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Alex Baldwin

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'The' Ohio State University's Newest Trademark Application Draws Public Backlash

By Alex Baldwin*

On August 8, 2019, The Ohio State University officially filed an application with the United States Patent and Trademark Office to trademark the word "The" in "The Ohio State University," prompting criticism and ire from an array of news outlets.¹ The goal of the trademark is to protect the use of the word "The" on shirts and hats in large letters with the school's logo placed underneath the word.² Shortly after the trademark application was discovered, The Ohio State University was criticized for abusing the trademark system by applying "for a trademark on the single most commonly used determiner in the English language."³ To defend the sought after trademark, the university was quick to point out that "The" is part of their legal name under Ohio state law.⁴ The university also argued the trademark was necessary to protect the school's brand as it provides value to the school "which benefits [their] students and faculty and the broader community by supporting [their] core academic mission of teaching and research."⁵

A trademark can be any word, symbol, or name that is: (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by the Lanham Act to distinguish one's goods from another's.⁶ The ultimate purpose of a trademark is to prevent others from using a similar (or the exact same) mark

* J.D. Candidate, 2021, Saint Louis University School of Law

¹ U.S. Trademark Application Serial No. 88571984 (filed Aug. 08, 2019).

² Cindy Boren, *The Ohio State University Wants to Trademark its favorite word: 'The'*, Washington Post, <https://www.washingtonpost.com/sports/2019/08/14/ohio-state-university-wants-trademark-its-favorite-word/> (last updated Aug. 14, 2019).

³ Timothy Geigner, *THE Ohio State University Applies for THE Stupidest Trademark in THE World* (Aug. 19, 2019, 7:36 PM), <https://www.techdirt.com/articles/20190814/14411142787/ohio-state-university-applies-stupidest-trademark-world.shtml>.

⁴ Alex Johnson, *'The' Ohio State University Wants to Trademark the Word 'The'* (Aug. 13, 2019, 10:26 PM), <https://www.nbcnews.com/news/education/ohio-state-university-wants-trademark-n1042106>.

⁵ *Id.*

⁶ 15 U.S.C. § 1127 (2006).

in order to prevent a likelihood of confusion with the marks.⁷ Avoiding this confusion not only benefits the consumer, but the creator of the mark as well.⁸ Allowing the creator of the mark to bring claims against infringers allows the creator to invest directly into the mark and products associated with the mark.⁹ Due to this investment and value, the holder of a trademark has a large incentive to watch their trademark closely for any misuse by competitors.¹⁰ Once a trademark is established, the protection associated with the trademark is indefinite.¹¹ This protection will last as long as the mark is used by the holder and is not abandoned.¹² However, if the mark becomes generic, the holder will lose trademark protection.¹³ Well known examples of protected trademarks include the Nike “swoosh”, the basic Mickey Mouse logo, and the Apple symbol that appears on the back of Apple products.¹⁴

Ohio State University is hardly the first entity that has attempted to trademark a word or phrase that drew anger or confusion from the general public. For example, in 2014, King.com Limited, the video game developer behind the mobile game “Candy Crush Saga” attempted to trademark the word “candy” to prevent other video game developers from using the word “candy” in the title of their games.¹⁵ Shortly after filing for the trademark, developers reported receiving emails “being asked to remove their apps from the App Store or prove that their games do not infringe upon the

⁷ PETER S. MENELL ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE VOL. II: COPYRIGHTS, TRADEMARKS & STATE IP PROTECTIONS* 875 (2019).

⁸ *Id.*

⁹ *Id.* at 876.

¹⁰ *Id.* at 875.

¹¹ Gary M. Ropski; Michael J. Kline, *A Primer on Intellectual Property Rights: The Basics of Patents, Trademarks, Copyrights, Trade Secrets and Related Rights*, 50 ALB. L. REV. 405, 420 (1986).

¹² *Id.*

¹³ *Id.*

¹⁴ SWOOSH, Registration No. 2164810; The mark consists of three circles which form a silhouette design of a mouse's head, Registration No. 5679476; APPLE TRADEMARK LIST, <https://www.apple.com/legal/intellectual-property/trademark/appletmlist.html> (last visited Aug. 29, 2019).

