

4. Defendants operate an internet website at www.buckeyeillustrated.com, which is a commercial website devoted entirely to Ohio State athletics.

5. This court has jurisdiction over this matter under 15 U.S.C. § 1125 and 28 U.S.C. § 1338. Venue is proper in this Court under 28 U.S.C. § 1391(b), as Ohio State's cause of action arose and Ohio State is being injured in this judicial district, and because Defendants have purposefully availed themselves of the privilege of doing business in this forum.

The Ohio State "Buckeye" Trademarks

6. Established in 1870, The Ohio State University has developed into one of the most well-respected institutions of higher learning in the country.

7. For more than 140 years Ohio State has been actively engaged in providing college level educational courses and college sport exhibition events and recreation programs, dramatic and musical entertainment events. Ohio State operates its own athletics website and has sold game day athletics programs for more than 100 years. Ohio State also licenses and markets various products and services, including publications, clothing, and other merchandise using Ohio State's trademarks.

8. In connection with the activities and products described in the preceding paragraphs, Ohio State is the owner of, among others, the following federally registered trademarks:

- a. "BUCKEYES" — registration number 1,152,683, registered April 28, 1981, to provide college sport exhibition events and recreation programs;
- b. "BUCKEYES" — registration number 1,267,035, registered on February 14, 1984 for use on: toy stuffed animals, Christmas decorations, bean bags, plastic toys, foam toys and equipment sold as a unit for playing a stick ball game; clothing-namely, T-shirts, ties, scarves, bibs, sweatshirts, athletic shorts, hats, aprons, jogging suits and sweaters; blankets, textile placemats, handkerchiefs, quilts and pennants; tumblers, cups, mugs, glasses and insulated beverage

container holders; hassocks, bean bag leisure furniture, letter holding boxes, mirrors, and folding seats for use by individuals in athletic stadiums and plaques; tote bags; pens, posters, decals, and paintings; jewelry-namely, rings, pins, belt buckles and key chains, all being made of precious metal; electric lamps; providing college level educational programs, sport exhibition events and recreation programs;

- c. BUCKEYE DESIGN — registration number 2,437,954, registered January 2, 2001 for use on decals and stickers;
- d. "OHIO STATE" — registration number 1,294,114, registered September 11, 1984 for providing college level educational programs, sport exhibition events, recreation programs, toy stuffed animals, Christmas decorations, bean bags, plastic figurine toys, foam figurine toys, bats, balls and other equipment sold as a unit for playing a stick ball game, shoe laces, t-shirts, ties, scarves, bibs, sweatshirts, shorts, hats, aprons, jogging suits, sweaters, blankets, pennants, textile placemats, handkerchiefs, quilts, tumblers, cups, mugs, glasses, beverage container insulators, hassocks, bean bag leisure furniture, mirrors, and folding seats for use by individuals in athletic stadiums, tote bags, pens, posters, decals, paintings, letter holding boxes, rings, pins, belt buckles, key chains and electric lamps;
- e. "OHIO STATE" — registration number 1,152,682, registered April 28, 1981 for college sport exhibition events and recreation programs, dramatical and musical entertainment events and college level educational courses;
- f. "OSU" — registration number 1,121,595, registered July 3, 1979 for college sport exhibition events and recreation programs, dramatical and musical entertainment events and college level educational courses;
- g. "OHIO STATE UNIVERSITY" — registration number 1,294,115, registered September 11, 1984 for jewelry-namely, rings, pins, belt buckles and key chains; pens, posters, decals, paintings, letter holding boxes; hassocks, bean bag leisure furniture, plaques, mirrors and folding seats for use by individuals in athletic stadiums; tumblers, cups, mugs, glasses and beverage container insulators; : blankets, pennants, textile placemats, handkerchiefs and quilts; clothing-namely, t-shirts, ties, scarves, bibs, sweatshirts, shorts, hats, aprons, jogging suits and sweaters; toy stuffed animals, Christmas decorations, bean bags, plastic figurine toys, foam figurine toys, and equipment-namely, bats and balls sold as a unit for playing a stick ball game; and : providing college level educational programs, sport exhibition events and recreation programs; and
- h. "O" — registration number 2,689,612, registered February 25, 2003 for clothing, namely, jackets, sweaters, hats and T-shirts.

