

UNITED STATES DISTRICT COURT FOR  
THE WESTERN DISTRICT OF VIRGINIA  
Roanoke Division

VIRGINIA POLYTECHNIC INSTITUTE )  
AND STATE UNIVERSITY, )

Plaintiff / Counterclaim Defendant, )

v. )

HOKIE REAL ESTATE, INC., )

Defendant / Counterclaim Plaintiff, )

v. )

Case No. 7-10-cv-00466

LOCKE WHITE and )

Serve: 629 Deercroft Drive )  
Blacksburg, VA 24060 )

LAWRENCE HINCKER, )

Serve: 215 Deercroft Drive )  
Blacksburg, VA 24060 )

Counterclaim Defendants. )

**DEFENDANT HOKIE REAL ESTATE, INC.'S COUNTERCLAIM,**  
**ANSWER AND AFFIRMATIVE DEFENSES**

Defendant and Counterclaim Plaintiff Hokie Real Estate, Inc. (“Hokie”), by counsel, states as follows for its Counterclaim against Plaintiff and Counterclaim Defendant Virginia Polytechnic Institute and State University (“VPI&SU”) and against Counterclaim Defendants Locke White (“White”) and Lawrence Hincker (“Hincker”), as well as for its Answer and Affirmative Defenses to the Complaint of Plaintiff VPI&SU.

THE CREEKMORE  
LAW FIRM PC

## **COUNTERCLAIM**

This is an action (i) under 15 U.S.C. §§ 1119 and 1064(3) to cancel the registration of a trademark, (ii) under 15 U.S.C. § 1119 for rectification of the trademark register; (iii) under 15 U.S.C. § 1119 for the determination of rights to registration of marks; (iv) under 15 U.S.C. § 1120 for damages sustained in consequence of the procurement of a trademark registration by false and fraudulent representations; and (v) under 15 U.S.C. § 1125(a)(1)(B) for false commercial advertising or promotion.

## **PARTIES**

1. Defendant and Counterclaim Plaintiff Hokie is a corporation organized under the laws of the Commonwealth of Virginia whose principal business address is located at 318 N. Main Street, Blacksburg, Virginia.

2. Plaintiff and Counterclaim Defendant VPI&SU is a Virginia land-grant university whose main campus and headquarters are located in Blacksburg, Virginia.

3. Mr. White, Counterclaim Defendant, is a natural person residing in Montgomery County, Virginia who is Director of VPI&SU's Office of Licensing and Trademarks.

4. Mr. Hincker, Counterclaim Defendant, is a natural person residing in Montgomery County, Virginia who is VPI&SU's Associate Vice President for University Relations.

## **JURISDICTION AND VENUE**

5. This Court has jurisdiction over these claims pursuant to 15 U.S.C. §§ 1119 (power of court over registration) and 1121 (Lanham Act jurisdiction); and pursuant to 28

U.S.C. §§ 1331 (federal question jurisdiction) and 1338 (trademark/unfair competition jurisdiction). Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391, because all Counterclaim Defendants reside in the Commonwealth of Virginia and because at least one Counterclaim Defendant resides in this judicial district.

## FACTS

### **Fraud on the U.S. Patent and Trademark Office: Falsification of 1896 Date of First Use of the Term HOKIES**

6. On May 23, 2000, VPI&SU obtained registration of the term HOKIES on the Principal Register of the United States Patent and Trademark Office (“USPTO”) where it was assigned Federal Trademark Registration No. 2,351,364 (the “Registration”). A copy of the Registration is attached as **Exhibit A**.

7. In order to obtain the Registration, VPI&SU submitted an Application for Trademark Registration to the USPTO on October 2, 1998 (the “Application”) which stated that VPI&SU’s first use of the HOKIES term in International Class 16, both in commerce and anywhere, occurred “at least as early as November 11, 1896.” The Application contained a Declaration executed on November 1, 1996 by Ann Spencer, Associate Vice President of VPI&SU, affirming the truth of all statements therein. The Application is attached as **Exhibit B**. The Application later was slightly amended.

8. Also in order to obtain the Registration, VPI&SU submitted to the USPTO a Declaration Under 37 C.F.R. Section 2.20 dated September 24, 1999 (the “1999 Declaration”), executed by Paul E. Torgerson, President of VPI&SU, that referred to the Application and confirmed with respect to the Application “[t]hat all the facts set forth therein, including the dates of use paragraphs, are true.” The 1999 Declaration is attached as **Exhibit C**.

9. The above-quoted statements in the Application and in the 1999 Declaration are false because the term HOKIES was not first used in 1896. The term HOKIES did not first appear until many decades thereafter.

10. Dr. Johann Norstedt, retired Chair of the English Department at VPI&SU, has previously stated in this case:

I also understand that VPI&SU has claimed that its first use of the plural term “hokies” occurred in 1896. This is simply not factual and borders on the preposterous. In his spirit yell, O.M. Stull [author of the 1896 spirit yell] used the term “hoki” to make an exclamation. He most certainly was not shouting “We’re the Hokies!” Use of the nickname “hokies” to refer to VPI&SU or its athletic teams likely evolved from continued use of the spirit yell over time. In any event, it did not first occur until well into the twentieth century.

(Decl. of Dr. Johann Norstedt (Document 20-2) ¶ 23.)

11. VPI&SU admits in its Complaint that “[t]he ‘e’ was added to ‘Hoki’ some time later” (*i.e.*, after the 1896 spirit yell was written). (Compl. ¶ 7). Because the further addition of the “s” to HOKIE to form the term HOKIES would have had to occur even later still, this confirms that HOKIES was not used in 1896.

12. In its Interrogatory No. 5 addressed to VPI&SU, Counterclaim Plaintiff Hokie directed VPI&SU to “Identify the date when the ‘s’ was first added to ‘Hoki’ after addition of the ‘e’ as described in Paragraph 7 of the Complaint.” VPI&SU responded as follows:

Virginia Tech objects to this interrogatory to the extent that it is seeking a date that is very old. It is unreasonable to expect Virginia Tech to provide a specific date, and Virginia Tech is unable to supply a specific date. Notwithstanding the foregoing, Virginia Tech believes that that term “hokies” was first used no later than the early 1950s.

(*Id.*)

13. In support of its Motion for Preliminary Injunction, VPI&SU has submitted an excerpt from the 1953 edition of the *Bugle* yearbook containing photos of that year’s men’s basketball team and containing the phrase, “The Tech basketball team just couldn’t get started this season. The Hokies had won three games and had lost nineteen at press time.” (Ex. 1 to

Hincker Decl., Binder 2.) This excerpt from the 1953 *Bugle* is the earliest occurrence of the term HOKIES that VPI&SU has produced in this case.

