

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Oral Hearing: March 29, 2007 Mailed: December 28, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

Council of Ivy Group Presidents

v.

Gray, Robert R.L.

---

Opposition No. 91161051  
to application Serial No. 78241931  
filed on 4/25/03

---

Glenn A. Gunderson of Dechert LLP for Council of Ivy League Presidents.

Arnold P. Lutzker of Lutzker & Lutzker for Robert R.L. Gray.

---

Before Zervas, Cataldo and Bergsman,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On April 25, 2003, Robert R.L. Gray filed an application to register on the Principal Register the mark IVY LEAGRO in typed or standard character form, based upon an allegation of his bona fide intent to use the mark in commerce on or in connection with the following goods and services:

catalogs, magazines and books in the field of educational services; printed educational and teaching materials, namely, education guide books;

**Opposition No. 91161051**

address books, scrapbook albums, printed awards, paper party bags, paper bags, ball-point pens, paper banners, loose leaf binders, book binders, bulletin boards, magnetic boards, date books, engagement books, picture books, sketch books, telephone number books, wire bound books, pencil boxes, stationery boxes, bumper stickers, window stickers or decals, playing card cases, pen cases, coasters made of paper, decals, paper party decorations, desk sets, diaries, paper party hats, letter openers, personal organizers, organizers for stationery use, decorative pencil-top ornaments, stationary, stencils, stickers, table napkins of paper, photograph albums, appliques in the form of decals, appointment books, art etchings, art pictures, art print, merchandise bags, plastic or paper bags of merchandise packing, mechanical binder sets including rings, dividers and folders; blotters, bond paper, book bindings, book covers, book holders, bookends, bookmarks, composition books, notebooks, business cards, calendar desk pads, desk calendars, pocket calendars, wall calendars, cards in the nature of blank cards and business cards, non-magnetically encoded credit cards, non-magnetically encoded debit cards, gift cards, greeting cards, playing cards, trivia cards, checkbook covers, clip boards, desk sets, desk pads, diaries, drawing instruments, namely, pencils, pens and brushes, telephone directories, paper emblems, envelopes, erasers, loose leaf paper, loose leaf binders, markers, note books, note pads, recycled paper, wrapping paper, typewriter paper, writing paper, paper flags, paper name badges, postcards, sketch books, writing tablets for household or office use; paper weights

in International Class 16;

clothing, namely, footwear, t-shirts, sweat shirts, sweatpants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters, belts, ties, nightshirts, hats, caps, baseball caps, warm-up suits, jackets, parkas, coats, cloth baby bibs, head bands, wrist bands, pajamas, pullovers, rain coats, rain wear, scarves, jogging suits, play suits, gym suits, body suits, sun visors, suspenders, wind-resistant jackets

**Opposition No. 91161051**

in International Class 25; and

providing information in the field of educational services via the Internet; providing on-line newsletter in the field of educational services

in International Class 41.<sup>1</sup>

Registration has been opposed by Council of Ivy League Presidents ("opposer"). As grounds for opposition, opposer asserts that it is an unincorporated association consisting of Brown University, Columbia University, Cornell University, Dartmouth College, Harvard University, University of Pennsylvania, Princeton University and Yale University; and that it is the owner of numerous marks, which it has previously used and registered on the Principal Register, including the following:

IVY LEAGUE

in typed or standard character form, for "paper products, namely, folders, pens" in International Class 16;<sup>2</sup>

THE IVY LEAGUE

in typed or standard character form, for "printed matter and publications, namely, books, newsletters, pamphlets and brochures in the field of intercollegiate athletics" in International Class 16;<sup>3</sup>

---

<sup>1</sup> Application Serial No. 78241931.

<sup>2</sup> Registration No. 2663674 issued on December 17, 2002.

<sup>3</sup> Registration No. 2475096 issued on August 7, 2001 with a disclaimer of "LEAGUE." Section 8 affidavit accepted; Section 15 affidavit acknowledged.

THE IVY LEAGUE

in typed or standard character form, for "clothing, namely, shirts" in International Class 25;<sup>4</sup>

THE IVY LEAGUE

in typed or standard character form, for "educational and entertainment services namely, conducting educational activities such as courses, seminars and conferences and sporting events at the college and university level" in International Class 41;<sup>5</sup> and

THE IVY LEAGUE

in typed or standard character form, for "informational services, namely, providing historical, educational and sports information via a global telecommunications network" in International Class 42.<sup>6</sup>

Opposer alleges that applicant's IVY LEAGRO mark and opposer's previously used and registered IVY LEAGUE, THE IVY LEAGUE, and other IVY formative marks are highly similar; that applicant's goods and services are closely related to those recited in opposer's registrations; that, as a result,

---

<sup>4</sup> Registration No. 2096273 issued on September 16, 1997. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

<sup>5</sup> Registration No. 2442152 issued on April 10, 2001 with a disclaimer of "LEAGUE." Section 8 affidavit accepted; Section 15 affidavit acknowledged.

<sup>6</sup> Registration No. 2138949 issued on February 24, 1998. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

**Opposition No. 91161051**

confusion, mistake and deception are likely among consumers as to the source thereof under Trademark Act Section 2(d); and that opposer will be damaged thereby. Opposer further alleges that its marks are famous and distinctive and were so prior to the filing date of the challenged application; that applicant's mark dilutes the distinctive quality of opposer's marks under Trademark Act Section 43(c)(1); and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.

