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To "THE" or not to "THE"? The Question has been Answered: An Examination of Trademark Bullying in the context of the Ohio State University's Recent Trademark Registration

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Cover Page Footnote

J.D. Candidate, 2024, University of Georgia School of Law. As a proud graduate of THE Ohio State University, I sincerely thank the institution for the incredible professional, academic, and personal experiences it continues to afford me. Also, I offer my deepest thanks to my late parents. From my earliest days, you instilled the traditions and beliefs that make our alma mater unique and extraordinary. With a mix of gratitude and longing, I dedicate this Note to you, forever cherishing the memories we shared and the legacy you left behind.

***TO "THE" OR NOT TO "THE"? THE QUESTION
HAS BEEN ANSWERED: AN EXAMINATION OF
TRADEMARK BULLYING IN THE CONTEXT OF
THE OHIO STATE UNIVERSITY'S RECENT
TRADEMARK REGISTRATION***

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* J.D. Candidate, 2024, University of Georgia School of Law. As a proud graduate of THE Ohio State University, I sincerely thank the institution for the incredible professional, academic, and personal experiences it continues to afford me. Also, I offer my deepest thanks to my late parents. From my earliest days, you instilled the traditions and beliefs that make our alma mater unique and extraordinary. With a mix of gratitude and longing, I dedicate this Note to you, forever cherishing the memories we shared and the legacy you left behind.

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I. INTRODUCTION

In recent years, large resource-rich institutions have been repeatedly labeled as “trademark bullies” due to their willingness to employ aggressive tactics to protect their marks.¹ Oftentimes, these behaviors extend past an acceptable demonstration of a mark owner’s recognized interest in defending their marks and creep into unlawful and unethical harassment or intimidation tactics.²

Recently the U.S. Patent and Trademark Office (“USPTO”) issued a trademark to the Ohio State University (“OSU”) for the word mark “THE.”³ Proponents of this registration commend OSU for protecting its \$12.5 million asset and cite its long-term branding strategy as the source of its success.⁴ However, critics of this registration view it as an endorsement of nebulous and crafty registration tactics that circumvent the true policy underpinnings of trademark law.⁵ This Note generally sides with the latter view, arguing that the recent registration provides OSU with a sword to wield against infringing and entirely lawful uses of the mark.

This Note proceeds in four parts; the first part describes the filing history of how “THE” was issued to OSU. Part II provides an in-depth explanation of the history and policy underpinnings of trademark law, and a description of the current state of United States trademark law and theories of liability. Part IV examines trademark bullying, how it is carried out and empowered by the current law, and its negative impacts on the marketplace, consumers, and producers. It

¹ Jason Vogel & Jeremy A. Schachter, *How Ethics Rules Can be Used to Address Trademark Bullying*, 103 TRADEMARK REP. 503, 503 (2013).

² Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 641-642 (2011) (“[S]ome trademark owners cross the line from aggressive, but reasonable, trademark enforcement to abusive trademark enforcement”).

³ THE, Registration No. 6,763,118.

⁴ JONES DAY TALKS, *Buckeyes Win: Ohio State Secures Trademark for “THE,”* Jones Day, (Aug. 2022), <https://www.jonesday.com/en/insights/2022/08/jones-day-talks-buckeyes-win-ohio-state-secures-trademark-for-the> (“[A]s early as 2005 ‘THE’ Ohio State University has been branding ‘THE’ and using ‘THE’ prominently such that consumers would recognize ‘THE’ as something coming from The Ohio State University”).

⁵ Rachel Smoot, *The Ohio State University wins trademark protection for THE*, WORLD TRADEMARK R. WKLY., (Jul. 14, 2022), <https://www.worldtrademarkreview.com/article/the-ohio-state-university-wins-trademark-protection-the> (“If simply adding the mark THE to a hangtag or label on a product is enough to get beyond a merely ornamental rejection, it would be easy to see OSU filing dozens of applications across numerous classes for ‘THE’”); Alex Betschen, *Sports Trademarks Gone Wrong: The Ohio State University Seeks to Register Trademark for “The,”* UB L. SPORTS AND ENT. F. (Aug. 16, 2019), <https://ublawsportsforum.com/2019/08/16/sports-trademarks-gone-wrong-the-ohio-state-university-seeks-to-register-trademark-for-the/>.

also explores the likely negative impact on the marketplace, the chilling effect on speech, and the suppression of speech that OSU’s registration will cause. Finally, it proposes potential remedies to disincentivize and curb bullying behavior by the University and similar actors.

II. “THE” HISTORY

The USPTO recently issued Registration No. 6763118 for the word mark, “THE,” to OSU for use in connection with “clothing, namely, t-shirts, baseball caps[,] and hats.”⁶ “THE Ohio State University” is a—now infamous—moniker touted by the prolific Columbus academic institution’s students, faculty, alumni, and fans.⁷ Although the definite article “THE” in OSU’s name has been formally recognized as part of its title since its renaming in 1878, its ubiquity in marketing, official communications, and culture has not.⁸ It is unclear exactly when the push to include and emphasize “THE” began. Evidence indicates, however, that the 1986 redesign of the University’s logo added “THE” to “reflect the national stature of the institution” and a subsequent push by the University to move its branding away from being known as another “OSU.”⁹

Although a rebranding campaign was well-underway for decades, OSU only formally filed a trademark application for the word mark “THE” with the USPTO on August 8, 2019.¹⁰ Originally, the institution claimed a current use in commerce (1(a)) filing basis.¹¹ However, the USPTO rejected the University’s initial application on two grounds, (1) an application for the mark in connection with clothing and apparel predated the University’s application, and (2) as demonstrated in the submitted specimen, OSU’s use of “THE” was “merely ornamental.”¹²

⁶ THE, Registration No. 6,763,118.

⁷ David K. Li, *Ohio State University officially wins trademark for the word ‘THE,’* NBC News (June 22, 2022, 5:28 PM), <https://www.nbcnews.com/news/us-news/ohio-state-university-officially-wins-trademark-word-federal-governmen-rcna34857> (“While those three letters might seem small or inconsequential to outsiders . . . ‘THE’ contributes . . . emotional capital to Buckeyes students, alumni and fans”).

⁸ *Historic Ohio State: FAQ*, THE OHIO STATE UNIV.: UNIV. LIBRS., <http://library.osu.edu/archives/faq#1> (last visited Mar. 28, 2023).

⁹ *Id.*; Response to Office Action at 8-9, Serial No. 88/571,984 (Mar. 11, 2020).

¹⁰ U.S. Trademark Application Serial No. 88/571,984 (filed Aug. 8, 2019).

