

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Carnegie Mellon University  
Mark: CMU  
Serial No.: 88/009,259  
Filed: June 21, 2018  
International Class: 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, 35, 36, 41, 42, 43, 44  
Examining Attorney: SHINER, MARK W  
Law Office: 105  
Attorney Ref. No.: 18-40069-US

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**RESPONSE TO OFFICE ACTION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Commissioner:

In response to the Office Action dated October 11, 2018, Applicant responds as follows, without prejudice, and respectfully requests reconsideration of same.

**AMENDMENT AND DELETION**

The identification of services in this application have been amended as follows:

~~Class 06 – metal key chains, key tags, and money clips~~

Class 09 – magnetically-encoded credit cards; magnetically-encoded debit cards; computer game cassettes; computer game discs; ~~computer game joy sticks~~; computer game programs; computer game software; computer game tapes

Class 14 – jewelry and clocks; metal key chains

Class 16 – paper goods and printed matter, namely, brochures, newspapers, journals, bulletins, programs, catalogs, printed instructional, education, and teaching materials, and books and magazines, all relating to general news, business, political, educational, sports, travel, and alumni affairs issues; school year books, class albums; media guides in the nature of athletic teams and event programs; \*telephone\* and address directories; registers, namely, books for receiving record entries; stationery; notebooks; stationery-type portfolios; binders; book covers; book ends; calendars; greeting cards; announcement cards; postcards; folders; wrapping paper; notecards; notepads; pocket and desk diaries; date books; appointment books; desk pads; memo pads; scrap

books; paper weights; pen and/or pencil holders; address books; printed awards; printed diplomas; diploma covers in the nature of document covers; business cards; stickers; bumper stickers; letter openers; personal organizers; photographic prints; art prints; printed paper signs; paper banners; checkbook covers and holders; pencils; pens; decals; paper napkins; credit cards without magnetic coding; debit cards without magnetic coding; and rubber stamps; paper tablecloths; money clips

Class 18 – tote bags; backpacks; all purpose athletic bags; sports bags; duffel bags; handbags; bookbags; pocketbooks; school bags; traveling bags; luggage; umbrellas; and umbrella covers

Class 20 – furniture, namely, chairs; mirrors; picture frames; seat cushions

Class 21 – coffee cups; mugs; drinking glasses; plates; bowls; insulated containers for food or beverages; household containers for foods; non-electric portable coolers; wastepaper baskets; bottle openers; corkscrews; coasters not of paper or textile and not being table linen; vases; salt and pepper shakers; and serving trays not of precious metal

Class 24 – bed linens, namely, sheets, bed spreads, quilts, blankets, throws, stadium blankets, comforters, pillow cases, pillow shams; table linens, namely, tablecloths not of paper, fabric napkins, fabric place mats, fabric table runners; bath linens, namely, towels, ~~bath mats~~; wash cloths; cloth pennants; cloth banners

Class 25 – jackets; shirts; shorts; sweatshirts; headware, namely, caps, hats, visors; neckties; boxer shorts; athletic uniforms; coats; sport coats; infantwear; baby bibs not of paper; socks; sweatpants; sweaters; slippers; pajamas and sleepwear; gloves; mittens; scarves; cardigans; and rainwear

Class 27 – bath mats

Class 28 – toys and sporting goods, namely, stuffed animals, board games, card games, wastepaper basketball games, dart games, yo-yos, footballs, basketballs, soccer balls, baseballs, decorative wind socks, flying discs, golf tees, golf bags, golf bag tags, golf club head covers and golf balls; holiday tree ornaments; playing cards; computer game joysticks

Class 35 – retail store services featuring collegiate and bookstore ~~items~~, apparel, gift, book, art, computer, and electronic items; online retail store services featuring collegiate and bookstore apparel, gift, book, art, computer and electronic items; research and consultation in the field of business; providing on-line campus, student, faculty, staff, business, telephone, and commercial directory information services also featuring hyperlinks to other web sites; providing a web site featuring information, resources, and links to other web sites regarding university employment opportunities, administrative services, and university alumni professional networking services

Class 36 – charitable fundraising services; leasing of college facilities; providing a web site featuring information, resources, and links to other web sites regarding university housing

