have cemented the presence of Ohio State, including its branding, on a national stage.
- 7. Ohio State has a storied history of brands, logos, trademarks and indicia used in connection with its products and services for which it has established tremendous goodwill. One such trademark is Ohio State's "Block O" mark in standalone and outlined formats:



(the "Block O Mark").

- 8. Since at least as early as 1898, Ohio State has used the Block O Mark in connection with Ohio State athletic and recreational programs and events by displaying it on the uniforms of student athletes, cheerleaders, drum majors and marching band members, as well as by displaying the Block O Mark on event programs and other forms of promotional material. Attached as Exhibit 1 are examples of this historical usage over the years.
- 9. The Block O Mark is the heart of the branding and image of Ohio State and is used in connection with all products and services offered and provided by Ohio State, including without limitation its athletic, recreational, arts and entertainment programs and services as well as its renowned educational programs, including its center for automotive research and related motorsports competitions ("University Services").

- 10. The Block O Mark is consistently displayed in the middle of the football field at Ohio Stadium where millions of viewers have seen the Ohio State Buckeyes football team play its home games. The Block O Mark is also prominently displayed on the floor of the Covelli Center where Ohio State hosts its home wrestling matches as well as on the Nick Swisher Field at Bill Davis Stadium where Ohio State hosts its baseball games. The Block O Mark can also be found on apparel worn by coaches, players, fans and recruits. Attached as <a href="Exhibit 2">Exhibit 2</a> are examples of current usage of the Block O Mark in connection with the rendering and promotion of Ohio State's University Services.
- 11. As the result of Ohio State's long, extensive and continuous use of the Block O Mark as described in the preceding paragraphs, the Block O Mark has achieved favorable national recognition and has become an asset of significant value as a symbol pointing uniquely to Ohio State, its services, products and goodwill. Indeed, consumers now associate the Block O Mark exclusively with Ohio State.
- 12. Ohio State strictly licenses, controls and markets many items under its common law and registered trademarks, including without limitation the Block O Mark, to protect the tradition, prestige and goodwill associated with its marks, and Ohio State makes systematic efforts to safeguard the quality and integrity of its marks.
- 13. Students, alumni and fans purchase licensed goods bearing various trademarks, designations and mottos of Ohio State, including without limitation the Block O Mark, to show their affinity for, and association with, Ohio State and its beloved athletic programs.
- 14. Consistent with Ohio State's branding efforts and licensing program and the demand for apparel, novelty items, and other consumer goods bearing the storied and historical marks of Opposer, Ohio State licenses the use of the Block O Mark on a wide variety of consumer

- goods, including without limitation, automotive accessories, clothing, watches, sporting equipment, toys, and decals ("Licensed Goods").
- 15. Over the last 10 years, Ohio State's licensing program has generated over \$145 million in royalty revenue from approximately \$2.2 billion in licensed retail sales.<sup>3</sup>
- 16. Based on Ohio State's long time, widespread and exclusive use and promotion of the Block O Mark, as well as the arbitrary nature of the Block O Mark in relation to the University Services and the Licensed Goods, consumers and businesses identify the goods and services offered under the Block O Mark as originating from or otherwise affiliated or connected with Ohio State.
- 17. Ohio State is the owner of, among others, the following federal trademark registration relevant to this matter:



— Registration No. 4,458,983 registered December 31, 2013, for entertainment services, namely, providing college level sport exhibition events and recreation programs; educational services, namely, providing courses of instruction in sports, fitness and exercise; providing a website containing news and information relating to sports and recreation events, including game schedules and ticket sales;

#### (the "Ohio State Registered Mark").

- 18. Pursuant to Trademark Rule 2.122(d)(1), Ohio State hereby provides proof of status and title of the Ohio State Registered Mark by filing a copy of the records from the USPTO electronic database attached hereto as Exhibit 3.
- 19. The certificate of registrations identified in Paragraph 17 are valid and subsisting and prima

<sup>&</sup>lt;sup>3</sup> This revenue supports Ohio State's students, faculty and staff with student scholarships, libraries, and other university initiatives that support Ohio State's overall mission as the leading state university in Ohio.

facie evidence of the validity of the registrations, of Ohio State's ownership of the Ohio State Registered Mark, of Ohio State's exclusive right to use the Ohio State Registered Mark in commerce in connection with the goods and services specified under the provisions of 15 U.S.C. § 1057(b), and constructive notice of Ohio State's claim of ownership under 15 U.S.C. § 1072. Moreover, the Ohio State Registered Mark is incontestable, which provides conclusive evidence of its validity, of Ohio State's ownership of the mark, and of Ohio State's exclusive right to use the Ohio State Registered Mark in commerce under 15 U.S.C. § 1115(b).

- 20. In addition to the rights afforded to Opposer by the Ohio State Registered Mark, Ohio State owns significant common law rights in the Block O Mark through its extensive and exclusive use in connection with the promotion, offering and provision of its goods and services for over 120 years, including without limitation the University Services and Licensed Goods (the Ohio State Registered Mark and the Block O Mark are hereafter collectively referred to as the "Block O Marks").
- 21. Despite Ohio State's prior rights in the Block O Marks and in the face of the Ohio State Registered Mark, Applicant applied to register the 1-Off Mark in the following stylization based upon an intent to use in connection with the Applied-for Goods:



22. As a result of the distinctiveness of the Block O Marks and Ohio State's long time, widespread and exclusive use and promotion of the Block O Marks, the Block O Mark is

- a famous trademark within the meaning of § 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and became famous prior to any first use of the 1-Off Mark in commerce or any other priority date on which the Applicant may rely.
- 23. The 1-Off Application published for opposition on October 18, 2022. On November 17, 2022, and again on December 16, 2022, Ohio State filed requests for extensions of time to file an opposition against the 1-Off Application.