¹¹ *Id.*; *Basis*, U.S. PAT. AND TRADEMARK OFF., <https://www.uspto.gov/trademarks/apply/basis> (last visited Apr. 25, 2023) (providing that filing on a Section 1(a) basis is for applicants currently using its “mark in commerce with [its] goods and/or services”).

¹² Nonfinal Office Action at 1–2, Serial No. 88/571,984 (Sep. 11, 2019).

OSU quickly remedied the issue underlying the first basis for rejection. It negotiated with the conflicting prior existing application's filer, Marc Jacobs, to make way for both entities' use in their respective markets.¹³ Marc Jacobs's amended application designated the use of the mark in connection with apparel "sold through channels customary to the field of contemporary fashion."¹⁴ Whereas OSU's amended application designated the use of the mark in connection with apparel "sold through channels customary to the field of sports and collegiate athletics."¹⁵

With the first issue settled, OSU filed a response to the USPTO Office Action, adding additional support to its contention that "THE"—rather than indicating the source of production—is a secondary source indicator or sponsorship indicator.¹⁶ The University argued that previous Trademark Trial and Appeal Board ("TTAB") decisions supported its contention, relying on a settled principle that ornamental material can be a source indicator if it "names the secondary source of the goods" or "it is ... a recognized trademark of [the] applicant[s] for other goods or services."¹⁷

Nonetheless, this argument failed because the proffered evidence only showed "THE," being sometimes emphasized but exclusively used jointly with "OHIO STATE UNIVERSITY."¹⁸ To succeed, the University must have demonstrated that "THE," alone, functioned as a source indicator for additional goods or services.¹⁹

After this loss, the University requested reconsideration by the USPTO and amended its filing basis to a Section 1(b) – intent-to-use – application.²⁰ To succeed in utilizing this basis, the University must have shown a "bona fide intention to use" the mark in commerce in the near future.²¹ To best ensure approval by the USPTO, it supplied evidence of an obvious source indicator on

¹³ Smoot, *supra* note 5.

¹⁴ TEAS Response to Suspension Inquiry at 1-5, Serial No. 88/571,984 (Apr. 23, 2021).

¹⁵ Amendment to Allege Use at 1, Serial No. 88/571,984 (Apr. 23, 2021); London Lundstrum, *THE Biggest Collegiate Trademark News This Year: How Ohio State University Trademarked THE*, JDSUPRA (July 22, 2022), <https://www.jdsupra.com/legalnews/the-biggest-collegiate-trademark-news-8547826/#:~:text=Interestingly%2C%20Ohio%20State%20was%20the,collegiate%20licensing%20programs%20in%201974>.

¹⁶ Response to Office Action, *supra* note 9, at 2.

¹⁷ *Id.* at 7 (citing *In re Dr. Ing. H.C. F. Porsche AG*, 2002 WL 732144, at *2 (T.T.A.B. Apr. 24, 2002)).

¹⁸ Final Office Action at 2, Serial No. 88/571,984 (Aug. 9, 2021).

¹⁹ *Id.*

²⁰ TEAS Request Reconsideration after FOA at 3, Serial No. 88/571,984 (Feb. 8, 2022).

²¹ *Basis*, *supra* note 11.

the tags inside apparel items.²² After publication for opposition, the TTAB registered the mark to OSU on the federal register.²³

III. FOUNDATIONS OF TRADEMARK LAW

United States trademark policy, statutory law, and common law root themselves in schemes and philosophies far older than our country. To adequately understand the current trademark bullying issue in the United States, it is imperative to understand the theoretical underpinnings, global history, and U.S. legal landscape of trademarks. This part first provides a brief global discussion of U.S. trademark law's historical and theoretical foundations. Then, it discusses the Lanham Act, the statutory scheme controlling the existence of trademarks in the United States. Finally, it describes relevant theories of liability for trademark infringement.

A. TRADEMARK LAW: WHERE WE ARE AND HOW WE GOT HERE

Merchants have used marks to identify the source of their goods for as long as the producer/consumer relationship has existed.²⁴ For example, evidence from over 3500 years ago shows ceramists often used marks to identify and distinguish the source of their clay-fired pots.²⁵ Likewise, while trading in the Mediterranean, Greek and Roman producers used marks on amphorae and vases to denote the source producers of wine and oil.²⁶ Moving into the Middle Ages, using marks expanded greatly into metalware, cloth, and eventually onto paper, partially due to the rise of artisan guilds.²⁷ These guilds allowed registered members to utilize marks authenticating and indicating the quality of goods in commerce.²⁸

Trademark jurisprudence abroad skyrocketed during the Industrial Revolution due to diminishing direct transactions between manufacturers and consumers.²⁹ Great Britain and parts of Europe enacted sweeping legislation

²² TEAS Request Reconsideration after FOA, *supra* note 20, at 3.

²³ Notice of Publication at 1, Serial No. 88/571,984 (Mar. 16, 2022); THE, Registration No. 6,763,118.

²⁴ AUSTIN T. STICKELLS, FEDERAL CONTROL OF BUSINESS § 10 (2022).

²⁵ 1 ANNETTE G. LALONDE & JEROME GILSON, GILSON ON TRADEMARKS § 1.06 (2022).

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.*

²⁹ Thomalyn Epps, *Trademark Law: How We Got to Where We Are Today*, 19 J. CONTEMP. LEGAL ISSUES 1, 4-5 (2010).

protecting consumers and manufacturers from counterfeiting and other fraudulent activities.³⁰ The United States Congress followed suit.

In 1870, Congress enacted the first federal trademark statute.³¹ In 1876, Congress passed another federal statute prohibiting counterfeiting.³² However, in the watershed *In re Trade-Mark Cases*, the Supreme Court found both pieces of legislation unconstitutional.³³ It reasoned that, as written, the statutes applied too broadly to actions outside Congress's express powers to regulate interstate or foreign commerce.³⁴ As a result, Congress passed the Trademark Act of 1881.³⁵ In 1905, Congress replaced the 1881 Act, then amended the 1905 Act in 1920.³⁶ Finally, Congress supplanted both pieces of legislation with the Lanham Act, which it passed in 1947 and remains in effect today.³⁷

B. THE LANHAM ACT

The Lanham Act provides that a trademark is any single or combination of a "word, name, symbol, or device" which is "used by a person" in commerce to identify and differentiate providers of goods and services from one another.³⁸ Although the Act lays out an avenue for federal registration of a mark, protection is still available to unregistered marks that would qualify for protection under the registration requirements.³⁹

To prove use in commerce as a source identifier, an applicant must demonstrate it has used its mark in a way that potential customers would perceive

³⁰ LALONDE & GILSON, *supra* note 25, § 1.06.

³¹ Trademark Act of 1870, ch. 230, 16 Stat. 198 (1870), *invalidated* by *In re Trade-Mark Cases*, 100 U.S. 82 (1879); LALONDE & GILSON, *supra* note 25, § 1.06.