14. Counterclaim Plaintiff Hokie has examined the first October issue of the student newspaper at VPI&SU for each of the years from 1935 through 1979 located in the VPI&SU library and has tallied all occurrences of the nicknames HOKIES, TECHMEN and GOBBLERS in each of those issues. A graph summarizing the results of this research is attached as **Exhibit D**. According to this examination, the first occurrence of the term HOKIES was in 1949.

15. VPI&SU did not use the term HOKIES in or before 1896. VPI&SU does not possess any evidence of its alleged use of the term HOKIES in or before 1896.

16. VPI&SU has intentionally sought to distort the historical record by glossing over the distinction between the term “Hoki,” which did appear in 1896 as part of O.M. Stull’s spirit yell, and the term “Hokies,” which did not first appear until more than fifty years later.

17. VPI&SU was in possession of these facts at the time of its submission of the Application and the 1999 Declaration to the USPTO. VPI&SU nevertheless knowingly and willfully made a false claim of an 1896 first-use date for HOKIES with the intent to mislead the USPTO and in order to induce the USPTO to grant VPI&SU’s application for registration of the HOKIES term.

18. By knowingly submitting the false Application and the false 1999 Declaration to the USPTO, VPI&SU made false material statements with the intent to deceive the USPTO and thereby committed fraud upon the USPTO. That the false statements were material is clear from their being singled out for special mention, from among all the other facts in the 1996 Declaration, for a specific confirmation of truth. (*See Exhibit C at 2, first line.*) The false

statements also were material because the Registration would not have issued in the absence of a first-use date.

19. The USPTO relied upon VPI&SU's false statements in examining, approving and issuing the Registration to VPI&SU, in that the Registration would not have issued in the absence of a first-use date.

**Fraud on the U.S. Patent and Trademark Office:  
False Declarations of Use of HOKIES on Goods Listed in Application**

20. In the Application and in the 1999 Declaration, VPI&SU declared under oath that it was then using the term HOKIES on all the goods identified in the Application. (*See* Exhibits B and C.)

21. In its Interrogatory No. 6 addressed to VPI&SU, Counterclaim Plaintiff Hokie directed VPI&SU to provide the dates of use in commerce of "all goods . . . ever sold, rendered, offered or provided by Plaintiff or its licensees under the HOKIE mark," which included the term HOKIES.

22. VPI&SU has failed to identify any goods on which the term HOKIES was being used at the time of the Application or the 1999 Declaration.

23. In its Requests for Production of Documents and Things Nos. 49, 50 and 51, Counterclaim Plaintiff Hokie directed VPI&SU to produce examples, photographs and drawings or other renditions of "all goods ever sold, rendered, offered or provided by Plaintiff or its licensees under the HOKIE mark," which included the term HOKIES.

24. VPI&SU has failed to provide any documents or things demonstrating that VPI&SU was in fact using the term HOKIES on any goods at the time of the Application or the 1999 Declaration.

25. At the time VPI&SU sought federal registration of the HOKIES term, it was not using the term HOKIES on certain of the goods identified in the Application and in the 1999 Declaration.

26. At the time of its submission of the Application and the 1999 Declaration to the USPTO, VPI&SU was aware that it was not using the term HOKIES on certain of the goods identified therein.

27. VPI&SU knowingly and willfully made false claims that it was using the term HOKIES on all the goods identified in the Application and in the 1999 Declaration.

28. VPI&SU made these false claims with the intent to mislead the USPTO and in order to induce the USPTO to grant VPI&SU's application for registration of the HOKIES term.

29. By knowingly submitting the false Application and the false 1999 Declaration to the USPTO, VPI&SU made false material statements with the intent to deceive the USPTO and thereby committed fraud upon the USPTO.

30. These false statements were material because the Registration would not have issued in the absence of a claim by VPI&SU that it was then using the HOKIES term on all the goods identified in the Application.

31. The USPTO relied upon VPI&SU's false statements in examining, approving and issuing the Registration to VPI&SU, in that the Registration would not have issued in the absence of a claim by VPI&SU that it was then using the HOKIES term on all the goods identified in the Application.

**Fraud on the U.S. Patent and Trademark Office:  
False Statements of Use of HOKIES in Renewal Applications**

32. In connection with VPI&SU's successive renewals of the Registration, VPI&SU submitted to the USPTO a Declaration of Use and Incontestability Under Sections 8 and 15 dated June 1, 2005 and executed by Hincker, which is attached as **Exhibit E** (the "2005 Declaration") and a Combined Declaration of Use and/or Excusable Nonuse / Application for Renewal of Registration of a Mark under Sections 8 & 9 dated May 19, 2010 and containing a Declaration dated April 28, 2010 also executed by Hincker, which is attached as **Exhibit F** (the "2010 Declaration").

33. Both the 2005 Declaration and the 2010 Declaration stated that term HOKIES was then in continuous use on all the goods listed in the Registration, including, among others, "tie tacks" and "gold pins" in International Class 14, "brief cases" in International Class 18, and "bath robes" in International Class 25.

34. In its Interrogatory No. 6 addressed to VPI&SU, Counterclaim Plaintiff Hokie directed VPI&SU to provide the dates of use in commerce of "all goods . . . ever sold, rendered, offered or provided by Plaintiff or its licensees under the HOKIE mark," which included the term HOKIES.

35. VPI&SU has failed to identify any goods on which the term HOKIES was being used at the time of the 2005 Declaration or the 2010 Declaration.

36. In response to Counterclaim Plaintiff Hokie's Requests for Production of Documents and Things Nos. 49, 50 and 51, VPI&SU produced several photographs, drawings and renditions of goods bearing the HOKIES mark. However, none of these depicted any tie tacks, gold pins, brief cases or bath robes bearing the HOKIES mark.



37. Counterclaim Plaintiff Hokie has conducted an intense and diligent search of retail outlets that sell products bearing the term HOKIES. Counterclaim Plaintiff Hokie also has conducted intense and diligent searches of outlets that sell HOKIES branded products over the internet. These searches occurred over the past several months and were ongoing at the time of the execution of the 2010 Declaration. Despite these intense and diligent searches Counterclaim Plaintiff Hokie has been unable to locate or identify any use by VPI&SU or its licensees of the term HOKIES on or in connection with tie tacks, gold pins, brief cases or bath robes.

38. In his deposition, White confirmed that he was responsible for conducting investigations into whether the term HOKIES was in use on each of the types of goods listed in the Registration at the time of execution of the 2005 Declaration or the 2010 Declaration. However, White was unable to offer any specifics relating to any such investigation. He stated that he did not remember what stores were visited in connection with any such investigation, that he did not remember where any specific products were found, that he did not remember whether anyone else helped him to conduct any investigation, that he did not remember whether he gave any documentation to Hincker, and that he did not remember what he told Hincker. He also admitted that he did not retain any written evidence or other kind of evidence of any such investigation.

