

EXHIBIT A

Response to Letter of Suspension

MUTUAL CONSENT TO REGISTER AGREEMENT

This MUTUAL CONSENT TO REGISTER AGREEMENT (“**Mutual Consent to Register**”) made this 9th day of April, 2021 (“**Effective Date**”), is by and between (i) The Ohio State University, an educational institution having a business address of 190 North Oval Mall, Columbus, Ohio 43210 (“**Ohio State**”) on the one hand, and (ii) Marc Jacobs Trademarks, L.L.C., having an address of 72 Spring Street, New York, NY 10012 (“**MJT**”) on the other hand. Ohio State and MJT are each a “Party” or collectively the “Parties” to this Mutual Consent to Register.

WHEREAS, MJT is the owner of the MARC JACOBS trademark and related trademarks and service marks associated with the Marc Jacobs brand, a well-known American fashion brand and producer of high-end/contemporary fashion apparel and related accessories;

WHEREAS, in 2018, MJT launched a new line of apparel and accessories branded “The Marc Jacobs” using “THE” branding in a prominent manner in connection with individual items, such as *The Grunge Sweater*, *The Tote Bag*, etc. Since such launch, MJT has likewise used the mark THE without an accompanying descriptive term on apparel and accessories products (collectively, “**MJT’s THE Mark**”);

WHEREAS, MJT is the owner of U.S. Trademark Application Serial No. 88/416,806 for THE in standard character format for use on, “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” in International 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” in International Class 25, filed on May 6, 2019 (“**MJT’s THE Application**”);

WHEREAS, Ohio State is one of the most well-respected institutions of higher learning in the United States and has provided college level educational courses and sponsored collegiate sporting events for over 150 years;

WHEREAS, Ohio State is a member of both the National Collegiate Athletic Association and the Big Ten conference, making it a “power 5” collegiate athletics program that has enjoyed a long and proud tradition of excellence in interscholastic athletic competition and an enthusiastic and loyal following;

WHEREAS, Ohio State, having placed an emphasis on “The” in its formal name since its establishment, began using THE in connection with its athletic program sometime in the 1980’s and Ohio State believes that it is a term that has become a source of pride amongst its current and former student-athletes and is now engrained within the student-life culture at Ohio State;

WHEREAS, Ohio State began including THE branding in its trademark and licensing program for use on apparel, accessories, and merchandise that are sold to students, alumni, and fans of Ohio State at least as early as 2005 (“**Ohio State’s THE Mark**”);

WHEREAS, Ohio State filed U.S. Trademark Application Serial No. 88/571,984 for THE in standard character format for use on “Clothing, namely, t-shirts, baseball caps and hats” in International Class 25 on August 8, 2019 (“**Ohio State’s THE Application**”);

WHEREAS, on September 11, 2019, the assigned Examining Attorney reviewing Ohio State’s THE Application issued an Office Action citing MJT’s THE Application as a potential bar to registration of Ohio State’s THE Application, given the earlier filing date of MJT’s THE Application;

WHEREAS, Ohio State’s THE Application is currently suspended pending the outcome of MJT’s THE Application, which published for opposition on October 27, 2020;

WHEREAS, Ohio State has filed extensions of time to oppose MJT’s THE Application before the Trademark Trial and Appeal Board (“**TTAB**”), given Ohio State’s claimed priority of use of Ohio State’s THE Mark (hereinafter the “**Dispute**”);

WHEREAS, Ohio State and MJT, believing 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, have entered into a Settlement and Coexistence Agreement dated on or about April 9, 2021 in order to resolve the Dispute.

WHEREAS, Ohio State and MJT have agreed to the terms provided in this Mutual Consent to Register with respect to MJT’s THE Application and Ohio State’s THE Application.

NOW THEREFORE, in consideration of the promises herein exchanged, the Parties agree as follows:

1. **Recitals**. The above recitals are hereby incorporated into this Mutual Consent to Register as if fully set forth herein.
2. **No Likelihood of Confusion**. The Parties believe that there is no likelihood for confusion, mistake, or deception with the contemporaneous use and registration of the respective THE marks identified above for at least the following reasons:
 - 2.1 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).
 - 2.2 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).

- 2.3 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.
 - 2.4 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).
 - 2.5 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.
3. Consent to Registration. In view of the reasons outlined above, each Party consents to the other Party's registration of its respective THE Mark as follows (and with amendments to be filed as appropriate):
- 3.1 MJT's THE Application. Ohio State hereby consents to MJT's registration of MJT's THE Mark for the goods listed in MJT's THE Application, as amended (**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.

3.2 Ohio State's THE Application. MJT hereby consents to Ohio State's registration of Ohio State's THE Mark for the goods listed in Ohio State's THE Application, as amended (**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.

4. Further Actions and Agreements.

4.1 Filings with the USPTO. The Parties agree to undertake the following:

4.1.1 Within ten (10) days of the Effective Date, MJT shall file a post publication amendment with the USPTO to amend the goods in MJT's THE Application to reflect the amended description of goods set forth in Section 3.1 above. MJT shall provide notice to Ohio State of said filing.

4.1.2 Within ten (10) days of receipt of notice of MJT's post publication amendment filing, Ohio State shall file a response to the letter of suspension with the USPTO, submitting this Mutual Consent to Register and evidence of the post publication amendment filed by MJT, in order to seek removal of MJT's THE Application as a block to registration of Ohio State's THE Application, and to further seek the amendment of the goods set forth in Section 3.2 above.

4.2 Covenants to Avoid Likelihood of Confusion. The Parties further agree to:

4.2.1 not represent that its respective goods or services originate from, are sponsored by, or are affiliated with the other Party; and

4.2.2 cooperate to address and resolve instances of any actual consumer confusion in the unlikely event that either Party becomes aware of any such confusion and avoid further instances of such confusion.

5. Counterparts. This Mutual Consent to Register may be executed in multiple counterparts, each of which will be deemed an original, and all of which together will constitute one and the same instrument. Signatures delivered by facsimile, PDF, or other electronic format shall be considered original signatures.

WHEREFORE, the Parties have each caused this Mutual Consent to Register Agreement to be signed by their respective, duly authorized officers, to be effective upon execution by all Parties as of the Effective Date.

THE OHIO STATE UNIVERSITY

MARC JACOBS TRADEMARKS, L.L.C.

By: _____
Name: Anne K. Garcia
Title: Senior Vice President & General Counsel
Date: _____

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Phillips Nazro
CB321E6A2028405
By: _____
Name: Phillips Nazro
Title: General Counsel
Date: 4/12/2021

WHEREFORE, the Parties have each caused this Mutual Consent to Register Agreement to be signed by their respective, duly authorized officers, to be effective upon execution by all Parties as of the Effective Date.

THE OHIO STATE UNIVERSITY

MARC JACOBS TRADEMARKS, L.L.C.

By: Anne K. Garcia
Name: Anne K. Garcia
Title: Senior Vice President & General
Counsel
Date: April 12, 2021

By: _____
Name: _____
Title: _____
Date: _____