³² Act of Aug. 14, 1876, ch. 274, 19 Stat. 141 (1876), *invalidated* by *In re Trade-Mark Cases*, 100 U.S. 82 (1879); LALONDE & GILSON, *supra* note 25, § 1.06.

³³ *Id.* (citing *In re Trade-Mark Cases*, 100 U.S. at 82).

³⁴ *In re Trade-Mark Cases*, 100 U.S. at 82.

³⁵ Act of Mar. 3, 1881, ch. 138, 21 Stat. 502, *repealed* by Act of Feb. 20, 1905, ch. 592, 33 Stat. 724, 731.

³⁶ Act of Feb. 20, 1905, ch. 592, 33 Stat. 724, 731, *amended* by Act of Mar. 17, 1920, ch. 104, 41 Stat. 533, 535.

³⁷ 15 U.S.C. § 1051.

³⁸ 15 U.S.C. § 1125(a).

³⁹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) ("[I]t is common ground that § 43(a) [of the Lanham Act] protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under §43(a).").

as a trademark for offered goods or services.⁴⁰ Mark owners that show first use of the mark in commerce receive protection under the United States first-to-use system.⁴¹ Recognition of this first use allows mark owners to monitor and block later use of identical or similar marks.⁴²

Additionally, mark owners seeking federal protection must prove distinctiveness.⁴³ Two types of distinctiveness exist: inherent and acquired.⁴⁴ Inherently distinctive trademarks are those whose “intrinsic nature serves to identify a particular source”⁴⁵ Non-inherently distinctive marks seeking protection must acquire distinctiveness, which is also sometimes called “secondary meaning.”⁴⁶ This requires that a mark “become[s] distinctive of the applicant’s goods in commerce.”⁴⁷

Both U.S. Courts and the USPTO classify marks on a spectrum to measure distinctiveness.⁴⁸ These categories, decreasing in distinctiveness, are (1) fanciful; (2) arbitrary; (3) suggestive; (4) descriptive; or (5) generic.⁴⁹ The designation a mark receives in court or by the USPTO determines whether or not a mark owner must provide evidence of acquired distinctiveness to obtain federal protection.⁵⁰

Generic terms point the public towards a “class or category of goods or services on or in connection with which it is used.”⁵¹ For example, utilizing “peach” to describe the fruit or “dog” to describe a canine.⁵² If mark owners do not diligently enforce their rights or instruct the public about the proper way to utilize the mark, otherwise protectable marks may fall victim to genericide.⁵³ Escalator, teflon, and aspirin are examples of products that once were trademarks

⁴⁰ *In re Settec, Inc.*, 80 U.S.P.Q.2d 1185, *4 (T.T.A.B. 2006) (stating that whether an applicant uses a mark in commerce as a source identifier of goods or services depends on “how th[e] [mark] is used and how it is perceived by potential recipients of the [goods or] services” (quoting *In re Ancor Holdings, LLC.*, 79 U.S.P.Q.2d 1218, *2 (T.T.A.B. 2006))).

⁴¹ Meaghan Annett, Note, *When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act*, 61 B.C. L. REV. 253, 265 (2020).

⁴² *Id.*

⁴³ 15 U.S.C. § 1127.

⁴⁴ LALONDE & GILSON, *supra* note 25, § 2.01.

⁴⁵ *Two Pesos*, 505 U.S. at 768.

⁴⁶ *Id.* at 769.

⁴⁷ *Id.*

⁴⁸ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

⁴⁹ *Id.*

⁵⁰ LALONDE & GILSON, *supra* note 25, § 2.01.

⁵¹ TMEP 1209.01(c)(i).

⁵² LALONDE & GILSON, *supra* note 25, § 2.01.

⁵³ *Id.* § 2.02.

but lost their status due to the mark becoming associated with the product itself not the source of the goods.⁵⁴

Descriptive terms merely describe goods to communicate to consumers what the product is; for example, “creamy” to describe yogurt or “apple pie” to describe the scent of potpourri.⁵⁵

Suggestive marks illicit some imagination to link a mark to goods or services.⁵⁶ A real-world example is “FROOT LOOPS” for the fruit-flavored cereal.⁵⁷ Arbitrary marks are familiar words used uniquely, such as “CAMEL” referring to cigarettes or “AMAZON” for an online store.⁵⁸ Fanciful marks, the most inventive, are concocted, meaningless words that do not appear in dictionaries.⁵⁹ Recognizable examples of these marks are “CLOROX,” referring to bleach, and “GOOGLE,” as an online search engine.⁶⁰

Fanciful, arbitrary, and suggestive trademarks require no additional showing of acquired distinctiveness to receive protection.⁶¹ Federal law does not protect generic marks nor some descriptive marks.⁶² In spite of this, descriptive mark owners can still gain protection by showing that their marks acquired secondary meaning.⁶³ To do this, mark owners must show extensive use and advertising in the market to a point where it is clear that consumers associate the product and its source.⁶⁴

Once a mark owner satisfies both the use in commerce and distinctiveness requirement, it is afforded both the exclusive right to use the mark and legal protection under the Lanham Act.⁶⁵

C. TRADEMARK LIABILITY THEORIES

To perpetrate trademark bullying, a mark owner relies on theories of trademark liability. Without these methods of legal recovery, bullies’ tactics fail

⁵⁴ *Id.*

⁵⁵ *Id.*; *Strong trademarks*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/strong-trademarks> (last visited Apr. 25, 2023).

⁵⁶ LALONDE & GILSON, *supra* note 25, § 2.01.

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Strong trademarks*, *supra* note 55.

⁶² *Id.*

⁶³ LALONDE & GILSON, *supra* note 25, § 2.06.

⁶⁴ *Id.*

⁶⁵ *Id.*

to threaten alleged infringers meaningfully. Therefore, to give additional context to the legal mechanisms relied on by bullies, this subpart describes two trademark liability theories employed by mark owners to protect their marks from unauthorized use.

1. *Trademark Infringement*

A plaintiff must demonstrate three elements to pursue a federal trademark infringement claim.⁶⁶ First, the plaintiff must own a valid, registered mark.⁶⁷ Second, the alleged infringer must engage in an unauthorized use of the plaintiff's mark.⁶⁸ Finally, the alleged infringer's use of the plaintiff's mark must cause a likelihood of confusion.⁶⁹

The cornerstone of the trademark infringement inquiry is the likelihood of confusion analysis. This analysis requires courts to balance multiple factors.⁷⁰ Each circuit adopts a slightly different non-exhaustive list of factors.⁷¹ However, each circuit's factors incorporate common premises, including the similarity of marks, the strength of the plaintiff's mark, actual consumer confusion, and the relatedness of the goods.⁷² Some circuits additionally consider a defendant's intention to infringe and buyer sophistication.⁷³

Although each of the circuits emphasizes different factors as being more or less integral to the likelihood of confusion analysis, the relatedness of the goods and the marks' similarity are “both of [the] highest importance and inversely

⁶⁶ 15 U.S.C. § 1114(1)(a).

