

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: January 30, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
American University

v.

American University of Kuwait

—
Cancellation No. 92049706

Stephanie Bald of Kelly IP, for American University.

Robert Ludwig of Ludwig & Robinson PLLC, for American University of Kuwait.

—
Before Wolfson, Greenbaum and Larkin,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

American University of Kuwait (Respondent) owns a Principal Register registration for the mark depicted below for “Educational services, namely, providing courses of instruction at the college level” in International Class 41:¹

—
¹ Registration No. 3387226 issued on February 15, 2008; renewed.



The colors maroon and gold are claimed as features of the mark, and “AMERICAN UNIVERSITY OF KUWAIT” has been disclaimed.²

American University (Petitioner) petitioned to cancel the registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Respondent’s use of the mark would be likely to cause confusion with Petitioner’s AMERICAN UNIVERSITY marks registered in International Class 41:³

² The description of the mark reads: “The mark consists of a minaret with a maroon clock face in the middle of the minaret with the wording ‘AUK’ in maroon underlined in yellow gold underneath the design. The wording ‘AMERICAN UNIVERSITY OF KUWAIT’ in maroon sits underneath the wording ‘AUK,’ also in maroon. The color maroon appears in all of the lettering in the mark and inside the window design and the clock design, both of which sit inside the minaret design. The color gold appears in the outline of the minaret design and inside the line that sits underneath the term AUK.”

³ In addition to these registrations, Petitioner pleaded Registration No. 2986715 for the mark AMERICAN INTERNATIONAL UNIVERSITY, registered as a collective membership mark used to indicate membership in an International University; issued August 23, 2005, renewed. In its brief, Petitioner notes that “[a]lthough pleaded, it is not relying on Reg. No. 2986715 for purposes of proving its likelihood of confusion claim.” 154 TTABVUE 28. Record citations are to TTABVUE, the Trademark Trial and Appeal Board’s publicly available docket history system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Confidential documents are referenced where appropriate; however, any confidential information in exhibits or otherwise will only be referred to in general terms.

- Registration No. 2878419 for the mark AU in stylized form, , for “Educational services, namely, providing courses of instruction at the college and graduate level, distributing course materials in connection therewith, conducting educational conferences and educational research in the fields of politics, science, history, languages, computer technology, math, arts, music; entertainment services, namely, radio programming for a university setting; organizing exhibitions of university-level athletics” and ancillary goods;⁴
- Registration No. 3337869 for the mark AU (typeset) for “Educational services, namely, providing courses of instruction at the college and graduate level, distributing course materials in connection therewith, conducting educational conferences and educational research in the fields of politics, science, history, languages, computer technology, math, arts, music; entertainment services, namely, radio programming for a university setting; organizing exhibitions of university-level athletics” and ancillary goods;⁵
- Registration No. 3559022 for the mark **A NEW AMERICAN UNIVERSITY** (standard characters; UNIVERSITY disclaimed; acquired distinctiveness claimed as to “AMERICAN UNIVERSITY”) for “Educational services, namely, providing courses of instruction at the college and graduate level, distributing course materials in connection therewith, conducting educational conferences and educational research in the fields of politics, science, history, languages, computer technology, math, arts, music; entertainment services, namely, radio programming for a university setting; organizing exhibitions of university-level athletics”;⁶ and
- Registration No. 4774583 for the mark **AMERICAN UNIVERSITY** (standard characters; “UNIVERSITY”

⁴ Issued August 31, 2004; renewed. Color is not claimed as a feature of the mark.

⁵ Issued November 20, 2007; renewed. A typed mark is the legal equivalent of a standard character mark. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

⁶ Issued January 6, 2009; renewed.

disclaimed; acquired distinctiveness claimed in whole) for “Educational services, namely, providing courses of instruction at the college and graduate level, namely, distributing course materials, conducting educational conferences and educational research in the fields of politics, science, history, languages, computer technology, math arts, music; entertainment services, namely, radio programming for a university setting; entertainment services, namely, organizing exhibitions of university-level athletics” and ancillary goods.⁷

In its Answer, as amended, Respondent denied the salient allegations of the Petition to Cancel, and asserted the affirmative defenses of unclean hands, estoppel by acquiescence, laches, and “fraud on the Board.”⁸ Respondent also counterclaimed to cancel Petitioner’s pleaded registrations that contain the phrase AMERICAN UNIVERSITY, on the ground that the phrase is generic or “commonly descriptive” without the ability to acquire distinctiveness.⁹ Petitioner denied Respondent’s counterclaims.¹⁰

⁷ Issued July 21, 2015. “Ancillary goods” include magnets in Class 9; alarm clocks, jewelry, trophies and watches in Class 14; newsletters, teaching materials, printed awards, binders, decals, stationery, bookmarks, business and greeting cards, pencils, pens and brushes in Class 16; golf umbrellas, book bags, billfolds, purses and luggage tags in Class 18; bulletin boards, picture frames and key chains in Class 20; beverage ware in Class 21; bed spreads and pillow cases in Class 24; clothing in Class 25; and playing cards, balls and Christmas tree decorations in Class 28.

⁸ As discussed more fully below, Respondent also alleged that Petitioner abandoned the mark AMERICAN UNIVERSITY by allowing the term to become generic for educational services.

⁹ Respondent did not counterclaim to cancel the two pleaded registrations for the “AU” mark, Reg. Nos. 2878419 and 3337869.

¹⁰ Petitioner’s affirmative defense of unclean hands, and its alleged “defense” that Respondent has failed to state a claim upon which relief may be granted, have not been considered. We give Petitioner’s affirmative defense of unclean hands no consideration as Petitioner did not pursue the defense at trial. *See Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (affirmative defenses deemed waived where no mention of them in trial brief); *cf. Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (failure to pursue pleaded claim results in waiver).

I. Procedural Background

This case commenced on July 25, 2008 with the filing of Petitioner's cancellation petition. On January 30, 2009, proceedings were suspended pending the disposition of Cancellation No. 92031743, *Am. Univ. v. Am. Univ. of the Caribbean*.¹¹ Proceedings were resumed on December 30, 2014, following dismissal of that cancellation proceeding.¹² On April 1, 2015, Respondent amended its answer (Respondent's first amended answer, 20 TTABVUE) to include counterclaims for cancellation of Petitioner's Registration Nos. 2986715,¹³ 3559022, and 4127891,¹⁴ on the ground that

We give its assertion that Respondent has failed to state a claim no consideration because it is not a true affirmative defense; it "relates to an assertion of the insufficiency of the pleading of the plaintiff's claim rather than a statement of a defense to a properly pleaded claim." *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) (citing *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001)).

¹¹ 13 TTABVUE. Respondent was not a party to this proceeding.

¹² 19 TTABVUE.

¹³ Although Petitioner is not relying on this mark for purposes of its likelihood of confusion claim, Respondent's counterclaim has not been withdrawn. On the other hand, Respondent has not submitted testimony or evidence on the issue of whether AMERICAN UNIVERSITY is generic for collective membership services, and we therefore consider the claim waived. Further, we disregard Respondent's arguments that the registration was obtained by a sham assignment or should be deemed abandoned due to naked licensing, 176 TTABVUE 46, as based on unpleaded claims and as unsupported by any testimony or documentary evidence.

¹⁴ Petitioner did not initially plead Reg. No. 4127891, but Respondent counterclaimed to cancel the registration in its first amended answer, 20 TTABVUE, and reasserted the counterclaim in its second and third amended answers, 42 TTABVUE and 89 TTABVUE. Petitioner made the registration of record at 108 TTABVUE 10-22.

Reg. No. 4127891 for the mark AMERICAN UNIVERSITY WASHINGTON COLLEGE OF LAW (and design) (claiming acquired distinctiveness in part under Section 2(f) as to "AMERICAN UNIVERSITY" and "WASHINGTON COLLEGE OF LAW" with a disclaimer of the terms "UNIVERSITY" and "COLLEGE OF LAW") issued on April 17, 2012, for, inter alia, "educational services, namely, providing courses of instruction at the graduate level and distributing course materials in connection therewith, conducting educational conferences in

the term AMERICAN UNIVERSITY is either generic or highly descriptive without acquired distinctiveness. Respondent again amended its answer on February 9, 2016¹⁵ to include a counterclaim for cancellation of the International Class 41 services in Registration No. 4774583 on the same ground.¹⁶

On May 1, 2017, Petitioner filed an answer to the counterclaims.¹⁷ The following day, Petitioner moved for leave to amend the petition to cancel to allege that Respondent's Registration No. 3387226 is void ab initio because Respondent was not using its mark in commerce in association with the recited services at the time it filed its application.¹⁸ The Board granted the request and allowed Respondent time to answer the amended petition to cancel.¹⁹ Respondent timely filed its third amended answer denying Petitioner's claims and reasserting Respondent's counterclaims.²⁰

the field of law studies, arranging and conducting educational conferences, educational research"; Section 8 affidavit accepted on March 30, 2018.

¹⁵ Respondent's second amended answer, 42 TTABVUE.

¹⁶ Proceedings had been suspended since May 4, 2015 pending the disposition of Respondent's motion to amend the answer and Petitioner's motion to compel discovery. 23 TTABVUE. Proceedings were resumed on January 6, 2016, contingent upon Respondent's payment of the counterclaim fee, which Respondent made upon filing its second amended answer on February 9, 2016.

¹⁷ 77 TTABVUE. Proceedings had been re-suspended on June 1, 2016, 57 TTABVUE, and were resumed on March 31, 2017, following disposition of Petitioner's motion for summary judgment and Respondent's motion to compel discovery, 75 TTABVUE.

¹⁸ 80 TTABVUE.

¹⁹ 87 TTABVUE. Petitioner's motion to add this claim was granted on September 5, 2017. 87 TTABVUE. Accordingly, Respondent's argument in its brief (filed August 3, 2018), 176 TTABVUE 49, that the motion was granted in error as an abuse of discretion is untimely and will not be further considered. Trademark Rule 2.127(b) ("Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof.").

²⁰ 89 TTABVUE.

Because the reasserted counterclaims are identical to those submitted on February 9, 2016, Petitioner's previous answers, submitted May 1, 2017, are deemed Petitioner's operative answers to the amended counterclaims.

The claims, affirmative defenses, and counterclaims in this case are thus as follows:

- Petitioner's claims of likelihood of confusion under Section 2(d) and that Respondent's Reg. No. 3387226 is void ab initio under Section 1(a).
- Respondent's affirmative defenses of unclean hands, estoppel by acquiescence, laches, and "fraud on the Board."
- Respondent's counterclaim that AMERICAN UNIVERSITY is generic or descriptive without acquired distinctiveness for educational services and that:
 - Petitioner's Registration No. 4774583 (AMERICAN UNIVERSITY), should be partially cancelled (as to Class 41); and
 - Petitioner's Registrations Nos. 2986715 (AMERICAN INTERNATIONAL UNIVERSITY), 3559022 (A NEW AMERICAN UNIVERSITY), and



4127891 (COLLEGE OF LAW), should be amended to delete the Section 2(f) claims as to the term AMERICAN UNIVERSITY in favor of a disclaimer of the term.

The parties agreed to proceed under the Board's Accelerated Case Resolution (ACR) procedure.²¹ Pursuant to their agreement, both parties filed testimony and documentary evidence by sworn declaration concurrently with their ACR briefs, or as

²¹ 95 TTABVUE. Approved by Board order, 97 TTABVUE.

an exhibit to the brief, and each party filed an ACR Reply Brief with additional evidence or testimony.²² The parties stipulated that the Board may decide any issues of material fact in dispute and make a final determination on the ACR record.²³

II. Objections to the Record

Petitioner makes several objections to Respondent's declarations and evidence.²⁴ We decide them below, but note that some of the key benefits of ACR are lost when the Board must cope with numerous evidentiary objections that could likely have been avoided in the process of formulating the parties' ACR agreement. *See Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 n.3 (TTAB 2018) ("To obtain the full benefits of ACR, it is important that parties draft clearly-worded stipulations regarding procedures, claims and defenses, and the factual record."); TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 528.05(a)(2) (June 2019) ("To optimize ACR efficiencies and streamline the case at final decision, parties should avoid excessive evidentiary objections. . . .").

²² We approve the parties' stipulation of August 31, 2018, 195 TTABVUE, to exempt the cover page and signature page of their briefs from the page limits as set forth in Trademark Rule 2.128(b), and to consider as timely Respondent's June 5-6, 2018 combined Main ACR Brief. We also have considered Respondent's submission of supplemental authority, 204 TTABVUE, and the cases attached to its filing.

²³ 95 TTABVUE.

²⁴ 192 TTABVUE. (Confidential version at 191 TTABVUE). In its response to Petitioner's objections, 201 TTABVUE 3, and specifically Petitioner's assertion that Respondent has waived any objections to Petitioner's evidence, Respondent argues that it objected to Petitioner's enforcement evidence in its Main ACR Trial Brief (at 176 TTABVUE 15), and Petitioner's actual confusion evidence (at 176 TTABVUE 32). However, Respondent's arguments go to the weight of the evidence and not its admissibility.

A. Objection to Respondent’s resubmission of certain declarations and evidence as untimely

Petitioner argues that Respondent went beyond the scope of Petitioner’s consent to an extension of time that was only intended to enable Respondent to re-file declarations with exhibits that it had inadvertently failed to attach to its June 5-6, 2018 submissions.²⁵ Petitioner argues that when Respondent filed new declarations on August 3, 2018, it added new exhibits not contemplated within the scope of the original declarations. Respondent argues that it merely corrected the declarations to reflect exhibit references and include the missing exhibits.²⁶ The exhibits at issue are:

- Exhibit 1 to the Corrected Declaration of Rawda Awwad (181 TTABVUE);
- Exhibits 1-25 to the Corrected Declaration of Dale Eickelman (182-83 TTABVUE); and
- Exhibits 1-135 to the Corrected Declaration of Amal Al-Binali (184-88 TTABVUE).²⁷

The motion to extend that included the parties’ stipulation stated:

The parties represent that good cause exists for this extension, namely, to allow [Petitioner] to review, consider, and address [Respondent’s] exhibits that [Respondent] inadvertently did not include with certain of its Main ACR Brief declarations. [Petitioner] has not yet received these

²⁵ 158-177 TTABVUE. Stipulation at 178 TTABVUE.

²⁶ Respondent also argues that Petitioner should have filed a motion to strike the declarations and exhibits, but Petitioner’s objections are not merely procedural or ones that could be cured if raised promptly by a motion to strike. *Compare* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 707.02(b) (June 2019) (favoring motions to strike for procedural objections that can be cured promptly) *with* TBMP § 707.02(c) (motions to strike generally improper to object to evidence on substantive grounds).

