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

Proceeding	92057455
Party	Plaintiff Board of Regents, The Texas State University System
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 3649427 owned by Old Grey Foundation, Inc. for the  
Mark: **TXST**; International Class 36; Registered on July 7, 2009

_____	)	
Board of Regents, The Texas State	)	
University System	)	
	)	
Petitioner	)	
	)	
v.	)	Cancellation No.: 92057455
	)	
Old Grey Foundation, Inc.,	)	
	)	
Respondent	)	
_____	)	

**RESPONSE TO RESPONDENT’S COUNTER-CLAIM FOR SUMMARY  
JUDGMENT AND MEMORANDUM OF AUTHORITIES IN SUPPORT  
THEREOF**

Board of Regents, The Texas State University System, by and on behalf of Texas State University, an institute of higher education having an address of 601 University Drive, San Marcos, Texas 78666 (“Petitioner”), submits this Response to *Respondent’s Counter-Claim for Summary Judgement [sic] and Memorandum of Authorities in Support Thereof* (the “Counter Motion”) in the above-referenced cancellation action.

**I. INTRODUCTION.**

**A. Respondent's Counterclaims are Not Valid Legal Defenses to Cancellation.**

Section 2 of the Trademark Act, 15 U.S.C. § 1052(a), states in relevant part that “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (a) [c]onsists of or comprises ... matter which may ... falsely suggest a connection with ... institutions ....”

Respondent, in its Counter Motion, raises four allegedly “undisputed defenses”: (1) licensee estoppel, (2) abandonment, (3) lack of commercial use, and (4) lack of enforceable right. Putting aside the issue of whether these four “defenses” are undisputed or even proper (they are not), as shown below, Petitioner only needs to show that Respondent intended to identify Petitioner in order to support a claim of false association. In this case, Respondent admitted to the USPTO that the mark at issue (“TXST”) was intended to refer to Texas State University. This admission conclusively prevents entry of summary judgment in Respondent’s favor, and in fact supports entry of summary judgment in Petitioner’s favor.

**B. Respondent's Exhibits are Not Authenticated and are Generally Not Admissible.**

Respondent’s Counter Motion did not include an affidavit authenticating the exhibits attached, as required by the Trademark Rules and the Federal Rules. “To be considered on summary judgment, documents must be authenticated by and attached to an affidavit made on personal knowledge setting forth such facts as would be admissible in evidence or a deposition that meets the requirements of FED. R. CIV. P. 56(e).

Documents which do not meet those requirements cannot be considered.” Shanklin v. Fitzgerald, 397 F.3d 596, 602 (8th Cir. 2005) (quoting Stuart v. Gen. Motors Corp., 217 F.3d 621, 635–36 n.20 (8th Cir. 2000)); Orr v. Bank of Am., 285 F.3d 764, 773 (9th Cir. 2002) (citations omitted) (“We have repeatedly held that unauthenticated documents cannot be considered in a motion for summary judgment.”).

Many of Respondent’s exhibits suffer from various issues, including (i) they do not constitute application files, registrations or printed publications within the trademark rules, or (ii) they are devoid of any detail or stated relevance to the matter at hand. For example, Respondent’s exhibit 1 is a purported trademark license agreement, exhibit 2 purports to be a letter from 2009, exhibit 3 is allegedly a vendor maintenance form, exhibit 4 purports to be a letter from 2010, exhibit 5 allegedly refers to a remittance, exhibit 6 is allegedly a settlement agreement, exhibit 7 is purportedly a letter from 2010, and exhibit 8 is titled “agency agreement.” None of the foregoing exhibits are publicly available documents that would be considered application files, registrations or printed publications within the meaning of the trademark rules. None of the foregoing have been proven up by a person with knowledge of the alleged facts stated therein. As a result, such documents should be disregarded.

In addition, the remaining exhibits referenced by Respondent suffer from lack of relevancy. For instance, exhibit 9 is merely a list of third party marks, with no supporting information as to first use or goods/services offered, and as a result, this exhibit is not relevant or dispositive to any issue. Exhibit 11 is a printout from the USPTO database regarding “Texas State Technical College,” as used for “vocational education in the fields of technology,” which is irrelevant for many reasons, not least of

which it does not impact the issue of whether Respondent's TXST mark was intended to create an association with Petitioner. Exhibit 12 is purportedly a list of business names from the Texas secretary of state's office, again without any information as to first use, whether such names are used as trademarks, and what goods/services may be offered in connection therewith.

As these examples show, Respondent's exhibits are not application files, registrations or printed publications within the meaning of the trademark rules, they are offered without any supporting affidavit or declaration, and should be disregarded.