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ 112 AM. JUR. 3D *Proof of Facts* § 10 (2010).

⁷¹ *Pignons S.A. de Machanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981), *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462-63 (3d Cir. 1983), *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984), *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 170 (5th Cir. 1986), *and Frisch's Rests., Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982), *and Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1330 (7th Cir. 1977), *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980), *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), *Sally Beauty Co. v. BeautyCo, Inc.*, 304 F.3d 964, 972 (10th Cir. 2002), *Frehling Enters., Inc. v. Int'l Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999), *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

⁷² 112 AM. JUR. 3D *Proof of Facts* § 10 (2010).

⁷³ *Id.*

related.⁷⁴ Others narrowly focus on the plaintiff's mark's strength.⁷⁵ This particular factor is most relevant to the subject of this Note.

A mark's strength can be discussed in two contexts: commercial and conceptual.⁷⁶ Conceptually strong marks are arbitrary or fanciful on the distinctiveness spectrum established in *Abercrombie & Fitch Co. v. Hunting World, Inc.*⁷⁷ All circuits look to a mark's conceptual strength in their analyses.⁷⁸ Commercial strength refers to the mark's public recognition level.⁷⁹ A mark reaches the high point of market strength when it achieves "fame."⁸⁰ Despite this, courts are not united on how to weigh fame while deciding how much or little protection to afford a mark.⁸¹ Therefore, it can sometimes be inconsistently applied depending on what court a party is in.

2. *Trademark Dilution*

The idea that other kinds of unauthorized acts cause harm to a mark or mark's owner even when the acts are unrelated to the goods or services the mark owner offers, forms the basis for dilution theory.⁸² Two types of dilution exist: blurring and tarnishment.⁸³ To establish either kind of dilution under federal law, a plaintiff must prove "that: (1) the plaintiff is the owner of a mark that qualifies as a 'famous' mark, (2) the mark is distinctive, (3) the defendant is making

⁷⁴ *Id.* § 11; *see also* *Nautilus Group, Inc. v. ICON Health and Fitness, Inc.*, 372 F. 3d 1330, 1335 (Fed. Cir. 2004) (finding likelihood of confusion high where the parties' marks' meanings and appearances were dissimilar but their products were "virtually interchangeable").

⁷⁵ *Id.*

⁷⁶ *Id.* § 12.

⁷⁷ *Id.*; *see also* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (establishing the distinctiveness spectrum as "(1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful").

⁷⁸ 112 AM. JUR. 3D *Proof of Facts* § 12 (2010).

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Compare* *S. Industries, Inc. v. Stone Age Equipment, Inc.*, 12 F. Supp. 2d 796, 817 (N.D. Ill. 1998) ("Any strength that [the plaintiff's mark] derives from its arbitrariness . . . is obliterated by the utter absence of evidence that the public associates this mark with any particular source"), *with* *M2 Software, Inc. v. Madacy Ent.*, 421 F.3d 1073, ("[W]e hold that a lack of commercial strength cannot diminish the overall strength of a conceptually strong mark so as to render it undeserving of protection. Otherwise, a mark which is conceptually strong may never have the opportunity to blossom into its full commercial potential through effective marketing").

⁸² 98 AM. JUR. 3D *Proof of Facts* § 5 (2007).

⁸³ *Id.*

commercial use of the mark in interstate commerce, (4) defendant’s use began after plaintiff’s mark became famous, and (5) likelihood of dilution.”⁸⁴

The cornerstone of any dilution claim is the fame requirement, and it is a high bar to overcome.⁸⁵ For a mark to be considered famous, the “general consuming public of the United States” must widely recognize the mark as a “designation of the source of the goods or services of the trademark’s owner.”⁸⁶ Accordingly, courts utilize four non-exhaustive factors to determine whether or not a mark is sufficiently famous to qualify for protection from dilution.⁸⁷ These include:

[(1)] The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; [(2)] The amount, volume, and geographic extent of sales of goods or services offered under the mark; [(3)] The extent of actual recognition of the mark. [(4)] Whether the mark was . . . registered.⁸⁸

Key in this analysis is the focus on the “general consuming public of the United States”⁸⁹ Although a mark may be famous in niche fields, that is not enough to meet the fame requirement.⁹⁰ For example, the Western District of Texas found that the University of Texas’s Longhorn logo did not meet the Lanham Act’s fame standard and showed that the logo acquired only niche market fame among college football fans.⁹¹ Therefore, many dilution claims fail because a mark has not achieved fame.

IV. TRADEMARK BULLYING AND IMPLICATIONS

There has been much academic and industry discussion about why bullying behavior occurs. Although professionals have submitted an array of hypotheses, the roots of this behavior reside in statutory and judicial trademark

⁸⁴ *Id.*; 15 U.S.C. § 1125(c).

⁸⁵ 98 AM. JUR. 3D *Proof of Facts* § 6 (2007).

⁸⁶ *Id.*

⁸⁷ 15 U.S.C. § 1125(c)(2).

⁸⁸ *Id.*

⁸⁹ 98 AM. JUR. 3D *Proof of Facts* § 6 (2007).

⁹⁰ *Id.*

⁹¹ Bd. of Regents, Univ. of Tex. Sys. *ex rel.* v. KST Elec., Ltd., 550 F. Supp. 2d 657, 677 (W.D. Tex. 2008).

jurisprudence.⁹² Therefore, in part IV, this Note explores what trademark bullying is⁹³, why and how it is perpetrated⁹⁴, and what statutory and judicial pitfalls exist that encourage bullying behavior⁹⁵. Additionally, it investigates the real-world implications of bullying behavior and its effects on speech, market competition, and small businesses. Finally, it analyzes the impact of OSU's recent trademark registration by highlighting the institution's intention to bully and the likely adverse effects of that behavior.⁹⁶

A. TRADEMARK BULLYING

1. *What is Trademark Bullying, and How is it Perpetrated?*

Though it has no doctrinal definition, trademark bullying is the growing practice by mark owners of aggressive tactics to attempt to enforce trademark rights outside of the scope of legal protection afforded to their mark.⁹⁷ "In a typical scenario, the trademark bully is a large entity with significant legal and economic resources. The target is an individual or a smaller entity that may lack the means or resolve to respond and therefore may capitulate quickly despite having a valid defense."⁹⁸

The trademark bully's first weapon of choice is the cease and desist ("C&D") letter.⁹⁹ In a C&D letter, a bully swiftly asserts its broad rights related to the mark in question and highlights the slippery slope towards contentious (and costly) litigation that the alleged infringer is barreling towards.¹⁰⁰ Then, the bully ensures the letter offers the recipient a clear exit strategy: abandoning their mark.¹⁰¹ Generally, C&D letters are perfectly adequate and appropriate measures for

⁹² See Jessica M. Kiser, *To Bully or Not to Bully: Understanding the Role of Uncertainty in Trademark Enforcement Decisions*, 37 COLUM. J.L. & ARTS 211, 218 (2014) (claiming that an absence of judicial precedent creates a "lack of clarity and predictability in the law encourages trademark bullying"); see also Irina D. Manta, *Bearing Down on Trademark Bullies*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 853, 858 (2012) (arguing trademark "law [] require[s] owners to police their marks if they want to maintain exclusive rights in their marks . . .").

