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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 12<sup>th</sup> Man/Tennessee

Serial No. 78020515

James H. Harris III of Gordon, Martin, Jones, Harris, Shrum  
& Benson for 12<sup>th</sup> Man/Tennessee.

John M. Gartner, Trademark Examining Attorney, Law Office  
102 (Karen M. Strzyz, Managing Attorney).

Before Quinn, Hohein and Wellington, Administrative  
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

12<sup>th</sup> Man/Tennessee has filed an application to register  
the mark 12TH CHIEF for goods ultimately identified as  
follows:

jewelry (in International Class 14);

bumper stickers (in International Class  
16);

insulated beverage containers (in  
International Class 21); and

clothing for informal wear, namely  
pants, jackets, shirts, t-shirts,

sweatshirts and shorts, tank tops, sweaters, jump suits, sleep wear, namely robes, night shirts and pajamas, golf shirts, jerseys, wristbands, warm up suits, raincoats, parkas, ponchos, gloves, ties, suspenders, cloth bibs, mittens, knit hats and caps, scarves, aprons, headbands, ear muffs and underwear; footwear, namely, boots, sneakers and athletic shoes (in International Class 25).<sup>1</sup>

The examining attorney has refused registration under Section 2(d), 15 U.S.C. §1052(d), on the ground of likelihood of confusion with three previously registered marks, which are the subjects of registrations issued to the same entity. The trademark examining attorney also has refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark falsely suggests a connection with this same entity, namely Kansas City Chiefs Football Club, Inc.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed have briefs.

At the outset we note that this appeal was suspended, pursuant to applicant's request, after applicant filed its appeal brief. Specifically, applicant asked for and this appeal was suspended pending a final determination involving two co-pending intent-to-use applications filed

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<sup>1</sup> Application Serial No. 78020515, filed August 10, 200, alleging a bona fide intention to use the mark in commerce.

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by applicant to register the marks 12TH BEAR (Serial No. 78023394) and 12TH RAVEN (Serial No. 78026554) for goods that are, in part, identical to the ones identified in the present application. Those applications were opposed by Chicago Bears Football Club, Inc. and NFL Properties LLC (Opposition No. 91150925 wherein plaintiffs own the marks BEARS and CHICAGO BEARS), and Baltimore Ravens Limited Partnership and NFL Properties LLC (Opposition No. 91157082 wherein plaintiffs own the mark BALTIMORE RAVENS), respectively, on the grounds of likelihood of confusion, dilution and falsely suggesting a connection. In both cases, the Board found a likelihood of confusion between the involved marks (not reaching the other two pleaded grounds for relief), and sustained the oppositions. See *Chicago Bears Football Club, Inc. v. NFL Properties LLC*, 83 USPQ2d 1073 (TTAB 2007). Applicant did not appeal.

The present ex parte appeal presents a likelihood of confusion issue markedly similar to the one decided in each of the earlier oppositions. The examining attorney has refused registration under Section 2(d) on the ground that applicant's mark, if applied to applicant's goods, so resembles the previously registered marks, as indicated below, as to be likely to cause confusion.



for

furnishing entertainment services in the nature of professional football games (International Class 41);<sup>2</sup>

CHIEFS for

furnishing entertainment services in the nature of professional football games and exhibitions (International Class 41);<sup>3</sup> and

KANSAS CITY CHIEFS for

trading cards, posters, magazines relating to football, postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper towels, books relating to football, posterbooks, notepads, paper party hats and greeting cards (International Class 16); and

men's, women's and children's clothing and footwear, namely, coaches caps, wool hats, painters caps, baseball caps, visors, headbands, ear muffs, knit face masks, belts, wristbands, T-shirts, tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, suspenders, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweatpants, jeans, pants, knickers, socks, underwear, bathing

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<sup>2</sup> Registration No. 0982132, issued April 9, 1974; second renewal. The words "Kansas City" are disclaimed apart from the mark.

<sup>3</sup> Registration No. 1085091, issued February 7, 1978; second renewal.

suits and leg warmers (International Class 25).<sup>4</sup>

In the present case, we affirm the refusal to register grounded on likelihood of confusion.

Applicant argues that, at worst, its mark only calls to mind registrant's marks. Applicant further contends that the cited CHIEFS mark is weak, making reference to a number of third-party registrations of CHIEF/CHIEFS marks, but failing to properly introduce any into the record. Applicant did submit, however, a summary of twenty-two listings of CHIEF/CHIEFS in the Kansas City (Kansas and Missouri) Yellow Pages. Nevertheless, applicant concedes that the cited marks "may be well known because of the national broadcast of professional football games."

The examining attorney maintains that applicant's and registrant's marks are similar and that applicant's goods are, in part, identical, or are otherwise related to registrant's goods and services in that applicant's goods are the types of consumer goods traditionally licensed and sold by professional sports organizations, including football teams like the Kansas City Chiefs. In support of the refusal, the examining attorney submitted excerpts of

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<sup>4</sup> Registration No. 1807453, issued November 30, 1993; first renewal. The words "Kansas City" are disclaimed apart from the mark.

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registrant's, applicant's and third-parties' websites, excerpts of articles retrieved from the NEXIS database, and copies of several of applicant's co-pending applications, all using the term 12TH in connection with the name of a National Football League team.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks in their entireties and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their entireties in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a

side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In a comparison of applicant's mark 12TH CHIEF to registrant's marks CHIEFS and KANSAS CITY CHIEFS, we find the marks are similar in that they include the word CHIEF or CHIEFS. The term CHIEFS comprises the entirety of one of registrant's marks and the term is the dominant part of the mark KANSAS CITY CHIEFS (whether typed or in logo form), where KANSAS CITY identifies the location of the Kansas City Chiefs football team.