9. Certified copies of the above referenced registrations have been submitted and are of record in this matter.

10. The certificates of registration identified in the preceding paragraph are valid and subsisting, and Ohio State has record title in the trademarks described above.

11. The certificates of registration are prima facie evidence of the validity of the registered trademarks, Ohio State's ownership of the registered trademarks, and Ohio State's exclusive right to use the registered trademarks in connection with the goods and services specified in the certificates of registration enumerated above. All of the registered marks are incontestable, which provides conclusive evidence of their validity under 15 U.S.C. § 1115(b), and constructive notice of the registrant's claim of ownership under 15 U.S.C. § 1072.

12. In addition, Ohio State owns common law trademarks in the distinctive use of its school colors, scarlet and gray, in the appearance of its website www.ohiostatebuckeyes.com, and in the use of the capital letter "O" in block text in conjunction with the school colors, among others.

13. One of the most well-known marks associated with Ohio State is the "Athletic Logo":



14. The Athletic Logo is featured prominently in Ohio Stadium – most notably, on the scoreboard, where hundreds of thousands of cars pass the scoreboard, which can be clearly

seen from State Route 315, and where more than 100,000 football fans see it at every home game, along with millions of television viewers around the world:



15. Ohio State has historically used the colors scarlet and gray both alone and in connection with its registered and common law trademarks. In 1878, Ohio State adopted as its school colors “scarlet and gray.” Further, in connection with the promotion of its various academic, athletic, entertainment and philanthropic activities, Ohio State has historically used the school colors scarlet and gray and the term “Scarlet & Gray” to refer to, describe and indicate origin in various individuals, teams, school songs and organizations affiliated with Ohio State, as well as Ohio State’s two campus golf courses, “Scarlet” and “Gray”.

16. In the past 15 years, Ohio State has also used the colors black and white as secondary colors in its official athletic uniforms and in licensed uniforms.

17. In connection with the promotion of its various academic, athletic, entertainment and philanthropic activities, and in association with its registered and common law trademarks, many of which include the term “Buckeyes”, Ohio State has historically used the term “Buckeyes” to refer to and describe various individuals, teams, school songs and organizations affiliated with Ohio State, including use of the school fight song “Buckeye Battle Cry” since 1919 and adoption of “Brutus Buckeye” as the official Ohio State mascot in 1965.

18. In connection with the promotion of its various academic, athletic, entertainment and philanthropic activities, Ohio State has also historically used, as trademarks, both the Block O and the Block O with Buckeye Leaves:



19. Ohio State's use of the Block O has been continuous since 1910, use of the Block O with Buckeye Leaves trademarks has been continuous since 1973 and use of the Athletic Logo has been continuous since 1992; and the public now associates the Athletic Logo, the Block O, and the Block O with Buckeye Leaves trademarks solely as indicating origin in Ohio State.

20. Ohio State has used the registered trademarks and the common law trademarks described above (collectively the "Ohio State Trademarks") continuously and exclusively for identification with Ohio State and its academic, athletic and entertainment activities. The Ohio State Trademarks are strong and their respective reputation and goodwill have continuously grown and are now well known throughout the City of Columbus, the State of Ohio and the United States.

21. The Ohio State Trademarks have become and are now solely associated with Ohio State in the minds of consumers.

22. Ohio State's athletic teams and students have been known as "Buckeyes" since at least as early as 1920. Due to the long, extensive and continuous use of the term "Buckeye" in association with Ohio State teams, programs, and events, consumers now associate the term Buckeye with Ohio State. When used in connection with Ohio State athletics the term "Buckeye," as well as the other Ohio State Trademarks are strong and readily accepted by the public as hallmarks of Ohio State athletics.

23. Ohio State licenses and markets many items using the trademarks "Buckeye," "Buckeyes," "Brutus Buckeye," Block O, Block O with Buckeye Leaves, "Go Bucks," the Athletic Logo and the decal "Buckeye Leaf," which have been placed on the helmets of Ohio State football players for making an excellent play for more than 40 years.