⁹³ See *infra* notes 97–98 and accompanying text.

⁹⁴ See *infra* notes 98–123 and accompanying text.

⁹⁵ See *infra* notes 104–123 and accompanying text.

⁹⁶ See *infra* notes 144–165 and accompanying text.

⁹⁷ Vogel & Schachter, *supra* note 1 at 503.

⁹⁸ *Id.*; U.S. DEP'T OF COM., TRADEMARK LITIGATION TACTICS AND FEDERAL GOVERNMENT SERVICES TO PROTECT TRADEMARKS AND PREVENT COUNTERFEITING 1 (2011), <https://www.uspto.gov/sites/default/files/trademarks/notices/TrademarkLitigationStudy.pdf>.

⁹⁹ Vogel & Schachter, *supra* note 1 at 503.

¹⁰⁰ *Id.*

¹⁰¹ *Id.* at 503-504.

those legitimately attempting to enforce their trademark rights.¹⁰² However, bullying creeps in when mark owners use a particularly hostile tone and often include additional rights or remedies beyond the scope of those actually available to them.¹⁰³

2. *Why do Mark Owners Bully?*

Although the USPTO registers trademarks, it does not monitor and enforce trademark rights outside of the scope of the registration process.¹⁰⁴ Therefore, mark owners have an affirmative obligation and legal right to continuously monitor and prevent misuse of their marks.¹⁰⁵ Suppose owners do not police and enforce their trademark rights. In that case, the mark’s strength, the owner’s ability to continue prohibiting others from using similar or the same marks in commerce, and the mark’s value will decline.¹⁰⁶ The damage to the mark may result in lost revenue, reputational harm, and consumer confusion or deceit regarding the source or sponsorship of goods or services.¹⁰⁷ At its worst, a mark owner’s failure to take action could result in the asset losing all trademark significance and allowing it to fall into the public domain.¹⁰⁸

Though this threat looms large over mark owners, it casts a much narrower shadow than mark owners perceive. Courts rarely find that a mark owner’s inattention sufficiently reaches the level of abandonment in cases where a party alleges abandonment due to failure to police use by third parties.¹⁰⁹

For one, alleging parties must prove abandonment of a mark by clear and convincing evidence.¹¹⁰ This evidentiary bar is incredibly high, requiring the alleging party to provide proof of an intent to abandon coupled with nonuse.¹¹¹ A mark owner’s prospective declarations of an intent to abandon do not meet

¹⁰² *Id.* at 503.

¹⁰³ *Id.*

¹⁰⁴ U.S. PAT. & TRADEMARK OFF., PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 31 (2020), <https://www.uspto.gov/sites/default/files/trademarks/basics/BasicFacts.pdf>.

¹⁰⁵ U.S. DEPT OF COM., *supra* note 98, at 6.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* at 6-7.

¹⁰⁹ Kiser, *supra* note 92, at 229 (“In the majority of cases in which a failure to police third party trademark usage is alleged, courts find that any such failure has not risen to the level of abandonment of the mark and thus is inconsequential.”).

¹¹⁰ MCCARTHY, *supra* note 121, § 17.12.

¹¹¹ M.L. Cross, Annotation, *Abandonment of Trademark or Tradename*, 3 A.L.R.2d 1226 § 2 (1949).

the evidentiary standard required if they are made while legitimately using their mark.¹¹² Furthermore, courts almost always view it as conclusive evidence refuting abandonment if a mark owner makes even minute use of the mark.¹¹³ Additionally, when courts do terminate a mark in abandonment cases, much of the analysis hinges on the mark owner's intent to abandon or pervasive market competitor usage that functionally stops the mark from serving as a source indicator for the mark owner's goods or services.¹¹⁴

This raises the question: what actions must a mark owner take to protect from abandonment allegations? Although there is no established requirement, courts generally look for a reasonable attempt by mark owners to stop continuous and notorious infringers.¹¹⁵ The doctrine does not require nor suggest that a mark owner expend endless financial and physical resources to hunt down all current and potential infringers.¹¹⁶ Essentially, courts look for a good-faith effort to protect the mark from unauthorized use.¹¹⁷

As previously mentioned but not explained, an owner's failure to police their mark can impact the mark's strength in the eyes of consumers.¹¹⁸ Mark strength is critical in infringement suits, as courts utilize mark strength to conduct the likelihood of confusion analysis and, in turn, determine the scope of protection for a mark.¹¹⁹ To ascertain a mark's strength, courts examine both conceptual and commercial strength.¹²⁰ Conceptual strength is the mark's placement on the distinctiveness spectrum, i.e., between descriptive and fanciful.¹²¹ Consumers' recognition in the marketplace determines a mark's commercial strength.¹²² Courts look to various factors to determine marketplace recognition, including advertising and promotion, sales volume and customer types, recognition by prospective customers and the media, and—notably—the volume of third-party

¹¹² 87 C.J.S. *Trademarks, Etc.* § 274 (2023).

¹¹³ M.L. Cross, *supra* note 111, § 2.

¹¹⁴ Kiser, *supra* note 92, at 229.

¹¹⁵ *Id.* at 229-230.

¹¹⁶ *Wallpaper Mfs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 766 (C.C.P.A. 1982).

¹¹⁷ *STX, Inc. v. Bauer USA, Inc.*, No. C 96-1140 FMS, 1997 WL 337578, at *13 (N.D. Cal. 1997).

¹¹⁸ Kiser, *supra* note 92, at 227.

¹¹⁹ Quynh La, Comment, *Bully No More: Why Trademark Owners Engage in Trademark Overreach and How to Prevent It*, 96 WASH. L. REV. 667, 689 (2021).

¹²⁰ 3 THOMAS D. SELZ ET AL., *ENTERTAINMENT LAW: LEGAL CONCEPTS AND BUSINESS PRACTICES* § 17.104 (2022).

¹²¹ THOMAS J. MCCARTHY, *MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION* § 11.80 (2022).