39. Plaintiff Hokie's Requests for Production of Documents and Things Nos. 75 through 78 directed VPI&SU to produce all documents relating to goods on which VPI&SU or its licensees were using the term HOKIES on the dates of the 2005 Declaration and the 2010 Declaration, as well as examples, photographs or drawings of all such goods. VPI&SU failed to produce anything in response to these Requests for Production, and instead stated that it

“does not maintain any documents or information regarding a specific list of goods offered for sale on specific dates.”

40. Hincker testified in his deposition that he did not himself do anything to confirm the accuracy of the statements in the 2005 Declaration or the 2010 Declaration before signing them, and that he instead relied in each case solely upon White’s representation that the statements in the declaration were correct.

41. Based upon the foregoing, on the dates of both the 2005 Declaration and the 2010 Declaration VPI&SU was not using the term HOKIES on or in connection with one or more of the goods in each class identified in the Registration. At a minimum, on these dates VPI&SU was not using the term HOKIES on or in connection with “tie tacks” or “gold pins” in International Class 14, “brief cases” in International Class 18, or “bath robes” in International Class 25.

42. VPI&SU, White and Hincker were aware of these facts at the time of their submission of the 2005 Declaration and the 2010 Declaration to the USPTO. Nevertheless, in each case VPI&SU, White and Hincker knowingly made the inaccurate claim that the term HOKIES then was currently being used on all the goods identified in the Registration. VPI&SU, White and Hincker made each such claim with the intention to mislead the USPTO in connection with the applications for renewal of the Registration of the HOKIES mark.

43. By knowingly submitting the inaccurate 2005 Declaration and the inaccurate 2010 Declaration to the USPTO, VPI&SU, White and Hincker made false statements with the intent to deceive the USPTO and thereby committed fraud upon the USPTO. The false statements were material because if they had not been made, the Registration would not have been renewed, or would have been renewed only with respect to certain goods.

**Illegal Use of the Federal Registration Symbol (“®”)  
With The Unregistered Term HOKIE**

44. VPI&SU does not own any federal trademark registration for the term HOKIE.

45. VPI&SU has used and continues to use (and to authorize the use of) the federal trademark registration symbol (“®”) in connection with the term HOKIE. This use is illegal under 15 U.S.C. § 1111, which permits use of the registration symbol only in connection with federally registered marks.

46. VPI&SU, White and Hincker knew that the term HOKIE was not registered and that it was illegal to use the federal trademark registration symbol (“®”) in connection with the term HOKIE. Legal information contained in the files of VPI&SU’s Office of Licensing and Trademarks and produced by VPI&SU in discovery clearly states that such use is illegal and that it can have grave legal consequences. Other documents produced in discovery, including correspondence dating from as far back as 2005 and directed to White and Hincker, demonstrate that they personally have long been aware that the term HOKIE is not a registered trademark.

47. VPI&SU’s illegal marking of the term HOKIE has been brazen, widespread and massive. Counterclaim Plaintiff Hokie itself has purchased dozens of goods bearing the term HOKIE and illegally marked with the federal registration symbol (“®”). A collection of photographs of some of these goods, together with a few other examples of such illegal marking collected by Counterclaim Plaintiff Hokie, is attached as **Exhibit G**. Some of these goods were marketed by VPI&SU itself. Others were marketed by third parties with the express approval of VPI&SU in each instance. A great many of these goods bear labels, tags

and/or hologram stickers proclaiming that they are “Officially Licensed Products” or “Collegiate Licensed Products.” Many of them were purchased on VPI&SU’s campus.

48. VPI&SU itself has provided many examples of its illegal uses of the term HOKIE together with the federal registration symbol (“®”). VPI&SU provided several such examples in support of its Motion for Preliminary Injunction. Images of these uses are attached as **Exhibit H**. VPI&SU then provided many more such examples in response to the discovery requests of Counterclaim Plaintiff Hokie. Images of these uses are attached as **Exhibit I**.

49. VPI&SU’s illegal marking of the term HOKIE has been and continues to be part of a concerted, deliberate and intentional campaign to deceive the public into believing that the term HOKIE is in fact a federally registered mark.

50. The massive number of illegally marked products that VPI&SU has approved for sale demonstrates that such illegal marking cannot possibly have been inadvertent.

51. VPI&SU’s illegal use of the federal registration symbol (“®”) extends to other unregistered marks. Such unregistered marks include but are not necessarily limited to the term HOKIE BIRD, the term TECH, the term VT, and the “vintage” over-and-under VT logo. Photographs of several such illegally marked products are included in **Exhibit J**.

52. In addition to illegal use of the federal registration symbol (“®”), on several occasions, the Counterclaim Defendants have falsely informed third parties that the term HOKIE is a federally registered trademark. (*See Exhibit K.*)

53. On January 25, 2010, VPI&SU’s counsel sent a letter to Counterclaim Plaintiff Hokie demanding that it cease use of the term HOKIE in its trade name. This letter falsely asserted that “[t]he term ‘Hokie’ is trademarked by Virginia Tech (Trademark registration #2351364).” A copy of this letter is attached as **Exhibit L**. Federal Trademark

Registration No. 2,351,364 is the Registration of the term HOKIES, not the term HOKIE.

VPI&SU's counsel knew that the assertion made in the letter was false.

54. VPI&SU's counsel repeated the false assertion that HOKIE was a federally registered mark in a second letter sent to Counterclaim Plaintiff Hokie on March 8, 2010, which is attached as **Exhibit M**.

55. On March 30, 2010, counsel for Counterclaim Plaintiff Hokie sent a letter to VPI&SU advising VPI&SU that Counterclaim Plaintiff Hokie was aware of VPI&SU's illegal marking campaign and demanding that VPI&SU cease all such illegal marking. The letter stated:

[E]ven a preliminary investigation into the University's practice of marking its licensed products reveals a number of University-licensed products that improperly use the Federal Trademark Registration Symbol "®" in connection with the use of the unregistered, and unprotectable, term "Hokie." We also have documented such misuse on the University's own web site. These practices, coupled with your attempting to leverage concessions or licenses from legitimate users of the mark "Hokie" through the false assertion of trademark rights in the term, not only is a violation of trademark law but also is actionable as an unfair trade practice. By this letter, we place the University on notice of its impermissible marking campaign, and demand hereby is made that it correct all such mismarkings immediately.

A copy of this letter is attached as **Exhibit N**.

