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

Proceeding no.	91283434
Party	Defendant 1-Off Creative Concepts, Inc.
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Date	03/27/2023
Attachments	1Off Answer to Notice of Opposition.pdf(158764 bytes)

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

The Ohio State University,

Opposer,

v.

1-Off Creative Concepts, Inc.,

Applicant.

Opposition No. 91283434

Serial No.: 97/155.253

ANSWER TO OPPOSITION

Applicant 1-Off Creative Concepts, Inc. (“Applicant”), by and through its undersigned counsel, hereby responds to the Notice of Opposition (the “Opposition”) filed by opposer The Ohio State University (“Opposer”) as follows:

The first paragraph in the Opposition is an introductory paragraph that does not require a responsive pleading. In the event any response is necessary, Applicant denies that Opposer will be damaged by registration of the U.S. Application Serial No. 97/155,253 (the “1-Off Application”) and denies that Opposer has any valid grounds on which to oppose the 1-Off Application.

1. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 1 and, therefore, Applicant denies the same.

2. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 2 and, therefore, Applicant denies the same.

3. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 3 and, therefore, Applicant denies the same.

4. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 4 and, therefore, Applicant denies the same.

5. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 5 and, therefore, Applicant denies the same.

6. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 6 and, therefore, Applicant denies the same.

7. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 7 and, therefore, Applicant denies the same.

8. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 8 and, therefore, Applicant denies the same.

9. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 9 and, therefore, Applicant denies the same.

10. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 10 and, therefore, Applicant denies the same.

11. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 11 and, therefore, Applicant denies the same.

12. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 12 and, therefore, Applicant denies the same.

13. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 13 and, therefore, Applicant denies the same.

14. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 14 and, therefore, Applicant denies the same.

15. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 15 and, therefore, Applicant denies the same.

16. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 16 and, therefore, Applicant denies the same.

17. Applicant admits that Opposer owns the mark with the Registration No. 4,458,983 (“Opposer’s Registered Mark”), but denies that Opposer’s Registered Mark is relevant to this matter.

18. Paragraph 18 attaches an exhibit and does not appear to require a responsive pleading. In the event any response is necessary, Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 18 and, therefore, Applicant denies the same.

19. Paragraph 19 consists of statements about Opposer's perception about the law and pleads legal conclusions to which no answer is required. In the event any response is necessary, Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 19 and, therefore, Applicant denies the same.

20. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 20 and, therefore, Applicant denies the same.

21. Applicant admits that it applied to register the 1-Off Mark, but denies the remaining allegations of paragraph 21.

22. Paragraph 22 consists of statements about Opposer's perception about the law and pleads legal conclusions to which no answer is required. In the event any response is necessary, Applicant denies the allegations contained in paragraph 22.

23. Admitted.

24. Applicant incorporates its responses to paragraphs 1-23 as though set forth fully herein.

25. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 25 and, therefore, Applicant denies the same.

26. Denied.

27. Denied.

28. Denied.

29. Denied.

30. Denied.

31. Denied.

32. Applicant admits that the 1-Off Application does not claim color. Applicant is without knowledge sufficient to form a belief as to Opposer's school colors and whether they are distinctive and, therefore, Applicant denies the remaining allegations contained in paragraph 32.

33. Denied.

34. Applicant is without knowledge sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 34 and, therefore, Applicant denies the same.

35. Applicant admits that the 1-Off Application has no restrictions as to channels of trade or class or purchasers, but denies the remaining allegations in paragraph 35.

36. Denied.

37. Applicant admits that if it 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 registered services, but denies that such registration would cause injury to the public or to Opposer.

38. Applicant admits that Opposer has made the requests stated in paragraph 38, but denies that such requests should be granted.

39. Applicant incorporates its responses to paragraphs 1-38 as though set forth fully herein.

40. Denied.

41. Denied.

42. Admitted.

43. Applicant admits that the 1-Off Mark is intended to be used all over the country and that the Applied-for-Goods can be purchased by any member of the consuming public, and denies the remaining allegations contained in Paragraph 43.

44. Denied.

45. Applicant incorporates its responses to paragraphs 1-44 as though set forth fully herein.

46. Denied.

47. Paragraph 47 consists of statements about Opposer's perception about the law and pleads legal conclusions to which no answer is required. In the event any response is necessary, Applicant denies the allegations contained in paragraph 47.

48. Denied.

49. Denied.

50. Applicant admits that Opposer has made the requests stated in paragraph 50, but denies that such requests should be granted.

AFFIRMATIVE DEFENSES TO COUNTERCLAIM

1. The Opposition fails to state claims upon which relief can or should be granted because, *inter alia*, the 1-Off Mark is not confusingly similar to Opposer's Registered Mark or to Opposer's claimed common law mark (together with Opposer's Registered Mark, "Opposer's Claimed Marks").

2. The Opposition fails to state claims upon which relief can or should be granted because, *inter alia*, Opposer's Claimed Marks are not famous.

3. The Opposition fails to state claims upon which relief can or should be granted because, *inter alia*, Opposer's Claimed Marks lack secondary meaning.

4. Opposer is not entitled to the relief sought because other third parties have used similar marks for similar goods, thus Opposer's Claimed Marks are weak and thus entitled to no protection, or only to a narrow scope of protection.

5. Opposer is not entitled to the relief sought because Opposer's Claimed Marks and/or a component of Opposer's Claimed Marks, is a descriptive term for Opposer's goods and/or services, thus Opposer's Claimed Marks are weak and thus entitled to no protection, or only to a narrow scope of protection.

6. Applicant reserves its right to raise any and all affirmative defenses based on information it learns, through discovery or otherwise, which would serve as the basis for an additional defense up to the time including after trial.

WHEREFORE, Application respectfully requests that the Opposition be dismissed in its entirety, with prejudice, and that the 1-Off Application be granted and registration issued to Applicant.

This Answer is being submitted electronically through ESTTA.

Dated: March 27, 2023

Respectfully submitted,

/Talya Goldfinger/

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Attorneys for Applicant 1-Off Creative
Concepts, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Applicant 1-Off Creative Concepts, Inc., in the above-captioned proceeding and that on the date which appears below, she caused a copy of the foregoing **ANSWER TO COUNTERCLAIM** to be served on the following, via electronic filing with the TTAB via ESTTA as well as via electronic mail:

Opposer's Attorney of Record:

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Dated: March 27, 2023

/Talya Goldfinger/
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