

RESPONSE TO LETTER OF SUSPENSION

This responds to the Letter of Suspension issued on April 4, 2020 which suspended action in the instant application pending the outcome of an earlier filed pending application, namely Serial No. 88/416,806.

Applicant filed the instant application for the mark THE for use on “Clothing, namely, t-shirts, baseball caps and hats” in Class 25 on August 8, 2019 (the “Applied-for Mark” or “Instant Application”). In an Office Action dated September 11, 2019, the Examining Attorney cited pending application Serial No. 88/416,806 for the mark THE in Classes 18 and 25 (“Cited Application”) owned by Marc Jacobs Trademarks L.L.C. (“MJT”) as a potential block to registration of the Instant Application, among other things¹. Applicant filed a response to the Office Action on March 11, 2020, submitting its arguments against the merely ornamental conclusion and requesting suspension of the Instant Application pending the outcome of the Cited Application. The Instant Application was thereafter suspended on April 4, 2020.

The Notification of Notice of Publication was issued for the Cited Application on October 7, 2020. Given Applicant’s priority of use of the Applied-for Mark, coupled with the fact that the Cited Application had been cited as a potential bar to registration of the Applied-for Mark, Applicant thereafter reached out to MJT’s counsel to discuss the matter of possible co-existence of the respective uses of THE in the marketplace and on the federal register (i.e., to see whether an amicable and informal resolution could be obtained). Concurrently, while Applicant and MJT (collectively, the “Parties”) engaged in discussions, the Cited Application published for opposition on October 27, 2020. As the Parties continued their discussions, Applicant filed extensions of time to oppose the Cited Application (first 30-day extension filed on November 25, 2020;

¹ The Examining Attorney also refused registration based upon a belief that the Applied-for Mark, as displayed on the goods, is merely ornamental. Applicant respectfully maintains its disagreement with this position as the Applied-for Mark, when used on clothing apparel, is an indicator of secondary source.

additional 60-day extension filed on December 23, 2020; final 60-day extension with consent filed on February 19, 2021) given its priority of use.

The discussion between the Parties ultimately concluded with their well-reasoned belief that there is no likelihood for confusion given the marketplace realities within which their respective THE branded apparel and accessories are promoted, sold, and distributed, coupled with the relevant purchasing public for the Parties' respective THE branded apparel and accessories, as memorialized in a Consent to Register Agreement (the "Agreement"). In this Agreement, the Parties have each consented to the each other's respective registration of THE based upon the actual differences in the marketplaces wherein the respective Parties exist, *provided* both MJT and Applicant undertake to submit certain amendments to their respective applications. A copy of the Agreement is attached hereto as Exhibit A. As such, Applicant respectfully requests that the Examining Attorney withdraw the Cited Application as a potential refusal.

a. Dupont Factors

Where there is a question of likelihood of confusion, the facts must be analyzed as they relate to the relevant factors set forth in *In re E.I. Dupont du Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973). These factors include: the similarity of the marks, goods, and trade channels; the conditions under which consumers encounter the services and the marks; the strength of the prior user's mark; the number of similar marks in use; any actual confusion; the length of time of any concurrent use without actual confusion; the variety of goods on which the mark is used; any market interface or relationship between the senior and junior users of the marks; the extent to which applicant has a right to exclude others from use of its marks on its goods; the extent of the potential for confusion; and any other probative facts relating to the use of the marks. *Id.* The *Dupont* court further elaborated:

[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. 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 568; *see also* TMEP §1207.01(d)(viii).

b. The Consent Agreement

The attached Agreement is the type of agreement to which the Examining Attorney should give substantial weight. *See* TMEP §1207.01(d)(viii). To be a true consent agreement, such as in the case of the attached Agreement, it must be more than a “naked” agreement. *Id.* The more information a consent agreement contains regarding why the parties believe confusion to be unlikely, and the more evidentiary support for such conclusions in the facts of record or in the way of undertakings by the parties, the more one can assume the consent is based on a reasoned analysis of the marketplace, and consequently the more weight the consent will be accorded. *In re Donnay Int'l, S.A.*, 31 USPQ2d 1953, 1956 (TTAB. 1994). Here, the Parties vividly describe the purpose of the Agreement and the sound reasons for their respective belief why confusion does not exist.