Class 41 – educational services, namely, developing, arranging for and providing courses of instruction and training at the undergraduate, graduate, post-graduate, and professional levels, developing, arranging for and providing courses of instruction and training at the undergraduate, graduate, post-graduate levels via a global computer network; research and consultation in the field of liberal arts education, namely, as it relates to education in literature, history, philosophy, psychology, fine arts and modern languages; research and consultation in the field of education; research and consultation in the field of liberal arts, namely, literature, history, philosophy, fine arts and modern languages; publishing services, namely, publication of books, pamphlets, textbooks and other materials, namely, magazines, newspapers, newsletters, and yearbooks in print and electronic format; production of radio and television programs; providing entertainment services, namely, providing cultural exhibitions; and motion picture exhibitions, concerts, plays, operas, musicals, recitals, dance performances, athletic events, and art exhibits; conducting educational conferences, lectures, workshops, demonstrations, and seminars; providing facilities for recreational, educational, and entertainment meetings; providing recreational, sports, and athletic facilities; providing ~~reference and library services; computer services, namely, providing a web site featuring information, resources, and links to other web sites regarding university admissions, academic and research programs, university athletic programs, university employment opportunities, university housing, university administrative services,~~ university alumni professional development, online and in-person seminars on professional and academic topics, entertainment, and educational activities and organizations, university educational and career counseling services, student entertainment and educational activities and organizations, university publications, university libraries, and university information technology services research programs in liberal arts education, namely, as it relates to education in literature, history, philosophy, psychology, fine arts and modern languages

Class 42 – computer services, namely, hosting the web sites of others on a computer server for a global computer network; research and consultation in the fields of science and engineering; psychology research; providing research and reference services by librarians and reference service specialists; providing a web site featuring information, resources, and links to other web sites regarding information technology services; providing a web site featuring information, resources, and links to other web sites regarding university scientific research programs

Class 43 – providing temporary sleeping ~~and eating~~ accommodations; providing eating services, namely, provision of food and drink; providing restaurant services; and providing community centers for social gatherings and meetings

Class 44 – psychology consultation; providing a web site featuring information, resources, and links to other web sites regarding university counseling services, namely, health counseling services, mental health counseling services, and nutrition counseling services

### **REMARKS**

Applicant has carefully reviewed the outstanding Office Action and respectfully requests that the Examining Attorney reconsider registrability of the subject application in light of the following remarks:

#### **I. Identification of Goods and Services**

The Examining Attorney has refused registration because the identification of goods is allegedly indefinite and must be clarified because it has goods and services that could be in other classes and lacks specificity required. (Office Action, p. 4-7.) In response to the Examining Attorney’s objection, Applicant has amended the goods and services as noted above in the Amendments section of this Response. In general, Applicant has accepted the Examining Attorney’s suggested amendments or otherwise addressed the issues raised by Examining Attorney with a few exceptions discussed below.

The Examining Attorney suggested moving “money clips” from Class 006 to Class 014. Applicant respectfully asserts that “money clips” are properly classified in Class 016 according to the USPTO’s Acceptable Identification Goods and Services Manual (“ID Manual”). *See* Term ID 016-1576. Therefore, “money clips” has been moved to Class 016.

The Examining Attorney suggested amending “athletic events” in Class 041 to “collegiate athletic events.” Applicant respectfully submits that this amendment is not necessary and unduly narrows Applicant’s identification of services. Applicant hosts both collegiate and non-collegiate events including but not limited to high school athletic camps.

Applicant believes that all rejections of the identification of goods has been addressed by this Response, and therefore requests withdrawal of all such rejections.

## **II. Multiple Class Requirements**

The Examining Attorney stated that Applicant must submit a filing fee for each international class not covered by the fees already paid. With Applicant's amendments to the identification of goods and services, Applicant has added 2 additional classes (16 total).

Applicant herewith submits a filing fee to cover the additional classes claimed.

## **III. No Likelihood of Confusion Exists**

The Examining Attorney has refused registration of the applied for mark, CMU, based on an alleged likelihood of confusion with the marks in U.S. Registration Nos. 5,534,103, 5,564,025, and 5,568,841, and Serial No. 87/766,967 (collectively, "Cited Marks") all owned by Central Michigan University. (Office Action, p. 3-4.)

Applicant respectfully submits that there is no likelihood of confusion with any of the Cited Marks. As discussed below, Applicant's mark has been in use with the goods and services identified in its application, and has co-existed with the Cited Marks, for many years. Moreover, Applicant has submitted herewith a copy of a Trademark Consent Agreement executed between Applicant and Central Michigan University ("Consent Agreement") (attached hereto as Exhibit A), confirming that the Applicant's CMU trademark and the Cited Marks have coexisted for over 50 years without confusion, and including proactive steps to continue to prevent consumer confusion.

