

APPENDIX

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APPENDIX 1

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Cancellation

Number: 92077130 **Filing Date:** 05/12/2021
Status: Suspended **Status Date:** 04/19/2022
General Contact Number: 571-272-8500
Interlocutory Attorney: KEVIN G CRENNAN
Paralegal Name: KARL S KOCHERSPERGER

Defendant

Name: Business Moves Consulting Inc. DBA
Business Moves

Correspondence:

BUSINESS MOVES CONSULTING INC
2827 ST ROCH AVE
NEW ORLEANS, LA 70122
UNITED STATES
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Serial #: 87670210 Application File Assignment

Registration #: 5496751

Application Status: Cancellation Pending

Mark: THEEILOVE

Plaintiff

Name: Jackson State University

Correspondence:

W WHITAKER RAYNER
JONES WALKER LLP
190 E CAPITOL ST
JACKSON, MS 39201
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jwtrademarks@joneswalker.com
Phone: 601-949-4724

Serial #: 88728596 Application File Assignment

Application Status: Report Completed Suspension
Check - Case Still Suspended

Mark: THEE I LOVE

Serial #: 88730067 Application File Assignment

Application Status: Report Completed Suspension
Check - Case Still Suspended

Mark: THEE I LOVE!

Serial #: 88730481 **Application File Assignment**

Registration #: 6050006

Application Status: Registered

Mark: HAIL HAIL TO THEE

Prosecution History

#	Date	History Text	Due Date
<u>29</u>	10/20/2022	<u>SUSP PEND DISP OF CIVIL ACTION</u>	
<u>28</u>	09/28/2022	<u>D RESP TO NOTIFICATION OF APPELLATE DECISION</u>	
<u>27</u>	09/08/2022	<u>P NOTIFICATION OF APPELLATE DECISION</u>	
<u>26</u>	04/19/2022	<u>SUSP PEND DISP OF CIVIL ACTION</u>	
<u>25</u>	03/28/2022	<u>D RESP TO BD ORDER/INQUIRY</u>	
<u>24</u>	03/14/2022	<u>P RESP TO D RESP TO BD ORDER/INQUIRY</u>	
<u>23</u>	03/11/2022	<u>SUSP PEND DISP OF OUTSTNDNG MOT</u>	
<u>22</u>	03/04/2022	<u>D RESP TO BD ORDER/INQUIRY</u>	
<u>21</u>	02/16/2022	<u>PROCEEDINGS RESUMED</u>	
<u>20</u>	01/24/2022	<u>RESPONSE DUE</u>	

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19 12/23/2021 SUSP PEND DISP OF OUTSTNDNG MOT
18 12/20/2021 P OPP/RESP TO MOTION
17 12/04/2021 D MOT TO SUSP PEND DISP CIV ACTION
16 11/20/2021 ANSWER
15 11/03/2021 P CERTIFICATE OF SERVICE OF APTC
14 10/26/2021 TRIAL DATES REMAIN AS SET
13 10/20/2021 P MOT TO AMEND PLEADING/AMENDED PLEADING
12 09/21/2021 P CHANGE OF CORRESP ADDRESS
11 09/21/2021 TRIAL DATES RESET
10 09/16/2021 P APPEARANCE / POWER OF ATTORNEY
9 08/17/2021 SUSPENDED
8 08/16/2021 D MOT TO JOIN/SUBSTITUTE PARTY
7 08/12/2021 D REQ FOR DISCOVERY CONFERENCE-ESTTA
6 07/26/2021 EXTENSION OF TIME GRANTED
5 07/19/2021 ANSWER
4 06/15/2021 D MOT FOR EXT W/O CONSENT

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3 05/12/2021 INSTITUTED
2 05/12/2021 NOTICE AND TRIAL 06/21/
 DATES SENT; ANSWER 2021
 DUe:
1 05/12/2021 FILED AND FEE

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*Trademark Trial and Appeal Board Electronic
Filing System. <https://estta.uspto.gov>*
ESTTA Tracking number: ESTTA1133461
Filing date: **05/12/2021**

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD**

Petition for Cancellation

Notice is hereby given that the following party has filed
a petition to cancel the registration indicated below.

Petitioner Information

Name	Jackson State University		
Entity	state public university	Citizenship	Mississippi
Address	1400 JOHN R. LYNCH STREET JACKSON, MS 39217 UNITED STATES		

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Attorney information	LARRY A. SCHEMME OFFICE OF THE ATTORNEY GENERAL P. O. BOX 1850 JACKSON, MS 39215-1850 UNITED STATES Primary Email: lschemmel@mdot.ms.gov Secondary Email(s): lschemmel@ihl.state.ms.us 601-359-7600
Docket Number	

Registration Subject to Cancellation

Registration No.	5496751	Registration date	06/19/2018
Registrant	Business Moves Consulting Inc 2827 ST ROCH AVE NEW ORLEANS, LA 70122 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2005/12/24 First Use In Commerce: 2017/03/03 All goods and services in the class are subject to cancellation, namely: Clothing, namely, athletic sleeves; Clothing, namely, base layers; Clothing, namely, crops; Clothing, namely, folk costumes; Clothing, namely, hand-warmers; Clothing, namely, khakis; Clothing, namely, neck warmers; Clothing,