24. As a result of Ohio State's fame and its extensive use, advertising, and sale of goods and performance of athletic services bearing the Ohio State Trademarks, the Ohio State Trademarks have acquired strong secondary meaning, have achieved favorable national recognition, and have become assets of significant value as symbols pointing only to Ohio State, its services, products and goodwill.

25. Ohio State approves and maintains quality control over all of the products and services it licenses and produces, the goods and services bearing its marks, and its trade dress to protect the tradition, prestige and goodwill associated with these marks, and Ohio State makes systematic efforts to safeguard the quality and integrity of the Ohio State marks, and the public assumes that Ohio State has approved, sponsored or endorsed all products and services bearing its trademarks.

26. For more than thirty (30) years, Ohio State has both used and licensed third parties to use the Ohio State Trademarks on various items and services, including clothing of all types, food products, restaurant services, internet websites, screen savers, athletic uniforms, calendars, novelties, books, household goods, toys, sporting goods, home furnishings, glassware, collectibles, pens and watches.

27. Ohio State's licensing program has become the most profitable collegiate licensing program in the United States in the past five (5) years, generating royalties of more than \$35 million. The past success of Ohio State's academic and athletic programs has resulted in extensive exposure of the Ohio State Trademarks to a national audience and has created a large demand for products and services bearing the Ohio State Trademarks throughout the United States.

28. Ohio State currently has approximately 500 authorized licensees for products using the Ohio State Trademarks on all types of clothing products, including shirts; sporting goods; calendars, athletic magazines, posters, books and paper products and writing instruments; food products and services, such as ice cream, breakfast cereals, popcorn snacks, pretzel snacks, tortilla chips, cinnamon cracker snacks, gourmet candies, hot dogs, cafés and restaurants, to computer equipment, such as screen savers, mouse pads, and wrist rests, hats, flags and banners.

Ohio State also licenses the sale of DVDs of important and memorable Ohio State athletic contests, which are a significant source of royalty income.

29. Ohio State's use of the words "Buckeye" and "Buckeyes" in connection with its trademarks and various activities has been continuous and the public now associates the words "Buckeye" and "Buckeyes" when used in conjunction with athletics services and many products to be affiliated with Ohio State.

30. Since 1997, Ohio State has published www.ohiostatebuckeyes.com, which is "The Official Website of Ohio State University Athletics," and features the Ohio State Trademarks throughout.

31. For at least 100 years, and continuing today, Ohio State also publishes, sells, and distributes print copies of athletics magazines and programs for Ohio State athletics teams and events. Currently, Ohio State licenses its Ohio State Trademarks to IMG, at a cost of over one million dollars, to publish athletic programs directed toward Ohio State fans.

32. Ohio State sells advertising in its publications, both on the official website www.ohiostatebuckeyes.com and within the pages of its official and/or licensed athletics magazines and programs.

33. Defendants are not and have not been licensed by Ohio State for any products or services.

Defendants' Infringing Use of the Ohio State Trademarks

34. Defendants publish a website at www.buckeyeillustraed.com and publish two electronic magazines, "Buckeye Gameday" and "Ohio State Buckeyes E-Book". Defendants are also in the process of printing over one hundred thousand copies of a football publication called "Buckeye Gameday, have published and sold advertising space within the "Buckeye Gameday" publication, on the website, and in the pages of the Ohio State Buckeyes E-Book.

35. The website www.buckeyeillustrated.com employs the trademark “Buckeye” in the domain name and throughout the pages of the website, and contains many other uses of the Ohio State Trademarks, including:

- a. The word “Buckeye” in large block letters similar to the font type used by Ohio State and in Ohio State’s school colors of scarlet and gray;
- b. A logo depicting the words “Buckeye Illustrated.com” and the claim “#1 Fan Site for Buckeye News and Information” also using Ohio State’s school colors of scarlet and gray;
- c. A section of the website designated as “Buckeye News” for each athletics team covered on the website, providing links to news stories relating to Ohio State athletics;
- d. An electronic version of a publication called “Buckeye Gameday” or “Buckeye Gameday Magazine” and the highly misleading statement that “At Buckeye Gamday [sic] we specialize in print and web media for Ohio State Buckeye men’s and women’s athletic programs”;
- e. An electronic publication identified as the “Gameday E-Book” or the “Ohio State Buckeyes E-Book”;
- f. A section of the website designated as the “Buckeye Gameday Fan Poll”;
and
- g. Numerous photographs depicting current and former Ohio State athletes in competition.

