RESPONSE TO OFFICE ACTION

In response to the Office Action dated February 4, 2019, Applicant requests reconsideration of the Examining Attorney's refusal to register Applicant's TENNESSEE mark of U.S. Application Serial No. 88/170,265 in view of the following Remarks.

REMARKS

Prior-Filed Application

Applicant notes that the Office Action indicates that Applicant's TENNESSEE mark may be refused registration based on a likelihood of confusion with respect to U.S. Application Serial No. 87/807,190 for a TENNESSEE SOCCER CLUB & Design mark ("'190 Application"). However, the '190 Application has since been abandoned. Thus, Applicant respectfully requests withdrawal of the mark of the '190 Application as a potential bar to registration of Applicant's TENNESSEE mark.

Identification and Classification of Services & Multiple Class Application Requirements

The Office Action asserts that Applicant's identification of services as originally submitted in Class 41 with respect to "multimedia content" must be clarified based on the assertion that it is too broad and could include advertising services in Class 35. In response, Applicant has amended the Class 41 identification of services as suggested by the Examiner. Accordingly, Applicant respectfully requests withdrawal of the objection to Applicant's identification of services as well as the multi-class application requirement of the present Office Action.

Applicant also notes that it has deleted the "providing news and information in the field of sports" portion of Applicant's identification of services to further clarify Applicant's services as compared to the services of the cited TENNESSEE SOCCER CLUB registration discussed below. In view of the amendment, Applicant's identification of services is now limited, *inter alia,* to educational services at the undergraduate and graduate level, entertainment services with respect to college athletics, organizing and conducting college sport competitions and athletic events, and providing sports news and information in the field of college athletics.

Likelihood of Confusion

The Office Action has initially refused registration of Applicant's TENNESSEE mark based on an assertion of likelihood of confusion with respect to (1) U.S. Registration No. 4,535,558

for the mark TENNESSEE TECH UNIVERSITY ("'558 Registration"); and (2) U.S. Registration No. 5,575,155 for the mark TENNESSEE SOCCER CLUB. The refusal is based in large part on the fact that Applicant's TENNESSEE mark is incorporated in full in the marks of the cited registrations. While Applicant acknowledges that a mark being incorporated in full in a previously registered mark often results in a finding that the marks are sufficiently similar to find a likelihood of confusion, Applicant respectfully disagrees in the present case as explained below.

1. *TENNESSEE vs. Tennessee Tech University*

Applicant is The University of Tennessee. In other words, Applicant is the flagship university of the higher education university system of the state of Tennessee. As the flagship university of the state of Tennessee, Applicant often markets itself and is commonly known but simply TENNESSEE in connection with Applicant's educational services as well as Applicant's entertainment services related to college sports. This nomenclature is commonly accepted, understood, and used by universities and the consuming public throughout the country with respect to state universities in addition to just Tennessee. As a result, the public has been conditioned to differentiate the flagship university from different universities within that particular state based on the addition of words such as "Tech University" after the name of a particular state. Further, the USPTO has recognized this fact as it allows registration of the flagship university of a particular state using a mark that includes just the name of the particular state while also allowing registration of marks of other universities within the same state that include additional words such as "____ Tech University". A very small sampling of such registrations for the name of a particular state followed by registrations by other universities in the same state is provided in the table below (printouts taken from search records of the United States Patent and Trademark Office electronic database are submitted herewith in Exhibit 1 as required by TMEP 1207.01(d)(iii)):

State Flagship University Registrations in Class 41 (registration # in parenthesis)	**Other University Marks Registered Within Same State in Class 41**
TEXAS (1231407)	TEXAS TECH UNIVERSITY (2511970)
MISSOURI (3618091)	• MISSOURI TECH (2438221) • MISSOURI STATE UNIVERSITY (5300163)
OHIO (1893175)	OHIO STATE (1294114)
KANSAS (2073857)	KANSAS STATE UNIVERSITY (1932874)

KENTUCKY (2069153)	• KENTUCKY STATE UNIVERSITY (3624845) • EASTERN KENTUCKY UNIVERSITY (4289108)

Given the above, Applicant respectfully requests withdrawal of the likelihood of confusion rejection of Applicant's TENNESSEE mark in view of the TENNESSEE TECH UNIVERSITY mark of U.S. Registration No. 4,535,558.