²⁷ Petitioner also objects to “AUK004143 [to] 99” (discussed more fully below) but did not object to exhibits attached to corrected Housey declarations D or E.

exhibits, but [Respondent] expects to provide them to [Petitioner] this week.²⁸

At the time the motion to extend was filed on July 31, 2018, Petitioner's Rebuttal ACR brief was due August 1, 2018,²⁹ (i.e., the following day), and it had been almost two months since Respondent filed its Main ACR brief. We agree with Petitioner that Respondent should be limited to only those new exhibits that were within the scope of statements made in the original declarations (the declarations themselves are substantively unchanged). New exhibits that go beyond the scope of the original declarations, or which have not been identified, are excluded as set forth below:

- Corrected Declaration of Rawda Awwad

Exhibit No. 1 to the corrected declaration of Rawda Awwad has been considered only in support of Awwad's testimony that she taught two interactive courses in 2009 in a "cross-border open classroom experience."

- Corrected Declaration of Dale Eickelman

The following exhibits to the corrected declaration of Dale Eickelman are excluded: Exhibit No. 13 (previously unidentified), No. 14 (previously unidentified), No. 15 (does not relate to the proposition for which it has been cited), No. 17 (mostly illegible; considered to the extent it can be read), Nos. 19-22 (previously unidentified), and No. 23 (does not relate to the proposition for which it has been cited).

- Corrected Declaration of Al-Binali

The following exhibits to the corrected declaration of Amal Al-Binali are excluded: Exhibit No. 5 (does not relate to the proposition for which it has been cited); No. 6 (to the extent it contains hearsay); Nos. 20 and 21 (not mentioned in the declaration); No. 23 (illegible); and No. 25 (irrelevant).

²⁸ 178 TTABVUE 3.

²⁹ Per stipulation filed May 31, 2018, 157 TTABVUE.

The parties stipulated to the authenticity of documents filed with their briefs so long as they were attached to a witness declaration and “admissible under Notice of Reliance regardless of whether produced during discovery”³⁰ or “produced in response to written discovery requests served in this proceeding.”³¹ Because Respondent alleges without objection that all documents were produced in response to discovery requests, we consider the remaining exhibits admissible (with the exception of 57 pages that it identified as AUK004143-99, discussed more fully below). However, their relative strength or weakness varies considerably, and in weighing the evidence we have taken their limitations into account, including whether they are being offered for the truth of the matter stated therein without proper testimonial support. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017) (“the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations”).

B. New document production

Respondent alleges that all documents were produced in response to discovery requests with the exception of 57 pages that it identified as AUK004143-99.³² We agree with Petitioner that their submission is untimely and exclude them from the record. These include the following pages that were attached to the above-noted corrected declarations:

³⁰ 95 TTABVUE 5.

³¹ *Id.*

³² 201 TTABVUE 4.

- Al-Binali Declaration (184 TTABVUE) - Exhibits 26, 35, 56, 57, 76, 127, 128, 130, 132, 133.³³
- Eickelman Declaration (182 TTABVUE) – Exhibit 16.³⁴

C. Objections to Internet evidence and publications on hearsay grounds

Petitioner objects to Respondent’s reliance on website printouts and other printed publications for the truth of the matters asserted therein.³⁵ We have long held that such evidence is only considered for what it shows on its face, i.e., that the publication or webpage was available on the date accessed and that the information printed thereon was available to the public on such date. *Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010) (evidence from the Internet is admissible “only to show what has been printed, not the truth of what has been printed”). We do not outright exclude the material as Internet printouts, and printed publications may be competent on their face to show public perceptions “regardless of whether the statements are true or false.” *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014). However, the websites are of “limited probative value,” as they are not evidence that the marks shown therein are in use. *Sports Auth. Mich. Inc. v. PC Auth. Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2002); *see also WeaponX*

³³ Not every page of these exhibits is stamped with a “AUK0041—” number. As identified in the Al-Binali declaration: Exhibit 35 is AUK004147-54; Exhibit 56 is AUK004155-56; Exhibit 57 is AUK0044158; Ex. 126 is AUK004159-60; Ex. 128 is AUK004161-62; Ex. 127 is AUK004165-70; Ex. 132 is AUK004177-86; Ex. 130 is AUK004196-98; and Ex. 133 is AUK004199.

³⁴ Identified in the Eickelman Decl. as AUK004157.

³⁵ Petitioner also objected to Exhibits 6, 7 and 19 to Housey Decl. A as not containing access dates, but as Housey set forth these dates in her declaration, the objection is overruled.

Performance Prods. Ltd. v. Weapon X Motorsports, Inc., 126 USPQ2d 1034, 1041 (TTAB 2018) (Internet evidence insufficient to establish priority of use); *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008) (website evidence “is not evidence that opposer is using its mark on any goods or services displayed or discussed on the site.”).

D. For failure to provide URL or date accessed

Petitioner objects to Exhibits A6(d)–(e), A7(a), A19(a)-(c) to the Housey Decl. A³⁶ as not indicating their URL or access date. We overrule the objection as the information was provided in the declaration itself.

E. Evidence from outside the United States

Petitioner argues that most of Respondent’s evidence consists of “Internet printouts or other documents and testimony about institutions located outside the United States,” which have no evidentiary value in determining how relevant consumers in the U.S. perceive the term AMERICAN UNIVERSITY.³⁷ Respondent counters that the website excerpts it has submitted are targeted to prospective U.S. students; are in English; and show how the term is perceived not only in the U.S., but around the world.³⁸

Here, we are only concerned with how the term AMERICAN UNIVERSITY is perceived in the United States, but do not exclude the evidence because it would likely

³⁶ 158 TTABVUE 74-79, 137-149.

³⁷ 192 TTABVUE 68.

³⁸ 201 TTABVUE 12.

be viewed by prospective consumers in the U.S., such as prospective transfer or exchange students. *See In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n. 10 (TTAB 2017) (“We evaluate the probative value of foreign information sources on a case-by-case basis.”) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007)). In view thereof, the objection is overruled, except with respect to the portions of Housey Decl. A³⁹ that are in Spanish. “Board proceedings are conducted in English. If a party intends to rely upon any submissions that are in a language other than English, the party should also file a translation of the submissions. If a translation is not filed, the submissions may not be considered.” TBMP § 104; *see also Swiss Watch Int’l Inc. v. Fed. of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (printed publications submitted in a foreign language without translations have no probative value). Because no translation was provided, we exclude the evidence in Spanish.

F. Google search engine results

Petitioner objects to Exhibit C1 to Housey Decl. C, 162 TTABVUE 8-17. The exhibit is a search summary-results list from the Google® search engine purporting to show results for a search of “American University of Kuwait.” These webpages have little probative value, because such a list “does not show sufficient context in which the term is used on the listed web pages.” *Couch/Braunsdorf Affinity, Inc. v. 12*

³⁹ 158 TTABVUE 162-165.

Interactive, LLC, 110 USPQ2d 1458, 1461 n.10 (TTAB 2014). Nevertheless, we have considered the “hit list” to the extent that we can glean from it any evidence of value.

G. Third-party registrations

Petitioner objects to Respondent’s submission of third-party registrations for marks containing the term AMERICAN UNIVERSITY and for marks containing the words AMERICAN and UNIVERSITY on the ground that the registrations are not admissible to show public use or exposure of the marks. Some of the marks are for educational services and some are for other goods and services. We have considered all the registrations for which proper status and title have been demonstrated for whatever probative value they have, not as evidence of use of the marks in the marketplace but to demonstrate that the terms may have commonly accepted meanings. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982, 194 L. Ed.2d 5 (2016); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Institut Nat’l Des Appellations D’Origine v. Vinters Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“[T]hird party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”).

We have not considered the registrations listed in the TESS printout submitted by Respondent at Housey Decl. A, Exhibit 73,⁴⁰ as introducing the registrations referenced therein. The search result list provides only the application serial number or registration number, mark, and status of the applications or registrations (“live” or “dead”). Such a list, without copies or electronic printouts of the applications or registrations, is insufficient to properly make the applications or registrations of record. *See, e.g., In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994). The list itself, while admissible, has little probative value.

H. Excerpts from scholarly books and articles

Petitioner objects to Respondent’s submission of excerpts from books or articles in academic literature, on the grounds that there is no evidence of record that prospective consumers of the parties’ services may encounter these publications or that they reflect current understanding of the term AMERICAN UNIVERSITY.⁴¹ Many are alleged to be “many decades old” and “have no bearing on how the relevant consuming public in the United States views American University’s AMERICAN UNIVERSITY mark.”⁴² Respondent argues to the contrary that the excerpts “are competent evidence of exposure of [AMERICAN UNIVERSITY] to the public and the meaning the public is likely to associate with the term.”⁴³

⁴⁰ 159 TTABVUE 11-12.

⁴¹ 192 TTABVUE 75.

⁴² 192 TTABVUE 75-76.

⁴³ 201 TTABVUE 15.

We agree such materials are relevant to show public exposure of the words “American” and “university” in connection with academic literature and have considered the evidence in light of its likely impact on consumers, keeping in mind the age of the materials, their subject matter, and intended academic audience.

I. Objection to Housey Declarations A and E as improper expert opinion

Housey’s declarations contain statements regarding her opinion of whether the term AMERICAN UNIVERSITY is generic or highly descriptive. Petitioner objects to admission of Housey’s opinions. Respondent contends that the testimony merely authenticates documents and explains their relevancy.

Whether or not considered expert testimony, the Board does not give consideration to statements that go to an ultimate question of law, such as whether Petitioner’s mark is generic or whether a likelihood of confusion exists. The opinions of witnesses, even expert witnesses, on such questions are entitled to no weight. “[W]e will not substitute the opinion of a witness, even an expert witness, for our evaluation of the facts.” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (citing *Mennen Co. v. Yamanouchi Pharm. Co.*, 203 USPQ 302, 305 (TTAB 1979) (holding the “opinions of witnesses, including those qualified as expert witnesses, on the question of likelihood of confusion are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question.”)). Accordingly, we give no weight to Housey’s opinions on ultimate questions of law.

J. Objection to exhibits to Housey, Al-Binali, and Eickelman declarations due to lack of foundation, personal knowledge; mischaracterization

Petitioner objects under Fed. R. Evid. 602 to certain exhibits attached to the Housey, Al-Binali, and Eickelman declarations as the witnesses allegedly have no personal knowledge of the contents thereof. Petitioner further objects to certain mischaracterizations allegedly in the declarations. Respondent argues that under the parties' ACR Stipulation, personal knowledge is not required for the admission of exhibits, in that the Stipulation allows parties to submit materials "admissible under Notice of Reliance" as exhibits to a witness declaration whether or not such material was produced during discovery, and that materials produced during discovery will be considered authentic whether or not they qualify as admissible under Notice of Reliance.

As noted above, Respondent contends, without objection, that all the material attached to its brief was produced during discovery. Thus, we consider the evidence authenticated under the terms of the Stipulation. We consider its probative value according to whether the materials attached to declarations support the witnesses' statements, whether statements in the declarations appear to be based on personal knowledge or are unsupported by exhibits, and whether documents, while deemed authenticated under the Stipulation, would typically require testimonial verification for the truth of any matter asserted therein. As to the declarations themselves, the Board is capable of weighing the relevance and strength or weakness of the testimony, and this precludes the need to strike it from the record.

K. Objections Raised During 30(b)(6) Perillo and Alston Depositions

Petitioner raised numerous objections to questions posed by Respondent's counsel during the Fed. R. Civ. P. 30(b)(6) depositions of Perillo and Alston.⁴⁴ To the extent the resultant testimony was not based on personal knowledge or appeared to be speculative, or where the question posed assumed facts not in evidence or called for a legal conclusion, we sustain Petitioner's objections and do not consider the testimony.⁴⁵ We have considered the remaining testimony with an eye to Petitioner's objections and as to whether the testimony is outcome-determinative, and accord it whatever probative weight it merits.

L. Objections to Respondent's amended responses to Petitioner's requests for admissions

Petitioner seeks to rely on Respondent's initial responses to Petitioner's first and second sets of request for admissions, and objects to Respondent's amended responses, in particular to amended response Nos. 2, 42, 49, 51, 52, and 68-71. Petitioner contends that Respondent was required to file a motion for leave to amend or withdraw its admissions pursuant to Fed. R. Civ. P. 36(b), which provides that "matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended." Respondent contends

⁴⁴ Objections were properly raised by Petitioner during the depositions of Perillo (170 TTABVUE) and Alston (171 TTABVUE 74-132).

⁴⁵ For example, *see* 170 TTABVUE 5 and 11, the witness was asked if he was aware of whether a third-party was using a mark in U.S. commerce; at 170 TTABVUE 14 and 17, the witness was asked to describe a use as "a trademark, a name, a generic or descriptive term;" at 171 TTABVUE 88, the witness was asked about usage of "American style of education."

that it did not need to file a motion to amend its initial responses but simply amended them by way of supplemental discovery.

Fed. R. Civ. P. 36(a)(3) provides that requests for admissions are deemed admitted unless written answers or objections thereto are received by the requesting party within 30 days of service of the requests. Here, Respondent served its response to Petitioner's first set of requests for admissions more than thirty days from the date of service, on September 9, 2015 (112 TTABVUE 73, Exhibit 281).⁴⁶ Respondent served its response to Petitioner's second set of requests for admissions within thirty days of the date of service, on April 20, 2016 (112 TTABVUE 87, Exhibit 283).⁴⁷ Respondent served its supplemental answers to Petitioner's first and second sets on March 3, 2017.⁴⁸ (112 TTABVUE 108, Exhibit 286 and 112 TTABVUE 115, Exhibit 287).

Fed. R. Civ. P. 36(b) provides that the court, on motion, may permit admissions to be withdrawn or amended. "[T]he court may permit withdrawal or amendment if it would promote the presentation of the merits of the action and if the court is not

⁴⁶ Petitioner's first set of requests for admissions was served on November 5, 2008. On that date, Respondent filed a contested motion to suspend proceedings, 7 TTABVUE, and on December 4, 2008, Respondent filed a contested motion for a protective order staying discovery. 9 TTABVUE. The Board granted both motions on January 30, 2009. 13 TTABVUE. Proceedings were resumed following resolution of civil action and prior Board proceedings on December 30, 2014. 19 TTABVUE. The applicable time period for Respondent to have served its response to Petitioner's first set of requests for admissions therefore was 30 days from December 30, 2014, or January 29, 2015.

⁴⁷ Petitioner served its second set on March 16, 2016.

⁴⁸ Although the certificates of service for both documents recite February 3, 2017 as the date of service, the answers themselves were signed on March 3, 2017.

persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits.” *Id.* Here, Respondent amended its written answers during the discovery period well in advance of the opening of Petitioner’s testimony period on April 2, 2018. There is no evidence that Petitioner expressly relied on the original admissions or suffered any legally cognizable prejudice that would arise from withdrawal of Respondent’s original admissions. The presentation of the merits of the action will be promoted by admitting the amended answers. Under these circumstances, the Board construes the initial answers as withdrawn and amended by Respondent’s supplemental answers served March 3, 2017. *See Checkpoint Sys. v. All-Tag Sec. S.A.*, 711 F.3d 1341, 106 USPQ2d 1234, 1238 (Fed. Cir. 2013) (“a party may rely on an admission as conclusively established unless the admission is recanted”) (internal quotations omitted) (*cert. granted, judgment vacated, and case remanded on other grounds, Kobe Props. Sarl v. Checkpoint Sys., Inc.*, 572 U.S. 1097, 134 S. Ct. 2134, 188 L. Ed. 2d 1121 (2014)); *cf. Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 56 USPQ2d 1332, 1342 (Fed. Cir. 2000) (pre-trial infringement admissions were binding because accused infringer “offered no correction of these admissions [made in a joint pre-trial statement of stipulated facts] before the court’s judgment”); *Giersch v. Scripps*, 85 USPQ2d 1306, 1307-09 (TTAB 2007) (“prejudice...relates to the special difficulties a party may face caused by the sudden need to obtain evidence upon withdrawal or amendment of admission.”).