### **A. The *DuPont* Factors**

The factors for determining likelihood of confusion are set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The Federal Circuit recently summarized the duty of the Examiner, TTAB, and Federal Circuit in considering these factors as follows:

“In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely.” *DuPont*, 476 F.2d at 1362 (emphasis in original). “In discharging this duty, the thirteen DuPont factors ‘must be considered’ ‘when [they] are of record.’” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997) (quoting *DuPont*, 476 F.2d at 1361). This is true even though “not all of the DuPont factors are relevant or of similar weight in every case.” *Id.* at 1406; *see also Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265 (Fed. Cir. 2002) (noting the likelihood of confusion analysis “considers all *DuPont* factors for which there is evidence of record” but may focus on dispositive factors).

*In re: Guild Mortgage Company*, --- F.3d ---, 2019 WL 178435, at \*2 (Fed. Cir. Jan. 14, 2019).

Here, the relevant factors are the presence of a consent agreement and long-standing concurrent use without evidence of actual confusion.

## **B. Consent Agreement**

*DuPont* factor 10 requires examination of the “market interface between applicant and the owner of a prior mark,” including the presence of “a mere ‘consent’ to register or use” or “agreement provisions designed to preclude confusion, i.e., limitations on continued use of the marks by each party.” *DuPont*, 476 F.2d at 1361. “The weight to be given more detailed agreements of the type presented here should be **substantial**.” *Id.* at 1362 (emphasis added). “Thus when 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. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.” *Id.* at 1363 (emphasis in original). Indeed, “there can be no better assurance of the absence of any likelihood of confusion, mistake or deception than the parties’ promises to avoid any activity which might lead to such likelihood.” *In re Beatrice Foods, Co.*, 429 F.2d 466, 166 (C.C.P.A. 1970).

For instance, the Federal Circuit reversed the TTAB's refusal to register the marks AMALGATED and AMALGATED BANK for banking services where the applicant and the senior user of the identical marks also for banking services had entered into a consent agreement. *Amalgamated Bank of New York v. Amalgamated Tr. & Sav. Bank*, 842 F.2d 1270 (Fed. Cir. 1988). The applicant had "continuously conducted banking services in the state of New York since its inception in 1923... and actively solicit[ed] business from unions and union members across the United States and also advertise[d] extensively nationwide in search of business." *Id.* at 1271. The senior user had "conducted somewhat similar banking services continuously in the state of Illinois since 1922 [and] also advertise[d] nationwide and ha[d] clients throughout the United States." *Id.* To obtain registration, the applicant submitted a consent agreement between the parties reciting "that each party had done business for many years under their present names, that each had been aware of the other's use of its name as at present, and neither knew of any instances of customers' confusion, mistake, or deception." *Id.* at 1271-72. The agreement further stated that the parties would take no action against each other's continued right to use the marks AMALGATED and AMALGATED BANK and permitted each other to advertise and deal with customers nationwide even in each other's territory. *Id.* at 1272.

The TTAB refused registration because the marks and services were essentially identical "and accorded the parties' agreement little weight as proof that confusion was not likely." *Id.* In the TTAB's view, the registration could not be allowed "unless the parties persuade[d] it that each user is effectively fenced out of the trading area of the other with a buffer zone in between them." *Id.* at 1274. The Federal Circuit rejected this reasoning finding that the "TTAB's reliance on its own views regarding the banking industry, rather than the views of the parties in question" was contrary to its precedents placing substantial weight on consent agreements

between industry participants. *Id.* at 1274-75. Accordingly, the Federal Circuit reversed and remanded. *Id.* at 1275; *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1566 (Fed. Cir. 1993) (reversing denial of registration for failure to properly consider consent agreement and noting that “the PTO’s role is to protect owners of trademarks by allowing them to register their marks. Denial of registration does not deny the owner the right to use the mark, and thus, will not serve to protect the public from confusion”); *In re N.A.D. Inc.*, 754 F.2d 996, 998-999 (Fed. Cir. 1985) (rejecting the TTAB’s reasoning that a consent “agreement must show that there are differences in the goods and that the registrant and the applicant can and will remain clear of each other’s marketing and trade channels”); *Application of United Oil Mfg. Co.*, 508 F.2d 1341, 1344 (C.C.P.A. 1975) (permitting registration of UNITED for gasoline over pre-existing registration for UNITED for lubricating oils and greases based on consent agreement); *DuPont*, 476 F.2d at 1358 (reversing refusal to register mark RALLY for a combination polishing, glazing, and cleaning agent for use on automobiles over pre-existing registration for RALLY for an all-purpose detergent based on consent agreement).