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namely, thobes; Footwear for men; Footwear for women; Footwear made of vinyl; Footwear, namely, pumps; Footwear, namely, rubbers; Hats; T-shirts; Athletic footwear; Baby layettes for clothing; Baseball caps and hats; Bed jackets; Belts; Belts for clothing; Bomber jackets; Camouflage jackets; Chef hats; Denim jackets; Down jackets; Fascinator hats; Fur hats; Fur jackets; Gloves as clothing; Graphic T-shirts; Head wraps; Headbands for clothing; Heavy jackets; Hiking jackets; Hoods; Hunting jackets; Jackets; Jerseys; Knit jackets; Leather hats; Leather jackets; Leather belts; Light-reflecting jackets; Long jackets; Mantles; Motorcycle jackets; Outerjackets; Padded jackets; Padding jackets; Pockets for clothing; Rain hats; Rainjackets; Rainproof jackets; Reversible jackets; Riding jackets; Safari jackets; Sedge hats (suge-gasa); Sheepskin jackets; Shell jackets; Short sets; Shoulder wraps; Shoulder wraps for clothing; Ski jackets; Small hats; Smoking jackets; Sports jackets; Sports caps and hats; Stocking hats; Stuff jackets; Suede jackets; Sweat jackets; Toboggan hats; Top hats; Track jackets; Trekking jackets; Underarm clothing shields; Wind resistant jackets; Wind-jackets; Woolly hats

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute	Trademark Act Sections 14(3) and 2(a)
Deceptiveness	Trademark Act Sections 14(3) and 2(a)
Disparaging	Trademark Act Sections 14(3) and 2(a)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used	Trademark Act Section 14(3)

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Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	88728596	Application Date	12/16/2019
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THEE I LOVE		
Design Mark	Thee I Love		
Description of Mark	NONE		
Goods/ Services	Class 006. First use: First Use: 2010/09/02 First Use In Commerce: 2015/09/02 Vehicle Tag Class 025. First use: First Use: 2010/09/09 First Use In Commerce: 2010/09/09 T-shirts, sweatshirts Class 041. First use: First Use: 1940/01/01 First Use In Commerce: 1940/01/01 The mark is included in several stanzas of the University Alma Mater		

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	which was written in the 1940's		
U.S. Application No.	88730067	Application Date	12/17/2019
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THEE I LOVE!		
Design Mark			
Description of Mark	The mark consists of Black HeatVectorian Style Typeface letters in all caps with the capital I in highlight blue and the O in Love replaced with a highlight blue heart.		
Goods/ Services	Class 025. First use: First Use: 2017/02/01 First Use In Commerce: 2017/02/01 T-shirts		

U.S. Registration No.	6050006	Application Date	12/17/2019
Registration Date	05/05/2020	Foreign Priority Date	NONE

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Word Mark	HAIL HAIL TO THEE
Design Mark	Hail Hail to Thee
Description of Mark	NONE
Goods/ Services	Class 025. First use: First Use: 2019/09/01 First Use In Commerce: 2019/09/01 t shirts
Attachments	88728596#TMSN.png(bytes) 88730067#TMSN.png(bytes) 88730481#TMSN.png(bytes) Petition for Cancellation_051221.pdf (63153 bytes)

Signature	/Larry A. Schemmel/
Name	Larry A. Schemmel
Date	05/12/2021

APPENDIX 2

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD**

Cancellation No. _____

Registration No. 5,496,751

Mark: THEEILOVE

[Dated May 12, 2021]

JACKSON STATE UNIVERSITY,)
Petitioner,)
)
v.)
)
BUSINESS MOVES CONSULTING, INC.,)
DBA BUSINESS MOVES,)
Registrant.)

PETITION FOR CANCELLATION

Jackson State University, a body politic and corporate duly organized and existing under the laws of the State of Mississippi, with a principal place of business at 1400 John R. Lynch Street, Jackson, Mississippi 39217 (“Petitioner” or the “University”), believes and asserts that it has been, is being, and will continue to be damaged by the registration of the

claimed THEEILOVE mark shown in U.S. Trademark Registration No. 5,496,751, and therefore petitions to cancel such registration pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064. In support of its petition, Petitioner alleges and states as follows:

Petitioner's Mark

1. The Petitioner University is a State of Mississippi public university originally founded in October, 1877, and is currently the fourth largest of Mississippi's eight public institutions of higher learning and one of the largest historically black colleges and universities (HBCUs) in the United States. Pursuant to the Mississippi Constitution, Petitioner is under the management and control of the Board of Trustees of State Institutions of Higher Learning. Petitioner has a long-standing tradition of providing quality undergraduate, graduate, post-graduate, and adult higher education and professional level education in a wide variety of fields, athletics, music, entertainment, and cultural programs and offerings, among other attributes. Petitioner currently serves over 5,300 national and international students across five campuses in the Jackson, Mississippi metropolitan area.

2. Petitioner has been for a long time and is currently extensively engaged in the business of providing educational services. In connection with the promotion, marketing, and provision of such services, Petitioner has extensively used and continues to use, since well prior to Registrant's filing date and alleged use of Registrant's claimed THEEILOVE mark, Petitioner's THEE I LOVE mark for both goods and

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services. Petitioner first adopted and used its well-known THEE I LOVE name and mark in the 1940s and continues to use the mark in U.S. commerce. Petitioner has also utilized for a long time numerous other trademarks, service marks, slogans, tag lines, and the like (“marks”), to promote and present its offerings of goods and services indicative of its rich traditions and quality of services and education. The public widely identifies the mark THEE I LOVE with the University.