56. In the year since VPI&SU received the March 30, 2010 letter from counsel for Counterclaim Plaintiff Hokie, VPI&SU has taken no steps to recall, or to halt sales of, goods bearing the term HOKIE illegally marked with the federal registration symbol ("®"). It has not directed any communications to its various licensees instructing them to cease illegal use of the federal registration symbol in connection with the term HOKIE. It has not instructed its licensees to remove the federal registration symbol from goods to which the symbol already has been applied illegally in connection with the term HOKIE. VPI&SU has failed to take these actions even though it has recalled goods on at least two previous occasions for other reasons, and even though VPI&SU's standard licensing agreement expressly permits it to rescind

approval of licensed goods and to require its licensees to remove such previously approved goods from public sale or distribution.

57. Many of the illegally-marked products identified in Exhibit G were purchased on VPI&SU's own campus many months after VPI&SU's receipt of the March 30, 2010 letter. Many of the illegally-marked products identified in Exhibits G, H and I continue to this day to be offered for sale at many locations on VPI&SU's campus and elsewhere.

58. On August 20, 2010, White instructed a subordinate to require a licensee to use the federal trademark registration symbol (“®”) on an unregistered mark, even though White knew that the registration symbol should not be used on that unregistered mark. In response to the subordinate's question whether the non-registered word mark “VT” should be required to bear the registration symbol, White replied, “Technically this VT should not have a registered mark but go ahead and tell them to put it on.” A copy of this e-mail exchange is attached as **Exhibit O**.

59. In October 2010, more than six months after VPI&SU received the March 30 letter demanding that VPI&SU cease making false statements about its ownership of a Federal registration for the term HOKIE, Hincker *again* falsely stated to a third party that “Hokie is a registered mark.” A copy of this statement is attached as **Exhibit P**.

60. By thus continuing its illegal activity for a full year after it was expressly notified of that activity and informed of the consequences thereof, VPI&SU has demonstrated that its illegal marking of the term HOKIE is part of a concerted, deliberate and intentional campaign to deceive the public into believing that the term HOKIE is a federally registered mark.

**Illegal Use of the Federal Registration Symbol (“®”) With the Term HOKIES  
On Classes of Goods for Which HOKIES is Not Registered**

61. VPI&SU has obtained registration of the term HOKIES in five International Classes: Class 14 (precious metals, jewelry, etc.), Class 16 (paper articles, etc.), Class 18 (leather and imitation leather goods, etc.), Class 21 (drinking glasses, mugs, etc.) and Class 25 (clothing, etc.) (*See Exhibit A.*)

62. In his deposition, White stated that he was responsible for confirming whether the term HOKIES was in use on each of the types of goods listed in the Registration at the time of execution of the 2005 Declaration or the 2010 Declaration. White therefore is familiar with the types of goods for which the term HOKIES is registered and for which it is not registered.

63. Hincker executed both the 2005 Declaration and the 2010 Declaration in connection with the renewal of the Registration, and thereby swore to the accuracy of those Declarations under penalty of perjury. (*See Exhibits E and F.*) Hincker is familiar with the types of goods for which the term HOKIES is registered and for which it is not registered.

64. VPI&SU has used and continues to use (and authorize the use of) the federal trademark registration symbol “®” in connection with the term HOKIES on goods outside the five International Classes for which the term HOKIES is registered. This use is illegal under 15 U.S.C. § 1111, which permits use of the registration symbol only in connection with goods in the International Classes for which a term is registered.

65. VPI&SU’s illegal marking of the term HOKIES in this manner has been brazen, widespread and massive. Counterclaim Plaintiff Hokie itself has identified dozens of goods outside the five International Classes for which the term HOKIES is registered that bear the term HOKIES illegally marked with the federal registration symbol (“®”). A collection of photographs of some of these goods is attached as **Exhibit Q**. Some of these goods were

marketed by VPI&SU itself. Others were marketed by third parties with the express approval of VPI&SU in each instance. Many of these goods bear labels, tags and/or hologram stickers proclaiming that they are “Officially Licensed Products” or “Collegiate Licensed Products.”

66. VPI&SU itself has provided many examples of its illegal uses of the term HOKIES together with the federal registration symbol (“®”) on classes of goods for which the term HOKIES is not registered. VPI&SU provided several such examples in support of its Motion for Preliminary Injunction. Images of these uses are attached as **Exhibit R**. VPI&SU then provided many more such examples in response to the discovery requests of Counterclaim Plaintiff Hokie. Images of these uses are attached as **Exhibit S**.

67. VPI&SU’s illegal marking of the term HOKIES in this manner has been and continues to be part of a concerted, deliberate and intentional campaign to deceive the public into believing that the term HOKIE is in fact a federally registered mark.

68. The massive number of illegally marked products that VPI&SU has approved for sale demonstrates that such illegal marking cannot possibly have been inadvertent.

69. On January 10, 2011, Counterclaim Plaintiff Hokie publicly raised VPI&SU’s illegal marking of the term HOKIES as a defense to VPI&SU’s Motion for Preliminary Injunction. In the two and a half months since then, VPI&SU has taken no steps to recall, or to halt sales of, goods outside the scope of the Registration that bear the term HOKIES illegally marked with the federal registration symbol (“®”). It has not directed any communications to its various licensees instructing them to cease such illegal use of the federal registration symbol in connection with the term HOKIES. It has not instructed its licensees to remove the federal registration symbol from such goods to which the symbol already has been applied illegally in connection with the term HOKIES. VPI&SU has failed to take these actions even though it has



recalled goods on at least two previous occasions for other reasons, and even though VPI&SU's standard licensing agreement expressly permits it to rescind approval of licensed goods and to require its licensees to remove such previously approved goods from public sale or distribution.

70. Many of the illegally-marked products identified in Exhibits Q, R and S continue to this day to be offered for sale at many locations on VPI&SU's campus and elsewhere.

71. By thus continuing its illegal activity after it was expressly notified of that activity, VPI&SU has demonstrated that its illegal marking of the term HOKIES is part of a concerted, deliberate and intentional campaign to deceive the public into believing that the scope of the Registration is far broader than it actually is.

#### **Damage to Counterclaim Plaintiff Hokie**

72. VPI&SU's fraudulently-obtained Registration of the term HOKIES (including the renewals thereof) is damaging and will continue to damage Counterclaim Plaintiff Hokie. VPI&SU is relying upon its fraudulently-obtained Registration of the term HOKIES to bring this federal action against Counterclaim Plaintiff Hokie, including claims for attorney's fees and other relief under the federal Lanham Act which VPI&SU would not be able to seek if it had not fraudulently obtained registration of the term HOKIES. (*See, e.g.*, Compl. ¶¶ 1, 16, E, G; *see also* Pl.'s Mem. In Supp. of Mot. Prelim. Inj. (Document 10) at 25 (citing existence of Registration in support of dilution claim).)