¹²² *Id.*

usage.¹²³ Therefore, mark owners have a vested interest in stopping unauthorized third-party usage of their marks by maximizing the protection afforded to them in the event of an infringement suit.

3. *Bullying Implications: Chilling Free Speech, Suppressing Marketplace Competition, and Stifling Small Businesses*

Trademark bullies inhibit First Amendment-protected speech by threatening and forcing litigation costs on speakers and producers they oppose.¹²⁴ The recent Second Circuit decision in *Louis Vuitton Malletier SA v. My Other Bag, Inc.* is instructive in this regard.¹²⁵ After the court found no infringement and fair use by a small producer, My Other Bag¹²⁶, a group of academics filed an amicus brief with the Second Circuit urging it to reconsider its decision to forgo fee-shifting.¹²⁷

My Other Bag is a small business; its products are canvas tote bags with hand-drawn pictures of luxury handbags from an array of luxury designers.¹²⁸ The canvas bags also included the expression “My Other Bag,” which MOB explains in their marketing materials is meant to “playfully parody designer bags.”¹²⁹ The district and appellate courts agreed that My Other Bag’s use was a quintessential fair use parody case.¹³⁰

My Other Bag moved for attorneys fees and costs, and the court deemed them unwarranted.¹³¹ The court justified its conclusion and explained that Louis Vuitton’s arguments supporting its trademark claims were “nonfrivolous” and there was no evidence that Louis Vuitton sued with “improper motive.”¹³² In the amicus brief filed by various academics, the authors recognize that the

¹²³ *Id.* § 11.81.

¹²⁴ Patrick J. Hughes, *Louis Vuitton should pay for suit against 'obvious parody,' professors say*, WESTLAW TODAY (July 6, 2018), [https://today.westlaw.com/Document/Ifa1ef8e6814511e8a5b3e3d9e23d7429/View/FullText.html?contextData=\(sc.Default\)&transitionType=Default&firstPage=true&OWSessionId=b6b4d1bd930c48a092195e56b855ade1&skipAnonymous=true&bhcp=1](https://today.westlaw.com/Document/Ifa1ef8e6814511e8a5b3e3d9e23d7429/View/FullText.html?contextData=(sc.Default)&transitionType=Default&firstPage=true&OWSessionId=b6b4d1bd930c48a092195e56b855ade1&skipAnonymous=true&bhcp=1).

¹²⁵ *Louis Vuitton Malletier SA v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, (S.D.N.Y. 2016); *aff'd*, 674 F. App’x 16 (2d Cir. 2016).

¹²⁶ *Id.* at *18.

¹²⁷ Brief for My Other Bag, Inc. as Amici Curiae Supporting Defendant-Appellant, *Louis Vuitton Malletier, S.A., v. My Other Bag, Inc.*, 764 F. App’x 39, (2d Cir. 2019) (No. 18-293-CV).

¹²⁸ *Louis Vuitton*, 156 F. Supp. 3d *431 (S.D.N.Y. 2016); *aff'd*, 674 F. App’x 16 (2d Cir. 2016).

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Louis Vuitton Malletier SA v. My Other Bag, Inc.*, 2018 WL 317850, *4 (S.D.N.Y. 2018).

¹³² *Id.*

Second Circuit afforded the proper broad allowance to criticism and parody inherent in the trademark system.¹³³ However, its decision creates an impossibly high standard to obtain fee-shifting in fair use cases.¹³⁴ This creates an environment where large, resource-rich mark owners can use the trademark legal system to subdue critics and cripple free speech.¹³⁵ Even outside the fair use parody cases, attorneys fees and other litigation costs loom largely over targets of trademark bullies.¹³⁶

Hand-in-hand with the dampening of free speech by competitors is also the detrimental impact on small businesses and competition in the marketplace. Large, resource-rich trademark owners are not, for the most part, pursuing their counterparts.¹³⁷ In actuality, small defendants bear the brunt of the harsh enforcement tactics perpetrated by trademark bullies.¹³⁸ Small businesses are particularly trigger-shy when it comes to engaging in litigation.¹³⁹ Even if small defendants did have an appetite for challenging large mark owners, litigation costs are high and seemingly ever-increasing.¹⁴⁰ Therefore, to stay afloat, small businesses are often forced into a settlement with inadequate representation and a misunderstanding of the merits of their claims.¹⁴¹

The cost of this unfortunate truth is ultimately externalized to consumers and the market itself.¹⁴² The impact of this bullying behavior is a consistent and large barrier for producers to enter the marketplace and directly affects the number of choices available to consumers.¹⁴³

¹³³ Brief for My Other Bag, Inc. as Amici Curiae Supporting Defendant-Appellant, *supra* note 127, at *1.

¹³⁴ *Id.* at *3.

¹³⁵ *Id.* at *8.

¹³⁶ Manta, *supra* note 92 at 860 (“Litigation can be prohibitively expensive for victims, and the costs of litigation alone can be enough to bankrupt a small business even if it ultimately prevails”).

¹³⁷ Leah C. Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 642 (2011) (“There are four elements in this Article's bullying definition, which are discussed in turn below: (1) unreasonable interpretation of rights, (2) intimidation tactics, (3) the trademark holder is a large corporation, and (4) the accused infringer is a small business or individual.”).

¹³⁸ *Id.*

¹³⁹ Anthony J. Dispoto, Comment, *Protecting Small Businesses Against Trademark Bullying: Creating a Federal Law To Remove the Disparity of Leverage Trademark Holders Maintain over Small Businesses*, 16 SAN DIEGO INT'L L.J. 457, 469 (2015).

¹⁴⁰ *Id.*

¹⁴¹ *Id.* at 473.

¹⁴² *Id.* at 469.

¹⁴³ *Id.*

B. IMPACT OF “THE” TRADEMARK

The TTAB’s issuance of Registration No. 67,631,18 demonstrates a lack of appetite to tackle bullying behavior and a continued departure from fundamental trademark principles. OSU makes it clear in the filing documents that it intends to behave similarly to Louis Vuitton and other historic bullies in attempting to squash small businesses, monopolize the marketplace, and chill free speech.¹⁴⁴

With the armor provided by its registration, OSU can actively pursue claims against parody or other fair use cases. The University regularly demonstrates commitment to aggressively and fiercely protect its brand.¹⁴⁵ This attitude cannot afford grace to parodic and critical perspectives. For example, “THE” is currently being used in the market by Smack Apparel, a sports merchandise brand, to comment on and parody OSU’s pretentious use of “THE”.¹⁴⁶

Smack Apparel offers a t-shirt on the market depicting a solid drawing of the state of Ohio, and the word “THE” is squarely centered and quoted within it.¹⁴⁷ Below that illustration is the word “worst.”¹⁴⁸ Of course, the shirt depicts all of the mentioned elements in the maize and blue color palette of OSU’s rival, the University of Michigan.¹⁴⁹ Equipped with the new mark, OSU could easily engage in bullying behavior to protect its brand. Additionally, due to the high bar required to receive fee-shifting, producers like Smack Apparel and even smaller producers are disincentivized to pursue a likely meritorious claim.¹⁵⁰ Therefore, free speech is subdued and chilled.