3. Petitioner has regularly used its THEE I LOVE mark as an institutional mark since at least the 1940s and, more recently, with a variety of goods and services as representative of its university offerings and athletic and other events and on products sold in multiple outlets, University store(s), and the Internet via both Petitioner and vetted licensees. In addition to its strong common law rights and the substantial goodwill developed in the THEE I LOVE mark, Petitioner also owns United States Trademark Registration No. 6,050,006 for the mark HAIL HAIL TO THEE, for ‘t shirts’ in Class 25 on the Supplemental Register, and multiple state registrations including the following registration with the Office of the Mississippi Secretary of State: the words THEE I LOVE, No. 15580, for ‘T-shirts, university alma mater, social media’ in the Classification entitled ‘Clothing, footwear, headgear’.

4. Petitioner has a long-standing, well-known, and closely-maintained association with its THEE I LOVE mark and controls its use and promotion, as well as for its other marks, through a mark licensure program for its goods and services. Petitioner has long-

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utilized, and currently continues to utilize, its THEE I LOVE mark as associated with and representative of the University and institution, its students, and its alumni and as the institutional public image of the University.

5. As a result of its significant local, regional, national, and international publicity and notoriety and affiliation with Petitioner, the THEE I LOVE mark is well-known by consumers of its goods, products, and services throughout the State of Mississippi, the South, the United States, and the world. Petitioner's mark is famous as an institutional mark that has represented the University for a long period of time. The trading and purchasing public has come to recognize Petitioner's THEE I LOVE mark as identifying Petitioner and its University and institution as the source of the relevant goods and its services. Petitioner's THEE I LOVE mark represents valuable goodwill built upon and from long-term use and effort that exclusively belongs to Petitioner.

6. Petitioner's THEE I LOVE mark has been and is used and offered by Petitioner in interstate commerce on numerous goods and services including in relevant part, but not limited to, apparel such as T-shirts and sweatshirts ("Petitioner's Goods").

7. Petitioner is the owner of the common law trademark rights for THEE I LOVE and is the applicant for the same word mark for registration with the USPTO as a standard character mark, as well as the applicant for a design logo mark for registration with the USPTO as a design plus words, letters, and/or numbers using the same three words.

8. Petitioner is the owner of an in-use based application, specifically U.S. Application Serial No. 88728596 for the mark THEE I LOVE in International Class 6 for use with vehicle tags, Class 25 for use with T-shirts and sweatshirts, and Class 41 (“Petitioner’s First Application”). Petitioner is also the owner of another in-use based application, specifically U.S. Application Serial No. 88730067 for the design logo mark THEE I LOVE in International Class 25 for use with T-shirts (“Petitioner’s Second Application”).

Registrant’s Mark

9. To the best of Petitioner’s knowledge, the claimed THEEILOVE mark shown in U.S. Trademark Registration No. 5,496,751 was registered on June 19, 2018, by Business Moves Consulting, Inc., DBA Business Moves, a Mississippi corporation with a place of business at 2827 St Roch Ave., New Orleans, Louisiana 70122 (“Registrant” or “Business Moves”).

10. Registrant filed its registration application for the claimed mark THEEILOVE (“Claimed THEEILOVE Mark”) on November 2, 2017.

11. Notwithstanding Petitioner’s prior rights in and to Petitioner’s THEE I LOVE marks (see Count II below), Registrant filed its registration application for the Claimed THEEILOVE Mark, reciting goods in Class 25, claiming FIRST USE on 12-24-2005 and FIRST USE IN COMMERCE on 3-3-2017.

12. Registrant is the record owner of U.S. Registration No. 5,496,751 (“Registrant’s Registration”) for the Claimed THEEILOVE Mark in Class 25 for

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alleged use with the following extensively long list of goods:

“Clothing, namely, athletic sleeves; Clothing, namely, base layers; Clothing, namely, crops; Clothing, namely, folk costumes; Clothing, namely, hand-warmers; Clothing, namely, khakis; Clothing, namely, neck warmers; Clothing, namely, thobes; Footwear for men; Footwear for women; Footwear made of vinyl; Footwear, namely, pumps; Footwear, namely, rubbers; Hats; T-shirts; Athletic footwear; Baby layettes for clothing; Baseball caps and hats; Bed jackets; Belts; Belts for clothing; Bomber jackets; Camouflage jackets; Chef hats; Denim jackets; Down jackets; Fascinator hats; Fur hats; Fur jackets; Gloves as clothing; Graphic T-shirts; Head wraps; Headbands for clothing; Heavy jackets; Hiking jackets; Hoods; Hunting jackets; Jackets; Jerseys; Knit jackets; Leather hats; Leather jackets; Leather belts; Light-reflecting jackets; Long jackets; Mantles; Motorcycle jackets; Outer jackets; Padded jackets; Padding jackets; Pockets for clothing; Rain hats; Rain jackets; Rainproof jackets; Reversible jackets; Riding jackets; Safari jackets; Sedge hats (suge-gasa); Sheepskin jackets; Shell jackets; Short sets; Shoulder wraps; Shoulder wraps for clothing; Ski jackets; Small hats; Smoking jackets; Sports jackets; Sports caps and hats; Stocking hats; Stuff jackets; Suede jackets; Sweat jackets; Toboggan hats; Top hats; Track jackets; Trekking jackets; Underarm clothing shields; Wind resistant jackets; Wind-jackets; Woolly hats.” (“Registrant’s Claimed Goods”, exactly as listed in Registrant’s Registration).