**C. Respondent Misrepresents the Factual Record**

Respondent provides two full pages for its "statement of facts," but even if these unsupported and unverified "facts" were true, they are completely irrelevant to the basis for cancellation of Respondent's mark: Respondent admitted to the USPTO that its TXST mark was intended to create an association with Petitioner. There is no dispute whatsoever as to Respondent's admission to the USPTO. In light of this, summary judgment should be granted in favor of Petitioner, and denied with respect to Respondent.

**II. ARGUMENT**

**A. Respondent Misstates Doctrine of Licensee Estoppel**

The first case cited by Respondent in its Motion, WCVB-TV v. Boston Athletic Ass'n, 926 F.2d 42, 47 (1st Cir. 1991), flatly contradicts Respondent's position:

Regardless, *we can find no case that would even prevent a challenge by a prior licensee*, based upon post-license facts, *after the license has expired*. See generally 3 CALLMAN, UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 19.48 (4th ed. 1989). *We cannot think of any reason why such a licensee ought to be estopped; or why, a grant of a license should permanently immunize a trademark holder from legal attack.*

*Compare Lear, Inc. v. Adkins*, 395 U.S. 653, 23 L. Ed. 2d 610, 89 S. Ct. 1902 (1969) (estoppel doctrine does not apply to patent licensees) with *Beer Nuts, Inc. v. King Nut Co.*, 477 F.2d 326, 328-29 (6th Cir.), cert. denied, 414 U.S. 858, 38 L. Ed. 2d 108, 94 S. Ct. 66 (1973) (estoppel doctrine does apply to trademark licensees).

(emphasis added).

Respondent states that the license agreement (shown in Respondent's exhibit 1) between Petitioner and Respondent expired on April 13, 2013, three months before Petitioner brought the present cancellation action. Counter Motion at 5. First of all, that agreement is an unverified, non-public document that is not admissible herein. Therefore, any allegations based thereon must be disregarded. In addition, Respondent's citation to WCVB-TV does not support its claim that licensee estoppel is a proper defense, as set forth by the language from the case referenced above.

Respondent's reliance upon Freeman v. Nat'l Assoc. Realtors, 64 U.S.P.Q.2d 1700 (TTAB 2002) is similarly unavailing. There, the Board stated "A former licensee, however, may challenge the validity of the licensed mark on facts which arose after the license expired." Id. at 10 (*citing* WCVB-TV v. Boston Athletic Assoc., 926 F.2d 42, 17 U.S.P.Q.2d 1688 (1st Cir. 1991); Nat'l Council of YMCA v. Columbia YMCA, 8 U.S.P.Q.2d 1682 (D.S.C. 1988)). Respondent has provided no authority or proof whatsoever that indicates that Petitioner knew of Respondent's representation to the USPTO that the TXST mark was intended to refer to Petitioner. Furthermore, "licensee estoppel is an equitable defense. '[T]he doctrine is not subject to rigid application. Instead, a court considering the doctrine's application remains free to consider the particular circumstances of the case, including the nature of the licensee's claim.'" John C. Flood of Va., Inc. v. John C. Flood, Inc., 700 F. Supp. 2d 90, 97 (D.D.C. 2010) (*citing*

Westco Group, Inc. v. K.B. & Assocs., Inc., 128 F. Supp. 2d 1082, 1090 (N.D. Ohio 2001); Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc., 43 Fed. Appx. 408, 414 (2nd Cir. 2002) (quoting RESTATEMENT (THIRD) UNFAIR COMPETITION § 33). Here, unlike in those cases, Petitioner does not assert that Respondent abandoned its mark or otherwise neglected it. Rather, Petitioner discovered that the purported “license” exceeded the scope of Respondent’s alleged rights, and that Respondent was creating a false association with Petitioner. Thus, estoppel is not appropriate as against Petitioner.

Additionally, Petitioner asserted in its Complaint, ¶24 that the license which forms the basis of Respondent’s asserted defense “was previously invalid/void because (a) the scope of the alleged license was broader than the services set forth in Respondent’s registration at issue, ... (c) Respondent breached its representations and warranties in section 5 in that Respondent was not the sole and exclusive owner of the asserted mark, and did not have legal authority to grant the underlying ‘license,’ or obtain the registration at issue, as the prosecution history (referenced above) makes clear.” As Petitioner has indicated previously, Respondent stated to the USPTO, in relevant part, as follows:

“[TXST] does not identify a geographic place, **other than its intended reference to Texas State University**, which has campuses located in San Marcos, TX as well as Round Rock, TX.”