Even outside the context of silencing critics and parodists, OSU has its sight set on monopolizing the market for any and all products related to the University.¹⁵¹ The University’s response to the TTAB office action on March 11,

¹⁴⁴ See *infra* notes 145–56 and accompanying text.

¹⁴⁵ Nicholas Piotrowicz, *Ohio State fiercely defends trademarks, branding*, TOLEDO BLADE, (Aug. 6, 2017, 12:33 AM), <https://www.toledoblade.com/sports/college/2017/08/06/Ohio-State-fiercely-defends-trademarks-branding-suing-14-entities-for-infringement-in-2009/stories/20170805183> (“Since 2009, Ohio State has sued 14 different entities for trademark infringement in U.S. District Court, opposed to dozens with the U.S. Patent and Trademark Office, and sent hundreds of cease and desist letters.”).

¹⁴⁶ SMACK APPAREL, <https://www.smackapparel.com> (click the search book and search “The Worst (Anti-Ohio State) Shirt for Michigan College Football Fans”) (last visited Jan. 17, 2023).

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ Hughes, *supra* note 124.

¹⁵¹ Piotrowicz, *supra* note 145 (“Ohio State has sued merchandisers, media outlets, a car dealership, and a poultry farm in U.S. District Court.”).

2020, only identifies one class of alleged unauthorized users of the then applied-for mark: small local producers.¹⁵² The University explicitly identifies small producers around OSU's stadium on athletic game days as alleged sellers of unlicensed and unauthorized merchandise.¹⁵³ The University mentions no other instances of alleged infringement in the hundreds of pages of filing documents. OSU's justification for desiring to register and protect this mark is to ensure that revenues generated from merchandise bearing its marks are used to serve the University's interests.¹⁵⁴ However noble this motive may seem, it is a thinly-veiled attempt to justify targeting local innovators in the market and capitalizing on their financial successes.

Perhaps the most damning evidence of the University's true desire to simply corner the market in all possible areas is its change in filing basis.¹⁵⁵ As motioned in Section II of this Note, OSU applied for the word mark "THE," utilizing a Section 1(a) use in commerce filing basis under the Lanham Act.¹⁵⁶ Filing on this basis means that the University claims that it is already using the mark substantially in commerce as a source identifier. The submitted specimen included a hat and t-shirt where "THE" was prominently featured on the front in conjunction with either the registered OSU block-o emblem¹⁵⁷ or the registered buckeye leaf¹⁵⁸.¹⁵⁹ The board ultimately found that the use of "THE" was merely ornamental due to its dominating placement and likely perception by consumers that there was no source-identifying significance.¹⁶⁰

In its March 11, 2020, response to this initial refusal, OSU argued that "THE" was a secondary source indicator of goods and services that the University provides.¹⁶¹ In their reply, the examining attorney explained that the evidence and arguments offered by OSU only showed that "THE," although

¹⁵² Response to Office Action, *supra* note 9, at 13–14 (noting that "unauthorized and unlicensed" goods are sold "in and around respective stadiums and arenas where home games are played" which are produced primarily by small businesses).

¹⁵³ Response to Office Action, *supra* note 9, at 10.

¹⁵⁴ *Id.*

¹⁵⁵ Amendment to Delete or Correct Filing Basis at 1, Serial No. 88/571,984 (Feb. 10, 2022).

¹⁵⁶ U.S. Trademark Application Serial No. 88/571,984 (filed Aug. 8, 2019); 15 U.S.C. § 1051(b).

¹⁵⁷ O, Registration No. 5,550,238.

¹⁵⁸ The mark consists of a stylized representation of a Buckeye Leaf, Registration No. 6,106,984.

¹⁵⁹ U.S. Trademark Application Serial No. 88/571,984 (filed Aug. 8, 2019).

¹⁶⁰ Nonfinal Office Action, *supra* note 12, at 2–3.

¹⁶¹ Response to Office Action, *supra* note 9, at 10.

sometimes emphasized, was used exclusively in conjunction with “Ohio State University.”¹⁶² Therefore, it did not function as a source indicator on its own.¹⁶³

In spite of this, the University amended its application to utilize a 1(b) intent-to-use filing basis under the Lanham Act. The evidence offered included a printed tag on the inside upper back of a garment using “THE” singularly and the creation of a brand called “THE” on OSU’s official team shop website.¹⁶⁴ This shift ultimately allowed for the acceptance and registration of the word mark “THE” to OSU. The change shows the University’s true intentions do not include preserving a brand rightfully recognized by federal trademark law but are actually to exploit that system to corner the market for all OSU-related merchandise. The registration granted under the 1(b) filing basis essentially provided OSU with a workaround to retain the power afforded to registered mark holders to pursue meritorious and frivolous claims against alleged infringers. In other words, OSU can use the registration to bully.

OSU clearly admits in its filing documents that it is concerned about the sale of merchandise around the University’s stadium during home football games, which is primarily produced by small, local producers.¹⁶⁵ When OSU inevitably uses the large stick given through the mark’s registration, small business owners in Columbus are unlikely to behave differently than similarly situated businesses in their response to any threatened legal action. When pressured with litigation, negative press coverage, and high legal costs by the University’s C&D letters, small businesses will likely submit to any demands made and likely cease sales. This almost definitely will result in OSU’s continued monopolization of the market, and ultimately the lack of marketplace competition will negatively impact consumers.

V. A PATH FORWARD

Although it is clear that bullying behavior has not been substantially curbed yet by Congress, judicial precedent, or USPTO action, there are viable options available to all three actors to alleviate bullying behavior. Section V offers potential statutory and judicial solutions to tackle and disincentivize bullying behavior.

¹⁶² Office Action Outgoing at , Serial No. 88/571,984 (Aug. 9, 2021).

¹⁶³ Suspension Letter at 1, Serial No. 88/571,984 (Apr. 4, 2020).

¹⁶⁴ Specimen, Serial No. 88/571,984 (Feb. 9, 2022).

¹⁶⁵ Response to Office Action, *supra* note 9, at 10.

A. SANCTIONS AGAINST HABITUAL AND ATTEMPTED OVER-ENFORCERS

A clear issue attached to trademark bullying is the lack of a disincentive to bully. While some frameworks are available to courts to impose sanctions against attorneys for ethical and conduct violations, none exist exclusively within the trademark ecosystem to solve this issue.¹⁶⁶ Adopting a new statutory regime targeting this issue would benefit courts by more clearly defining problematic behaviors and therefore more effectively combat bullying behavior.