73. VPI&SU's fraudulently-obtained Registration of the term HOKIES (including the renewals thereof) is damaging to Counterclaim Plaintiff Hokie because VPI&SU is relying upon the Registration as grounds for preventing Counterclaim Plaintiff Hokie from using the

term HOKIE in its business in a generic or descriptive sense (meaning “a supporter of VPI&SU”). Counterclaim Plaintiff Hokie has a strong interest in using the term HOKIE in its business, both to indicate that supporters of VPI&SU are welcome customers and also to indicate that its owner is a supporter of VPI&SU.

74. VPI&SU’s fraudulently-obtained Registration of the term HOKIES (including the renewals thereof) is damaging to Counterclaim Plaintiff Hokie because the false date of first use stated by VPI&SU in the Application and in the 1999 Declaration is being used by VPI&SU in an attempt to lessen the burden of proof that VPI&SU may have to meet in this litigation and in potential future litigation.

75. VPI&SU’s fraudulently-obtained Registration of the term HOKIES (including the renewals thereof) is damaging to Counterclaim Plaintiff Hokie because it is permitting VPI&SU to impose other costs upon Counterclaim Plaintiff Hokie, such as Counterclaim Plaintiff Hokie’s attorney’s fees and other costs associated with this litigation.

76. The illegal use of the federal registration symbol (“®”) in connection with the terms HOKIE and HOKIES, which has been allowed, authorized or required by VPI&SU, White and Hincker, is intended to, and is likely to, influence the purchasing decisions of the members of the public. Specifically, this illegal marking is intended to exploit, and does effectively exploit, the preference of the general public to purchase merchandise that has been officially authorized by VPI&SU. This preference is well-recognized by the collegiate products industry.

77. One way in which VPI&SU, White and Hincker endeavor to exploit customers’ preference for officially authorized merchandise is by labeling (or causing to be labeled) products bearing its marks with tags, labels and hologram stickers prominently

indicating that a given product is a “Collegiate Licensed Product” or “Officially Licensed Collegiate Product” or “Authentic Athletic Apparel.”

78. VPI&SU itself has acknowledged (and tried to reinforce) customers’ preference for officially authorized merchandise in a brochure detailing its Collegiate Licensing Program, in which it has stated as follows:

**Look for the symbol of quality**

How does one tell if the merchandise is licensed? The “Officially Licensed Collegiate Products” label should appear on all merchandise authorized by Virginia Tech.

With this label, the alumnus, student and fan know that they are buying a product of quality and authenticity that represents the goodwill of the University. So look for the “Officially Licensed Collegiate Products” label. It represents a mark of excellence.

VPI&SU expends significant time and effort on measures intended to heighten the general public’s preference for officially authorized merchandise over unauthorized merchandise.

79. One way in which VPI&SU, White and Hincker endeavor to exploit customers’ preference for officially authorized merchandise is by encouraging retailers of authorized merchandise to post notices touting officially authorized merchandise and/or proclaiming its advantages. For example, many independent retailers marketing goods branded with Virginia Tech marks prominently display large signs bearing the phrase, “Officially Licensed Virginia Tech Merchandise.”

80. VPI&SU, White and Hincker illegally use (or require VPI&SU’s licensees to use) the federal registration symbol (“®”) on products in connection with the terms HOKIE or HOKIES in order to emphasize (falsely) the impression that each such product is officially licensed or officially authorized. In doing so VPI&SU, White and Hincker seek to increase the perceived value of the product in the mind of the customer. Customers understandably presume that the federal registration symbol would not be used on an unauthorized product. VPI&SU, White and Hincker have confirmed this in the Policies and Procedures Manual of

VPI&SU's Office of Licensing and Trademark Administration, which advises licensing staff engaging in audits of retail outlets to "check for . . . an encircled 'R' on each product type" as a part of the process of assessing whether a given product is authentic.

81. Upon information and belief, the presence of the federal registration symbol ("®") on a product creates for that product an aura of authenticity that permits the product to be sold for a higher price. Customers care whether products bear the federal registration symbol, and they are more willing to buy products that bear it. By marketing (or authorizing the marketing) of products bearing the terms HOKIE and HOKIES illegally marked with the federal registration symbol, VPI&SU, White and Hincker influence the public's purchasing decisions and thereby permit VPI&SU to profit at the expense of the members of the public who are deceived by this illegal activity.

82. Counterclaim Plaintiff Hokie, as a purchaser of licensed VPI&SU merchandise illegally marked with the federal registration symbol ("®"), has suffered harm as a result of this illegal activity in that it has paid higher prices for such merchandise.

83. By (a) fraudulently obtaining the Registration of the term HOKIES (including the renewals thereof), and (b) allowing, authorizing or requiring illegal use of the federal registration symbol ("®") on products bearing the terms HOKIE and HOKIES, VPI&SU, White and Hincker have harmed Counterclaim Plaintiff Hokie, and are likely to harm Counterclaim Plaintiff Hokie in the future, because the respect in which businesspersons hold certificates of Federal registration has caused third parties to believe that VPI&SU's trademark rights in the terms HOKIE and HOKIES are stronger than they really are. This has caused third parties to question Counterclaim Plaintiff Hokie's business judgment in selecting a business name including the term HOKIE. This has harmed Counterclaim Plaintiff Hokie's reputation

for business acumen (which is a very important attribute of a successful real estate broker) and has caused Counterclaim Plaintiff Hokie a lessening of goodwill, loss of business, loss of income, and difficulties in entering into revenue-sharing agreements with real estate agents.

84. Specifically, on numerous occasions Counterclaim Plaintiff Hokie has been approached by third parties, including peers and fellow professionals, who have pointedly asked Counterclaim Plaintiff Hokie whether it obtained permission from VPI&SU to use the term HOKIE in its business name, and who have expressed and/or implied a belief that for Counterclaim Plaintiff Hokie to use the term HOKIE in its business name without obtaining such permission would be unlawful. Upon information and belief, these and other third parties have expressed such opinions in more forceful terms outside the presence of Counterclaim Plaintiff Hokie. These expressions of opinion have harmed Counterclaim Plaintiff Hokie's reputation for business acumen, have lessened its goodwill, and have harmed its business.

**FIRST CLAIM FOR RELIEF  
(Against VPI&SU)  
(Cancellation of Registration of HOKIES under 15 U.S.C. §§ 1119 and 1064(3))**

85. Counterclaim Plaintiff Hokie incorporates by reference, as if fully set forth herein, paragraphs 1 through 83 above.

86. In submitting the Application and the 1999 Declaration to the USPTO, VPI&SU knowingly made false representations of material facts to the USPTO with the intent to deceive the USPTO in order to obtain federal registration of the term HOKIES.

87. In submitting the 2005 Declaration and the 2010 Declaration to the USPTO, VPI&SU knowingly made false representations of material fact to the USPTO with the intent to deceive the USPTO in order to obtain renewal of its federal registration of the term HOKIES.