Petition for cancellation at para. 9, referring to Exhibit 6 thereto.

Respondent thoroughly ignores this issue in its Counter Motion. None of Respondent’s exhibits address or are even relevant to this issue. Respondent’s registration for TXST was specifically intended to create an association with Petitioner,

by Respondent's own admission to the USPTO, and regardless of whether a license agreement existed or not (and which in any event is unverified and inadmissible), the undisputed admission of association remains.

**B. Summary Judgment Based Upon Abandonment is Not Warranted**

Respondent has not shown that "abandonment" is an appropriate defense to cancellation for false association, even if proven (and Respondent has not done so). Nonetheless, Section 45 of the Trademark Act, 15 U.S.C. § 1127 states that a mark shall be deemed "abandoned" when its use has been discontinued with intent not to resume such use, or when the owner's conduct causes the mark to become the generic name for the goods/services with which it is used, or otherwise to lose its significance as a mark.

With respect to this language, the Fifth Circuit has observed as follows:

The language of subsection 1127(2) reflects that **to prove "abandonment" the alleged infringer must show that, due to acts or omissions of the trademark owner, the incontestable mark has lost "its significance as a mark."** See Defiance Button Mach. Co. v. C & C Metal Products, 759 F.2d 1053, 1061-1062 (2d Cir.) (concluding that section 1127(2) was intended to apply only when the subject mark ceased to be an indicator of origin), cert. denied, 474 U.S. 844, 106 S. Ct. 131, 88 L. Ed. 2d 108 (1985); Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp., 680 F.2d 755, 766 n. 13 (C.C.P.A.1982) ("from the legislative history it is evident that abandonment under part (b) [subsection 1127(2)] was principally intended to encompass acts of omission or commission by the registrant which resulted in the mark becoming a generic term") (citation omitted).

Exxon Corp. v. Oxxford Clothes, Inc., 109 F.3d 1070, 1079 (5th Cir. 1997) (emphasis added). If the "Texas State" mark has not lost its significance, then a required element of abandonment has not been shown. Respondent argues, without any foundation or admissible evidence, that Petitioner has not taken steps to enforce its mark. Respondent also argues that other entities have used the mark "Texas State," particularly "Texas State

Technical College.” There is, however, nothing in the record that suggests that Texas State Technical College has ever identified itself as “Texas State.” *See Reply in Support of Petitioner’s Motion for Summary Judgment (“Petitioner’s Reply”)* at 9.

Furthermore, while Respondent ignores its own admission that it intended to associate its mark with Petitioner, Respondent provides no evidence that the term “Texas State” is used to identify any of the entities listed in its Counter Motion. Respondent’s cited evidence, ironically, actually rebuts Respondent’s implicit contention that “Texas State” has lost its significance and no longer identifies Petitioner. For example, the alleged use of the “Texas State” mark by the Texas State Alumni Foundation, which is comprised of alumni of Texas State University, constitutes *proof*, not disproof, that the mark is strongly associated with Petitioner and is still significant. Counter Motion at 8–9. Thus, at a minimum, there is an issue of material fact as to whether Petitioner has abandoned its mark.

Respondent also argues, without appropriate basis or foundation, that Petitioner has “taken steps to affirmatively disavow and denounce the use of TXST.” Even if the documentation cited by Respondent for this principle, an editorial style guide and branding standards, were relevant, they address only how Petitioner chooses to officially refer to itself. As Petitioner has established in its own motion for summary judgment, Petitioner has used “TxSt” for various matters, but it is not an approved “shorthand” designation for “Texas State University.” Just because Petitioner prefers that “TXST” not be used as the official abbreviation or shorthand for Texas State University in all matters does not mean that it cannot seek to stop third parties from using TXST as a means of associating with Petitioner. In other words, regardless of whether TXST is an

official designation for Petitioner or not, this does not give third parties the authorization to use TXST to associate their goods or services with those of Texas State University.

Furthermore, even if Petitioner has “abandoned” any rights in TXST, the cancellation action would still be properly brought because Petitioner has an interest in preventing false associations between Respondent and Petitioner. Univ. of Notre Dame Du Lac v. J.C. Gourmet, 703 F.2d 1372, 1377 (Fed. Cir. 1983) states that, even if the factfinder concludes that a name is not solely associated with Petitioner, a finding of unmistakable association under Section 2(a) can still be found “if the evidence showed that Gourmet [respondent] intended to identify the University, as the University argues. Evidence of such intent would be highly persuasive that the public will make the intended false association. The defense that the result intended was not achieved would be hollow indeed.” As Petitioner noted in its own Motion for Summary Judgment, Respondent admitted to the USPTO that its mark is intended to identify Petitioner: “[TXST] does not identify a geographic place, **other than its intended reference to Texas State University**, which has campuses located in San Marcos, TX as well as Round Rock, TX.” Petitioner’s Motion for Summary Judgment (“Petitioner’s Motion”) at 3 (citation omitted) (emphasis added). Thus, abandonment is not a proper defense to Petitioner’s claims under the instant facts and summary judgment in Respondent’s favor is inappropriate.

