

Response to Office Action

In response to the Office Action dated August 29, 2019, Applicant's attorney respectfully requests that the Examining Attorney reconsider and withdraw the refusal of registration of the above-identified mark due to Trademark Act Section 2(e)(2). Alternatively, in the event that the Examining Attorney determines to maintain her refusal pursuant to Trademark Act Section 2(e)(2), the Applicant submits that the Mark has secondary meaning and acquired distinctiveness through consumer association of the Mark with the Applicant through its consistent use in the provision of education services for more than 200 years.

DISCUSSION

A. Primarily Geographically Descriptive.

It is the position of the Applicant as set forth below, that the subject mark is capable of registration upon the Principal Register as a source indicator which is suggestive of the Applicant's services because it is not primarily geographically descriptive. Specifically, the subject mark is consistent with and functions as a source indicator of Applicant's services in the manner that consumers have come to identify with the Applicant and is not primarily geographically descriptive.

Applicant submits that the proposed mark is not primarily geographically descriptive and as such, is entitled to registration on the Principal Register notwithstanding the provisions of the Trademark Act Section 2(e)(2). Indeed, before a mark should be refused registration, the proposed mark must be *primarily* geographically descriptive (emphasis added). See TMEP §1210.02, 1210.03. As the Trademark Trial and Appeal Board has recognized, "an admittedly well-recognized geographic term may have other meanings, such that the term's geographical significance may not be the primary significance to the prospective purchasers." *In re Handler Fenton Westerns, Inc.*, 214 U.S.P.Q. 848, 850 (T.T.A.B. 1982). The terms, "Michigan" being used

for educational services, does not refer to the state of Michigan, but rather to a specific institution. "Michigan" in this instance does not connote a geographic location, but rather the stability, security and quality of a venerated institution. In other words, consumers of services for which the registration of the marks is applied (education courses in the fields of arts and culture, business, data science, education, health, science, social sciences and technology), do not make the services / geographic place association. They make a services / institution association for educational services. The geographic location is not of primary significance.

Applicant respectfully directs the Examining Attorney's attention to the enclosed articles regarding The University of Michigan, including those on the occasion of its bicentennial anniversary. As is noted in the articles, the establishment of the University of Michigan and its predecessors predated the existence of Michigan as a state. Shortly after Michigan became a state, the current institution was formally authorized by the state as a constitutional corporation and a subdivision of the state of Michigan. The University of Michigan then began a long history of achievements which distinguish it from its peers. In addition, the Applicant has been consistently rated in the top universities in the United States, and even ranking highly in many international rankings.

Through the prominent use of its name Michigan and its many educational colleges, including Michigan Law and Michigan Medicine, the public has come to recognize "Michigan" as the Applicant. In other words, the Applicant truly does connote not a geographic location but an institution of high renown, not only among those knowledgeable in educational circles, but with the consumers of education services and the public at large. (Please see filed Wikipedia article.) It is not merely the location of origin of the services it provides but of the institution that it providing them. For those persons acquiring educational services, the term "Michigan" serves as a source

indicator and its primary significance was, and is, the institution, not "primarily" the state in which it is located.

Applicant submits that the purpose for this exception to register geographic terms is based upon the fact that often the term may be merely descriptive of the location of the origin of the goods or services and not any single source. As noted above, this is not the situation here. While the Applicant understands that the Office is not bound by public sources such as Wikipedia, it submits that when such a source specifically states that the Applicant is "often simply referred to as Michigan," in the first sentence, this is a specific recognition that even public has come to recognize "Michigan" *is* the Applicant, especially when considering education services such as those for which registration is sought, and not merely the place where it is located. The Applicant's mark truly does serve as a designator of the institution and its services and not merely as a geographic location. In this regard, "any doubt with respect to the issue of descriptiveness should be resolved in applicant's behalf." *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994). Thus, it is respectfully submitted that the subject mark serves as a non-descriptive source identifier of the Applicant's services and it should be permitted registration in the Principal Register notwithstanding the provisions of Trademark Act §2(e)(2).

B. The Michigan Online mark has acquired distinctiveness and secondary meaning as a result of its association the University of Michigan and many other Michigan Marks. In other words, Michigan Online is no different than Michigan Radio (Reg. Nos. 2,712,985, '986); University of Michigan Health System (Reg. No. 2,408,175); University of Michigan Business School (Reg. No. 2,440,222), Michigan (Reg. No. 1,310,132) and M Michigan (Reg. No. 1,308,044), The University of Michigan 1817 Artes Scienta Veritas (Reg. No. 5,944,239; Michigan Medicine University of Michigan (Reg. No. 5,596,050); M University

of Michigan (Reg. No. 4,898,744)

In the alternative, Applicant respectfully submits that the proposed mark has obtained acquired distinctiveness pursuant to 15 U.S.C. 1052(f). See TMEP 1212. In making this claim, Applicant expressly relies upon the provisions of TMEP 1212.02(c) which encourages the practice of considering the issue of acquired distinctiveness in the alternative. See also *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983). This acquired distinctiveness is established through (1) prior registrations owned by the Applicant, and (2) actual evidence of acquired distinctiveness.

The Applicant notes that the mark has become distinctive of the services as evidenced by ownership of U. S. Registration Nos. noted above. TMEP §1202.04(e). The Applicant further notes that the registrations cited were similarly based upon proof of secondary meaning.

In addition, the submissions described above and submitted herewith amply demonstrate that the mark distinguishes the Applicant's services. TMEP 1212.6. The determination to be made regarding whether a mark has acquired distinctiveness is whether the mark has, in fact, been established in the minds of the public as a source of the services provided. As noted in the attached submissions, this fact has been amply demonstrated by the extensive and substantial association between the "Michigan" and the Applicant and its services. Without limiting the extensive support for the distinctiveness that the submission demonstrates, the Applicant specifically notes that it has been using the term "Michigan" in conjunction with the services for which registration is sought for more than 200 years. Its use in conjunction with the education services dates to 1817 and has been continuous and extensive since then as the submitted evidence demonstrates. The Applicant submits that the evidence of such long use, coupled with the effectiveness and distinctiveness that the submissions disclose with regard to a consumer identification of the mark "Michigan" with the

Applicant constitute a prima facie case of acquired distinctiveness. See TMEP §1212.06(a).

Finally, Applicant respectfully requests that, in the event that the Examining Attorney maintains objections under Section 2(e) and fails to accept Applicant's showing under Section 2(f), the Applicant be permitted the opportunity to present additional evidence and arguments in support of registration and the Applicant expressly requests suggestions from the Examining Attorney pursuant to TMEP §1212.02(h). Alternatively, if such request is denied, the Applicant further requests that it be permitted to submit further evidence and arguments.