88. The USPTO relied upon VPI&SU's false representations in examining, approving, issuing and renewing the Registration.

89. VPI&SU's false representations constituted fraud on the USPTO.

90. Under 15 U.S.C. § 1064(3), a registration can be cancelled if it was obtained fraudulently. Furthermore, 15 U.S.C. § 1119 authorizes this Court to effect such cancellation.

91. Counterclaim Plaintiff Hokie therefore requests this Court to enter an order canceling in its entirety VPI&SU's federal registration of the term HOKIES, Federal Trademark Registration No. 2,351,364, and to certify such cancellation to the Director of the USPTO, for appropriate entry upon the records of the USPTO.

92. In the alternative, to the extent that VPI&SU has made such a false representation in the Application, the 1999 Declaration, the 2005 Declaration or the 2010 Declaration with respect to the use of the HOKIES term on goods in any individual International Class covered by VPI&SU's federal registration, Counterclaim Plaintiff Hokie requests this Court to enter an order canceling, in that individual International Class, VPI&SU's federal registration of the term HOKIES, Federal Trademark Registration No. 2,351,364, and to certify such cancellation to the Director of the USPTO, for appropriate entry upon the records of the USPTO.

**SECOND CLAIM FOR RELIEF  
(Against VPI&SU)  
(Rectification of the Trademark Register under 15 U.S.C. § 1119)**

93. Counterclaim Plaintiff Hokie incorporates by reference, as if fully set forth herein, paragraphs 1 through 91 above.

94. Pursuant to 15 U.S.C. § 1119, this Court has the power to rectify the register of trademarks.

95. In the alternative to the First Claim for Relief set forth above, Counterclaim Plaintiff Hokie requests this court to enter an order rectifying the register of trademarks by deleting the 1896 dates of first use anywhere and first use in commerce from VPI&SU's federal registration of the term HOKIES, Federal Trademark Registration No. 2,351,364, and to certify such deletion to the Director of the USPTO, for appropriate entry upon the records of the USPTO.

**THIRD CLAIM FOR RELIEF  
(Against VPI&SU)  
(Determination of Registration Rights in the term HOKIE under 15 U.S.C. § 1119)**

96. Counterclaim Plaintiff Hokie incorporates by reference, as if fully set forth herein, paragraphs 1 through 94 above.

97. Pursuant to 15 U.S.C. § 1119, this Court has the power to determine the right to registration of a mark.

98. VPI&SU, by illegally marking the unregistered term HOKIE with the federal registration symbol ("®") as part of a concerted, deliberate and intentional campaign to deceive the public into believing that the term HOKIE is in fact a federally registered mark, has engaged in inequitable conduct that bars it from seeking or obtaining any federal registration of the term HOKIE and also from asserting trademark or service mark rights in the term HOKIE in *inter partes* actions before the USPTO.

99. Counterclaim Plaintiff Hokie therefore requests this Court to enter an order pursuant to 15 U.S.C. § 1119 forever barring VPI&SU (a) from seeking or obtaining any federal registration of the term HOKIE and (b) from asserting trademark or service mark rights in the term HOKIE in *inter partes* actions before the USPTO, and to certify such order to the Director of the USPTO, for appropriate entry upon the records of the USPTO.

**FOURTH CLAIM FOR RELIEF**  
**(Against VPI&SU)**  
**(Determination of Registration Rights in the term HOKIES under 15 U.S.C. § 1119)**

100. Counterclaim Plaintiff Hokie incorporates by reference, as if fully set forth herein, paragraphs 1 through 98 above.

101. Pursuant to 15 U.S.C. § 1119, this Court has the power to determine the right to registration of a mark.

102. By illegally marking the term HOKIES with the federal registration symbol (“®”) on goods outside the International Classes for which it is registered, and by doing so as part of a concerted, deliberate and intentional campaign to deceive the public into believing that the scope of the registration of the term HOKIES is far broader than it actually is, VPI&SU has engaged in inequitable conduct that bars it from seeking or obtaining any federal registration of the term HOKIES and also from asserting trademark or service mark rights in the term HOKIES in *inter partes* actions before the USPTO.

103. Counterclaim Plaintiff Hokie therefore requests this Court to enter an order pursuant to 15 U.S.C. § 1119 forever barring VPI&SU (a) from seeking or obtaining any new federal registration of the term HOKIES (including any amendment of its existing registration to include additional International Classes of goods or services), and (b) from asserting trademark or service mark rights in the term HOKIES in *inter partes* actions before the USPTO, and to certify such order to the Director of the USPTO, for appropriate entry upon the records of the USPTO.



**FIFTH CLAIM FOR RELIEF  
(Against White and Hincker)  
(Damages Sustained in Consequence of the False and Fraudulent  
Procurement of a Trademark Registration by False and Fraudulent Representations  
under 15 U.S.C. § 1120)**

104. Counterclaim Plaintiff Hokie incorporates by reference, as if fully set forth herein, paragraphs 1 through 102 above.

105. By knowingly submitting the inaccurate 2005 Declaration and the inaccurate 2010 Declaration to the USPTO, White and Hincker made materially false statements to the USPTO with the intent to deceive the USPTO, in order to procure the renewal of the Registration. The USPTO relied on these statements. Accordingly, White and Hincker thereby committed fraud upon the USPTO.

106. Pursuant to 15 U.S.C. § 1120, White and Hincker are liable to Counterclaim Plaintiff Hokie for its damages sustained in consequence of their use of false and fraudulent declarations and representations to procure the Registration in the USPTO.

107. Counterclaim Plaintiff Hokie therefore requests this Court to enter an award of damages against White and Hincker and in favor of Counterclaim Plaintiff Hokie in an amount to be determined at trial.

**SIXTH CLAIM FOR RELIEF  
(Against VPI&SU, White and Hincker)  
(False Commercial Advertising or Promotion under 15 U.S.C. § 1125(a)(1)(B))**

108. Counterclaim Plaintiff Hokie incorporates by reference, as if fully set forth herein, paragraphs 1 through 106 above.

109. The numerous illegal markings with the federal registration symbol (“®”) of products bearing the terms HOKIE and HOKIES effected or authorized by VPI&SU, White and Hincker are literally false representations of fact about products of VPI&SU and its

licensees, in that such markings falsely represent that the terms HOKIE and HOKIES are registered for use in connection with such products.

110. The false representations so made by VPI&SU, White and Hincker are likely to influence customers' purchasing decisions because, among other things, they exploit customers' preference for authorized and officially licensed collegiate-branded merchandise.