Additional Relevant Facts/Statements/Allegations

13. On February 11, 2020, the USPTO issued an Office Action in Petitioner's First Application in which the USPTO refused registration of Petitioner's THEE I LOVE mark under Trademark Act Section 2(d), likelihood of confusion in part as to International Class 25 only, based on Registrant's Registration. Further, the USPTO also preliminarily refused registration of Petitioner's THEE I LOVE mark under Trademark Act Section 2(d), likelihood of confusion, based on a prior-filed pending application of Registrant, which is U.S. Application Serial No. 88707020 ("Registrant's Application") for the word mark THEE I LOVE in International Class 25 for alleged use with the following also extensively long list of goods AND services covering multiple goods and services classifications:

"Bottoms as clothing; Fabric sold as an integral component of finished clothing items, namely, Back packs; Backpacks with rolling wheels; Backpacks, book bags, sports bags, bum bags, wallets and handbags; Drawstring bags; All-purpose athletic bags; Leather bags; Sack packs, namely, drawstring bags used as backpacks; Straps for carrying Bags and backpacks. Music and sound recording and advertisement and business consulting services. Leather goods, purses and hand bags. marketing services. online blogs. Magazines and printed materials. cups and mugs. retail stores and fashion shows and entertainment events featuring live music and events featuring pre recorded music.; Straps for carrying luggage bags. clothing, hats and footwear, namely, shirts baseball caps and tennis shoes

advertising services; business management; business administration services; providing office functions. license plates made of metal and novelty license plates and souvenir license plates. leather goods and events featuring music and games. party and nightclub promotions; Tops as clothing.” (“Registrant’s Listed Goods”, exactly as written and listed in Registrant’s Application). Registrant’s Application was abandoned on September 17, 2020 (Notice of Abandonment date) and was apparently revived on March 13, 2021. Although not relevant to this Petition, the Registrant’s Application will become the subject of a duly filed Notice of Opposition by the Petitioner if and when any Notice of Allowance is published.

14. Also on February 11, 2020, the USPTO issued an Office Action in Petitioner’s Second Application in which the USPTO refused registration of Petitioner’s THEE I LOVE design logo mark under Trademark Act Section 2(d), likelihood of confusion, also based on Registrant’s Registration. Further, the USPTO also preliminarily refused registration of Petitioner’s THEE I LOVE design logo mark under Trademark Act Section 2(d), likelihood of confusion, also based on the same prior-filed pending Registrant’s Application No. 88707020. The third basis of refusal listed in that Office Action will be addressed by Petitioner upon subsequent continued prosecution.

15. The USPTO issued Suspension Letters in Petitioner’s First Application and Petitioner’s Second Application. Therefore, action in both applications has been suspended pending final disposition of the Registrant’s Application No. 88707020.

16. Petitioner has standing to bring this cancellation proceeding and has a reasonable belief that it will continue to be harmed by Registrant's Registration, as well as by Registrant's Application, because Registrant's Registration (AND Registrant's Application) form the basis of the USPTO's refusals of both Petitioner's First Application AND Petitioner's Second Application.

17. Registrant's Registration was issued on June 19, 2018, which was within five (5) years of the filing date of this Petition for Cancellation. Therefore, this Petition for Cancellation is timely filed. Moreover, certain Counts below are not dependent upon or bound by such five-year time period.

18. Registrant also filed a trademark infringement action against Petitioner's licensees, incredulously claiming infringement of Registrant's Claimed THEEILOVE Mark, in the United States District Court, Eastern District of Louisiana, No. 2:20-cv-839. The District Court dismissed the action. Registrant has appealed the decision to the U.S. Court of Appeals for the Fifth Circuit in Cause No. 20-30796. These actions are attempts to preclude Petitioner and its licensees from using Petitioner's own THEE I LOVE mark.

COUNT I: FALSE SUGGESTION OF CONNECTION TO PETITIONER INSTITUTION AND/OR NAME OR IDENTITY
Section 2(a) of the Lanham Act,
15 U.S.C. § 1052(a)

19. Petitioner restates and incorporates by reference all preceding allegations.

20. Petitioner's THEE I LOVE mark has been so closely associated with Petitioner and its University and institution for so long that Petitioner's goods and services have become identified with Petitioner itself.

21. Registrant's Claimed THEEILOVE Mark falsely suggests a connection with the Petitioner and its institution and has a potential to disparage and bring into contempt or disrepute Petitioner's THEE I LOVE mark that Petitioner seeks to protect. Section 2(a) of the Lanham Act, specifically 15 U.S.C. § 1052(a), prohibits registration on the Principal Register of a mark which disparages or falsely suggests a connection with persons, living or dead, institutions, beliefs, or national symbols, or which brings them into contempt or disrepute.

22. Registrant's Claimed THEEILOVE Mark is so much like and the same as Petitioner's THEE I LOVE mark, except for the spacing between letters, that the former is and/or would be recognized as identifying or falsely suggesting a connection with the latter such that it points uniquely and unmistakably to Petitioner and its institution and/or its name or identity.

23. Neither Petitioner nor its institution are connected or identified with the Registrant, its activities, or its goods under Registrant's Claimed THEEILOVE Mark.