M. Objections to Respondent's purported claim that the registrations should be cancelled entirely; fraud and abandonment

Petitioner objects to Respondent's alleged counterclaims to the extent they purport to seek cancellation of Petitioner's registrations in their entireties. Petitioner is correct that with respect to Registration Nos. 2986715, 3559022 and 4127891, Respondent's counterclaims are construed only as a request for restriction under Section 18 to delete any claim under Section 2(f) in favor of a disclaimer of "AMERICAN UNIVERSITY."⁴⁹ As for Reg. No. 4774583 for the mark AMERICAN UNIVERSITY, the counterclaim is for partial cancellation; in particular, for deletion of the International Class 41 services from the registration.

Petitioner further objects to inclusion of abandonment and "fraud on the Board" as grounds for Respondent's counterclaims as unpleaded defenses. It is axiomatic that a party may not rely on an unpleaded claim or defense. *See, e.g., UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 (TTAB 2015) (unpleaded allegations relating to fraud will not be heard); TBMP § 314 and authorities cited therein. Respondent does not directly address Petitioner's objection to its purported fraud defense, arguing that it properly pleaded unclean hands. 201 TTABVUE 22. To the extent Respondent's unclean hands pleading is intended to be a pleading that Respondent's witnesses knowingly gave false testimony and thus committed "fraud

⁴⁹ 41 TTABVUE 5. "Inasmuch as Respondent's allegations concern *only portions* of the subject marks [in Reg. Nos. 2986715, 3559022 and 4127891], the Board construes Respondent's claims as one under Trademark Act Section 18, 15 U.S.C. Section 1068, for restriction of Petitioner's registrations."

on the Board,” we find no support for such defense in the witnesses’ transcripts and give it no further consideration.

Respondent also argues that because the term “AMERICAN UNIVERSITY” was in use by others when first adopted by Petitioner, Petitioner’s application for registration of the term is tainted by fraud in the execution of the application. Suffice it to say, this purported allegation has not been properly pleaded, nor does the evidence show that the issue of fraud was tried.

As for Respondent’s alleged abandonment defense, Respondent pleaded, under the heading “acquiescence,” that “Petitioner unintentionally abandoned the term AMERICAN UNIVERSITY when Petitioner allowed numerous unrelated and unlicensed parties to use the term AMERICAN UNIVERSITY for many years without objection or action.”⁵⁰ The statutory definition of “abandonment,” Trademark Act Section 45, 15 U.S.C. § 1127, posits two possibilities in this situation: the mark owner’s “acts of omission” by failing to challenge others has caused the mark to either: (1) “become the generic name for the goods or services on or in connection with which it is used;” or (2) “to lose its significance as a mark.” To the extent Respondent has pleaded an abandonment defense based on a theory that Petitioner’s alleged failure to police its mark has caused “AMERICAN UNIVERSITY” to become a generic term or to have lost its significance as a mark, we consider the defense in the context of Respondent’s counterclaims and Petitioner’s likelihood of confusion claim, and do not

⁵⁰ 89 TTABVUE 17.

entertain a separate abandonment defense.⁵¹ *Cf.* MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:17 (5th ed.) (McCarthy) (“[T]he actual relevancy of failure to prosecute others is to the possible impact such failure may have on the strength of the plaintiff’s mark.”).

N. Evidence Attached to Respondent’s Reply Brief

The purpose of a reply brief is to address arguments made in the adverse party’s main brief, not to supplement the record by submitting evidence that supports a party’s own case. New evidence that accompanies or is attached to a reply brief that supports the party’s case in chief is untimely and will not be considered. *See, e.g., Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1720 n.3 (“The presentation of one’s arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.”); Trademark Rule 2.123(l), 37 C.F.R. § 2.123(l) (“Evidence not obtained and filed in compliance with these sections will not be considered.”); TBMP § 801.03 (a reply brief “must be confined to rebutting the defendant’s main brief” and “limited to the key points in defendant’s brief which plaintiff believes require clarification or response”); *cf. Kellogg Co. v. Pack’Em Enters. Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff’d*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (evidence supporting a motion for summary judgment must be submitted with the motion); *Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d

⁵¹ Because of the public interest in having registrations which are void ab initio stricken from the register, Respondent’s asserted affirmative defense of laches is unavailable against Petitioner’s claim of nonuse. *Saint-Gobain Abrasives Inc. v. Unova Indus. Automation Sys. Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (“[T]his interest or concern cannot be waived by the inaction of any single person or concern no matter how long the delay persists.”).

1197, 1199 (TTAB 2018) (objections raised for the first time in reply brief are untimely because they effectively foreclose the adverse party from responding to the objections).

With its reply brief as plaintiff on the counterclaims, Respondent submitted Housey Declarations F and G along with accompanying Exhibits F, F1–F35 and G1-G52. This copious additional evidence⁵² does not address issues raised in Petitioner’s combined reply brief (as plaintiff in the cancellation and defendant on the counterclaims), but constitutes an attempt to supplement the existing record on issues related to Respondent’s counterclaim that the term AMERICAN UNIVERSITY is generic. Being procedurally prohibited from responding to the testimony and evidence due to the absence of the right to file a sur-reply, Petitioner is effectively foreclosed from challenging it. Accordingly, we have not considered Housey Declarations F and G or the accompanying Exhibits F, F1–F35 and G1-G52.⁵³

⁵² Housey Declarations F and G together with accompanying Exhibits F, F1–F35 and G1-G52 total 924 pages: 196 TTABVUE (245 pages); 197 TTABVUE (259 pages); 198 TTABVUE (127 pages); 199 TTABVUE (199 pages); and 200 TTABVUE (94 pages).

⁵³ The parties’ ACR stipulation, 95 TTABVUE, allowed the parties to offer into evidence witness testimony with exhibits filed concurrently with their ACR briefs. We read this language as allowing only proper rebuttal evidence to be attached to a party’s reply brief, and not as allowing case-in-chief evidence to be attached to a party’s reply brief. Further, to the extent Respondent seeks to rely on the parties’ stipulation that allowed Respondent to attach evidence inadvertently omitted from its main trial brief, 178 TTABVUE, the stipulation does not apply to its reply brief. The purpose of admitting evidence under that stipulation was to allow Petitioner to “review, consider, and address exhibits that [Respondent] inadvertently did not include with certain of its Main ACR Brief declarations,” not to add new exhibits. 178 TTABVUE 3.

III. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the application files for the challenged registrations.⁵⁴ In addition, in light of the above evidentiary determinations, the record includes:

A. Petitioner’s Testimony and Evidence

- Confidential declaration of Justin Perillo, Associate General Counsel at American University, and Exhibits 1-17 (100-06 TTABVUE)⁵⁵ (“Perillo Decl. A”);
- Declaration of Michael A. Cajon, Counsel for American University, and Exhibits 1-294 (107-117 TTABVUE)⁵⁶ (“Cajon Decl. A”);
- Confidential declaration of Sharon Alston, Vice Provost for Undergraduate Enrollment at American University, and Exhibits 1-235 (118-52 TTABVUE);⁵⁷
- Confidential rebuttal declaration of Justin Perillo and Exhibits 1-14 (189 TTABVUE) (“Perillo Decl. B”);
- Rebuttal Declaration of Michael A. Cajon and Exhibits 1-78 (190 TTABVUE) (“Cajon Decl. B”).

B. Respondent’s Testimony and Documentary Evidence

- Declaration “A” of Janice Housey, Counsel for American University of Kuwait, and Exhibits A1-A76 (158-159 TTABVUE);⁵⁸ Exhibit B (159

⁵⁴ In light of the above determinations, there are no remaining affirmative defenses to any pleaded claim or counterclaim.

⁵⁵ The record includes a redacted version of the declaration. 101 TTABVUE. Exhibits 28 and 31-34 are confidential; 104, 106 TTABVUE.

⁵⁶ Exhibits 291-292 and 295-296 are confidential; 113, 117 TTABVUE.

⁵⁷ The record includes a redacted version of the declaration at 119 TTABVUE. Exhibits 39, 131, 146, 153, 165, 189, 191, and 234-235 are confidential; 126, 135, 137, 139, 141, 143, 145, & 152 TTABVUE.

⁵⁸ Excluding Exhibit No. 23A at 158 TTABVUE 162-165.

- TTABVUE 35-41); Exhibits A29a-b, A47, and A52a-b (200 TTABVUE) (“Housey Decl. A”);
- Declaration “B” of Janice Housey and Exhibits B1-B30 (160-61 TTABVUE) (“Housey Decl. B”);
 - Declaration “C” of Janice Housey and Exhibits C1-C9 (162 TTABVUE) (“Housey Decl. C”);
 - Declaration “D” of Janice Housey and Exhibits D1-D87 (163-66 TTABVUE) (“Housey Decl. D”);
 - Declaration “E” of Janice Housey and Exhibits E1-E56 (173-75 TTABVUE) (“Housey Decl. E”);
 - Declaration of Amal Al-Binali, Vice President for Admissions and Public Affairs at the American University of Kuwait (167 TTABVUE);⁵⁹
 - Declaration of Dale Eickelman, Professor of Anthropology and Human Relations at Dartmouth College and Relationship Coordinator (Director) of the Dartmouth College-American University of Kuwait Program (168 TTABVUE);⁶⁰
 - Declaration of Rawda Awwad, Provost and Professor of English at American University of Kuwait (169 TTABVUE);
 - Corrected Declarations:⁶¹
 - Corrected Declaration “D” of Janice Housey and Exhibits D88-D95 (179 TTABVUE) (“Corrected Housey Decl. D”); corrected to renumber exhibit references and include Exhibits D88-95;
 - Corrected Declaration “E” of Janice Housey and Exhibits E26-E27 and E57-E58 (180 TTABVUE) (“Corrected Housey Decl. E”); corrected to reflect exhibit references in ¶¶ 16, 19, 46, 55, 58-59 and include Exhibits E26-27, 57-58.

⁵⁹ Excluding Exhibit Nos. 35, 56, 57, 76, 26, 127, 128, 130, 132, 133.

⁶⁰ Excluding Exhibit No. 16.

⁶¹ For each of the corrected declarations, we have considered all the exhibits, including those attached to the original declarations that have been superseded.

- Corrected Declaration of Rawda Awwad and Exhibit Awwad 1 (181 TTABVUE) (“Corrected Awwad Decl.”); corrected to reflect exhibit references and include Exhibit 1;
- Corrected Declaration of Dale Eickelman and Exhibits Eickelman 1-25 (182-183 TTABVUE)⁶² (“Corrected Eickelman Decl.”); corrected to reflect exhibit references and include Exhibits 1-25;
- Corrected Declaration of Amal Al-Binali and Exhibits Al-Binali 1-135 (184-88 TTABVUE)⁶³ (“Corrected Al-Binali Decl.”); corrected to reflect exhibit references and include Exhibits 1-135.
- Excerpts from depositions of Justin Perillo (170 TTABVUE);⁶⁴
- American University’s third supplemental responses to American University of Kuwait’s first set of requests for admissions (171 TTABVUE 2-72);
- Deposition of Sharon Alston (171 TTABVUE 73-132);
- Printout from U.S. News & World Report Best Colleges (172 TTABVUE);
- Confidential Exhibit 11 consisting of American University’s supplemental responses to American University of Kuwait’s interrogatories nos. 4 and 6 (177 TTABVUE under seal).

IV. Respondent’s Counterclaims

We turn first to Respondent’s counterclaims to cancel Reg. Nos. 2986715, 3559022, 4127891, and 4774583, as the validity of Petitioner’s registrations has a bearing on Petitioner’s main claims. *Schieffelin & Co. v. The Molson Cos. Ltd.*, 9

⁶² Excluding Exhibit Nos. 13, 14, 15, 17, 19-22 and 23. Note, 183 TTABVUE was filed under seal; Exhibits 2-8, 11, 16, and 25 are confidential.

⁶³ Excluding Exhibit Nos. 5, 6, 20, 21, 23, and 25. Note, 188 TTABVUE was filed under seal; Exhibits 19, 35, 36, 56, 74-76, 99, 113, 115, 117, 121, 127, 129, 130, and 134 are confidential.

⁶⁴ As noted above, we do not consider statements from the Perillo or Alston depositions that are not based on personal knowledge, are speculative, assumed facts not in evidence or called for a legal conclusion.

USPQ2d 2069, 2071 (TTAB 1989) (electing to first decide applicant's counterclaims because "the validity of opposer's pleaded registrations has been made an issue as a result of applicant's counterclaims"). Respondent argues that the term AMERICAN UNIVERSITY is generic, either as a common term used for a style of education, or as the result of widespread use by unrelated third parties. Alternatively, Respondent claims that the term is merely descriptive without acquired distinctiveness.

A. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). As a counterclaim plaintiff, Respondent's standing is inherent; it "need not allege its standing to challenge the pleaded registrations." *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007); *see also Carefirst of Md., Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492 (TTAB 2005); *Bankamerica Corp. v. Invest Am.*, 5 USPQ2d 1076, 1078 (TTAB 1987) (defendant seeking to cancel pleaded registration on ground of descriptiveness or genericness in an opposition based on likelihood of confusion need not allege that it has an interest in using the term sought to be cancelled).

Respondent has standing to assert that the term AMERICAN UNIVERSITY is generic or merely descriptive without secondary meaning.⁶⁵

⁶⁵ Respondent's standing includes its standing to counterclaim against Reg. No. 4127891.

B. Respondent’s Claim that AMERICAN UNIVERSITY is Generic

Respondent offers two theories under which it claims the Board may find the term AMERICAN UNIVERSITY to be generic. First, Respondent contends that the term was generic when adopted by Petitioner in the early 1890’s.⁶⁶ Second, Respondent contends that Petitioner has allowed the term AMERICAN UNIVERSITY to become generic by its failure to police its mark, allowing “numerous unrelated and unlicensed parties to use the term AMERICAN UNIVERSITY for many years without objection or action.”⁶⁷ Under either theory, the determination of whether the mark has become “the common descriptive name of a class of goods or services” is the same.

“[D]etermining a mark’s genericness...requires ‘a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?’” *Princeton Vanguard, LLC v. Frito-Lay North Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). Further, “whether the mark is a compound term or a phrase, the applicable test is the same and the Board must consider the record evidence of the public’s understanding of the mark as a whole.” *Princeton Vanguard*, 114 USPQ2d at 1832

⁶⁶ Petitioner was incorporated in 1891 as “The American University” under the laws of the District of Columbia. Alston Decl., 119 TTABVUE 5. It was formally chartered under the name “The American University” in 1893 by an Act of Congress, signed by President Benjamin Harrison.

