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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pro-Football, Inc. and NFL Properties LLC
v.
David S. Campbell

Opposition No. 91152156
to Application No. 76021469
filed on April 10, 2000

Robert Lloyd Raskopf, Jennifer Johnson Millones and Sean D. Burke of White & Case for Pro-Football, Inc. and NFL Properties LLC.

David S. Campbell, Esq., Pro se.

Before Walters, Rogers and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Pro-Football, Inc. and NFL Properties LLC ("opposers") filed their opposition to the application of David S. Campbell to register the mark WASHINGTON PIGSKINS for the goods identified below:

"Trading cards, posters, magazines, and books regarding football; postcards, calendars, wrapping

paper, paper gift boxes, paper stickers, paper napkins, paper towels, poster books, note pads, paper hats, and greeting cards," in 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, wrist bands, t-shirts, tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, braces, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweat pants, jeans, pants, knickers, socks, underwear, bathing suits, and leg warmers," in International Class 25.¹

As grounds for opposition, opposers assert that applicant's mark, when applied to applicant's goods so resembles opposer Pro-Football, Inc.'s previously used and registered marks incorporating the terms WASHINGTON REDSKINS, REDSKINS and SKINS for organizing, conducting and promoting the Washington Redskins football franchise and for a wide variety of goods and services including paper goods, printed matter and clothing, as to be likely to cause confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The registered marks pleaded by opposers are set forth below:

¹ Application Serial No. 76021469, filed April 10, 2000, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

REDSKINS

for "entertainment services - namely, presentations of professional football contests," in International Class 41;²



for "entertainment services - namely, football exhibitions rendered live in stadia and through the media of radio and television broadcasts," in International Class 41;³



for "entertainment services - namely, presentations of professional football contests," in International Class 41;⁴

² Registration No. 1,085,092, issued February 7, 1978, to Pro-Football, Inc. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. Renewed for a term of 10 years from February 7, 1998.]

³ Registration No. 836,122, issued September 26, 1967, to Pro-Football, Inc. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. Renewed for a term of 20 years from September 26, 1987.]

⁴ Registration No. 987,127, issued June 25, 1974, to Pro-Football, Inc. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. Renewed for a term of 10 years from June 25, 1994.]

WASHINGTON REDSKINS

For "entertainment services - namely, presentations of professional football contests," in International Class 41;⁵



for "entertainment services - namely, presentations of professional football contests," in International Class 41.⁶

Additionally, opposers assert as a ground for opposition, under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), that applicant intends to trade on the goodwill associated with opposers, and that applicant's intended use of his mark will falsely suggest a connection with opposer.

Opposers also assert a ground for opposition under Sections 2(f) and 13(a) of the Trademark Act, 15 U.S.C. §§1052(f) and 1063, alleging that the registration of applicant's proposed mark "will dilute the distinctive and

⁵ Registration No. 978,824, issued February 12, 1974, to Pro-Football, Inc. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. Renewed for a term of 10 years from February 12, 2004.]

⁶ Registration No. 986,668, issued June 18, 1974, to Pro-Football, Inc. [Section 8 affidavit accepted. Renewed for a term of 10 years from June 18, 1994.]

famous quality of the SKINS marks.”⁷ [Notice of Opposition, para. 21.]

Applicant, in his answer, stated he was without sufficient information to admit or deny or he denied the salient allegations of the claim and asserted as affirmative defenses the equitable grounds of waiver, laches, estoppel and unclean hands.⁸ Additionally, applicant asserted that he “does not purport to own or run a football team” (para. 6); that opposer’s marks are disparaging; and that his mark “does not purport to characterize an ethnic group” (para. 5).⁹

The Record

The record consists of the pleadings; the file of the involved application; certified status and title copies of opposer Pro-Football Inc.’s five pleaded federal

⁷ It appears that opposers intended to plead a claim of dilution under Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c), and we have so considered it. Additionally, we have considered paragraph nos. 9 and 10 together and find that opposers’ allegation of dilution is legally sufficient, inasmuch as the two paragraphs together contain the required allegation that opposer Pro-Football Inc.’s marks became famous prior to the filing date of the involved application. See *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). See also, *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Therefore, we have considered this to be a properly pleaded claim of dilution.

⁸ These defenses have not been tried by the parties and, therefore, we have considered them waived. Additionally, we note opposer’s Interrogatory No. 13, asking applicant’s basis for these defenses, and applicant’s response that “Applicant will agree to dismiss these equitable defenses.”