36. “Buckeye Gameday Magazine” features Ohio State’s “Buckeye” trademark in its name, and throughout the pages of the publication and contains many other uses of the Ohio State Trademarks, including:

- a. Repeated use of “Buckeye Gameday” throughout the publication;
- b. A section titled “2010 Buckeye Football Season Preview”;
- c. A purported advertisement that states “Buckeye Football presented by Gatorade” printed over a photograph of Ohio State football player Terrell Pryor; and
- d. A “Buckeye Football Schedule” that includes a watermark of the Ohio State Athletic Logo trademark;
- e. A “Buckeye Football Roster” and section titled “Buckeye Football Stats;” and
- f. Numerous photographs depicting current and former Ohio State athletes in competition.

37. According to the electronic pages of “Buckeye Gameday Magazine,” “100,000+ Copies” of the publication will be printed and will be “Distributed to 100’s of locations throughout the city of Columbus.”

38. The “Ohio State Buckeyes E-Book” appropriates the trademarks “Ohio State” and “Buckeye” as its name and contains numerous photographs depicting current and former Ohio State athletes in competition;

39. Defendants unauthorized use of the Ohio State Trademarks is commercial in nature and is intended to, and will, directly compete with the lawful publication, distribution and advertising commercial activities of Ohio State and its licensees to the detriment of Ohio State.

Likelihood of Confusion

40. The Ohio State Trademarks, as described herein, are quite strong in the context of a website or publication providing information exclusively related to Ohio State athletics.

41. The relatedness, or similarity, between materials either published or licensed by Ohio State and the Defendants' website and publications point to a high likelihood of confusion. Consumers of the information contained on the Defendants' website and publications are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by Ohio State. The information offered by Defendants is certainly likely to be connected to Ohio State in the mind of a prospective visitor to the website or reader of the publications.

42. Defendants have used both actual marks of Ohio State and styled their publications to appear like licensed or original Ohio State materials. This factor weighs heavily in favor of the likelihood of confusion.

43. The similarities between the predominant customers of the parties' respective goods and services and the similar marketing approaches employed by them are likely to lead consumers to believe that Defendants and Ohio State are affiliated in some way.

44. Consumers of Defendants' publications and website will not exercise a high degree of care when viewing Defendants' products. Internet consumers are especially unlikely to make significant efforts or to take care in ascertaining the true source of the material they view, particularly when both the domain name and the website itself display Ohio State's name and trademarks associated with Ohio State.

45. Defendants intentionally copied the Ohio State Trademarks intending to capitalize on the commercial value of Ohio State's reputation and good will, making this an exceptional case within the meaning of 15 U.S.C. § 1117.

46. Defendants use of the Ohio State Trademarks is not a fair use because the marks at issue are not used in the descriptive sense, but instead are used as marks.

47. Defendants are poised to expand the market and distribution channels for their products. Such expansion will undoubtedly enlarge the breadth of the competition between Ohio State and Defendants and further illustrates the likelihood that confusion among consumers will be compounded over time to Ohio State's detriment.

48. Defendants' actions constitute trademark infringement and unfair competition under the Lanham Act, 15 U.S.C. § 1114 and § 1125(a).

Irreparable Harm

49. Because Ohio State has demonstrated a likelihood of confusion, it follows that Ohio State has suffered irreparable harm. Ohio State has demonstrated that there is a high likelihood that consumers will associate Defendants' website and publications with Ohio State.

50. Given a trademark's unique role in protecting intangible assets, such as reputation and good will, injuries that result as a result of trademark infringement are by their very nature irreparable and not susceptible of adequate measurement for remedy at law.