⁶⁷ Respondent’s Answer, 89 TTABVUE 17.

(citing *In re Am. Fertility Soc.*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

As counterclaim plaintiff, Respondent must establish that AMERICAN UNIVERSITY is generic by a preponderance of the evidence. *Id.* Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *Royal Crown Co. v. The Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018); *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016); *Princeton Vanguard*, 114 USPQ2d at 1830.⁶⁸

1. What is the genus for the services?

The relevant genus of services is defined by the recitation of services in each of Petitioner's registrations, including "educational services, namely, providing courses of instruction at the college and graduate level and distributing course materials in connection therewith"; "conducting educational conferences in the fields of politics, science, history, languages, computer technology, math arts, music, and law studies"; and "arranging and conducting educational conferences and educational research"⁶⁹ all in International Class 41. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d

⁶⁸ Respondent argues that "in the field of higher education, AMERICAN has meant a generic type of university"; that "the word UNIVERSITY is generic"; and that therefore AMERICAN UNIVERSITY as a whole is generic for "an American-style university." 176 TTABVUE 26. While we may consider the meanings of each term individually, ultimately our decision rests on consideration of the mark in its entirety. *Princeton Vanguard*, 114 USPQ2d at 1832.

⁶⁹ Although the recitation of educational services for each of Petitioner's registrations varies slightly, each covers an aspect of educational services and therefore falls within the same genus. An exception is Reg. No. 2986715, which is registered as a collective membership mark "used to indicate membership in an International University." The genus in that case is collective membership in an "international university" and the consumers of these services are individuals with a common interest in the activities of the university.

965, 128 USPQ2d 1370, 1379 (Fed. Cir. 2018) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application[,] regardless of what the record may reveal as to the particular nature of an applicant’s goods”) (citing *In re Cordua*, 118 USPQ2d at 1636) (internal quotation marks and citation omitted).

Although Reg. Nos. 3559022 and 4774583 include “entertainment services, namely, radio programming for a university setting; organizing exhibitions of university-level athletics,” Respondent focuses on “educational services” and does not offer any evidence that could be construed as relevant to showing that AMERICAN UNIVERSITY is generic for Petitioner’s entertainment services. Accordingly, we consider Respondent’s counterclaim waived as to entertainment services and focus on Petitioner’s educational services, noting that if Petitioner’s mark is generic for any one of these services, the registration must be cancelled as to the entire International Class. *Cordua Rests.*, 118 USPQ2d at 1638 (“a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole”); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1988 (TTAB 1988), *aff’d*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (“There is no logical reason to treat differently a term that is generic of a category or class of products where some but not all of the goods identified in an application fall within that category.”); MCCARTHY § 12:57 (5th ed.) (“A registration is properly refused if the word is the generic name of any of the goods or services for which registration is sought.”); *see also* Trademark Act Section 15(4),

15 U.S.C. § 1065(4) (“no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered”).

We further find that the relevant public consists of men and women who are interested in attending college or graduate level courses at a university or by attending educational conferences.

2. Was AMERICAN UNIVERSITY generic when adopted by Petitioner?

Respondent argues that the term AMERICAN UNIVERSITY was generic before Petitioner first adopted its mark in 1892⁷⁰ because two “other schools were using AMERICAN UNIVERSITY to offer college-level instruction,” the American University at Cairo (AUC) and the American University of Beirut (AUB).⁷¹ According to Respondent, the American University at Cairo “was known in the U.S. as ‘the American University’ at least by 1885,” and the Syrian Protestant College, allegedly chartered in 1863,⁷² was renamed “American University of Beirut” in 1920.⁷³ Both

⁷⁰ In September 1892, Petitioner began publishing a newspaper under the title “The American University Courier.” 119 TTABVUE 5.

⁷¹ 176 TTABVUE 14.

⁷² Respondent’s support for this date is a printout from AUB’s website. Exhibit 10 from Housey Decl. A, 158 TTABVUE 97. However, because Housey did not verify the date contained in the printout, the printout is competent to show only that the public has been exposed to the date and not for the truth of the matter. It is included here to show the purported basis for Respondent’s allegation that AMERICAN UNIVERSITY was generic prior to 1892. See Fed. R. Evid. 801(c); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1165 (TTAB 2017) (“However, such reports have limited probative value, because they may only be used for what they show on their face and not for the truth of the matter asserted in the reports, and also because the extent of exposure of these reports to relevant consumers is unknown.”); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013).

⁷³ *Id.* Respondent characterizes Petitioner’s first use of its mark in association with the recited services as being in 1925: “While [Petitioner] may have ‘admitted its first class and

institutions are located outside of the United States, in Cairo, Egypt, and Beirut, Lebanon respectively. There is no evidence that prior to Petitioner's first use of its mark, any appreciable segment of the United States population was aware of either foreign institution.

Respondent further argues that newspaper articles written in the 19th century before Petitioner opened its doors popularized the term "American university" for a university located in the United States.⁷⁴ Petitioner responds that such references "have no bearing on how the relevant consuming public in the United States views" its mark, and that even a "well-documented 19th Century Protestant American university movement" would likewise be irrelevant.⁷⁵ We find that these earlier usages have little bearing on how the relevant consuming public in the United States views Petitioner's AMERICAN UNIVERSITY mark today. *Alcatraz Media*, 107 USPQ2d at 1763 ("To determine if a mark is generic, we examine the evidence up through the time of trial."); *accord Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1730 (Fed. Cir. 2012) (acquired distinctiveness); *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010)

began offering educational services' in 1914, *id.* (citing Alston Decl. ¶14), that was at a graduate level, not college level." 176 TTABVUE 14 n. 4. However, the recitation of services in Petitioner's registrations, "providing courses of instruction at the college and graduate level," include both levels of teaching. Thus, we find its first use to be in 1914. Alston Decl., 119 TTABVUE 6; Exhibit 3 at 120 TTABVUE 21-94.

⁷⁴ See Exhibits E38-E40 attached to Housey Decl. E, 175 TTABVUE 82-110.

⁷⁵ 192 TTABVUE 23.

(inherent distinctiveness); *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1113 n. 69 (TTAB 2018) (dilution).

3. Is the term AMERICAN UNIVERSITY generic today?

a) Does the term denote a style of education?

A term that is understood by the relevant purchasing public primarily to refer to a type or style of services is unregistrable for that category of services. *See Cordua Rest.*, 118 USPQ2d at 1632 (“Churrasco” is generic for restaurants that specialize “in meat grilled in the churrasco style”). The Federal Circuit has held that “[t]he test is not only whether the relevant public would itself *use* the term to describe the genus, but also whether the relevant public would *understand* the term to be generic.” *Id.* (citing *1800Mattress.com*, 586 F.3d 1359, USPQ2d 1682, 1685 (Fed. Cir. 2009) (“[A]ny term that the relevant public understands to refer to the genus . . . is generic.”); *see also* MCCARTHY, § 12:23 (5th ed.).

Respondent’s Vice President for Admissions and Public Affairs, Amal Al-Binali, testified that “the term ‘American University’ is used by college administrators throughout the world to denote that an educational institution offers an American-style post-secondary education,” and that “universities that use American University as part of the name of their institutions generally do so to broadcast that the school uses an American-style of education.”⁷⁶ She describes an “American-style of

⁷⁶ Al-Binali Decl., 184 TTABVUE 3, 4. Her statements have been reiterated by Awwad and Eickelman in their declarations, creating an unnecessary burden on the Board’s limited resources caused by the duplicative filings. Moreover, Respondent improperly includes hyperlinks to various online web pages and websites. The inclusion of hyperlinks is insufficient to introduce the underlying information into the record. *See In re Aquitaine Wine*

education” as one that “typically...encompasses the following: educational courses in English with a sequence of general instruction followed by a particular field of study, each with significant emphasis on class instruction, and attainment of a U.S.-equivalent ‘Bachelor of Arts’ or ‘Bachelor of Sciences’ degree upon successful completion of required course work.”⁷⁷ In support, Respondent asserts that it has submitted “numerous authoritative books, newspapers, periodicals, and websites reflecting the use of the term ‘American university’ generically to mean ‘American-style’ universities.”⁷⁸

Petitioner counters that Respondent “has presented no direct evidence that the relevant consumers primarily understand AMERICAN UNIVERSITY as denoting a genus, species, category, or class of courses of instruction at the college or graduate level.”⁷⁹ Petitioner correctly points out that whether foreign students understand “American style” or “American model” as referring to an approach to higher education is not an issue in this proceeding. We are concerned with the perception of U.S. consumers. *See In re Consol. Cigar Corp.*, 13 USPQ2d 1481, 1483 (TTAB 1989) (“The relevant test is, of course, consumer perception in this country.”) (citing *Nature’s Way*

USA, LLC, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (“we do not consider websites for which only links are provided”); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017) (“Because the information displayed at a link’s Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record.”). The Board will not utilize a link or reference to a website’s internet address to access the site to consider whatever content may appear therein.

⁷⁷ 184 TTABVUE 4-5.

⁷⁸ 176 TTABVUE 44.

⁷⁹ 192 TTABVUE 14.

Prods. Inc. v. Nature's Herbs Inc., 9 USPQ2d 2077, 2080 n.3 (TTAB 1989) (refusing to infer that foreign uses “have had any material impact on the perceptions of the relevant public in the United States”); *cf. Russell Stadelman & Co. v. U.S.*, 242 F.3d 1044, 1050, 22 ITRD 2345 (Fed. Cir. 2001) (“In considering the common, dictionary definition of an HTSUS term [under the Harmonized Tariff Schedule of the United States], only common use of that term in the United States is relevant.”); *Well Living Lab*, 122 USPQ2d at 1781 (TTAB 2017) (foreign websites’ probative value depends on the extent to which they are accessible to and viewed by U.S. consumers).

Respondent alleges the following factors establish the U.S. public’s understanding of the term “AMERICAN UNIVERSITY” as a style of education.

(1) Accreditation Standards

Respondent argues that institutions offering university education around the world seek accreditation by a U.S.-based accreditation agency, which standards “often include a requirement that the seeking university be an American-style university.”⁸⁰ For example, The New England Association of Schools and Colleges requires institutions outside the U.S. to declare themselves to be American-style institutions and meet certain standards “through its name, mission statement, catalog, and other declarations and actions that reflect its commitment to offering an American-style education abroad” before they can be considered for accreditation.⁸¹ Although institutions outside the United States may seek accreditation based on

⁸⁰ 184 TTABVUE 6.

⁸¹ Al-Binali Decl. Exhibit 7, 185 TTABVUE 39.

standards they understand to be “American-style,” Respondent has not shown that the relevant public is aware of these standards or that universities seek to be “American-style.”

(2) Respondent’s self-promotion as an American-style university

Respondent self-identifies as an “American-style university,” and as such, Respondent “uses a traditional American academic calendar year... [and] American-style course numbers” and class-year designations (Freshman, Sophomore, Junior, and Senior); Respondent also conducts classes in English and its graduates complete a minimum of 124 credit hours which is “commensurate with U.S. credit hours” and receive a Bachelor’s degree.⁸² Respondent belongs to several U.S. professional associations and maintains accreditations from four U.S. accrediting organizations.⁸³ Respondent’s self-promotional efforts likely reach relevant consumers, who may understand Respondent’s alignment with the term “American-style” and the use of “American university” to denote such style.

(3) Petitioner’s use of “American-style university” to denote a style of education

Respondent asserts that Petitioner “has long advised the public, in response to email inquiries, that the term ‘American University’ means an ‘American style’ university.”⁸⁴ Respondent provided copies of five emails from the years 2007, 2011, 2012 (two), and 2013 wherein Petitioner responded to an inquiry about affiliation

⁸² 184 TTABVUE 9.

⁸³ *Id.* at 9-10.

⁸⁴ *Id.* at 18.

with other universities using “American University.”⁸⁵ In its response to four of the inquiries, Petitioner advised the recipient that foreign institutions unaffiliated with Petitioner use the term to indicate that they are American-style universities.⁸⁶ These emails are of limited probative value, as they reflect only the authors’ understanding of what “American-style” means; all but one were at least six years old when they were made of record; and they are too few in number to demonstrate public awareness of the meaning of “American university” through Petitioner’s actions.

Respondent also asserts that Petitioner has been directly and indirectly involved “in founding American-style universities using the term ‘American University.’”⁸⁷ Respondent contends that Samih Farsoun, “Professor of Sociology for 30 years and founder of [Petitioner’s] Arab Studies Program,”⁸⁸ served as Respondent’s “founding consultant [] from May 2003 through Spring 2004.”⁸⁹ Respondent alleges that Petitioner assisted in the founding of two other international schools, the American University of Sharjah (AUS) in the United Arab Emirates and the American University of Nigeria (AUN).⁹⁰ Petitioner’s alleged connection with AUS is through

⁸⁵ Exhibit 33, 186 TTABVUE 112-121.

⁸⁶ The fifth simply notes that Petitioner has programs abroad with American University of Cairo and American University of Rome, but that they are separate institutions. Exhibit 33, 186 TTABVUE 119.

⁸⁷ 184 TTABVUE 18.

⁸⁸ *Id.* at 11.

⁸⁹ *Id.* at 12.

⁹⁰ *Id.* at 11 and 16. Petitioner submitted copies of its confidential license agreements with AUS and AUN, under which it licenses the AMERICAN UNIVERSITY mark. 189 TTABVUE 10-11 (confidential), Exhibits 8 at 189 TTABVUE 130 (confidential) (AUS); Exhibits 9 and 10 at 189 TTABVUE 139-167 (confidential) (AUN and successor ABTI).

Farsoun, who “served as AUS’s Founding Dean from 1997-1999.”⁹¹ Petitioner’s alleged connection with AUN is through “Dr. Lou Goodman, Dean of Petitioner’s School of International Service and Professor of Sociology,” who serves as an AUN trustee.⁹² Although Petitioner has not contested Drs. Farsoun’s or Goodman’s involvement, there is no clear evidence of record that U.S. consumers have been aware of either professor’s role. Moreover, the use of “American University” in the names of three foreign universities that are affiliated with Petitioner reinforces the public’s understanding that the phrase “American University” has trademark significance.⁹³

(4) Third-party use of “American University” to denote a style of education

Respondent submitted copies of several third-party university websites that describe their model of education as based on an “American style.” The following illustrates how these entities use the expression:

- **American University of Health Sciences** – located in Signal Hill, CA. “AUHS offers an American-style liberal arts education to students of any nationality.”⁹⁴
- **American University in Bulgaria** – located in Bulgaria. “...a private American style university.”⁹⁵

⁹¹ 184 TTABVUE 11.

⁹² *Id.* at 16-17.

⁹³ Petitioner “operates three international centers, AU BRUSSELS, AU MADRID, and AU NAIROBI. These centers are the University’s home base for study abroad programs in Belgium, Spain, and Kenya.” Alston Decl., 119 TTABVUE 20.

⁹⁴ 158 TTABVUE 116.

⁹⁵ *Id.* at 50.