Indeed, despite the prolific media attention that the respective applications have received, coupled with the actual use of the respective marks in their respective marketplaces, there have been no instances of actual confusion. This is understandable given the actual marketplace realities as memorialized in the Agreement, namely:

- The actual differences in the fields/markets to which the products bearing the respective marks are promoted, distributed, and sold (*i.e.*, sports and collegiate athletics in the case of Ohio State on the one hand, and high-end/contemporary fashion in the case of MJT on the other hand) (*See* Ex. A, pg. 2, Section 2.2.1);
- The commercial context within which a consumer would view and/or otherwise encounter the marks (*i.e.*, within a larger offering of collegiate-specific merchandise in the case of Ohio State on the one hand, and within the specific context of a high-end/contemporary fashion line bearing other MARC JACOBS branding in the case of MJT on the other hand) (*See* Ex. A, pg. 2-3, Section 2.2.2);

- The commercial impression of the respective marks, with THE being shorthand for a power five collegiate athletics program in the case of Ohio State on the one hand, and a high-end/contemporary fashion brand in the case of MJT on the other hand (*See* Ex. A, pg. 3, Section 2.2.3);
- The relevant purchasing group for the respective products bearing the respective marks (*i.e.*, consumers wishing to show affinity for a power five collegiate athletics program in the case of Ohio State on the one hand, and consumers wishing to show affinity to a high-end/contemporary fashion brand in the case of MJT on the other hand) (*See* Ex. A, pg. 3, Section 2.2.4); and
- The lack of actual confusion to date despite the prominent usage of the respective marks in their respective fields/markets for at least the last 2 years, and the corresponding press coverage that the use of and applications for the respective marks has invoked (*See* Ex. A, pg. 3, Section 2.2.5).

Based upon these marketplace realities, the Parties have consented to the registration of their respective applications, with the following amendments that track the marketplace realities outlined above:

- The Cited Application is to be amended as follows (**bold** for additions):
 - “Handbags; knapsacks; back packs; rucksacks; tote bags; beach bags; carry-all bags; satchels; clutch bags; shoulder bags; sling bags; purses; cosmetic bags sold empty; change purses; wallets; leather pouches; business card cases; credit card cases; toiletry cases sold empty; crossbody bags; traveling bags; **all of the foregoing being promoted, distributed, and sold through channels customary to the field of contemporary fashion**” in Class 18; and
 - “Clothing, namely, underwear, socks, hosiery, jerseys, shirts, t-shirts, blouses, sweaters, cardigan sweaters, pullovers, hoodies, sweatshirts, pants, jeans, shorts, dresses, skirts, blazers, jackets, coats, overcoats, waterproof clothing, namely, jackets and jumpsuits; bathing suits; belts; scarves; shawls; bandanas; waistcoats; pajamas; footwear, namely, shoes, boots, sandals and slippers; headwear, namely, hats and caps; **all of the foregoing being promoted, distributed, and sold through channels customary to the field of contemporary fashion**” in Class 25.

(*See* Ex. A, pg. 3, Section 3.1).

- The Instant Application is to be amended as follows (**bold** for additions):
 - “Clothing, namely, t-shirts, baseball caps and hats; **all of the foregoing being promoted, distributed, and sold through channels customary to the field of sports and collegiate athletics**” in Class 25.

(*See* Ex. A, pg. 4, Section 3.2). It should be noted that MJT filed its post-publication amendment in accordance with Sections 3.1 and 4.1 of the Agreement on April 14, 2021 “in order to narrow the channels of trade for [MJT’s] goods bearing the mark THE.” *See* Exhibit B. In turn, Applicant is hereby requesting an amendment to its recitation of goods in the Instant Application as outlined above and in accordance with Sections 3.2 and 4.2 of the Agreement.

It should further be noted that, in an abundance of caution, the Parties have further agreed to not represent that its respective goods or services originate from, are sponsored by, or are affiliated with the other Party. (*See* Ex. A., pg. 4, Sec. 4.2.1). Additionally, in the unlikely event the Parties become aware of instances of actual confusion, notwithstanding the terms of the Agreement, the Parties agree to cooperate to resolve the confusion and to avoid further instances of confusion. (*See* Ex. A., pg. 4, Sec. 4.2.2).

III. Conclusion.

The Parties, i.e., the entities that are the most familiar with the use of the respective THE marks in the marketplace and most interested in precluding confusion, have entered into an Agreement which is designed to memorialize the marketplace realities that has allowed for the contemporaneous use of the respective marks without any instances of actual confusion so as to continue to avoid any such confusion in the future.

An assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not. *See Dupont*, 177 U.S.P.Q. at 568. Therefore, the scales of evidence are tilted in favor of registration, and Applicant respectfully requests that the Examining Attorney withdraw the Cited Application as a potential block and approve the Instant Application for publication. An early action to this end is courteously solicited.