# CLAIM I — PRIORITY AND LIKELIHOOD OF CONFUSION

- 24. Ohio State hereby realleges and incorporates by reference the allegations of the preceding paragraphs as though fully set forth herein.
- 25. As indicated above, Ohio State has continuously, and long prior to Applicant's constructive first use date of December 3, 2021, used the Block O Marks to identify and distinguish its University Services and Licensed Goods sold to students, alumni, and fans of Opposer.
- 26. Accordingly, there is no question as to Ohio State's priority of use over the Applicant.
- 27. The 1-Off Mark is highly similar to the Block O Marks in sight, sound and meaning.
- 28. The 1-Off Mark incorporates the Block O Mark in its entirety, having only added the phrase "Creative Concepts" in a font size that is a small fraction of the size of the Block O element and overlaying a "1" over the Block O.
- 29. The "1" in the 1-Off Mark does not obstruct the commercial impression of the Block O incorporated into the mark and, notably, is commonly associated with many of Ohio State's services, namely, athletic competitions, including in the arena of motorsports.
- 30. Indeed, the "block styled" O is the central element of the 1-Off Mark and, as such, is the dominant portion of the 1-Off Mark.
- 31. As a result, the 1-Off Mark conveys the same or substantially similar overall commercial

- impression as the Block O Marks.
- 32. In addition, because the 1-Off Mark does not claim color, registration of the 1-Off Mark would provide the Applicant the presumptive right to use the 1-Off Mark with any color, including Ohio State's distinctive school colors of scarlet and gray<sup>4</sup>.
- 33. Use of the 1-Off Mark in Ohio State's school colors or combination of colors would only further heighten the likelihood of confusion to arise from Applicant's use of the 1-Off Mark with the Applied-for Goods.
- 34. The success of Ohio State in both its educational missions and its athletic programs have cemented the presence of the Block O Marks on a national stage—making goods and services bearing the Ohio State Marks even more sought after and desired.
- 35. Because the 1-Off Application and the Ohio State Registered Mark have no restrictions as to channels of trade or class of purchasers, the Applied-for Goods are presumed to travel in the same channels of trade to the same class of purchasers as those of the goods and services identified in the Ohio State Registered Mark.
- 36. The 1-Off Mark so resembles the Block O Marks 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 Applicant 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.

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<sup>&</sup>lt;sup>4</sup> The school colors of scarlet and gray have become synonymous with Opposer in the relevant marketplace. Indeed, the colors scarlet and gray have been characterized by federal courts as a trademark that is strongly associated with The Ohio State University. See e.g., Bd. of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co., 550 F.3d 465, 486 (5th Cir. 2008).

- 37. If the Applicant is granted a registration for the 1-Off Mark, Applicant would obtain a *prima facie* exclusive right to use the mark in commerce on or in connection with the registered services. Thus, such registration would be in furtherance of the injury to the public and Ohio State's trade and goodwill.
- 38. Therefore, Ohio State respectfully requests that this opposition be sustained and that the registration of the 1-Off Application for the 1-Off Mark be refused pursuant to §§ 2(d) and 13(a) of the Trademark Act, 15 U.S.C. §§ 1052(d), 1063(a).

# **CLAIM II – FALSE SUGGESTION OF A CONNECTION**

- 39. Ohio State hereby realleges and incorporates by reference the allegations of the preceding paragraphs as though fully set forth herein.
- 40. The 1-Off Mark is the same as or a close approximation of the name or identity used by Ohio State.
- 41. The 1-Off Mark will be recognized as uniquely and unmistakably pointing to Ohio State.
- 42. Ohio State is not connected to the services offered by Applicant under the 1-Off Mark, nor is Applicant related to Ohio State in any manner.
- 43. The 1-Off Mark is intended to be used all over the country, including in Ohio, and the Applied-for Goods will be offered to the same consuming public that Ohio State's products and services are advertised, offered, and sold to—namely, the students, alumni, fans, and supporters of Ohio State.
- 44. The fame and reputation in connection with its University Services and Licensed Goods is such that when Applicant uses the 1-Off Mark to identify any products or services, a connection with Ohio State will be presumed, thus creating a false sense of connection with Opposer under Section 2(a).

# **CLAIM III — DILUTION**

- 45. Ohio State hereby realleges and incorporates by reference the allegations of the preceding paragraphs as though fully set forth herein.
- 46. Given Ohio State's extensive use of the Block O Marks for over a century in connection with its University Services, and its subsequent expansion of the Block O Marks for use in connection with the Licensed Goods sold in connection therewith, the Block O Marks became famous long before Applicant's constructive first use date.
- 47. The Block O Mark is distinctive and is a "famous mark" within the meaning of § 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).
- 48. The Block O Marks became famous prior to any first use of the 1-Off Mark in commerce that may be claimed by Applicant or any other date on which the Applicant may rely for purposes of priority.
- 49. Registration by Applicant of the 1-Off Mark for the Applied-for Goods would be likely to impair the distinctiveness, and cause dilution by blurring, of Opposer's famous Block O Marks in violation of § 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).
- 50. Accordingly, Ohio State respectfully requests that this opposition be sustained and that the registration of the 1-Off Application be refused pursuant to §§ 43(c) and 13(a) of the Trademark Act, 15 U.S.C. §§ 1125(c), 1063(a).

WHEREFORE, Opposer prays this Notice of Opposition be sustained and that the 1-Off Application be refused registration.

Date: February 15, 2023

Respectfully submitted,

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