Here, Applicant and Central Michigan University (both long-time participants in their industry) entered into just such a detailed agreement regarding the Applicant’s mark and the Cited Marks. (*See* Consent Agreement, p. 1 (defining “Carnegie Mellon Applications” and “Central Michigan Applications” to include Applicant’s application and the registrations and application cited by the Examiner). This agreement follows a prior coexistence agreement that governed an over 25-year period of coexistence between the parties. (*Id.*)

Under the terms of the Consent Agreement, the parties state the following as the basis of their agreement:

WHEREAS, Carnegie Mellon has used the CMU Trademark [defined as “the trademark ‘CMU,’ in any form”] in interstate commerce for over fifty (50) years



for certain of the CMU Goods and Services [defined as “the goods and services offered by a university . . .”], and wishes to file US trademark applications for the CMU Trademark;

WHEREAS, Central Michigan has used the CMU Trademark in interstate commerce for over fifty (50) years for certain of the CMU Goods and Services, and has filed the Central Michigan Applications [including those cited by the Examining Attorney] for the CMU Trademark;

WHEREAS, the Parties have used the CMU Trademark in coexistence for over fifty (50) years with no likelihood of confusion;

WHEREAS, the Parties previously agreed to coexist regarding their respective unregistered uses of the CMU Trademark in the United States and have been doing so without issue for over twenty-five (25) years; and

WHEREAS Carnegie Mellon and Central Michigan believe that both Parties’ continued use of the CMU Trademark will not create actual or likelihood of confusion as set out in this Agreement.

(Consent Agreement, p. 1.)

The Consent Agreement further includes proactive steps to prevent confusion:

Each Party agrees not to promote, market, license or sell products or services in a way that would cause confusion regarding each Party’s use of the CMU Trademark.

(*Id.*, § 3); and

Each Party agrees that it will not advertise or promote its goods and services under the CMU Trademark in a manner that implies that such Party or its goods and services are affiliated or connected with the other Party or the other Party’s goods and services.

(*Id.*, § 5).

In addition, the Agreement includes detailed and specific restrictions on each parties’ use aimed at avoiding any potential for confusion. As reproduced below, the Consent Agreement requires each party to use the CMU trademark with “at least one of its own Identifying Elements” (such as school color combinations or mascot) (*id.*, § 3(b)) and prohibits each party

from using the other party’s “Identifying Elements” in connection with the CMU trademark (*id.*, § 3(a)).

(a) Each Party agrees that when using the CMU Trademark, that it will not use the CMU Trademark with words, symbols, or other source indicators ("Identifying Element") of the other Party, namely:

| Identifying Element       | Carnegie Mellon            | Central Michigan                         |
|---------------------------|----------------------------|--|
| School Name               | Carnegie Mellon University | Central Michigan University              |
| School/Sports Nicknames   | Carnegie Mellon, Tartans   | Central, Chippewas, Chips, Fire Up Chips |
| School Color Combinations | See Exhibit A              | See Exhibit C                            |
| School Mascot             | Scotty                     | None                                     |
| Other School Trademarks   | See Exhibit B              | See Exhibit D                            |

The Parties acknowledge that the trademarks listed in Exhibits B and D include those applied for or registered as of the Effective Date, and that the Identifying Elements will include trademarks included in US trademark applications and registrations filed or obtained after the Effective Date, or other trademarks communicated by either Party.

(b) Each Party agrees to use at least one of its own Identifying Elements in conjunction with each use by that Party of the CMU Trademark; and

(c) The Parties agree that, unless required to do so by legal process, they each will not make any disparaging statements or representations, either directly or indirectly, whether orally or in writing, by word or gesture, to any person whatsoever, about the other Party’s use of the CMU Trademark. For purposes of this paragraph a disparaging statement or representation is any communication which, if publicized to another, would cause or tend to cause the recipient of the communication to question the business condition, integrity, competence, good character, or quality of the person or entity to whom the communication relates. For example, neither Party will make statements that any part is the “real” or “authentic” owner or user of the CMU Trademark.

(Consent Agreement, § 3.)

Based on these covenants, the parties agree “there is and will be no likelihood of consumer confusion resulting from the simultaneous use and registration of the CMU Trademark for their respective CMU Goods and Services.” (*Id.*, § 4.) Importantly, the parties back up this agreement with specific evidence. The parties acknowledge that they “have already substantially

been following the guidelines laid out in [the Consent Agreement] and have thereby coexisted without confusion for over fifty (50) years.” (*Id.*, § 4 & p. 1.) The parties realize that the “internet is the primary channel in which consumers will be exposed to both Parties’ use of the CMU trademark.” (*Id.*) However, “in those circumstances, the Parties agree that by complying with [the specific restrictions on use in the Consent Agreement], there will be no likelihood of confusion.” (*Id.*)

Nonetheless, although the Applicant and Central Michigan University do not believe there is a likelihood of confusion, they have also agreed to take prompt action to address any actual confusion for which they become aware and take steps to prevent its future occurrence. (*See* Consent Agreement, § 6.)