2. *TENNESSEE vs. Tennessee Soccer Club*

Similarly, Applicant asserts that there is no likelihood of confusion between Applicant's TENNESSEE mark and the TENNESSEE SOCCER CLUB mark of U.S. Registration No. 5,575,155 due to the fact that consumers have been conditioned to understand that the use of a particular state name as a mark in connection with educational services and collegiate athletics is a reference to the flagship university of that particular state. As a result, the addition of "Soccer Club" in the TENNESSEE SOCCER CLUB mark differentiates the two marks in this case as consumers will understand that TENNESSEE refers to Applicant's university while TENNESSEE SOCCER CLUB refers to a soccer club located within the particular state.

Additionally, Applicant has amended the present application to limit its athletic related services to the field of college athletics to further differentiate Applicant's university/college related services from the club services of the cited TENNESSEE SOCCER CLUB mark.

Accordingly, Applicant respectfully requests withdrawal of the likelihood of confusion rejection of Applicant's TENNESSEE mark in view of the TENNESSEE SOCCER CLUB mark of U.S. Registration No. 5,575,155.

Acquired Distinctiveness

The Office Action has also refused registration of Applicant's TENNESSEE mark based on the assertion that "the applied-for mark is primarily geographically descriptive of the origin of applicant's services." In response, Applicant has amended the present application herein to seek registration under Section 2(f) of the Trademark Act based on the claim of "acquired distinctiveness" in an effort to expedite prosecution. In support of Applicant's claim of acquired distinctiveness, Applicant submits herewith (1) a declaration that Applicant's TENNESSEE mark has become distinctive of Applicant's services through the applicant's substantially exclusive and continuous use of the mark in commerce for at least the past five years; and (2) a sampling of

unsolicited media coverage in which Applicant's mark is used as a source identifier for Applicant and Applicant's services.

1. *Applicant's Substantially Exclusive and Continuous Use of TENNESSEE Should be Accepted as Prima Facie Evidence of Distinctiveness*

Submitted with the present response is the signed declaration stating that "[Applicant's TENNESSEE] mark has become distinctive [in connection with Applicant's services] through [A]pplicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." Applicant respectfully requests that this statement be accepted as prima facie evidence of distinctiveness pursuant to 37 C.F.R. § 2.41(a)(2), particularly when considered in conjunction with the additional evidence of acquired distinctiveness submitted herewith and described below. *See In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1570, 4 U.S.P.Q. 2d 1141 (Fed. Cir. 1987) ("It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve doubt in favor of the applicant.").

Applicant further notes that Applicant's has used its TENNESSEE mark much longer than five years as evidenced by the media coverage described below and attached as Exhibit 2 as well as Applicant's registration of its TENNESSEE mark since 1985 in connection with various goods that, at least in part, are purchased and used based on the connection of the goods to the University's educational and entertainment/athletic related services.

2. *Actual Evidence of Acquired Distinctiveness*

"An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product." TMEP § 1212.06 (*quoting In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985). While the types of evidence may vary depending on the circumstances of a particular case, the Trademark Office "may examine copying, advertising expenditures, sales success, length and exclusivity of use, *unsolicited media coverage*, and consumer studies" in determining whether acquired distinctiveness has been obtained. *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75

U.S.P.Q. 2d 1420, 1424 (Fed. Cir. 2005) (emphasis added). "On this list, no single factor is determinative [and a] showing of secondary meaning [i.e., acquired distinctiveness] need not consider each of these elements." *Id.*

In the present case, length and exclusivity of use of Applicant's TENNESSEE mark as a source identifier for Applicant's services favors Applicant. *See* declaration submitted herewith and described above as well as the dates of the evidence of media coverage described below. Further, Applicant has received significant unsolicited media coverage as exemplified in Exhibit 2 submitted herewith in which Applicant's school and associated athletic programs are identified as just TENNESSEE.

Conclusion

The foregoing is submitted as a full and complete response to the above Office Action. It is submitted that the mark of the present application is in condition for publication and such action is respectfully requested.