24. The reputation and/or fame of Petitioner's THEE I LOVE mark is such that, when and/or if Registrant's Claimed THEEILOVE Mark is used with Registrant's goods, a connection or identification with Petitioner and its institution would be presumed.

25. On information and belief, Registrant intentionally identifies goods and/or services that it provides under Registrant's claimed THEEILOVE mark with Petitioner's THEE I LOVE mark and brand(s) and misrepresents that Registrant's claimed THEEILOVE mark includes Petitioner's Goods and/or its services.

Further on information and belief, Registrant intentionally and purposely selected and adopted Registrant's claimed THEEILOVE mark for the purpose and intention of trading on Petitioner's THEE I LOVE mark and brand(s) that were already long-associated with Petitioner long before Registrant's adoption and use. Registrant has misrepresented and continues to misrepresent the source of its THEEILOVE products and goods and continues to deceive the consuming public and trade on Petitioner's goodwill and the reputation of its long-used marks and brand(s), which further results in the tarnishing of Petitioner's marks and brands.

26. Petitioner has standing to petition to cancel Registrant's Registration as Petitioner believes it has

been, is being, and will continue to be harmed by such false suggestion of connection and by the continued existence of Registrant's Claimed THEEILOVE Mark registration and by Registrant maintaining ANY rights whatsoever in any THEE I LOVE or THEEILOVE mark.

COUNT II: PRIORITY OF USE AND LIKELIHOOD OF CONFUSION
Section 2(d) of the Lanham Act,
15 U.S.C. § 1052(d)

27. Petitioner restates and incorporates by reference all preceding allegations.

28. Petitioner has maintained continuous use of its THEE I LOVE word mark, according to Petitioner's First Application, at least as early as the 1940s (for both FIRST USE and FIRST USE IN COMMERCE) for institutional University services, and at least as early as 9-9-2010 (for both FIRST USE and FIRST USE IN COMMERCE) for apparel that lists T-shirts and sweatshirts. Further, Petitioner has maintained continuous use of its THEE I LOVE design logo mark, according to Petitioner's Second Application, at least as early as 2-1-2017 (for both FIRST USE and FIRST USE IN COMMERCE) for apparel that lists T-shirts. These dates are listed in Petitioner's application data for each respective relevant mark. Registrant has allegedly used Registrant's Claimed THEEILOVE Mark for ALL of its listed goods since 12-24-2005 (listed FIRST USE date) and since 3-3-2017 (listed FIRST USE IN COMMERCE date). Therefore, Petitioner has maintained continuous use of both its THEE I LOVE word mark AND its THEE I LOVE design logo mark

IN COMMERCE prior to Registrant's alleged earliest use in commerce of Registrant's Claimed THEEILOVE Mark listed in Registrant's Registration.

29. Petitioner has continuously used both its THEE I LOVE word mark AND its THEE I LOVE design logo mark IN COMMERCE in connection with Class 25 apparel, for example, T-shirts and sweatshirts, among other institutional services and unlisted goods, prior to Registrant's alleged earliest use in commerce of Registrant's Claimed THEEILOVE Mark shown in Registrant's Registration AND prior to the filing date of Registrant's Registration application of 11-2-2017.

30. Petitioner has continuously used its THEE I LOVE name and mark since the 1940s.

31. On information and belief, Petitioner has priority over Registrant to use Petitioner's THEE I LOVE word mark AND its THEE I LOVE design logo mark. On information and belief, Petitioner's rights in its THEE I LOVE marks predate Registrant's alleged right in Registrant's Claimed THEEILOVE Mark.

32. Petitioner has expended considerable effort, time, and financial support in advertising and promoting its THEE I LOVE word mark and, more recently, its design logo mark through extensive licensing and sales in connection with Petitioner's Goods as well as Petitioner's services. Petitioner has spent many years marketing its offerings, services, products, and brands in connection with its THEE I LOVE mark(s) via licensing and a wide range of media including print, online, television, and radio.

33. The purchasing public and those seeking higher education services have come to know, rely upon, and recognize Petitioner's THEE I LOVE word mark, and more recently Petitioner's THEE I LOVE design logo mark, as strong indicators of the source of Petitioner's Goods as well as its services, that being Jackson State University.

34. Petitioner's THEE I LOVE word mark and design logo mark are strong and inherently distinctive.

35. On information and belief, Registrant's Claimed THEEILOVE Mark is clearly likely to be and is in fact pronounced exactly the same as Petitioner's THEE I LOVE word mark AND Petitioner's THEE I LOVE design logo mark by an ordinary American consumer, particularly by a typical local and/or regional consumer. This is likely true even though the "O" of "LOVE" in the Petitioner's design logo mark is characterized and stylized as a heart and intended to be read as an "O". This is also likely true even though the Registrant's Claimed THEEILOVE Mark is 'one word' and the Petitioner's word mark and design logo mark are not.

36. On information and belief, both Petitioner's THEE I LOVE word mark and Petitioner's THEE I LOVE design logo mark are exactly identical in sound to Registrant's Claimed THEEILOVE Mark.

37. Petitioner's THEE I LOVE word mark and Registrant's Claimed THEEILOVE Mark are nearly identical and confusingly similar in appearance, sight, sound, meaning, and overall commercial impression because the letters are exactly the same and the marks

are read exactly the same, despite the minor non-substantive difference of the three words of the former and the script and ‘one word’ of the latter. Further, Petitioner’s THEE I LOVE design logo mark and Registrant’s Claimed THEEILOVE Mark are also nearly identical and confusingly similar in sight and overall commercial impression because the letters are virtually and substantially the same and the marks are also read exactly the same, despite minor differences in design element and use of a stylized heart read as an “O” in place of the “O” of “LOVE” in the former.