In view of the Consent Agreement between Applicant and Central Michigan University, Applicant respectfully submits that there is no likelihood of confusion between the present application and the Cited Marks. “The weight to be given more detailed agreements of the type presented here should be **substantial**.” *DuPont*, 476 F.2d at 1362 (emphasis added). Therefore, for this reason alone, Applicant submits that there is no likelihood of confusion, and requests that the Examining Attorney withdraw the rejection. *See Amalgamated Bank of New York*, 842 F.2d at 1275.

### **C. Long-Standing Concurrent Use Without Evidence of Actual Confusion**

*DuPont* factor 8 requires examination of “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361. The Federal Circuit recently reversed a decision that there is a likelihood of confusion between two marks because of a failure by the Examiner and Board to consider evidence of concurrent use relevant to factor 8. *Guild Mortgage*, 2019 WL 178435, at \*3. The evidence showed “concurrent use of [] two marks for a particularly long period of time—over 40 years—

in which the two businesses operated in the same geographic market—southern California—without any evidence of actual confusion.” *Id.* (emphasis added). The Court found that the failure to consider this evidence was error “because this evidence weighs in favor of no likelihood of confusion.” *Id.* at \*3; *see also In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012) (reversing refusal to register the mark ANYWEAR for “footwear” over ANYWEAR BY JOSIE NATORI for “jackets, shirts, pants, stretch T-tops and stoles” because of coexistence for over five years); *In re Palm Beach Inc.*, 225 USPQ 785 (TTAB 1985) (allowing registration of ADLER and Design for pants over the pre-existing ADLER for socks because the “fact that the parties have used their marks contemporaneously for more than forty-five years without any known instances of confusion is strong evidence that confusion is not likely to occur as a result of continued use of the marks in the future”).

Applicant and Central Michigan University have used the CMU trademark in coexistence for over fifty (50) years with no actual confusion. (*See* Consent Agreement, p. 1 and § 4.) This coexistence is due in part to the Applicant and Central Michigan University already substantially following the guidelines laid out in the Consent Agreement. (*Id.* at § 4.) Therefore, this factor weighs strongly in favor of no likelihood of confusion. *See Guild Mortgage*, 2019 WL 178435, at \*3; *In re Strategic Partners, Inc.*, 102 USPQ2d 1397; *In re Palm Beach Inc.*, 225 USPQ 785.

#### **D. No Likelihood of Confusion Exists**

While a possibility of confusion always exists, what may be possible may be not at all probable and, if not probable, it is not likely. *See MTD Products, Inc. v. Universal Tire Corp.*, 193 USPQ 56, 60 (TTAB 1976). As the former Court of Customs and Patent Appeals aptly stated in *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimus* situations but with the practicalities of the commercial world, with which the trademark law deals.

164 USPQ 43, 44-45 (CCPA 1969) (emphasis added). *See also Jerrold Electronics Corp. v. The Magnavox Co.*, 199 USPQ 751, 756 (TTAB 1978); *In re Massey-Ferguson, Inc.*, 222 USPQ 367, 368 (TTAB 1983); *Brennan's, Inc. v. Brennan's Restaurant, L.L.C.*, 69 USPQ2d 1939, 1945 (2d Cir. 2004).

The Consent Agreement between Applicant and Central Michigan University including the agreement that they have and will continue to prevent confusion and the over fifty (50) years of coexistence of Applicant's mark and the Cited Marks are cogent distinctions which preclude any real chance for a likelihood of confusion between Applicant's mark and the Cited Marks. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) ("We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with *de minimus* situations but with the practicalities of the commercial world, with which the trademark laws deal.") (*quoting Witco Chemical*, 164 USPQ 44-45).

Based on the foregoing arguments and authorities, Applicant respectfully submits that there is no likelihood of confusion and respectfully requests withdrawal of this rejection.

### **CONCLUSION**

Applicant now believes that it has completely responded to the outstanding Office Action. Applicant therefore respectfully requests that the Examining Attorney reconsider the refusal to register Applicant's "CMU" mark; indicate the registrability of the mark "CMU" in connection with the amended services description; and pass the subject application for publication for Opposition in accordance with 15 U.S.C. § 1062.

Date: March 22, 2019

Respectfully submitted,  
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