111. The false representations so made by VPI&SU, White and Hincker have actually deceived a substantial segment of the audience for such false representations (*i.e.*, purchasers and potential purchasers of collegiate-branded merchandise), and have a tendency to deceive such audience, both because the members of such audience generally rely upon the perceived trustworthiness of VPI&SU, which generally is considered an esteemed educational institution operated by the Commonwealth of Virginia; and because the members of such audience generally are relatively unfamiliar with the details of trademark law and trademark registration.

112. VPI&SU, White and Hincker placed the false representations as to the federal registration of the terms HOKIE and HOKIES into interstate commerce by making such false representations themselves, by allowing others to make such false representations, by approving such false representations when made by others, or by requiring other to make such false representations.

113. Such false representations made by VPI&SU, White and Hincker have harmed Counterclaim Plaintiff Hokie and are likely to harm Counterclaim Plaintiff Hokie in the future.

114. These actions by VPI&SU, by White and by Hincker constitute false commercial advertising or promotion under 15 U.S.C. § 1125(a)(1)(B).

115. Counterclaim Plaintiff Hokie therefore requests this Court to (a) enter an order against VPI&SU pursuant to 15 U.S.C. § 1118 directing that all articles illegally using the federal registration symbol (“®”) in connection with the terms HOKIE and HOKIES, together with all plates, molds, matrices, and other means of making the same, be delivered up and destroyed; (b) enter an order against VPI&SU pursuant to 15 U.S.C. § 1117(a) requiring VPI&SU to disgorge its profits and/or royalties earned through the sale of merchandise bearing the terms HOKIE and HOKIES illegally marked with the federal registration symbol; (c) enter an award of damages against White and Hincker and in favor of Counterclaim Plaintiff Hokie in an amount to be determined at trial; (d) enter a permanent injunction against VPI&SU, White and Hincker pursuant to 15 U.S.C. § 1116(a) forever enjoining them from using or authorizing the illegal use of the federal registration symbol in connection with the terms HOKIE or HOKIES; and (e) enter an order pursuant to 15 U.S.C. § 1117(a) declaring this to be an “exceptional case” and entering an award against VPI&SU, White and Hincker granting to Counterclaim Plaintiff Hokie its costs and reasonable attorney’s fees incurred in the defense and prosecution of this matter.

### **JURY DEMAND**

Counterclaim Plaintiff Hokie requests a trial by jury on all claims and issues set forth in its Counterclaim, to the extent so triable.

## ANSWER

In response to the numbered paragraphs of Plaintiff's Complaint, Defendant responds as follows:

1. Defendant denies that Plaintiff has stated any viable legal claim as asserted, and denies any liability therefor. Defendant admits that the Court has jurisdiction over this matter.
2. Admitted.
3. Admitted.
4. Upon information and belief, Defendant admits this assertion.
5. Admitted.
6. Defendant admits that Plaintiff is one of many colleges and universities in the Commonwealth of Virginia; that Plaintiff is located in Blacksburg, Virginia; that Plaintiff has been in operation for in excess of one hundred years; that thousands of students are enrolled with Plaintiff each year; and that there are numerous alumni of Plaintiff in Virginia and nationwide. Other than as admitted herein, Defendant denies any remaining allegations.
7. Defendant admits, upon personal knowledge, in part, and upon information and belief, in part, that the term "Hokie" is widely, freely and openly used by individuals and businesses across Virginia, the nation and, perhaps, worldwide, to define themselves as supporters of Virginia Tech. Defendant denies that the word "hokie" was a made up word or a coined term with no meaning prior to 1896, inasmuch as its origin and use is well documented and predates Plaintiff's existence. Other than as admitted or denied herein, Defendant lacks information upon which to base a response to the remaining allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

8. Defendant admits that Plaintiff fields multiple teams that compete, sometimes successfully and sometimes unsuccessfully, nationwide, and that the nickname “Hokies” is used in one or more ways in connection therewith, and that many individuals and businesses not owned, sourced, sponsored by or affiliated with Plaintiff identify themselves as “Hokies” and as members of “Hokie Nation.” Other than as admitted herein, Defendant denies any remaining allegations.

9. Denied.

10. Defendant admits that Plaintiff has obtained U.S. Registration No. 2,351,364 (the “Registration”) for the mark HOKIES for the goods and services identified therein, which Registration speaks for itself. Defendant admits that Plaintiff has used the mark HOKIES on a broad range of goods and services, though Defendant lacks information as to whether Plaintiff properly has used its mark on all such goods and services contained in the Registration. Defendant denies that the Registration extends to, or otherwise covers, use of the term HOKIE or that Plaintiff possesses any trademark rights in the term HOKIE. Other than as admitted or denied herein, Defendant lacks information upon which to base a response to the remaining allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

11. Defendant lacks information upon which to base a response to the allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

12. Upon information and belief, Defendant admits that Plaintiff houses thousands of students annually in its residence halls; that it owns property in the Blacksburg, Virginia area; and that it may lease property in the same area. Other than as admitted, Defendant lacks information upon which to base a response to the remaining allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

13. Defendant admits, upon personal knowledge, in part, and upon information and belief, in part, that Plaintiff unsuccessfully attempted to work with an architect to develop the proposed HOKIE HOME program, which never has materialized, never has been fully agreed upon between Plaintiff and the architect, and never has resulted in any sales. Defendant admits that the proposed HOKIE HOME program has not been very active recently. Other than as admitted, Defendant lacks information upon which to base a response to the remaining allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

14. Defendant admits that in late 2009 it made plans to offer, and thereafter began so offering, real estate services under the business name Hokie Real Estate; that in 2010 Plaintiff demanded Defendant cease and desist from operating under the business name Hokie Real Estate; that Defendant responded by informing Plaintiff, among other things, that Plaintiff had no legal right to make such demand; and that Defendant refused to accede to Plaintiff's ultimatum. Defendant denies any suggestion by the allegation that Plaintiff offered, or entertained, any other resolution.

15. The responses contained in Paragraphs 1 through 14 of this Answer are incorporated herein by reference as if set forth in full.

16. Defendant admits that the Registration speaks for itself. Defendant denies that the Registration extends to, or otherwise covers, use of the term HOKIE; that Plaintiff possesses any trademark rights in the term HOKIE; that Plaintiff enjoys "significant trademark rights" in the term HOKIES; or that Plaintiff enjoys any trademark rights in connection with real estate services. Other than as admitted or denied herein, Defendant lacks information upon which to base a response to the remaining allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

17. Denied.

18. Denied, and Defendant calls upon Plaintiff for strict proof of any and all harm and damage it alleges herein.

19. The responses contained in Paragraphs 1 through 18 of this Answer are incorporated herein by reference as if set forth in full.