¹⁵ Anthony Wing Kosner, *Candy Crush Saga Has Trademarked Candy and Apple's App Store is Helping Enforce It* (Jan. 20, 2014, 4:14 PM), <https://www.forbes.com/sites/anthonykosner/2014/01/20/candy-crush-saga-has-trademarked-candy-and-apples-app-store-is-helping-enforce-it/#882795147090>.

Candy Crush trademark.”¹⁶ Almost a month after filing for the trademark, King abandoned their trademark applications.¹⁷

Harley Davidson Inc. once attempted to trademark the iconic sound of their idling V-twin engine.¹⁸ One might argue attempting to trademark a sound is harder than trademarking a generic word, like Ohio State University; at the time of Harley Davidson’s application, only twenty-three of seven-hundred and thirty thousand active trademarks were issued approving a trademark to protect a noise.¹⁹ One example of a sound being trademarked is the iconic roar of the MGM lion, which can hardly be considered generic.²⁰ Competing motorcycle companies argued the sound of Harley Davidson’s V-twin engine was too generic and claimed the sound was a characteristic of all V-twin engines and not just Harley Davidson’s.²¹ Eventually, Harley Davidson abandoned their application to obtain the trademark.²²

Taking a risk and trademarking phrases that one might think would not get approved sometimes pays off. For example, Pat Riley, current president of the Miami Heat, has made extra money off royalties from his trademarked “three-peat” phrase.²³ While president of the Los Angeles Lakers, after the 1988 season when the Lakers won their second championship in a row, Riley filed an application to trademark the phrase “three-peat” in anticipation of using it in the event of the Lakers winning their third championship in a row.²⁴ However, despite the Lakers losing the following championship to the Detroit Pistons, the trademark still proved to be valuable.²⁵ Riley was able to cash in on royalties after the Chicago Bulls and

¹⁶ *Id.*

¹⁷ U.S. Trademark Application Serial No. 85842584 (filed Feb. 6, 2013).

¹⁸ John O’Dell, *Harley-Davidson Quits Trying to Hog Sound* (June 21, 2000, 12:00 AM), <https://www.latimes.com/archives/la-xpm-2000-jun-21-fi-43145-story.html>.

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.*

²² *Id.*

²³ Darren Rovell, *Pat Riley files for ‘3-peat’ Trademark*, ESPN https://www.espn.com/nba/truehoop/miamiheat/story/_/id/10965180/pat-riley-miami-heat-riley-files-3-peat-trademark-jewelry-rings-sports-memorabilia (last updated May 21, 2014).

²⁴ *Id.*

²⁵ *Id.*

the New York Yankees won three championships in a row.²⁶ Successful strange trademarks such as Riley's are part of the reason why Ohio State University attempts to protect their brand with absurd trademarks.

The Ohio State University's proposed trademark's fate currently lies in the hands of the United States Patent and Trademark Office, who will issue a decision to either grant or deny the trademark. Likely, the trademark will be denied since the mark's sole purpose is for clothing, which the trademark office requires the mark to be used on the tagging or labeling of clothing, which is not the university's aim.²⁷ Another likely scenario, supported by the King Limited and Harley-Davidson debacles, is the university abandons the application altogether.²⁸ These public relation nightmares seem to suggest when the public backlashes due to overbroad and greedy trademarks, the company attempting to protect the mark might abandon the application altogether.²⁹ Alternatively, the university may keep the application open and justify the proposed trademark by arguing the school's brand holds value that must be protected.³⁰ Regardless if the trademark is approved or not, by filing for the mark, Ohio State has signaled they are willing to protect their brand, even if it creates another reason for Michigan football fans to dislike the school.

Edited by Jessica Gottsacker

²⁶ *Id.*

²⁷ Boren, *supra* note 2.

²⁸ See *generally* Kosner, *supra* note 15 and O'Dell, *supra* note 18.

²⁹ *Id.*

³⁰ Boren, *supra* note 27.