- **American University of Armenia** – located in Armenia. “The idea of establishing an American-style university in Armenia emerged in a conversation...”⁹⁶
- **American University of Iraq Sulaimani** – located in “Iraqi Kurdistan.” “To support its mission of bringing American-style, liberal arts higher education to Iraq, AUIS has set American regional accreditation as a key institutional goal.”⁹⁷
- **American University of Science & Technology** – located in Lebanon. “The University strives to provide top-level education at moderate costs to avail needy students of opportunities to receive American-style education.”⁹⁸
- **Girne American University** – located in Canterbury, UK. “Girne American University provides American Education Model to the students....”⁹⁹

All of these usages except one are from outside the United States. They tend to show that some foreign universities, and one domestic one, which use “American University” in their name together with a geographic or subject-area term, advertise themselves as providing an “American-style” of education. To the extent that these uses have received exposure in the United States, they are probative of an established meaning of the term “American-style” but do not show that the term “American university” would be understood by United States consumers to denote a unique style of education.

⁹⁶ *Id.* at 85.

⁹⁷ *Id.* at 120.

⁹⁸ *Id.* at 178.

⁹⁹ 159 TTABVUE 4.

(5) Media use

Respondent submitted several media references that purport to use the phrase “American university” generically. For example, a December 11, 2004 Daily Star article reporting Respondent’s opening is titled: “Kuwait City is latest Arab capital to get an American University/ AUK joins US-style institutions of higher learning in Cairo, Beirut, Sharjah, and Dubai.”¹⁰⁰ The article discusses the Arab institutions, noting that “[c]ontrary to easy assumptions, none are linked into a satellite system of schools and none save AUS bear any connection to the American University in Washington, DC.”¹⁰¹ We accord this article limited probative value because it appears the Daily Star is a United Kingdom publication, it is over ten years old, and the record does not contain information as to any circulation or exposure in the United States.¹⁰²

Respondent submitted a copy of an article from 2004 published in BAZAAR MAGAZINE purporting to interview Farsoun.¹⁰³ Readers will encounter the phrases “US style education” and “the style of education reflects the American philosophy,” used by the author to describe her interpretation of Farsoun’s statements, but the article does not quote Farsoun directly. Respondent also submitted a mission statement of the Association of American Universities (AAU) that explains that it is

¹⁰⁰ 184 TTABVUE 14; Exhibit 17, 185 TTABVUE 164.

¹⁰¹ *Id.*

¹⁰² We also note that on its face, it refers to Petitioner by name.

¹⁰³ Staples, Emma, “AUK-the new face of education in Kuwait”; Exhibit 18, 185 TTABVUE 167-68.

comprised of 62 universities, two of which are located in Canada.¹⁰⁴ TOWN & COUNTRY reported on the recruitment of students as spies, in an article entitled “How Spy Agencies Use American Universities to Secretly Recruit Students.”¹⁰⁵

These sources have some weight in showing that relevant consumers are familiar with the words “American” and “university(-ies)” used to refer to universities located in the United States or to an American style or philosophy of university education. In contrast, Petitioner submitted “150 representative news articles, wire service articles, and transcripts available to the general public in libraries, newsstands, online, and on NEXIS or PROQUEST databases” that show unsolicited media use of the term AMERICAN UNIVERSITY to refer to Petitioner “between 1928 and 2017 in major U.S. publications and news outlets, such as *The Washington Post*, *The New York Times*, *CNN Today*, *Associated Press*, *Chicago Tribune*, and *Washington Business Journal*.”¹⁰⁶ Such a “mixture of uses,” which on this record skews strongly in favor of trademark use, supports a finding that the term is not generic. *See In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) (“Mixture of uses” of both generic and non-generic for “Cash Management Account” for brokerage services did not prove that the designation was a generic name); *Luxco*, 121 USPQ2d at 1497 (because record was mixed, evidence failed to show that certification mark had lost significance as designation of

¹⁰⁴ 158 TTABVUE 14; Exhibit A45a-b, 158 TTABVUE 232-250.

¹⁰⁵ 158 TTABVUE 15; Exhibit A46, 158 TTABVUE 251-252.

¹⁰⁶ Chajon Decl., 107 TTABVUE 5; Exhibits 9-158, 108-110 TTABVUE.

geographic origin); *In re Am. Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006) (“the evidence of generic use is offset by Applicant’s evidence that shows not only a significant amount of proper trademark use but also trademark recognition [by third parties]”). Unsolicited media use of “American university” does not show the term has become generic.

(6) Academic sources

As discussed, the scholarly and academic sources attached to Housey Decl. Exhibit E¹⁰⁷ that refer to AUC and AUB are mostly dated pre-1920.¹⁰⁸ Respondent has submitted other more recent academic reference works that refer to institutions of higher learning in the United States as “American universities.”¹⁰⁹ Many of them harken back to earlier usage of the phrase in connection with “the discussion scholars had conducted in the Protestant American universities of the nineteenth century.”¹¹⁰ Other references use variations, such as “American-style university,”¹¹¹ to describe universities outside the United States that are attempting to emulate the characteristics of U.S. institutions of higher learning, particularly in Arab countries.

¹⁰⁷ 173-175 TTABVUE and 180 TTABVUE.

¹⁰⁸ The evidence primarily consists of personal correspondence from the then-president of the university in Beirut.

¹⁰⁹ *See, e.g.*, Jacques Barzun, *The American University How It Runs Where It Is Going*, 1968 (Harper & Row), Housey Decl., Exhibit E4, 174 TTABVUE 75-86.

¹¹⁰ Betty S. Anderson, *THE AMERICAN UNIVERSITY OF BEIRUT ARAB NATIONALISM AND LIBERAL EDUCATION*, 2011 (Univ. of Tex. Press), Housey Decl. Exhibit E13 at 174 TTABVUE 174.

¹¹¹ *See, e.g.*, Housey Decl. Exhibit E36, 175 TTABVUE 43, “Studying the American Way/ An Assessment of American-Style Higher Education in Arab Countries,” Washington Institute for Near East Policy, June 2007.

Indeed, the term “American-style” as used in these references does not refer only to universities in the United States:

While American, Australian, British, and Canadian higher education may differ in content (an American bachelor’s degree has two years of general education and two concentrated years, whereas a British bachelor’s degree has four concentrated years), they distinguish themselves from Arabic higher education in their student focus, their use of English textbooks, their English-speaking faculty trained in the West, and their instruction emphasizing critical thinking and analysis. Therefore, in this study, Australian, British, and Canadian in addition to American institutions of higher education are included in the terms “American-style” or “American higher education.”

“Studying the American Way/ An Assessment of American-Style Higher Education in Arab Countries,” WASHINGTON INSTITUTE FOR NEAR EAST POLICY, June 2007.¹¹²

Respondent has not shown that an appreciable number of these books or articles are available outside of scholarly or academic circles. Even the excerpts from the more recent works that may appeal to a wider audience do not demonstrate that the primary significance of the term “American university” denotes a style of educational services.¹¹³ At best, the evidence shows geographically descriptive use of the words “American university(-ies)” to describe universities located in the United States, and “American-style” to describe certain characteristics of a type of university located in

¹¹² Housey Decl. Exhibit E36, 175 TTABVUE 43.

¹¹³ For example, Respondent submitted pages from Amazon.com showing sale of a book published in 2015 titled “Designing the New American University,” Exhibit A42, 158 TTABVUE 229, and a book published in 2010 titled “The Great American University,” Exhibit A44, 158 TTABVUE 231. The pages fail to provide the context in which the titles are used.

the United States, Canada, England, or Australia. It does not demonstrate that the mark AMERICAN UNIVERSITY is generic.

Summary – AMERICAN UNIVERSITY does not denote a style of education

The preponderance of the evidence does not demonstrate that the term AMERICAN UNIVERSITY has been so widely used to describe a style of educational services that the relevant public in the United States, including scholars, educators, alumni, students, or prospective students, will view the term solely as referring to such style, type, or category of educational services, and not as the name of a particular institution. The mark is not a generic term in the United States for “American-style” education services. *Cf. Cordua Rests.*, 118 USPQ2d at 1637 (a term can be generic for a genus of goods or services if the relevant public “understands the term to refer to a key aspect of that genus”).

b) Is the term generic due to Petitioner’s failure to police?

“The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.” *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (citing *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)); *see also In re Steelbuilding.com*, 415 F.3d 1293, 1298, 75 USPQ2d 1420, 1423 (Fed. Cir. 2005) (finding that “steelbuilding” is not commonly used as composite word and therefore is not generic); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (affirming Board’s finding that screenwipe is a generic composite of the “commonly used generic term” wipe coupled with the word screen); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455,

1460-61 (TTAB 1998) (DRIVE SAFELY not registrable because it would be perceived only as an “everyday, commonplace safety admonition”); *cf. In re Chippendales*, 96 USPQ2d at 1686 (“The test for inherent distinctiveness depends on whether the mark, or a variation thereof, has been in common use in general or in the particular field.”).

Respondent argues that numerous third parties have used the term AMERICAN UNIVERSITY since at least 1925; and that due to such widespread use of the term for educational services, it does not serve to identify Petitioner as a single source: “Literally scores of other universities use or refer to themselves as AMERICAN UNIVERSITY in trademarks and other uses for higher education services, related goods and services.”¹¹⁴ Respondent asserts that there are “more than 70 distinct users of AMERICAN UNIVERSITY to which [Petitioner] appears to have no affiliation, and several more users which appear to have a ‘relationship.’”¹¹⁵ In support, Respondent offers the Housey declaration,¹¹⁶ which authenticates attached webpage excerpts of many institutions that appear to include “American University” in their trade name. We group them as follows:¹¹⁷

(1) American University followed by descriptive wording:

- American University for Humanities (Exhibits A1a-1b)

¹¹⁴ 176 TTABVUE 15.

¹¹⁵ *Id.* at 16.

¹¹⁶ 158 TTABVUE. Housey’s position or affiliation is not identified in her declaration; she is identified as Respondent’s counsel in Respondent’s main trial brief, 176 TTABVUE 13.

¹¹⁷ Housey Decl. A; 158 TTABVUE; specific Exhibits relating to each website noted above.

- American University for Leaders (formerly American University in London) (Exhibits A2a-2b)
- American University of Complementary Medicine (Exhibits A15a-15b)
- American University of Culture & Education (Exhibit A70)
- American University of Science & Technology (Lebanon) (Exhibits A25a-25c)
- American University of Technology (Exhibits A69a-69b)
- American University Preparatory School (Exhibits A28a-b)

(2) American University followed by a geographic term:

- American University of Afghanistan (AUAF) (Exhibits A6a-6e)
- American University of Antigua (Exhibits A7a-7c)
- American University of Armenia (Exhibits A8a-8c)
- American University of Barbados (Exhibits A9a-9c)
- American University of Beirut (Exhibits A10a-10e)
- American University of the Caribbean (Exhibits A13a-13b) (with permission)
- American University of Central Asia (Exhibit A14)
- American University of Iraq, Baghdad (Exhibit A17d)
- American University of Iraq, Sulaimani (Exhibits A17a-17c)
- American University of Kurdistan (Exhibit A66)
- The American University of London (Exhibit A18)
- American University of Madaba (Exhibits A19a-19c)
- American University of the Middle East, Kuwait (Exhibit A20)
- American University of Nigeria (Exhibits A21a-21c) (under license)
- The American University of Paris (Exhibits A22a-22d)
- American University of Puerto Rico (Exhibits A23a-23b)
- American University of Rome (Exhibits A24a-24e)
- American University of Sharjah (Exhibits A26a-26b) (under license)
- American University of St Vincent (Exhibits A27a-27b)
- American University in the Emirates (Exhibits A68a-68c)
- American University in Bulgaria (Exhibits A3a-3c)
- The American University in Cairo (Exhibits A4a-4d)
- American University in Dubai (Exhibits A5a-5e)

(3) American University preceded by an unrelated term:¹¹⁸

- Allied American University – (Exhibits A64)
- Arab American University (Exhibit A30)
- Aston American University – (Exhibits A76a-76bc)

¹¹⁸ Respondent’s declarant also lists the “Anglo-American University,” and cites to Exhibits A29a-29b. There are no such exhibits, or any webpages displaying the use of “Anglo-American University.”

- California American University (Exhibits A31a-31c)
- Gateway to the American University (Exhibit A32)
- Girne American University – (Exhibits A71a-71b)
- Hellenic American University (Exhibit A33)
- International American University – (Exhibits A72a-72c)
- Irish American University – (Exhibit A34)
- Islamic American University (Exhibit A35a-35c)
- Lebanese American University (Exhibit A36a-36c)
- National American University (Exhibit A37)
- North American University (Exhibits A40a-40b)
- Romanian American University (Exhibits A41)
- Texila American University (Exhibits A67a-67b)
- University of the People Accredited Online American University – (Exhibits A65a-65c)

Corroborating the websites, Respondent offered the testimony of three additional witnesses, Amal Al-Binali, Respondent’s Vice President for Admissions and Public Affairs, Dale F. Eickelman, Relationship Coordinator (Director) of the Dartmouth College-American University of Kuwait Program, and Rawda Awwad, Respondent’s Provost and Professor of English, who each testified that he/she is “personally familiar” with the above institutions; that they “include” or “use” the term AMERICAN UNIVERSITY and are “currently” or “likewise” offering “educational experiences” under the term.¹¹⁹ Respondent also submitted Petitioner’s “Supplemental Responses to AUK’s Interrogatories No. 4 and 6” wherein Petitioner names 17 entities in response to the question “Identify any use, application or registration by anyone other than Petitioner or Registrant of a mark or slogan that

¹¹⁹ 181 TTABVUE 3, 182 TTABVUE 7, and 184 TTABVUE 5. The declaration statements vary slightly, but the general endorsement is the same.

includes the word “AMERICA” and the word “UNIVERSITY,” regardless of whether these two terms are adjacent in such mark.¹²⁰

The evidence, taken as a whole, does not establish that the relevant public refers to or would understand AMERICAN UNIVERSITY as the name of the relevant genus of services here, i.e., “educational services,” “conducting educational conferences” or “educational research.” While the raw numbers are impressive, the vast majority of these institutions are located overseas and would be expected to attract students primarily from their regional locale. Contrary to Respondent’s assertion that website printouts “show on their face actual use in commerce,”¹²¹ the website evidence only shows that potential consumers may have been exposed to the statements made therein. *See WeaponX Performance Prods.*, 126 USPQ2d at 1041 (“Internet evidence is only admissible for what it shows on its face, and because it does not fall within an exception to the hearsay rule, will not be considered to prove the truth of any matter stated therein,” including use). Although the corroborating testimony suggests that the universities are currently using the marks, the witnesses’ statements notably do not discuss matters such as the size, scope or location of the establishments, whether they have attracted students from the U.S., have a particular history or longevity, a certain size student body, credentials or accreditation status, or the extent (if any) of their exposure to the relevant public in the United States. Moreover, Petitioner’s witness testified that Petitioner “has initiated dozens of opposition and cancellation

¹²⁰ 177 TTABVUE 19-23 (confidential).