38. The identification of Registrant’s Claimed Goods in Registrant’s Registration, aside from appearing to be an exhaustively large and assumably provable accurate list of a wide variety of goods with which Registrant’s Claimed THEEILOVE Mark is being used or supposed to be used, is unrestricted as to classes of consumers.

39. Registrant’s Claimed Goods are presumed to be available to and directed to all classes of consumers.

40. The identification of Registrant’s Claimed Goods in Registrant’s Registration is unrestricted as to channels of trade.

41. Registrant’s Claimed Goods are presumed to travel in all channels of trade.

42. Registrant’s Claimed Goods are directly related to Petitioner’s Goods.

43. Registrant’s Claimed Goods are overlapping with Petitioner’s Goods.

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44. Petitioner's Goods of T-shirts and sweatshirts directly encompasses Registrant's Claimed Goods and its extensively long list of products on which Registrant claims to use Registrant's Claimed THEEILOVE Mark.

45. Petitioner's Goods and Registrant's Claimed Goods are identical to the extent that they both encompass Class 25 apparel including T-shirts and sweatshirts.

46. Registrant's Claimed THEEILOVE Mark so resembles Petitioner's THEE I LOVE word mark, and Petitioner's THEE I LOVE design logo mark, particularly concerning the words and letters themselves, when used on or in connection with Registrant's Claimed Goods, as to be likely to cause confusion, and/or to cause mistake, and/or to deceive the trade and the consuming public.

47. The goods of the Petitioner and the goods of the Registrant are offered to the same, similar, or overlapping classes of purchasers and consumers.

48. The use of Registrant's Claimed THEEILOVE Mark on or in connection with Registrant's Claimed Goods is likely to cause consumers and purchasers to mistakenly believe that Registrant's Claimed Goods originate with or are sponsored, endorsed, and/or approved by Petitioner and its University or institution, or are in some other way affiliated, connected, and/or associated with Petitioner and its University or institution, to the detriment of Petitioner and its University or institution. Any use by Registrant of Petitioner's rightful mark(s) is damaging and continues to damage Petitioner's marks and brands

and the latter's long-established association and identity of the Petitioner's THEE I LOVE mark with Petitioner and its brands.

49. The continued registration and use of Registrant's Claimed THEEILOVE Mark by Registrant in any way or association, and particularly associations with the recited goods, is likely to cause confusion as to the source or origin of Registrant's goods and is likely to mislead consumers and/or purchasers, all to the Petitioner's damage and continued damage.

50. Registrant's Claimed THEEILOVE Mark has in no way whatsoever ever been, or is now or ever in the future to be, associated with Petitioner or its long-standing and reputable University or institution, or with any of Petitioner's Goods, or with any of Petitioner's long-provided, valuable, and respectable higher education services.

51. Registrant admitted by affirmatively asserting in the federal court trademark litigation matter cited above that there is likely confusion between the mark(s) used by the defendants (Petitioner's licensees), which are in fact Petitioner's rightful mark(s), when used in connection with its products and/or services, and Registrant's Claimed THEEILOVE Mark, when used in connection with its products and/or services.

52. Consequently, Petitioner respectfully requests that the Board sustain this Petition for Cancellation and grant judgement as soon as possible in Petitioner's favor by ordering the cancellation of

Registrant's Registration on the grounds of priority of use by the Petitioner and likelihood of confusion.

**COUNT III: INVALIDITY DUE TO FRAUD
Section 14(3) of the Lanham
Act, 15 U.S.C. § 1064(3)**

53. Petitioner restates and incorporates by reference all preceding allegations.

54. Federal Rule of Civil Procedure 9(b) provides that in alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. Further, malice, intent, knowledge, and other conditions of a person's mind may be alleged generally.

55. Petitioner's use of its THEE I LOVE word mark, and its design logo mark, includes its use on apparel including t-shirts and sweatshirts in Class 25, as well as use for institutional services over a long period of time. Although Registrant includes those same goods, as well as an extensive list of other apparel goods, in Class 25 in its registration, on information and belief Registrant does not actually use its mark in commerce in conjunction with such goods described.

56. On information and belief, Registrant knew or should have known of Petitioner's mark and long-term use. On information and belief, Registrant intentionally registered, used, and continues to use Petitioner's word mark as its own to the detriment and damage of Petitioner. Further, if the fraudulently-obtained registration of Registrant's Claimed THEEILOVE Mark is allowed to remain registered,

Petitioner asserts that such continuation will cause continued damage to Petitioner and adversely affect Petitioner's rights in both its THEE I LOVE word mark and design logo mark.

57. On information and belief, Registrant did not and does not use Registrant's Claimed THEEILOVE Mark in commerce in connection with the goods recited in its application(s), at the time of application to the present, which includes the goods described in Petitioner's applications. Registrant's alleged use of Registrant's Claimed THEEILOVE Mark as set forth in its application(s), in connection with the goods recited in its application(s) and the use dates thereof, is fraudulent.

58. On information and belief, no evidence exists of Registrant's use of Registrant's Claimed THEEILOVE Mark in connection with the goods recited in its application(s) via a search of Internet website(s) or elsewhere.