⁹ Applicant’s statements constitute, in the absence of a counterclaim to cancel opposer’s pleaded registrations, an impermissible attack on the validity of such registrations. We add that, while applicant has stated his belief that opposer Pro-Football’s registrations have been cancelled, applicant’s statement is inaccurate.

registrations¹⁰ and photocopies of various state registrations, made of record by opposers' notice of reliance; various printed publications and a copy of a prior decision of this Board, all made of record by applicant's notice of reliance¹¹; and the testimony depositions, with accompanying exhibits, by opposers of David M. Proper, counsel in the legal department of the National Football League, and Susan Rothman, senior director of licensing for the National Football League. Only opposers filed a brief on the case and a hearing was not requested.

Factual Findings

The record establishes the following facts in this case.

Opposer NFL Properties, LLC ("NFL Properties") is the exclusive licensee of the National Football League ("NFL"); and its purpose is to promote and exploit the trademarks and intellectual property of the NFL and its member clubs. NFL Properties has been entering into sponsorship and licensing agreements for NFL trademarks since 1963.

¹⁰ Opposer also included a certified copy of its Registration No. 1,606,810, which was not pleaded and, therefore, has not been considered.

¹¹ Opposers filed, but withdrew, a motion to strike applicant's notice of reliance as untimely filed. However, opposers' stated in their brief that the Board should grant their motion to strike as conceded because applicant did not respond thereto. It was reasonable for applicant not to respond in view of opposers withdrawal of the motion. We consider opposers to have waived their objection and, thus, the documents submitted by applicant's notice of reliance are part of the record.

Opposer Pro-Football, Inc. ("Pro-Football") has operated the Washington Redskins professional football team since 1937; and it is the owner of the pleaded and established registrations for marks including the terms REDSKINS and WASHINGTON REDSKINS for entertainment services pertaining to professional football games.

The NFL provides coverage and broadcasts of the Redskins football games nationwide via its broadcast partners, CBS, ABC, ESPN and Fox; and the REDSKINS and WASHINGTON REDSKINS marks are used in connection therewith. In 1999, Redskins football games televised in the Washington area had a 29.9 average rating (percentage of total TVs, whether on or off, viewing Redskins games) and 55 average share (percentage of TVs on and viewing Redskins games). In 2000, the average rating was 24.8 and the average share was 48.

The WASHINGTON REDSKINS and REDSKINS marks have been used widely in many print media articles about the football team. Additionally, many print media articles from approximately 1983 to the time of trial refer to the Redskins football team and/or players on the team as HOGS.

NFL licensed goods include, among many items, stationery and school supplies, calendars, posters, mugs, bar supplies, key chains, aprons, hats, trading cards, paper products and party goods, and many types of clothing for

men, women and children. The majority of the NFL licensed items range in wholesale price between approximately \$5 and \$15 for non-clothing items and between approximately \$15 and \$35 for clothing items. Sales revenue generated by sales of NFL licensed products is approximately \$2 billion retail annually, of which one percent is attributable to products bearing the WASHINGTON REDSKINS and REDSKINS trademarks. NFL licensed items are sold to consumers through mass merchandisers, including K-Mart, Wal-Mart and Target; national retailers, including Sears and JC Penney; department stores, including Federated Stores and May Company; and sporting goods stores, including Footlocker, Champs and Sports Authority. NFL licensed items are also sold via the Internet and TV shopping channels HSN and QVC.

Applicant responded to a letter from opposer NFL Properties' counsel, David Proper, and wrote a letter to Mr. Proper dated February 25, 2002 that stated, in part, the following:

... I am now, and have been for 30 years, a fan of the Washington Redskins football team.

...

In 1993, I set out on a project to apply some creativity to solve the Washington NFL team name problem.

...

I became committed to the discovery and development of a new team name and logo for the Washington DC NFL football franchise. I undertook this work as a friend and fan of the team. After several weeks of research and writing, I came upon the name which I believed was a worthy successor name: the WASHINGTON PIGSKINS.™

...
The reasons I believe that WASHINGTON PIGSKINS™ is the appropriate new successor name for the Washington DC Redskins are as follows:

1. WASHINGTON PIGSKINS™ does not stray very far from the current team name. It has the same number of syllables and the same number of letters. It rhymes with "Washington Redskins."
2. WASHINGTON PIGSKINS™ incorporates the nickname for a football: a pigskin.
3. Many Washington fans have already shortened the "Redskins" to the "Skins." Naming the team PIGSKINS means that fans can still abbreviate the team name to the 'Skins.
4. Washington's NFL team already has a history of porcine affinity ... the offensive front line has been know as the "hogs" for decades.