¹²¹ Reply Brief, 202 TTABVUE 9.

proceedings before the [TTAB], and has sent dozens of cease-and-desist letters to third parties objecting to the use and/or registration of marks containing “AMERICAN” and/or “AMERICAN” and “UNIVERSITY.”¹²² Twenty-seven Board proceedings were identified by the witness; two of them were actions taken by third parties against Petitioner’s marks AMERICAN INTERNATIONAL UNIVERSITY and A NEW AMERICAN UNIVERSITY, which resulted in dismissal.¹²³ The remainder were actions taken by Petitioner. Fifteen terminated in abandonment or cancellation of the adverse party’s application or registration; three resulted in assignment of the marks to Petitioner; four resulted in amendments of the applications or registrations to delete or limit the Class 41 services; and three resulted in confidential settlement agreements.¹²⁴

In total, Petitioner submitted copies of eleven confidential agreements.¹²⁵ Because the details of the parties’ agreements have been filed under seal, we discuss them only generally.¹²⁶ Only one, entered into with AUC School of Medicine B. V. (“AUC”),

¹²² Perillo Decl., 101 TTABVUE 3.

¹²³ Opp. No. 91177645 and Can. No. 92052923. *See* 101 TTABVUE 4-6.

¹²⁴ 101 TTABVUE 3-7.

¹²⁵ Filed under seal at 189 TTABVUE.

¹²⁶ While the Board is sensitive to the confidential nature of the agreements, it is the general policy of the Board that all papers in a proceeding be public. *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1476 n.19 (TTAB 2017). Petitioner did not file a redacted copy of its 189 TTABVUE submission, in noncompliance with Trademark Rule 2.126(c). That rule requires parties who file confidential filings to concurrently file a copy of the submission for public viewing with the confidential portions redacted. At the end of this decision, the Board will allow Petitioner time to submit a redacted version of 189 TTABVUE, failing which it will be made public.

permitted registration: AUC's registration of the mark "AMERICAN UNIVERSITY OF THE CARIBBEAN" for medical education services.¹²⁷ Two are for marks that do not use the composite phrase AMERICAN UNIVERSITY. The remainder include a variety of provisions restricting the third-party's use of the mark.¹²⁸ Although Respondent argues that the agreements are sham transactions, we do not find them to be so. The terms generally conform to those found in similar coexistence agreements, subjecting each side to adhere to conditions intended to avoid confusion, such as including disclaimers, registering and using specific forms of the marks, and notifying the other party of any third-party unauthorized use that comes to its attention. *Cf., e.g., In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993) (reversing Board's affirmance of Section 2(d) refusal on basis of consent agreement, noting that the "self-interest of trademark owners" operates to police trademark use so as to protect the public from confusion); *Bongrain Int'l v. Delice de France*, 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987) (finding coexistence agreements carry "great weight" in determining lack of likelihood of confusion); *In re Wacker Neuson SE*, 97 USPQ2d 1408, 1412 (TTAB 2010) ("[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted.") (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563,

¹²⁷ See Reg. No. 2618194 and 1846403, AUC's registrations for the mark. Perillo Decl., Exhibits 29 and 30, 101 TTABVUE 7. Copy of the agreement at 189 TTABVUE 15-23.

¹²⁸ 189 TTABVUE 3.

568 (CCPA 1973)). Petitioner's enforcement efforts weigh against a finding that Petitioner has allowed its AMERICAN UNIVERSITY mark to lose its significance as a source-indicator.

Justin A. Perillo, Petitioner's Associate General Counsel, testified that "American University has also for decades licensed the AMERICAN UNIVERSITY mark and other marks for use on or in connection with a wide range of branded merchandise products" and that "American University currently licenses its mark to seventy six (76) merchandise licensees."¹²⁹ Petitioner's merchandise licensing activities provide additional support for our finding that the mark has not become generic due to Petitioner's failure to police unauthorized uses of term AMERICAN UNIVERSITY.

Summary - The mark is not generic due to Petitioner's failure to police

The fact that none of the outside entities use AMERICAN UNIVERSITY by itself, together with Petitioner's policing efforts, and a public disclaimer by at least one entity recognizing Petitioner's rights,¹³⁰ show that the term AMERICAN UNIVERSITY is not generic as a result of Petitioner's alleged failure to police its marks.

V. Conclusion – AMERICAN UNIVERSITY is not generic

We have carefully considered all of Respondent's evidence and arguments. For the reasons discussed above, we conclude that the term AMERICAN UNIVERSITY is not

¹²⁹ 101 TTABVUE 8.

¹³⁰ "Hellenic American University is not affiliated with, sponsored by or related to American University." 158 TTABVUE 205.

generic for the recited services. Although the term AMERICAN UNIVERSITY is arguably an “apt” name for a university located in the United States, “[a]ptness is insufficient to prove genericness.” *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

VI. Are Petitioner’s registration nos. 2986715, 3559022, and 4127891 supported by sufficient evidence of acquired distinctiveness?

A. Degree of descriptiveness

Respondent’s failure to prove that AMERICAN UNIVERSITY is generic for educational services does not preclude it from showing that the mark has not acquired distinctiveness. *Alcatraz Media*, 107 USPQ2d at 1761-67 (finding that respondent’s mark was not generic for respondent’s services, but granting petition for cancellation on alternative ground that the involved mark had not acquired distinctiveness). Respondent contends that in each of Petitioner’s registrations, “the claim of acquired distinctiveness of AMERICAN UNIVERSITY based on ‘substantial exclusivity’ under [Trademark Act Section] 2(f) for at least five years before the filing was improper,”¹³¹ and that Petitioner cannot meet its burden of showing that AMERICAN UNIVERSITY has acquired distinctiveness. Petitioner counters that Respondent has not met its burden to establish a prima facie showing that the record

¹³¹ 176 TTABVue 42. Petitioner did not rely solely on use of its mark for the five years preceding the filing date of its applications for its AMERICAN UNIVERSITY marks. Petitioner also provided a copy of the 1893 Act of Congress (27 Stat. 476), a newspaper article from “The American University Courier” dated September 1892, and copies of webpages from Petitioner’s website (“to show exclusive and continuous use of the mark”). See September 15, 2006 Response to Office Action in Reg. No. 3559022 at TSDR 2-4; January 17, 2001 Response to Office Action in Reg. No. 4774583 at TSDR 8-9.

evidence of acquired distinctiveness presented by Petitioner during prosecution of the applications that matured into the subject registrations failed to prove acquired distinctiveness.¹³² In the alternative, Petitioner argues that even if the burden of persuasion were shifted to Petitioner, Petitioner's evidence of acquired distinctiveness proves that AMERICAN UNIVERSITY "had acquired distinctiveness at the time of its registration, which continues to this day."¹³³

"The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and the nature of the mark sought to be registered." *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017); *see also Royal Crown Co.*, 127 USPQ2d at 1047 (court has "long held that 'the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.'") (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)). Petitioner's claim to the benefit of Section 2(f) in its registrations for the term AMERICAN UNIVERSITY with "UNIVERSITY" disclaimed amounts to an acknowledgment that at the time of registration, AMERICAN UNIVERSITY was merely descriptive as a whole for educational services, and "UNIVERSITY" was generic. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive"); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*

¹³² 192 TTABVUE 28.

¹³³ *Id.*

Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512 (TTAB 2019); *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1403 (TTAB 2018) (applicant required to disclaim generic component of mark otherwise registrable under Section 2(f)). However, having carefully considered the entire record,¹³⁴ and keeping in mind the burdens of proof and persuasion applicable in this case, *Cold War Museum*, 92 USPQ2d at 1629-30, we find that the term AMERICAN UNIVERSITY acquired distinctiveness at least as early as 2009 and maintains its distinctiveness to date.¹³⁵

We make this determination based on all the evidence made of record during prosecution and any additional evidence introduced in the cancellation proceeding.

B. Petitioner’s evidence of acquired distinctiveness

“To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or

¹³⁴ *Id.* We note that Petitioner did not rely solely on a declaration of five years use during prosecution of the applications that resulted in registrations of its pleaded marks.

¹³⁵ In a cancellation proceeding, “we look at both the time when the registrant registered its marks as well as at the present day to determine whether the mark must be cancelled.” *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, *16 (TTAB 2019); *see also Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1747 (TTAB 1989) (“In most cases, the time period of primary concern is the time when the registration issued.”); *cf. Coach Servs.*, 101 USPQ2d at 1730 (“Acquired distinctiveness and buyer recognition is to be tested in an opposition proceeding as of the date the issue is under consideration.”); *cf. In re Chippendales*, 96 USPQ2d at 1686 (proper time for measuring distinctiveness of a mark in a pending application is at the time it is being considered for registration).

Here, we have three dates of registration: Reg. No. 3559022 issued on January 6, 2009; Reg. No. 4127891 issued on April 17, 2012; and Reg. No. 4774583 issued on July 21, 2015. In examining the evidence, we have measured the distinctiveness of Petitioner’s mark against all three registration dates.

service itself.” *Steelbuilding.com*, 75 USPQ2d at 1424. “The considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the [service mark] with a particular source by actual purchasers (typically measured by consumer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark...” *Virtual Indep. Paralegals*, 2019 USPQ2d at 11 (quoting *In re SnowWizard, Inc.*, 129 USPQ2d 1001, 1005 (TTAB 2018)). Although “[a]ll six factors are to be weighed together in determining the existence of secondary meaning,” *id.*, no single factor on this list is determinative, and not all factors need be considered. Here, the parties have presented evidence on factors 2, 3, 4, and 6, and we address these factors below.

1. Length, degree, and exclusivity of use of AMERICAN UNIVERSITY

Sharon Alston, Petitioner’s Vice Provost for Undergraduate Enrollment, testified regarding Petitioner’s more than 100 years of use of the mark AMERICAN UNIVERSITY. She testified that on February 24, 1893, American University was chartered by an Act of Congress and granted the right to confer college, university, and other degrees.¹³⁶ Petitioner began construction of the university in 1902, and its

¹³⁶ Alston Decl., Exhibit 8, 119 TTABVUE 5. The university was incorporated in 1891 as The American University and began publishing a newspaper under the title “The American University Courier” in September 1892. *Id.*; see Exhibits 4-7 (representative samples of the newspaper distributed from 1892 to 1926).

first class was admitted in 1914.¹³⁷ The opening of the schools of “Diplomacy, Jurisprudence and Citizenship” was announced in 1920;¹³⁸ the School of International Service (SIS) opened in 1957; and at present, American University is home to eight schools and colleges: the School of International Service, College of Arts and Sciences, Kogod School of Business, School of Communication, School of Professional and Extended Studies, School of Public Affairs, School of Education, and the Washington College of Law.¹³⁹ Petitioner submitted ten course catalogs from 1926 to 2017 (attached as Alston Decl. Exhibits 9-19) to show its use of the mark; in 1926 the AMERICAN UNIVERSITY Bulletin published the “School of the Political Sciences” annual catalog for 1926-27;¹⁴⁰ and in 2017, the “American University Catalog” was published for the academic year 2017-2018.¹⁴¹ Petitioner has shown a long period of use of the mark and wide exposure, and while Respondent challenges its exclusivity as previously discussed, no other institution exists, or has existed since 1893, named “American University” alone.

2. Amount and manner of advertising

Petitioner has engaged in extensive advertising of its educational offerings. To illustrate, Petitioner submitted copies of numerous print advertisements: one from 1917, at least one for each year from 1920 to 1943, at least one for each year from

¹³⁷ *Id.* at 6.

¹³⁸ 119 TTABVUE 9; *see also* Alston Decl. Exhibit 22, 125 TTABVUE 1245-53.

¹³⁹ 119 TTABVUE 8-9; *see also* Exhibit 20, 125 TTABVUE 1231.

¹⁴⁰ Alston Decl. Exhibit 9, 120 TTABVUE 132-196.

¹⁴¹ Alston Decl. Exhibit 19, 125 TTABVUE 13-1230.

1945 to 1953, at least one for each year from 1956-2001 (except for 1962, 1971, and 1974), and one from 2006. These were placed in the WASHINGTON POST (76 ads), THE NEW YORK TIMES (10 ads), THE WALL STREET JOURNAL (8 ads), the ATLANTA JOURNAL-CONSTITUTION (2 ads) and the BALTIMORE SUN (4 ads).¹⁴² Petitioner has also advertised in national magazines such as NEWSWEEK, THE WASHINGTON DIPLOMAT, and the HOLLYWOOD REPORTER, as well as in publications directed to higher education such as THE CHRONICLE OF HIGHER EDUCATION and INSIDE HIGHER EDUCATION.¹⁴³ Petitioner has also run display ads in Washington area Metro stations and at Reagan National Airport in Washington, D.C.¹⁴⁴ Petitioner maintains a presence on Facebook and Twitter social media sites, as well as on YouTube, Instagram, and LinkedIn. “Each of these pages prominently features the AMERICAN UNIVERSITY Mark.”¹⁴⁵ Petitioner’s following on Facebook has grown from roughly 9,000 total “likes” in 2009, “to over 245,000 in March 2018.”¹⁴⁶ Petitioner also advertises on the Internet at such websites as Yahoo.com, Forbes.com and USAToday.com.¹⁴⁷ Petitioner’s efforts have garnered several awards in the years 2011 through 2017.¹⁴⁸

¹⁴² Exhibits 159-258, 107 TTABVUE 27.

¹⁴³ Alston Decl., Exhibits 146 and 147, 119 TTABVUE 38.

¹⁴⁴ 119 TTABVUE 40-44.

¹⁴⁵ *Id.* at 49.

¹⁴⁶ *Id.*, Exhibit 165 (confidential) at 141 TTABVUE.

¹⁴⁷ 119 TTABVUE 50, Exhibits 166-188 at 142 TTABVUE 4-75.

¹⁴⁸ 119 TTABVUE 52, Exhibits 189-90 (Exhibit 189 is confidential) at 143-144 TTABVUE.

Petitioner has also received exposure through sporting events. “In 1925, American University fielded its first intercollegiate athletics teams, and ever since it has continuously offered sporting events and services under the AMERICAN UNIVERSITY Mark.”¹⁴⁹ American University’s athletic teams compete across the country and “attract student-athletes from all over the world.”¹⁵⁰ Petitioner also “maintains television rights agreements with CBS Sports Network and NBC Sports Washington, which broadcast about 3 to 5 American University Athletic games per year.”¹⁵¹ In 2012, Petitioner entered into a partnership with the Washington Nationals, the major league baseball team in Washington, D.C. Alston asserts that “[t]hroughout the course of this partnership, the Washington Nationals showed American University advertisements prominently featuring the AMERICAN UNIVERSITY Mark on 200 display screens in concession areas, on the Jumbotron and out-of-town scoreboard, on the stadium LED banner that encircles the interior of the stadium, and on rotational signs behind first and third base and home plate.”¹⁵²

Petitioner is affiliated with the WAMU radio station, whose predecessor, WAMC, was established in 1947.¹⁵³ Thus, “for more than 70 years” the AMERICAN UNIVERSITY mark has been promoted over the radio, “exposing at least tens of millions of listeners to the AMERICAN UNIVERSITY Mark in connection with

¹⁴⁹ 119 TTABVUE 21.