59. On information and belief, Registrant made the false statements as to use of Registrant's Claimed THEEILOVE Mark and first use and first use in commerce dates with the intent to obtain a registration, knowing of Petitioner's mark, and to which Registrant is not entitled whatsoever.

60. On information and belief, Registrant knowingly made false statements as to use of Registrant's Claimed THEEILOVE Mark and first use and first use in commerce dates with the intent to obtain a registration, knowing of Petitioner's mark, and to which Registrant is not entitled whatsoever.

61. On information and belief, Registrant's Claimed THEEILOVE Mark is being used by Registrant to misrepresent the source of the goods on or in connection with which the mark is used. Such use represents a false designation of origin and a misrepresentation as to the origin or source of goods and/or services.

**COUNT IV: INVALIDITY DUE TO LACK OF
USE OR NON-USE IN
COMMERCE**
**Section 1 of the Lanham Act, 15
U.S.C. § 1051**

62. Petitioner restates and incorporates by reference all preceding allegations.

63. On information and belief, Registrant's Claimed THEEILOVE Mark was registered based, at least in part, on Registrant's alleged actual use in commerce for all goods listed in the registration. Further on information and belief, Registrant has not used its registered mark in commerce for such goods described, which includes the goods described in Petitioner's applications, at any time before or after Registrant's registration or filing date of the application for registration.

64. As a result, Registrant's Registration for Registrant's Claimed THEEILOVE Mark is void and is invalid as a matter of law, particularly as to all goods described therein.

WHEREFORE, Petitioner believes that it has been, is, and will continue to be damaged by the Registrant's Claimed THEEILOVE Mark. Petitioner has priority of use of its THEE I LOVE word mark AND design logo mark over Registrant. Further, pursuant to Section 1 of the Lanham Act, 15 U.S.C. § 1051; Section 2 of the Lanham Act, 15 U.S.C. §§ 1052(a) and 1052(d); and Section 14 of the Lanham Act, 15 U.S.C. § 1064(3), respectively, Petitioner respectfully requests that the Trademark Trial and Appeal Board:

1. Sustain this Petition for Cancellation;
2. Cancel U.S. Registration No. 5,496,751; and
3. Grant Petitioner any and all further relief the Board deems appropriate, equitable, just and proper.

DATE: May 12, 2021

Respectfully submitted,

JACKSON STATE UNIVERSITY

Lynn Fitch, Attorney General of Mississippi

/s/ Lawrence A. Schemmel
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**ATTORNEYS FOR PETITIONER,
JACKSON STATE UNIVERSITY**

*Trademark Trial and Appeal Board
Electronic Filing System.
<https://estta.uspto.gov>*
ESTTA Tracking number:
ESTTA1176511
Filing date: **12/04/2021**

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD**

Proceeding	92077130
Party	Defendant Business Moves Consulting Inc DBA Business Moves
Correspondence Address	BUSINESS MOVES CONSULTING INC 2827 ST ROCH AVE NEW ORLEANS, LA 70122 UNITED STATES Primary Email: cpaulbordenave@yahoo.com 972-589-5495
Submission	Motion to Suspend for Civil Action
Filer's Name	Business Moves Consulting inc
Filer's email	cpaulbordenave@yahoo.com
Signature	/curtis bordenave/
Date	12/04/2021
Attachments	Motion-1of3.pdf(5580956 bytes) Motion-2of3.pdf(3811971 bytes) Motion-3of3.pdf(2622960 bytes)

APPENDIX 3

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD**

Cancellation No. 92077130

Registration No. 5,496,751

Mark: THEEILOVE

[Dated December 4, 2021]

JACKSON STATE UNIVERSITY,)
Petitioner,)
)
v.)
)
BUSINESS MOVES CONSULTING, INC.)
DBA BUSINESS MOVES,)
Registrant.)
)

**MOTION TO SUSPEND PROCEEDINGS
PENDING THE OUTCOME OF A CIVIL
ACTION**

Registrant Business Moves Consulting, Inc. dba Business Moves, (“Business Moves” or “Registrant”) hereby moves to suspend the above captioned proceeding pending the final disposition of a currently pending action, pursuant to 37 C.F.R. § 2.117 and

TBMP § 510.02(a). A copy of the currently pending action before the United States Court of Appeals for the Fifth Circuit is attached as Exhibit A. The pending civil action in the present situation involves all of Jackson State University licenses through its licensing agent Collegiate Licensing Company, L.L.C., with Registrant as Plaintiffs/Appellants.

Pursuant to 37 C.F.R. § 2.117(a), when a party or parties involved in a pending TTAB proceeding are involved in a civil action that may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992). Proceedings may be suspended *sua sponte* by the Board or upon motion for good cause. C.F.R. § 2.117(c). A civil action may consider broader issues beyond right to registration and therefore, judicial economy is served by suspension. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015).

It is the “standard procedure” of the Board to suspend administrative proceedings, such as the current cancellation proceeding, pending the outcome of related civil litigation when a party or the parties are involved in court proceedings concerning the same marks and issues. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (quoting 6 McCarthy on Trademarks and Unfair Competition §32:47 (5th ed. updated September 2017)). Unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final

determination of the other proceeding may have a bearing on the issues before the Board. *Id.* In order to warrant a suspension, the civil action does not have to be dispositive of the Board proceeding. Instead, the civil action need only “have a bearing on the issues before the Board” to justify a suspension. *Id.* The civil action justifies suspension as there are clear bearings on the issues before the Board, in addition to questions of fact, questions of law, and common parties.