In applicant's mark, the term CHIEF dominates the mark over the 12TH portion. This is so because the numerical designation does not distinguish the marks inasmuch as it reinforces the connection with the Kansas City Chiefs football team by specifically identifying a particular Chief, namely the twelfth Chief (a loyal fan of the team). In comparing the marks, "[t]here is nothing improper in stating that, for rational reasons, more or less weight has

been given to a particular feature of a mark, provided that the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant explains the meaning of 12TH in its mark as follows:

Applicant's purpose in using the word "12" in connection with its goods is to specify and to involve the team sports fan. That fan is the sixth person on a basketball team, the tenth on a baseball team, the twelfth on a football team. It is the fan who watches his or her teams, who imagines himself or herself as a supporter of and participant in the sport, and who seeks an expression of his/her self-image as a fan of the particular sport and team.

By its use of its mark, Applicant simply hopes to create in fans throughout this country a secondary identification of the mark with a source of quality goods that will enhance the fan's appreciation for and love of that fan's particular sport of choice.

Granted that the use of 12<sup>th</sup> in this case is designed to engender in the fan a sense of belonging and participation with a football team. There is nothing sacrosanct about a football team or any other kind of team.

(Brief, pp. 6-7). This intended meaning is supported by the several articles introduced by the examining attorney

regarding the "12<sup>th</sup> man" and its connotation of a fan of a particular football team.

We also do not attribute trademark significance to the difference in the plural and singular form of the word "Chief" in the marks. See *Wilson v. Delauney*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ["It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark."]. Although we doubt that the singular/plural difference would even be noticed by consumers, it is likely that the singular form of the word would merely be viewed as identifying someone who is associated with the Kansas City Chiefs. Moreover, applicant's mark would be suggestive of a group, as are registrant's marks, because implicit in the idea of a 12TH CHIEF is that there are at least 11 others. Thus, the marks CHIEFS and 12TH CHIEF have similar meanings and commercial impressions. The addition of the designation 12TH does not result in the marks having significantly different appearances or pronunciation given that these marks are dominated by the term CHIEF/CHIEFS and the designation 12TH reinforces the CHIEF portion of the mark. We find that the similarities

between 12TH CHIEF and CHIEFS in sound, appearance, meaning and commercial impression outweigh their differences.

We likewise find that the marks 12TH CHIEF and KANSAS CITY CHIEFS (with or without a design) are similar. Again, the term CHIEFS dominates both of registrant's marks, and this term is virtually identical to the dominant portion of applicant's mark. The geographically descriptive term KANSAS CITY is not as significant as the term CHIEFS, and thus does not distinguish the marks. See *In re Chatam International Incorporated*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004). The marks are similar in sound, appearance, meaning and commercial impression. See also *Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club Limited Partnership*, 34 F.3d 410, 31 USPQ2d 1811 (7<sup>th</sup> Cir. 1994); and *National Football League Properties, Inc. v. New Jersey Giants, Inc.*, 637 F. Supp. 507, 229 USPQ 785 (D.N.J. 1986).

We obviously have considered the difference between 12TH and KANSAS CITY, but this difference does not result in the marks not being similar. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984).

In view of the above, we conclude that applicant's mark 12TH CHIEF and registrant's marks CHIEFS and KANSAS

CITY CHIEFS (with or without a design) are similar. This factor weighs in favor of finding likelihood of confusion.

We next turn to consider whether the goods and/or services are related. In this case, the goods are, at least in part, identical. The cited registration of the mark KANSAS CITY CHIEFS covers goods that are, in part, identical to the goods identified in the present application, including pants, t-shirts, golf shirts, tank tops, ear muffs, headbands and wristbands, among other items. The clothing items are otherwise related. To the extent that the goods are identical, when marks are used in connection with identical goods, as is the case herein, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines."

*Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Further, as stated by the Board in prior cases, it is common knowledge that the licensing of commercial trademarks on "collateral" goods has become a part of everyday life. See *DC Comics v. Pan American Grain Mfg. Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005); and *Turner Entertainment v. Nelson*, 38 USPQ2d 1942, 1944 (TTAB 1996). See also *Chicago Bears Football Club, Inc. and NFL Properties LLC v. 12<sup>TH</sup> Man/Tennessee LLC*, 83 USPQ2d at 1077.

The excerpts of registrant's website show that the Kansas City Chiefs football team has a robust licensing program, offering its fans a wide variety of products for sale, all related to registrant's entertainment services in the nature of providing professional football games. Thus, we find that applicant's goods in Classes 14, 16, 21 and 25 would be viewed as collateral products to registrant's services.

Applicant's goods and registrant's goods and services would move in the same trade channels to the same classes of purchasers, including ordinary ones. *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). It is beyond dispute that applicant intends to market its goods to registrant's fans and customers.

The evidence of record also shows that registrant and its KANSAS CITY CHIEFS and CHIEFS marks have been the subject of substantial publicity. Contrary to applicant's argument, the meager Yellow Pages listings (22) of CHIEF(S) businesses do nothing to diminish the distinctiveness of registrant's marks for its goods and services.

We conclude that applicant's mark, 12TH CHIEF, if it were used on the identified goods, is likely to cause confusion with registrant's marks CHIEFS and KANSAS CITY CHIEFS (with or without a design).

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In view of our disposition on the likelihood of confusion refusal, we do not reach the falsely suggesting a connection refusal.

**Decision:** The refusal to register is affirmed.