**C. Summary Judgment Based Upon Commercial Use is Not Warranted.**

Respondent again fails to cite a single case or statute in support of its putative affirmative defense. Furthermore, as noted *supra*, Petitioner need not own the disputed mark in order to properly bring a petition to cancel Respondent’s mark. *See also*

Jewelers Vigilance Comm., Inc. v. Ullenberg Corp., 823 F.2d 490, 493 (Fed. Cir. 1987).

Thus, it is unclear as to how potential commercial use of the disputed mark constitutes an affirmative defense. Regardless, Respondent's argument lacks evidentiary foundation and is demonstrably false. See Petitioner's Petition for Cancellation, ¶12. Thus, summary judgment in Respondent's favor is inappropriate.

**D. Petitioner has an Enforceable Right to "Texas State."**

Respondent relies upon Univ. of Southern Carolina v. Univ. of Southern California, to argue that to "prevail on a Section 2(a) Lanham Act claim for cancellation based on false association, Petitioner must show that the challenged mark is 'unmistakably associated' with another person or institution." Counter Motion at section II(4), on p. 12. That case draws its support from Univ. of Notre Dame Du Lac v. J.C. Gourmet, 703 F.2d 1372 (Fed. Cir. 1983), which was discussed in Section B above.

Petitioner has already established that Respondent admitted to the USPTO that TXST refers to Petitioner. See citations in Sections A and B herein. Similarly, Respondent testified under oath that it intends to utilize the affiliation with Texas State University:

Q. So Renegade Rugby, in order to -- if I understand, in order to participate as a collegiate team, utilizes the affiliation with Texas State University --

A. Correct.

Petitioner's Motion for Summary Judgment at p. 7 (citation omitted). Respondent again does not address this evidence in either its Response to that Motion or its Counter Motion.

The testimony and evidence presented by Petitioner stands in direct contrast to Univ. of Notre Dame Du Lac, where the court found “[t]here is no direct evidence here establishing an intent on the part of Gourmet to identify the University [of Notre Dame]. To the contrary, Gourmet’s [respondent] general manager testified that he selected the name while viewing the Cathedral of Notre Dame in Paris, when he was in France on a business trip to purchase cheese, and a representation of this edifice forms part of the mark sought to be registered.” *Supra*, at 1377. As the courts have stated, “analyzing the intent of the defendant in using the mark will allow the court to understand the defendant’s reason for utilizing the mark in the manner that it did. ... Whereas the traditional ‘intent’ prong looks at intent to adopt a similar mark, here the key inquiry is whether the mark is being used so as to convey a connection between the parties that may not exist.” Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 226 (3rd Cir. 2005).

Unlike the fact scenario in the cases cited by Respondent, here Respondent intended to identify and associate its mark with Petitioner, as Petitioner’s evidence indicates. Thus, evidence of such intent is “highly persuasive” that the public will make the intended false association. Accordingly, summary judgment in favor of Respondent is inappropriate.

### **III. CONCLUSION.**

Respondent’s Counter-Motion for Summary Judgment is full of argument, but is without evidentiary basis. The majority of exhibits to the Counter-Motion are not verified, or do not constitute application files, registrations or printed publications, and are therefore inadmissible. Even more broadly, however, Respondent’s Counter-Motion

raises a whole host of issues that are completely irrelevant to the fact that Respondent admitted to the USPTO that TXST refers to Texas State University, and that Respondent intended to make that false association. Nothing presented or argued by Respondent changes that simple fact. In light of the above, Petitioner respectfully requests that Respondent's Motion be denied.

Respectfully submitted,

Board of Regents,  
The Texas State University System

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Dated: September 5, 2014

**CERTIFICATE OF SERVICE**

I hereby certify I caused a true and correct copy of the foregoing *Response to Motion for Summary Judgment and Memorandum of Authorities in Support Thereof* to be served upon counsel for Respondent, as identified below, by first class mail, postage prepaid, this 5<sup>th</sup> day of September 2014.

Scot Courtney  
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