...
For the foregoing reasons, I don't believe that NFL Properties is compelled to oppose the registration of this mark, and should rather work together with me to assure that the Redskins have the WASHINGTON PIGSKINS™ name in reserve if things turn out badly in the legal process.

Analysis

Likelihood of Confusion

Inasmuch as certified copies of opposer Pro-Football Inc.'s registrations are of record, there is no issue with respect to opposers' priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Additionally, opposers have established use of the marks WASHINGTON REDSKINS and REDSKINS in connection with many, if not all, of the goods identified in the opposed application since long before the filing date of the application.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The first *du Pont* factor we consider is fame and we conclude that opposers have established that their WASHINGTON REDSKINS and REDSKINS marks are strong, famous marks in connection with their entertainment services, and that this fame extends to their wide range of licensed products bearing the marks. This factor weighs strongly in opposers' favor. See, *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

As our primary reviewing Court has made clear, fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. "Famous or strong marks enjoy a wide latitude of legal protection" and a famous mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In this regard, the Court has noted that there is "no excuse for even approaching the well-known trademark of a competitor ... and that all doubt as to whether confusion, mistake, or

deception is likely is to be resolved against the newcomer, especially when the established mark is one which is famous." *Kenner Parker Toys, id.* at 1456. See also, *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 2 USPQ2d 1901, 1904 (Fed. Cir. 1989). This is so because "a well-known mark enjoys an appropriately wider latitude of legal protection, for similar marks tend to be more readily confused with a mark that is already known to the public." *Opryland USA, Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992). See also, *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984)(involving the marks SPICE ISLANDS and SPICE VALLEY).

With respect to the goods and services of the parties, we observe that there is a substantial overlap in the goods identified in the application and the licensed goods that use the WASHINGTON REDSKINS and REDSKINS marks. Further, many of applicant's identified goods, e.g., "trading cards," "posters," "books regarding football," "coaches caps," "jerseys" and "sweat pants," are exactly the types of licensed products that are likely to be associated with opposers' entertainment services in the nature of professional football games. Thus, we conclude that the goods of the parties are either identical or closely related and applicant's goods are related to opposer's services.

Because the parties' goods are identical or closely related, such goods will travel through the same trade channels to the same classes of purchasers. The American public are the likely purchasers of the parties' goods and of opposers' services.

Moreover, opposer's evidence establishes that the goods identified in the application and those upon which opposers' marks are used are relatively inexpensive and are likely to be purchased by the general consumer with less purchasing care than would be exercised for a more expensive product.

Turning to the marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

For all of the reasons noted by applicant and quoted above, we find that applicant's proposed mark, WASHINGTON PIGSKINS is substantially similar to opposers' word marks and design marks incorporating WASHINGTON REDSKINS or REDSKINS in appearance, sound, connotation and overall

commercial impression. Applicant essentially conceded this in the referenced letter. The terms WASHINGTON REDSKINS and WASHINGTON PIGSKINS have the identical first word and identical last syllable, they have the same number of syllables, the same number of letters and the marks rhyme. As applicant stated, "pigskin" is an informal term for a football,¹² and thus, it is likely to bring to mind opposers' marks and services; and "hogs" has been used in connection with players on opposers' Redskins football team, so that applicant's mark incorporating the synonymous term "pig" is likely to bring to mind opposers' marks and services. We conclude that applicant's mark is substantially similar to each of opposers' pleaded and established marks including the terms WASHINGTON REDSKINS or REDSKINS and that this similarity is all the more significant in view of the fame of opposers' marks.

Finally, we find that the evidence clearly establishes applicant's bad faith adoption of the proposed mark. His above-referenced letter establishes that his sole purpose in adopting WASHINGTON PIGSKINS is to trade off the fame and reputation of opposers' marks. The fact that he states that he is a fan with the interests of the football team at heart

¹² We take judicial notice of the definition of "pigskin" as "3. Informal a. Football" in *The American Heritage Dictionary*, 2nd College Edition, 1992.

in adopting this proposed mark is not relevant to our analysis of the trademark issues herein.

Therefore, the relevant factors overwhelmingly lead us to the conclusion that in view of the fame of opposers' marks, the substantial similarity in the commercial impressions of the parties' marks, and applicant's intent in adopting his proposed mark, the contemporaneous use of the parties' marks on the goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Opposer's Additional Claims

Because we have found that opposers have priority and that a likelihood of confusion exists, we need not, and do not, reach opposers' claims of a false suggestion of a connection with opposers, under Section 2(a) of the Trademark Act, and dilution, under Section 43(a) of the Trademark Act.

Decision: The opposition is sustained.