51. Ohio State will suffer irreparable harm if Defendants continue to publish and disseminate their products because they improperly trade on the goodwill and reputation of Ohio State.

52. On August 26, 2010, the Court heard argument from counsel for both parties on Ohio State's Motion for Temporary Restraining Order and Preliminary Injunction. On

August 27, 2010, the Court issued its Opinion and Order granting Ohio State's Motion for Temporary Restraining Order and Preliminary Injunction (Dkt. No. 19), and such findings are incorporated into this Consent Judgment and Permanent Injunction in their entirety.

PERMANENT INJUNCTION

This cause having come on for hearing and by and with the consent of the parties and the Court having been fully advised in the premises, it is hereby ORDERED, ADJUDGED and DECREED that:


1. Defendants and their agents, servants, employees, successors, representatives and assigns, and all others in concert and privity with them are permanently enjoined from infringing, or falsely designating the origin of the Ohio State Trademarks, from using the Ohio State Trademarks in commerce in any way, and from injuring Ohio State's reputation;
2. Defendants and their agents, servants, employees, successors and assigns, and all others in active concert and participation are permanently restrained from using, registering, selling, transferring or assigning any domain name that contains the Ohio State Trademarks except as set forth in subsection (3) below;
3. Defendants are ordered to assign and transfer to Ohio State, at Defendants' cost, the domain name "www.buckeyeillustrated.com" and any other domain name currently owned or registered by Defendants that contains any of the Ohio State Trademarks;
4. Defendants are permanently enjoined from using any of the Ohio State Trademarks or names or marks deceptively similar to the Ohio State Trademarks in connection with a website or as metatags, directory names, other computer addresses, invisible data, or otherwise engaging in acts or conduct that would cause confusion as to the source, sponsorship or affiliation of Ohio State with Defendants;
5. Defendants are ordered to provide the Court and Ohio State with a complete list of all third persons, including, without limitation, retailers, distributors, agents, employees or representatives of Defendants, to whom Defendants has supplied copies of any print publication that includes any of the Ohio State Trademarks, including but not limited to the Infringing Publications; and that Defendants are further ordered to take all legal and equitable measures to regain possession of all copies of any publications containing any of the Ohio State Trademarks, including but not limited to the Infringing Publications;

6. Defendants are ordered to surrender all copies of print publications that include any of the Ohio State Trademarks, including but not limited to the Infringing Publications, for destruction; and
7. Defendants are ordered to disgorge all profits realized from the sale of print publications that include any of the Ohio State Trademarks, including but not limited to the Infringing Publications, or from the sale of advertising within such publications.
8. Nothing contained herein shall in any way restrict Defendants' use of the Ohio State Trademarks in connection with a website devoted to the Big Ten Conference which does not use as a domain name or title the Ohio State Trademarks and does not focus on Ohio State, but deals with all schools in the Big Ten Conference in a manner whereby no more than 10% of the total pages of such website are devoted to Ohio State and 90% of the total pages of such website are devoted to all of the other universities in the Big Ten; and all use of metatags, directory names, other computer addresses, invisible data relating to the Ohio State Trademarks on such website occurs with use of similar data relating to all of the other schools in the Big Ten Conference.

IT IS FURTHER ORDERED:

1. That this Court has jurisdiction over the parties to and subject matter of this action.
2. That jurisdiction over this cause is retained by this Court for the sole purpose of enforcement of compliance with this Injunction and for further orders and directions as may be necessary or appropriate from the construction and effectuation of this Final Consent Judgment and Permanent Injunction.
3. That except for the relief herein granted, the above identified civil action, including all claims, counterclaims, and affirmative defenses which Plaintiffs or Defendants have, could have or should have accorded therein, is hereby dismissed with prejudice;
4. Plaintiff and Defendants have waived notice of the entry of this Final Consent Judgment and Permanent Injunction and the right to appeal therefrom or to test its validity; and
5. Each party to pay its own attorneys' fees.

Dated: 11/8/10



GREGORY L. FROST
United States District Court Judge

APPROVED AS TO FORM:

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