¹⁵⁰ *Id.*

¹⁵¹ *Id.* at 22.

¹⁵² *Id.* at 46, Exhibit 151 at 138 TTABVUE 77.

¹⁵³ 119 TTABVUE 36.

WAMU's radio programming over the years.”¹⁵⁴ Its efforts have resulted in significant exposure for many years.

3. Amount of sales and number of customers

Petitioner sells branded merchandise at retail outlets and on its campus, as well as online.¹⁵⁵ Petitioner currently licenses its mark to 76 merchandise licensees.¹⁵⁶ Annual royalty figures show a steady increase of sales since 2012, and net sales from merchandise sold through Petitioner's bookstore, about 85% of which bears the AMERICAN UNIVERSITY mark, topping one million dollars annually since 2012.¹⁵⁷

We also consider Petitioner's revenue stream and number of college enrollees under this factor. While figures have been produced under seal, we note that Petitioner receives significant “annual unrestricted” sources of income as well as “revenue derived from private sources and endowment income.”¹⁵⁸ As of 2018, Petitioner's endowment “stands at \$642 million.”¹⁵⁹ Petitioner has enrolled “over 10,000 students per year for past 40 years” and during the 2017-2018 academic year,

¹⁵⁴ *Id.*

¹⁵⁵ Perillo Decl., 101 TTABVUE 9. *See* fn. 7, listing examples of branded merchandise registered under the AMERICAN UNIVERSITY mark, Reg. No. 4774583.

¹⁵⁶ *Id.* at 8.

¹⁵⁷ *Id.* Sales and advertising figures, as well as other information regarding Petitioner's policing efforts and customers have been filed under seal. We will discuss those portions of the evidence and briefs that are properly designated “confidential” only in general terms as necessary to support our determination. *See Grote Indus.*, 126 USPQ2d at 1201 (TTAB 2018); *Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1511 (TTAB 2017).

¹⁵⁸ 119 TTABVUE 31 (confidential); Exhibit 31 (confidential).

¹⁵⁹ 119 TTABVUE 32.

Petitioner's total enrollment "was 13,858 students."¹⁶⁰ In the 2017–2018 school year, Petitioner offered "69 Bachelor's programs, 78 Master's programs, and 10 Doctoral programs in a wide variety of subject matters."¹⁶¹ Through its Washington Semester Program, Petitioner offers internships to students from around the United States.¹⁶² In 2017, students from 177 colleges and universities participated in the Washington Semester Program, which has over 50,000 alumni.¹⁶³ "The Washington Semester Program works with 3,000+ organizations in the Washington D.C. area that promote their internships for students in the program."¹⁶⁴ Petitioner also offers over 150 study abroad programs in 40 countries, including 11 Middle Eastern countries.¹⁶⁵ "American University's study abroad offerings began in 1982 and have been similar in scope to today's offerings since before 2006."¹⁶⁶

4. Unsolicited media coverage

Petitioner has ranked high on the listing of top U.S. universities by U.S. NEWS AND WORLD REPORT. "Since at least 2004, *U.S. News and World Report* has ranked American University among the top 100 best undergraduate universities in the

¹⁶⁰ 23.

¹⁶¹ *Id.* at 8-9.

¹⁶² *Id.* at 17.

¹⁶³ *Id.*

¹⁶⁴ *Id.* See also Exhibits 46 and 47 at 127 TTABVUE 36-67.

¹⁶⁵ 119 TTABVUE 19.

¹⁶⁶ *Id.*

United States.”¹⁶⁷ In 2018, Petitioner’s school of law tied for sixth place on the list of U.S. NEWS AND WORLD REPORT “Best International Law Programs – 2018.”¹⁶⁸

As discussed above, Petitioner authenticated numerous representative news articles and the like to show unsolicited media use of the term AMERICAN UNIVERSITY to refer to Petitioner.¹⁶⁹ Samples of these articles show exposure to the public of “American University” in their headlines as follows:¹⁷⁰

8/19/1928 THE WASHINGTON POST, “Political sciences hold unique place: **American University** was founded on pet theory of study;” (Exhibit 10)

11/13/1938 THE NEW YORK TIMES, “15 Foreign fellows in hall of nations: **American University** division stresses our ways with government cooperation”; (Exhibit 13)

6/2/1964 THE WASHINGTON POST, TIMES HERALD, “At Site of Famous ‘Peace Speech’: Dedication set for monument to JFK on campus of **American University**”; (Exhibit 22)

9/9/1997 CNN TODAY, “Clinton speaks at **American University**; reiterates agenda for second term” by Natalie Allen, Eileen O’Connor; (Exhibit 26)

5/6/2002 CHICAGO TRIBUNE, “Telephone lines coming down: **American University** will go wireless” by Reuters; (Exhibit 31)

4/16/2004 BUSINESS WIRE, “On campus with T-Mobile hotspot; teachers, students, staff and alumni get more/r/: **American University** becomes first T-Mobile hotspot campus;” (Exhibit 39)

¹⁶⁷ Alston Decl. 118 TTABVUE 15 (confidential). Exhibits 39 (confidential) at 126 TTABVUE; 40 and 41 at 27 TTABVUE 4-16.

¹⁶⁸ *Id.*, Exhibit 37 at 125 TTABVUE at 1668-69.

¹⁶⁹ Chajon Decl., 107 TTABVUE 5, Exhibits 9-158 at 108-110 TTABVUE.

¹⁷⁰ 107 TTABVUE 6-27.

3/3/2008 THE WASHINGTON POST, “Obama top choice in **American University** survey” by Sakina Rangwala and Liz Anderson; (Exhibit 42)

10/17/2008 THE WASHINGTON POST, “Going out guide: **American University**”; (Exhibit 46)

10/11/2009 THE WASHINGTON TIMES, “Dalai Lama ends D.C. visit; **American University** speech caps meetings-packed trip” by Julia Duin; (Exhibit 51)

7/1/2010 CNN NEWSROOM, “Police reopen Gore case; Obama talks immigration reform at **American University**; oil spill affecting fourth of July vacations” by Tony Harris, Dana Bash, Casey Wian, Ted Rowlands, Bonnie Schneider; (Exhibit 56)

2/6/2013 THE WASHINGTON POST, “Area colleges score well in Peace Corps rankings; **American University** ranked second among mid-size schools, the agency said” by Al Kamen; (Exhibit 65)

9/29/2014 WASHINGTON BUSINESS JOURNAL, “**American University** will cover extended Metro service during Nationals playoff games” by Staff; (Exhibit 84)

3/11/2015 THE WASHINGTON TIMES, “**American University** basketball on the cusp of return to the NCAA tournament” by Tom Schad; (Exhibit 90)

9/26/2016 FOX – 2 WJBK, “**American University** professor who has predicted presidential winner since 1984 says Trump will win” by Marina Marraco; (Exhibit 132)

1/27/2017 THE WASHINGTON POST, “**American University** names new president: Obama cabinet member Sylvia Mathews Burwell” by Nick Anderson; (Exhibit 145)

2/11/2017 THE CHRISTIAN SCIENCE MONITOR, “Video: what is a zero-day?; Melanie Teplinsky, cybersecurity expert and adjunct professor at **American University’s** Washington College of Law, explains” by Fallon Schlossman and Evelyn Wang; (Exhibit 150)

3/23/2017 STATES NEWS SERVICE, “Dr. Jane Goodall to address students at **American University** School of International Service” by States News Service; (Exhibit 153)

Petitioner's unsolicited exposure to the public by the media supports a finding that AMERICAN UNIVERSITY acquired distinctiveness as of the registration date and that it presently maintains its distinctiveness. *Milwaukee Elec. Tool Corp.*, 2019 USPQ2d at *16.

Summary - AMERICAN UNIVERSITY has acquired distinctiveness

The term AMERICAN UNIVERSITY is conceptually weak but commercially strong, acquired distinctiveness and has maintained its distinctiveness as a mark to the present, signifying a single source of educational services in Petitioner. Accordingly, we find that Respondent has not carried its burden of persuasion to show that the term AMERICAN UNIVERSITY is merely descriptive without acquired distinctiveness. To the contrary, we find that AMERICAN UNIVERSITY acquired distinctiveness that it maintains as of trial. *Cold War Museum*, 92 USPQ2d at 1629-30; *Milwaukee Elec. Tool Corp.*, 2019 USPQ2d at *16.

VII. Conclusion – Respondent's counterclaims are denied

Respondent's counterclaims for amendment of Registrations Nos. 2986715, 3559022, and 4127891 to delete the Section 2(f) claims as to the term "AMERICAN UNIVERSITY" in favor of a disclaimer of the term, and for partial cancellation of Registration No. 4774583 as to the International Class 41 services, are **denied**.

VIII. Is Respondent's registration void ab initio for nonuse?

Respondent filed the application that matured into its registration on May 15, 2006, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). Respondent alleged

“2003” as its date of first use and date of first use in commerce. Respondent further alleged in the declaration in the application that its mark was in use at the time of filing, as required. 15 U.S.C. § 1051(a); Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i).

In a use-based application reciting services, if an applicant fails to use its mark “in commerce” in association with any of the services in a particular class specified at the time of filing, the application and any resulting registration are void ab initio as to that entire class on the ground of nonuse. *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015) (quoting Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i)); see *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009) (“The registration of a mark that does not meet the use requirement is void ab initio.”); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1044 (TTAB 2014) (“In an application based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date.”); *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012) (registration void ab initio where applicant failed to use mark before filing date on any of the goods or services listed in the application); *Hurley Int’l LLC v. Paul & Joanne Volta*, 82 USPQ2d 1339, 1344-1345 (TTAB 2007) (“[T]he law is clear that an applicant may not claim a Section 1(a) filing basis unless the mark was in use in commerce on or in connection with all the goods or services covered by the Section 1(a) basis as of the application filing date.”).

The Court of Appeals for the Federal Circuit, our primary reviewing court, provides a succinct summary of the requirements for a service mark to be used in “commerce”:

For service marks, the “use in commerce” requirement is met when (1) a mark is “used or displayed in the sale or advertising of services” and (2) either (i) the services are “rendered in commerce” or (ii) the services are “rendered in more than one State or in the United States and a foreign country and the person rendering those services is engaged in commerce in connection with the services.”

Aycock Eng’g, 90 USPQ2d at 1305 (quoting Trademark Act Section 45, 15 U.S.C. § 1127); *Couture v. Playdom*, 113 USPQ2d at 2043.¹⁷¹

The “use in commerce” requirement for a mark used in conjunction with services is therefore a two-part requirement. First, the mark must be used or displayed in the sale or advertising of the services. Second, the services rendered must be rendered in more than one state or “in the United States and a foreign country.” Respondent’s registration is void ab initio if Respondent fails either requirement; that is, if it cannot show that either (1) it has used its mark in the sale or advertising of educational services in commerce prior to May 15, 2006, the filing date of the underlying application, or (2) that it has rendered educational services under the mark in commerce prior to the filing date.

We examine each requirement in turn, starting with whether Respondent displayed its mark in the sale or advertising of its services in commerce. Although we

¹⁷¹ This definition of “use in commerce” is coextensive with the limits of the Commerce Clause of the U.S. Constitution, which provides that “The Congress shall have Power...to regulate Commerce with foreign nations, and among the several States, and with the Indian Tribes[.]” *U.S. Const.* art. I, § 8, cl. 3.” 15 U.S.C. § 1127.

find that Respondent has not demonstrated use of its mark in the sale or advertising of its services in commerce, and thus the mark is void ab initio, for sake of completeness, we also consider the second requirement. There, too, we find that Respondent fails to show that it rendered services in commerce under the registered mark as of May 15, 2006, the filing date of the underlying application.

A. Did Respondent display its mark in the sale or advertising of educational services prior to its filing date?

Respondent argues that it has:

actively used and displayed its mark in advertising its services in the United States and U.S. commerce since 2003 and well prior to its filing date of May 15, 2006, including but not limited to: its website accessible since 2003 in the U.S., and promotional materials distributed to American students, faculty, exchange students, Fulbright and research scholars, and others, as listed in AUK's application under the registered mark, as well as recruitment advertisements and job postings.¹⁷²

Respondent refers to statements made by Al-Binali (Decl. ¶¶ 38-39, 57, 73-80); Awwad (Decl. ¶¶ 22-23, 40); and Eickelman (Decl. ¶¶ 14, 17) in support of its argument.¹⁷³ A careful examination of these declarants' statements and the documentary evidence attached to their declarations leads us to conclude that

¹⁷² 176 TTABVUE 19.

¹⁷³ The allegations regarding dates of use made by Respondent in its application for the involved registration are not evidence on Respondent's behalf, nor are the specimens of use filed in support of the registration admissible to prove use. Trademark Rule 2.122(b)(2), 37 CFR § 2.122(b)(2). ("Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.")

Respondent did not use its mark in the sale or advertising of the identified services prior to May 15, 2006.

Respondent submitted copious documents – nearly 1,000 pages were attached to Al-Binali’s declaration alone – but the majority of Respondent’s purported advertising fails to show the mark used or displayed in the sale or advertising of the services before the application filing date. Most of the material fails to display the mark at all. Some documents display a variation of the mark but not the registered mark.¹⁷⁴ Much of the evidence post-dates 2006. Of the remainder, the best evidence uses the mark, advertises the services, and contains on its face a pre-2006 date, but is not supported by testimony that any of the material ever made its way into the United States. The only evidence suggesting that Respondent’s advertising was connected to a plan for providing educational services to students from the United States is Respondent’s declarants’ unsupported testimony. Although the oral testimony even of a single witness may be sufficient to prove the first use of a party’s mark when it is based on personal knowledge, is “clear and convincing,” and is not characterized by “inconsistencies, contradictions and indefiniteness,” *Nat’l Blank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 827, 828 (TTAB 1993), unsupported statements carry

¹⁷⁴ Exhibits 22 and 46 to the Al-Binali declaration display a modified version of the mark, which we do not consider to be (and which Respondent has not argued to be) sufficiently similar to the registered mark to qualify as showing use thereof. *See, e.g.*, 186 TTABVUE 15



(Exhibit 22) and 186 TTABVUE 234



(Exhibit 46).

little weight. *See Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376-1377 (Fed. Cir. 1998) (“*Linville II*”) (“A registrant’s proclamations of his intent to resume or commence use in United States commerce during the period of nonuse are awarded little, if any, weight.”); *Kemi Organics*, 126 USPQ2d at 1607-1608 (oral testimony even of a single witness may be adequate to establish priority, “but only if it is sufficiently probative.”); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (“Oral testimony is strengthened by corroborative documentary evidence.”); *Liquacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305, 316 (TTAB 1979) (testimony must be clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value).