20. Defendant admits that Plaintiff has made use of terms including the words HOKIES and HOKIE in connection with services, and that Plaintiff claims to have authorized third parties to use such terms on merchandise. Defendant denies that the terms HOKIES and HOKIE as used by Plaintiff are “marks.” Defendant denies that the purported HOKIES and HOKIE marks are “famous marks.” Other than as admitted or denied herein, Defendant lacks information upon which to base a response to the remaining allegations and, therefore, denies the same and calls upon Plaintiff for strict proof thereof.

21. Denied.

22. Denied, and Defendant calls upon Plaintiff for strict proof of any and all harm and damage it alleges herein.

23. The responses contained in Paragraphs 1 through 22 of this Answer are incorporated herein by reference as if set forth in full.

24. Denied.

25. Denied, and Defendant calls upon Plaintiff for strict proof of any and all harm and damage it alleges herein.

26. Defendant denies that Plaintiff is entitled to any of the relief requested in its prayer for relief, and specifically as set forth in subparagraphs A through H of its prayer, or otherwise as requested in its Complaint.

27. Any allegation contained in the Complaint and not expressly addressed above is denied.

28. Defendant requests a trial by jury on all claims and issues set forth in the Complaint, to the extent so triable.



## **AFFIRMATIVE DEFENSES**

In response to Plaintiff's Complaint, Defendant responds that Plaintiff's claims are barred in whole or in part by one or more of the following affirmative defenses:

1. The terms HOKIE and HOKIES entered the English language long ago, without any involvement by Plaintiff, and are part of the public domain, which Plaintiff cannot appropriate for its sole use.
2. Plaintiff's alleged marks are used in a generic sense.
3. Plaintiff's alleged marks are used in a descriptive sense and lack secondary meaning.
4. Plaintiff is barred from any recovery on its Complaint by virtue of its own unclean hands, including but not limited to its actions in fraudulently obtaining the Registration, in illegally using the federal registration symbol ("®") on terms that are not registered, in illegally using the federal registration symbol on registered terms in connection with goods or services that fall outside the scope of the registration of such terms, in falsely claiming that unregistered terms are registered so as to intimidate third parties, in seeking and attempting to coerce licensing agreements in situations in which Plaintiff lacks trademark rights to license, in engaging in false advertising and promotion, and in engaging in unfair methods of competition.
5. One or more of Plaintiff's registered marks was/were obtained and/or has/have been maintained fraudulently and are entitled to no protection.
6. Plaintiff has granted naked licenses of its alleged mark(s) to third parties.
7. Plaintiff has abandoned its alleged mark(s).

8. Significant third party use of either or both of the terms HOKIE and HOKIES has diluted, weakened and/or eliminated entirely (through genericization) any rights Plaintiff may have had in either or both of these terms.

9. Plaintiff cannot establish, and lacks, proper chain of title to the alleged mark(s).

10. Plaintiff lacks standing to enforce any trademark rights in either HOKIE or HOKIES by virtue of one or more of the aforementioned affirmative defenses.

11. Plaintiff has not continuously used its alleged mark(s).

12. Plaintiff's alleged marks are not famous.

13. Plaintiff fails to state facts sufficient to state a claim upon which relief can be granted.

14. No likelihood of confusion exists as between any purported trademark uses between Defendant and Plaintiff and/or as to any goods and services offered under any such purported trademark uses between Defendant and Plaintiff.

15. Plaintiff's identification of goods and services in connection with one or more of Plaintiff's marks is so vague and indefinite in one or more material respects that Plaintiff should be entitled to no protection, or at least very limited protection, for the alleged mark(s), thereby precluding Plaintiff from any recovery as against Defendant for any alleged infringement of such marks.

16. Plaintiff's identification of goods and services offered in connection with one or more of Plaintiff's registered marks is so vague and indefinite in one or more material respects as to provide no reasonable notice as to what goods and services are covered by such registrations.

17. Plaintiff has not suffered any damages.

18. Defendant has not engaged in any unlawful conduct.
19. Defendant has not engaged in any tortious act.
20. Defendant has not engaged in trademark infringement.
21. Defendant has not engaged in false designation of origin.
22. Defendant has not engaged in unfair competition.
23. Defendant's use of its mark is not dilutive of Plaintiff's alleged marks.
24. Plaintiff's claims are barred by the doctrine of fair use, inasmuch as Defendant's use of the term HOKIE could be considered a nominative or descriptive fair use only.
25. Defendant has not used the complained of term as a trademark.
26. Plaintiff's claims are limited by the doctrine of innocent intent. Any alleged activities by Defendant were innocent and not undertaken in an intentional or willful manner.
27. This is not an exceptional case and, as such, Plaintiff is entitled to no enhanced recovery.
28. The principles of equity do not merit an award of any of the following: an injunction, lost profits, any damages sustained by the Plaintiff, attorneys' fees, and/or costs of the action.
29. Defendant reserves the right to supplement these affirmative defenses as may be warranted by evidence obtained through discovery.

**PRAYER FOR RELIEF**

WHEREFORE, Defendant and Counterclaim Plaintiff Hokie prays this Court to enter judgment against Plaintiff and Counterclaim Defendant VPI&SU and against Counterclaim Defendants White and Hincker, pursuant to which the Court will (a) dismiss VPI&SU's Complaint with prejudice and (b) grant the relief against VPI&SU, White and Hincker identified in the six Claims for Relief set forth in the above Counterclaim.

HOKIE REAL ESTATE, INC.

By: s/ Keith Finch

James R. Creekmore, Esq. (VSB No. 36246)  
Keith Finch, Esq. (VSB No. 37599)  
Brian S. Wheeler, Esq. (VSB No. 74248)  
Attorneys for Defendant Hokie Real Estate, Inc.  
THE CREEKMORE LAW FIRM PC  
106 Faculty Street  
Blacksburg, Virginia 24060  
(540) 443-9350 (phone)  
(540) 443-9350 (fax)  
james@creekmorelaw.com  
keith@creekmorelaw.com  
brian@creekmorelaw.com

CERTIFICATE OF SERVICE

I hereby certify that on the 28th day of March, 2011, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

John H. Thomas, Esq.  
Counsel for Plaintiff and Counterclaim Defendant  
Virginia Polytechnic Institute and State University  
THOMAS & KARCESKI, PC  
536 Granite Avenue  
Richmond, VA 23226  
jthomas@ip-counsel.net

s/ Keith Finch  
James R. Creekmore, Esq. (VSB No. 36246)  
Keith Finch, Esq. (VSB No. 37599)  
Brian S. Wheeler, Esq. (VSB No. 74248)  
Attorneys for Defendant Hokie Real Estate, Inc.  
THE CREEKMORE LAW FIRM PC  
106 Faculty Street  
Blacksburg, Virginia 24060  
(540) 443-9350 (phone)  
(540) 443-9350 (fax)  
james@creekmorelaw.com  
keith@creekmorelaw.com  
brian@creekmorelaw.com