The pending civil action in the present situation involves all of Jackson State University licenses through its licensing agent Collegiate Licensing Company, L.L.C. In addition, determinations of ownership, priority, and likelihood of confusion regarding the contested mark will have bearing on the determination of the issues in the present TTAB proceeding. Suspension of this TTAB proceeding is warranted pending the final disposition of civil action, as conclusions of law, findings of fact, and judgment by the Court will have a direct bearing on the key issues before the Board.

The Board has sole discretion regarding the suspension of a Board proceeding pending the final determination of another proceeding. *Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990). The court in which a civil action is pending has no power to suspend proceedings in a case before the Board. *Id.* The interests of judicial economy and the parties’ resources are best served by a suspension of the present TTAB proceeding.

CONCLUSION

The currently pending civil action involves Jackson State University licenses through its licensing agent Collegiate Licensing Company, L.L.C., as well as Registrant. The action will have bearing on a variety of issues relevant to the present TTAB proceeding between the same parties, such as determinations of priority, ownership, and likelihood of confusion regarding the contested mark. In addition, suspension befits the interest of judicial economy. Registrant respectfully requests that its motion to suspend these proceedings be granted in accordance with 37 C.F.R. § 2.117.

Dated: December 4, 2021

Respectfully Submitted,

By: */Curtis Bordenave /*
Curtis Bordenave VP
2827 St Roch Ave New Orleans LA 70122

Registrant
Business Moves Consulting, Inc.

*Trademark Trial and Appeal Board
Electronic Filing System.
<https://estta.uspto.gov>*
ESTTA Tracking number:
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Filing date: **09/28/2022**

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD**

Proceeding no.	92077130
Party	Defendant Business Moves Consulting Inc DBA Business Moves
Correspondence Address	BUSINESS MOVES CONSULTING INC 2827 ST ROCH AVE NEW ORLEANS, LA 70122 UNITED STATES Primary Email: cpaulbordenave@yahoo.com 972-589-5495
Submission	Other Motions/Submissions
Filer's Name	Business Moves Consulting Inc
Filer's email	cpaulbordenave@yahoo.com, cpaulbordenavejr@gmail.com
Signature	/Curtis Bordenave/
Date	09/28/2022
Attachments	untitled 01.pdf(3107100 bytes) untitled 02.pdf(3108381 bytes)

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing document has been served on Jackson State University through its counsel, Whitaker Rayner, wrayner@joneswalker.com. Certified this the 28th day of September, 2022

*/s/*Curtis Bordenave
BUSINESS MOVES CONSULTING INC.

APPENDIX 4

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD**

Cancellation No. 92,077,130

Registration No. 5,496,751

Mark: THEEILOVE

[Dated September 28, 2022]

JACKSON STATE UNIVERSITY,)
Petitioner,)
)
v.)
)
BUSINESS MOVES CONSULTING, INC.,)
DBA BUSINESS MOVES,)
)

**REGISTRANT'S RESPONSE TO PLAINTIFF
NOTIFICATION OF APPELLATE DECISION**

Pursuant to the TTAB's instruction, the Registrant, Business Moves Consulting Inc., notifies the Trademark Trial and Appeal Board that on August 24, 2022, United States Court of Appeals for the Fifth Circuit affirmed the dismissal of the civil action the subject of the stay in this matter.

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A copy of the Fifth Circuit's opinion and judgment has already been submitted as Exhibit A. by Petitioner, Registrant request that the stay in this matter be continued. pending its appeal to the United States Supreme Court. Registrant is in the process of filing a appeal to the United States Supreme court. When the appeal is filed, a copy of appeal will be submitted to the TTAB by Registrant. This 28th day of September, 2022.

Respectfully Submitted,

**BUSINESS MOVES
CONSULTING INC.**

BY: /s/*Curtis Bordenave*
2827 St. Roch Ave.
New Orleans, LA 70122

APPENDIX 5

UNITED STATES PATENT AND
TRADEMARK OFFICE
Trademark Trial and
Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number:
571-272-8500
General Email:
TTABInfo@uspto.gov

KGC

October 20, 2022

Cancellation No. 92077130

Jackson State University

v.

*Business Moves Consulting
Inc. DBA Business Moves*

Kevin G. Crennan, Interlocutory Attorney:

Petitioner submitted a copy of a decision of the U.S. Court of Appeals for the Fifth Circuit (27 TTABVUE) in a case the Board found may bear on this cancellation proceeding, which was suspended as a result of this appeal (26 TTABVUE 4).

Respondent requests proceedings remain suspended pending an appeal to the U.S. Supreme Court, which Respondent is purportedly in the process of filing. 28 TTABVUE.

Pursuant to Trademark Rule 2.117(a), “[a] civil action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any appeal or other further review has expired with no further review sought.”

In view thereof, proceedings remain **suspended**, and the parties must notify the Board within **twenty (20) days** after the time for any appeal or other further review, such as to the U.S. Supreme Court, has expired and Respondent has not sought further review, so that this proceeding may be called up for appropriate action.

If Respondent appeals to the U.S. Supreme Court, it must, within **twenty (20) days** from filing the appeal, submit to the Board and serve on Petitioner a copy of the appeal for the Board to determine whether continued suspension of this cancellation proceeding is warranted.