To the extent Respondent may argue that it satisfies the first element of the “use in commerce” requirement merely by advertising its services in promotions extending to the U.S. from Kuwait, Respondent has not proffered, nor have we found, any precedent for so expansive a reading of Trademark Act Section 45. *Cf. Linville v. Rivard*, 41 USPQ2d 1731, 1736 (TTAB 1996) (“*Linville I*”) (“We reject respondent’s argument that through his advertising [on Canadian radio and television stations extending to the U.S. and in Canadian newspapers that reached the U.S.], he has used the mark ULTRACUTS in the United States continuously since 1986.”), *aff’d*, 45 USPQ2d at 1377; *Mother’s Rests. Inc. v. Mother’s Other Kitchen, Inc.*, 218 USPQ 1046, 1048 (TTAB 1983) (“prior use and advertising of a mark in connection with goods or services marketed in a foreign country (whether said advertising occurs inside or outside the United States) creates no priority rights in said mark in the

United States as against one who, in good faith, has adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner's first use of the mark on goods or services sold and/or offered in the United States.”); accord *Morningside Grp. Ltd. v. Morningside Capital Grp., L.L.C.*, 182 F.3d 133, 51 USPQ2d 1183 (2d Cir. 1999) (“Mere advertising and promotion of a mark in this country are not enough to constitute ‘use’ of the mark ‘in commerce’ so as to bring the activity within the scope of the Lanham Act.”); *Buti v. Impresa Perosa, S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985, 1989-1990 (2d Cir. 1998) (promotional activities in the United States by eating establishment located in Italy did not secure for it “any rights in the name under the Lanham Act”).

We find Respondent's registration void ab initio based on its failure to use its mark in the sale or advertising of educational services under the mark, in the United States, before May 15, 2006.¹⁷⁵ We next consider whether Respondent has fulfilled the additional requirement for use in commerce under the Act's second requirement – that the services be rendered in commerce “in the United States and a foreign country.” 15 U.S.C. § 1127.¹⁷⁶

¹⁷⁵ As noted, Trademark Act § 45, 15 U.S.C. § 1127, defines the type of use that will qualify to support a registration of a mark identifying services: “For the purposes of this Act a mark shall be deemed to be used in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.” Respondent argues that it displayed its mark in advertising its services in the United States, but does not argue that it has used the mark in the sale of services in the United States. To the extent Respondent contends that using its mark on a website that has been accessed in the United States is a “sale,” as discussed infra, Respondent has not proven that it used its mark on a website prior to May 15, 2006 or that it “sold” educational services via its website.

¹⁷⁶ Respondent also argues that it rendered services affecting interstate commerce, discussed more fully below.

B. Did Respondent render services “in the United States and a foreign country” prior to its filing date?”

The recitation of services in Respondent’s use-based registration reads “educational services, namely, courses of instruction at the college level.” Respondent bears the burden to show that it offered these services “in the United States and a foreign country” (“foreign commerce”) prior to its May 15, 2006 application filing date, or its registration is void ab initio. *Aycock Eng’g*, 90 USPQ2d at 1305. Respondent argues that it has borne its burden in three ways. First, Respondent alleges that it rendered educational services to U.S. nationals in Kuwait.¹⁷⁷ Second, Respondent argues that it accepted and processed “cross-border applications.”¹⁷⁸ Third, Respondent claims that it rendered educational services in the United States under the “AUK-Dartmouth intern exchange program” and through the “Soliya Connect videoconferencing program based in New York that connected U.S. and foreign students in real-time online.”¹⁷⁹ We consider each in turn.

1. Rendering of educational services in Kuwait

Al-Binali testifies that since 2004, interns and exchange students from the United States have attended college-level classes at the American University of Kuwait.¹⁸⁰ Similar assertions were made by Awwad.¹⁸¹ Al-Binali also asserts that Respondent

¹⁷⁷ 176 TTABVUE 55.

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* at 56.

¹⁸⁰ 184 TTABVUE 30.

¹⁸¹ 181 TTABVUE 7.

sponsored “American students under its Fulbright program offered under the Subject AUK Mark since 2005, beginning with one that was accepted in 2005/2006.”¹⁸² However, there is no evidence of record corroborating the attendance, at the American University of Kuwait, for any students from the United States in the years 2004, 2005 or 2006. Although, as noted, oral testimony may in certain cases be sufficient to prove use, the statements made herein are not sufficiently probative for two reasons. First, the declarants make only bald conclusions in general terms unsupported by any evidence, and we would expect corroboration if such statements were true. Second, even if American students attended Respondent’s college in Kuwait prior to May 15, 2006, they would not have attended as part of an exchange program, as none existed at the time. Simply travelling to Kuwait to attend classes in Kuwait is not the type of foreign commerce contemplated by the Trademark Act. Services rendered wholly within a foreign country are not a type of commerce that Congress may regulate, even if the services are provided to citizens of the United States while in the foreign country. *See Linville I*, 41 USPQ2d at 1736 (“[W]e reject respondent’s argument that his services are rendered in commerce because commerce is affected by the travel of customers from the United States to respondent’s Canadian salons.”); *Mother’s Rests.*, 218 USPQ at 1048 (rejecting argument that display of a trademark in association with restaurant services provided in Canada to citizens of the United States created

¹⁸² 184 TTABVUE 32. *See also* 182 TTABVUE 11 (Eickelman Decl., “AUK hosts American national scholars in a Fulbright Program at AUK, under the Subject AUK Mark, arranging to sponsor its first Fulbright scholar in 2005.”).

priority rights in the United States); *Stagecoach Props., Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 349 (TTAB 1978) (noting that argument that use of a mark on hotel and restaurant services provided in Mexico to “people from the United States” created rights protectable under U.S. law “ignores the fundamental rule that activity outside of the United States is ineffective to create rights in marks within the United States.”).

Linville I is illustrative. In *Linville I*, the petitioner sought to cancel a registration for the mark ULTRACUTS for hair dressing and beauty salon services owned by respondent, a Canadian citizen, on the ground that because he had never used his mark in the United States, but only in Canada, he had abandoned it. The respondent admitted that he personally made no sales of hair dressing or beauty salon services under the mark in the United States, but argued that he had operated many hair salons successfully in Canada; that he had a large U.S. clientele; that he used hair salon products from the United States in his salons; and that he sold such products to U.S. customers at his salon. The Board “reject[ed] respondent’s argument that his services are rendered in commerce because commerce is affected by the travel of customers from the United States to respondent’s Canadian salons.” *Linville I*, 41 USPQ2d 1736. Further, the Board distinguished two cases (upon which Respondent urges us to rely) for the proposition that its activities affect foreign commerce: *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1992), and *Penta Hotels Ltd. v. Penta Tours*, 1988 U.S. Dist. LEXIS 15713, 9 USPQ2d 1081, (D. Conn. 1988). The Board noted that those cases involved services

which were actually rendered in the United States, i.e., a restaurant located in Tennessee, which attracted interstate travelers and a hotel in New York, which was affiliated with a European hotel. Like *Linville I*, this case “is readily distinguishable as respondent rendered no [educational services] in the United States during the relevant time period.” *Linville I*, 41 USPQ2d at 1736.

Respondent urges us to apply the rationale of the Fourth Circuit in *Int’l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 66 USPQ2d 1705, 1715-16 (4th Cir. 2003), which found that a foreign company’s rendering of casino services wholly within the country of Monaco supported the company’s trademark infringement and cybersquatting claims against the user of the same mark (CASINO DE MONTE CARLO) in 53 contested domain names for Internet gambling. *Bancorp*, 66 USPQ2d at 1723. A sharply divided panel of the court held that the defendant’s advertisement of its services in the United States, coupled with evidence that United States citizens went to Monaco and gambled at its casino, constituted “trade with a foreign nation that Congress may regulate under the Commerce Clause.” 66 USPQ2d at 1710. The court affirmed the district court’s award of monetary damages on defendant’s trademark infringement claim and transferred 43 of the 53 contested domain addresses on its cybersquatting claim. 66 USPQ2d at 1707.

We decline to follow the analysis of the Fourth Circuit majority laid down in a trademark infringement and cybersquatting context for several reasons. First and foremost, *Bancorp* is not controlling precedent in Board proceedings, and its holding

is contrary to the decisions rendered by our primary reviewing court, which require more than the rendering of services to U.S. citizens in a foreign country. *E.g.*, *Linville I*, 41 USPQ2d 1731 (travel by U.S. citizens to Canada for hair dressing and salon services does not establish sufficient nexus to United States). We are bound by Federal Circuit law and as the dissent in *Bancorp* stated, “the Federal Circuit has clearly and repeatedly embraced a rule that directly conflicts with the majority’s [rule].” *Bancorp*, 66 USPQ2d at 1729 (Motz, Judge, dissenting). Second, clearly stated in the statute is the requirement that for registration purposes, services must be rendered “in the United States and a foreign country.” 15 U.S.C. § 1127. Respondent’s services, provided wholly within Kuwait, fall outside the reach of the Commerce Clause and the Trademark Act’s definition of “use in commerce.” Finally, *Bancorp* is distinguishable on its facts. The court in *Bancorp* relied on defendant’s extensive advertising in the United States, and actual travel of U.S. citizens to defendant’s casinos in Monaco; here we have no evidence of U.S. advertising or travel by U.S. citizens during the relevant time frame.¹⁸³

2. Accepting and processing cross-border applications

Respondent argues that it has taken and accepted college applications through its website since 2003 and that “taking and accept[ing] college applications is...an

¹⁸³ We further note that Professor McCarthy has criticized the court’s analysis in *Bancorp* as failing to account for specific provisions in Section 43(a), and suggesting that “the case should have been analyzed as an application of the ‘famous marks’ doctrine.” MCCARTHY § 29:4 (5th ed.). The famous marks doctrine has not been invoked in this proceeding, and Section 43(a)(1) is inapplicable in any event.

integral part of providing educational services.”¹⁸⁴ In support, Respondent submitted several exhibits to Al-Binali’s declaration purporting to show that it displays application forms online for prospective students to print out and mail in to Respondent in Kuwait.¹⁸⁵ None of the exhibits display the registered mark. Accordingly, none of the evidence is probative.

3. Rendering of educational services in the United States

In response to Petitioner’s Interrogatory No. 16, “Identify each State in the United States in which the Respondent has provided courses of instruction at the college level in connection with the Mark,” Respondent answered: “Respondent does not provide courses of instruction at the college level in the United States.”¹⁸⁶ However, Respondent argues that “under an AUK-Dartmouth intern exchange program that commenced in 2005, Dartmouth sent students to Kuwait in the Spring 2005, and AUK sent students to Dartmouth beginning June 2006, as arranged pre-May 15, 2006.”¹⁸⁷ As noted above, the record evidence is insufficient to show that any such program was operational before May 15, 2006, and none of the evidence in the record associated with the AUK-Dartmouth program displays Respondent’s registered mark.

¹⁸⁴ 176 TTABVUE 56.

¹⁸⁵ These include Exhibits 22, 45 and 46 to Al-Binali’s Decl., 186 TTABVUE 11-33, 186 TTABVUE 220-25, and 186 TTABVUE 227-34.

¹⁸⁶ 112 TTABVUE 47.

¹⁸⁷ Applicant’s Brief, 176 TTABVUE 56.

Respondent contends it simultaneously transmitted course instruction through the Soliya Connect program. The Soliya Connect program, “involving video-conferencing and an instructor-guided interconnectivity and interactivity, simulates a cross-border open-space classroom between Soliya in New York and AUK in Kuwait, along with other participating universities.”¹⁸⁸ Neither the record evidence nor Respondent’s testimony confirms that Respondent provided educational services in connection with the program.¹⁸⁹

Summary - Nonuse

Respondent has not rendered services in the United States. It is well settled under binding Federal Circuit and Board cases that activities wholly outside the United States do not create rights in marks in the United States. *Linville I*, 41 USPQ2d at 1736-37; *Fiat Grp. Automobiles S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1115 (TTAB 2010) (“[A]ctivity solely outside the United States is ineffective to create or maintain rights in marks within the United States.”) Respondent’s identified services were rendered under the mark entirely in Kuwait prior to the filing date of the application maturing into the subject registration.¹⁹⁰ This does not constitute foreign commerce.

¹⁸⁸ Awwad Decl., 181 TTABVUE 7.

¹⁸⁹ Al-Binali Decl., Exhibit 102, 187 TTABVUE 90-102,.

¹⁹⁰ To the extent Respondent engaged with U.S. citizens as prospective or as actual students, such contacts do not qualify as use of the mark “in the United States and a foreign country.” See *Linville II*, 45 USPQ2d at 1376 (sporadic trips to the United States, cursory investigations of potential sites for salons, and half-hearted attempts to initiate the business relationships necessary to open a salon did not amount to use in commerce); *Linville I*, 41 USPQ2d at 1737 (that United States residents availed themselves of respondent’s services while in Canada did not constitute “technical trademark use...sufficient to obtain or maintain a registration in the United States”); *Mother’s Rests.*, 218 USPQ at 1048 (evidence that Canadian restaurant had distributed promotional material at tourist information booths, and

To the extent Respondent suggests that its use “affects” foreign commerce, we decline to extend by analogy the holdings in those cases finding commercial activity, conducted wholly within a single state in the United States, to be regulable by Congress on the basis that it affects interstate commerce. With respect to international borders and foreign commerce, “[t]he concept of territoriality is basic to trademark law.” *Person’s Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); *see also Buti v. Perosa*, 45 USPQ2d at 1989 (applying the territoriality rule to service marks).

IX. Conclusion – Respondent’s registration is void ab initio

Respondent advertises and renders educational services under the mark within Kuwait. To the extent Respondent’s advertising may have reached the United States before May 15, 2006, such advertising alone is not enough to support registration; Respondent’s services also must have been rendered in commerce. The evidence does not show that Respondent rendered services under the mark in commerce prior to the filing date of the application maturing into Registrant’s registration. Failure to satisfy either element of the “use in commerce” test renders a registration void ab initio, and here Respondent has failed to satisfy both. Accordingly, Respondent’s registration is void ab initio under Trademark Act Section 1(a).

that U.S. citizens had dined in the restaurants did not qualify as use in commerce); *Stagecoach Props.*, 199 USPQ at 349 (use of a trademark on hotel and restaurant services in Mexico did not qualify).

Decision: Respondent's counterclaims for amendment of Registrations Nos. 2986715, 3559022, and 4127891 to delete the Section 2(f) claims as to the term "AMERICAN UNIVERSITY" in favor of a disclaimer of the term, and for partial cancellation of Registration No. 4774583 as to the International Class 41 services, are **denied**.

Petitioner has established by a preponderance of evidence that Respondent did not use its mark in commerce within the meaning of Section 45 of the Trademark Act for the services identified in its involved registration prior to May 15, 2006, the filing date of its use-based application. Accordingly, the petition to cancel is **granted** under Section 1(a) and Respondent's registration will be cancelled in due course.¹⁹¹

In view thereof, we need not reach Petitioner's claim under Section 2(d). *Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (the Board's determination of registrability does not require, in every instance, decision on every pleaded claim).

¹⁹¹ Petitioner is allowed until thirty (30) days from the mailing date of this decision to comply with Trademark Rule 2.126(c) by filing a redacted version of 189 TTABVUE, failing which 189 TTABVUE will be treated as part of the public record. *Kohler Co.*, 125 USPQ2d at 1476 n.19 (TTAB 2017) quoting *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016). The parties are reminded that the Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party. Trademark Rule 2.116(g).