In the interim, courts can still enforce trademark bullies through conventional Rule 11, 28 U.S.C. § 1927, and Section 35 of the Lanham Act.¹⁶⁷ Courts could maintain the necessary dexterity to apply the appropriate sanctions to attorneys, clients, or both. Historically, however, judicial sanctions are rare in trademark actions.¹⁶⁸ Fortunately, a bill introduced in the Minnesota State House of Representatives provides an excellent starting point.

The cornerstone of House Bill No. 2996 is that it provides an alternative, cost-conscious strategy to traditional civil trademark litigation in creating an administrative avenue to pursue.¹⁶⁹ The bill allows either party to request a settlement conference in this proposal.¹⁷⁰ The meeting must occur within thirty days of the request, and it allows for virtual attendance, depending on the parties' locations.¹⁷¹ All of these are incredibly pertinent provisions.

First, the allowance to opt into an administrative proceeding can significantly reduce the costs to mark owners (especially small businesses) when defending their marks. Additionally, the time constraint placed on commencing the meeting provides the opportunity for quick resolution between both parties. Finally, virtual flexibility is imperative to allow geographically diverse parties to appear before the decisionmaker efficiently and reduce costs for both parties to defend their marks.

¹⁶⁶ FED. R. CIV. P. 11 (providing that Rule 11 violations impose penalties on attorneys, clients, or both for pleadings filed with improper purpose or frivolous arguments); 28 U.S.C. § 1927 (making sanctions available for "unreasonabl[e] and vexatious[] . . . conduct"); Lanham Act § 35, 15 U.S.C. § 1117 (awarding attorney's fees to prevailing parties in "exceptional cases," traditionally understood as those cases involving willful infringement and/or bad faith behaviors).

¹⁶⁷ FED. R. CIV. P. 11; 28 U.S.C. § 1927; Lanham Act § 35, 15 U.S.C. § 1117.

¹⁶⁸ Manta, *supra* note 92, at 860.

¹⁶⁹ H.B. 2996, 2012 Leg., 87th Sess. § 3-4 (Minn. 2012).

¹⁷⁰ *Id.* § 4.

¹⁷¹ *Id.*

The proposed legislation outlines procedural and evidentiary allowances during the hearing.¹⁷² Notably, the bill allows for the admission of expert witness testimony, evidence that supports a mark’s use in commerce, and any pertinent industry practice standards.¹⁷³ These types of evidence are all the similar kinds that parties present in traditional suits.¹⁷⁴ This provides both parties with adequate opportunity to advocate for their marks effectively.

The proposed legislation also allows administrative law judges to issue summary judgment with or without the request of either party, and the bill’s language explicitly outlines this use for “case[s] of trademark bullying.”¹⁷⁵ This allows for increased efficiency in dispute resolution and a speedier identification of bullying behavior.

The most interesting and arguably impactful aspect of this proposed legislation is its relentless emphasis on its purpose to produce meaningful outcomes and prevent the frivolous expenditure of resources. For example, subdivision 4 of Section 4 highlights the need for parties to “be prepared” and “meaningful[ly]” participate in settlement discussions.¹⁷⁶ Additionally, subdivision 9 of Section 4 dictates that alleging parties who refuse to participate will be fined and held responsible for the defending party’s costs and attorney’s fees.¹⁷⁷ These and other provisions underscore the demand placed on parties to actively and meaningfully engage in the process to prevent the expense of time, money, and other resources.

Most important, though, is the proposed statute’s acknowledgment of the importance of aggregation. Trademark bullying persists because of the continuous and overzealous presence of the bully. Therefore, the ability of the court system to award treble damages for those it identifies as engaging in bullying behavior provides a substantial threat to would-be bullies.¹⁷⁸ Additionally, the ability of the court to award treble damages after two instances of bullying in ten years cuts what could become prolific bullies off early and

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ *Frosty Treats Inc. v. Sony Comput. Enter. Am.*, 426 F.3d 1001, 1003-1006 (8th Cir. 2005) (expert conducted a survey of customers in plaintiff’s markets demonstrating that plaintiff’s mark had not acquired secondary meaning); *Paddington Corp. v. Attiki Importers & Distrib., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993) (soda industry practice would render green cans generic for the purpose of lime-flavored soda).

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

ideally prevent parties from further engaging in abusive practices.¹⁷⁹ Overall, the proposed Minnesota statute creates an excellent skeleton for a federal statutory enactment to combat trademark bullying.

B. REMOVING ENFORCEMENT FROM THE EQUATION

Trademark owners must proactively ensure that no third-party uses infringe on their marks or create consumer confusion in the marketplace.¹⁸⁰ Increasingly though, trademark owners use concern about consumer confusion as to mask their true aim to snuff out marketplace competition. Because bolstering trademark strength is currently achieved in part by the active pursuit of alleged infringers and consumer confusers, the concealment of the underlying desire to squash competition continues. Therefore, removing mark strength from the likelihood of confusion equation and, in turn, the amount of protection afforded to the mark would force much of the negative behavior to cease.

As previously mentioned in this Note, one of the roots of trademark law is to protect consumers.¹⁸¹ Consumers rarely benefit from the stifling of competition.¹⁸² However, trademark owners are. Protecting and growing market share by increasing goodwill with consumers makes trademarks valuable in the marketplace.¹⁸³ However, diminishing consumer choice by policing others' use of a mark displays neither consumer identification, goodwill, nor mark strength. It only shows that a mark owner possessed enough resources to over-monitor its mark. Therefore, trademark law should cease relying on a mark's commercial strength to justify additional protection.

VI. CONCLUSION

The theoretical underpinnings of trademark law focus on protecting consumers from confusion in the marketplace. This aim is not served by inhibiting competition through the excessive policing of trademarks by resource-rich mark owners like OSU. Although the USPTO granted federal registration to OSU, there are steps that the legal system can take to prevent bullying behaviors from taking root in the University's mark protection strategy. This

¹⁷⁹ *Id.*

¹⁸⁰ DEP'T OF COM., *supra* note 98, at 6.

¹⁸¹ MCCARTHY, *supra* note 121, § 2.2.

¹⁸² Kiser, *supra* note 92, at 223.

¹⁸³ *Id.* at 242.

includes enacting a federal statutory scheme aimed at opening access to litigation, lowering costs, and punishing habitual over-protection by trademark bullies. Also included is the removal of or decreased emphasis on a mark’s strength in determining the level of legal protection afforded by courts. Both strategies would disincentive aggressive policing by mark holders and therefore decrease bullying behaviors overall.