**The Record**

The record consists of the pleadings, and the file of the involved application. In addition, during its assigned testimony period, opposer took the deposition, with accompanying exhibits, of Jeffrey Orleans, its Executive Director. Opposer also filed notices of reliance upon the following:

(1) certified copies of its pleaded registrations, which show that the registrations are subsisting and are owned by opposer;

(2) extracts from books, dictionaries, encyclopedias, and other general reference materials, published prior to the filing date of the involved application, which show use of the term IVY LEAGUE in reference to opposer;

**Opposition No. 91161051**

(3) a listing of articles from the Lexis Nexis "All News" database published between March 1, 2003 and April 24, 2003 that use IVY LEAGUE to refer to opposer, its members and their academic or athletic activities, as well as a sample of 20 articles therefrom;

(4) a listing of all articles in the Lexis Nexis "Major Newspapers" database, published in the first month of every year from 1991 to 2005, that use IVY LEAGUE to refer to opposer, its members and their academic or athletic activities, as well as a sample of 150 articles therefrom;

(5) a listing of all articles in the Lexis Nexis database published in *The New York Times*, *The Washington Post*, *The Boston Globe*, *Los Angeles Times*, and *Chicago Tribune* in 2005 that use IVY LEAGUE to refer to opposer, its members and their academic or athletic activities, as well as a sample of 50 articles therefrom;

(6) applicant's responses to opposer's Interrogatory Nos. 7 and 8;

(7) excerpts from the discovery deposition of opposer's Executive Director, Jeffrey Orleans;<sup>7</sup>

(8) printed copies of third-party registrations obtained from the United States Patent and Trademark

---

<sup>7</sup> Opposer introduced these excerpts pursuant to Trademark Rule 2.120(j)(4), 37 CFR §2.120(j)(4).

**Opposition No. 91161051**

Office's (USPTO) Trademark Applications and Registrations Retrieval (TARR) database;

(9) extracts from dictionaries containing definitions of various institutions and organizations, and printed copies of trademark registrations therefor obtained from the USPTO's Trademark Electronic Search System (TESS) database; and

(10) an extract from a dictionary containing a definition of the term "negro."

Applicant, during its assigned testimony period, took the depositions, with accompanying exhibits, of applicant and applicant's expert witness, Dr. Geoffrey Nunberg.

Applicant also filed notices of reliance upon the following:

(1) excerpts from the discovery deposition of opposer's Executive Director, Jeffrey Orleans;

(2) newspaper and journal articles, advertisements, comic strips, extracts from books and dictionaries, legal briefs and Supreme Court decisions containing various uses of IVY LEAGUE; and

(3) printed copies of third-party registrations of various IVY formative marks from the USPTO's TESS database.

The parties have designated portions of the record as "confidential." Thus, we will refer to such testimony and evidence that was submitted under seal in only a very general fashion.

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief. In addition, both parties were represented by counsel at an oral hearing held before the Board.

**Evidentiary Matters**

Before addressing the merits of the case, certain evidentiary matters require our attention. Opposer has filed numerous objections against certain testimony and exhibits introduced by applicant. Applicant has responded to opposer's objections. The majority of opposer's objections go to the relevance, competence and materiality of the testimony and exhibits in question.

We note, nonetheless, that none of the testimony and/or exhibits sought to be excluded is outcome determinative, alone or cumulatively. Given this fact, coupled with the number of objections, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections thereto, and we have accorded whatever probative value the subject testimony and exhibits merit.

**General Facts**

The record shows that opposer is an association of eight of the oldest and most prestigious postsecondary schools in the United States. Collectively, these

**Opposition No. 91161051**

institutions are known as "The Ivy League" or "the Ivies. These institutions use the marks IVY LEAGUE and THE IVY LEAGUE to identify themselves, their educational and extracurricular activities, and a variety of goods and services related thereto.

The record further shows that applicant coined the term IVY LEAGRO by combining the terms "IVY LEAGUE" and "NEGRO" while an undergraduate student at Brown University as a reference to himself and other African-American students at Ivy League schools. Applicant has sold T-shirts bearing the IVY LEAGRO mark to students at Brown University as well as Howard University and Morehouse College, which institutions are commonly referred to as "Black Ivies."

**Opposer's Standing**

Because opposer has properly made its pleaded registrations of record, and further has shown, by its use and registration of marks that are at least arguably similar to applicant's mark that it is not a mere intermeddler, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

### Priority of Use

Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks therefor and the goods and services recited therein. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We further note that applicant does not contest that opposer has made prior use of the marks in its pleaded registrations.

### Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We note that opposer relies upon status and title copies of nineteen of its registrations for various IVY formative marks. (Opp. 1<sup>st</sup> notice of reliance). For purposes of the *du Pont* factors that are relevant to this case we will concentrate our discussion of the issue of

likelihood of confusion on those registrations of opposer's which are closest to the mark for which applicant is seeking registration, namely, opposer's five above-referenced registrations for IVY LEAGUE and THE IVY LEAGUE in typed or standard character form for the goods and services enumerated therein.

Fame of Opposer's IVY LEAGUE and THE IVY LEAGUE Marks

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's marks and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

*Bose Corp. v. QSC Audio Products Inc.*, *supra*, 63 USPQ2d at 1305.

**Opposition No. 91161051**

The September 15, 2005 testimony deposition of Jeffrey Orleans, opposer's Executive Director, and the exhibits thereto, establish the following undisputed facts. The term "Ivy League" was coined in the 1930s by sportswriters reporting on athletic events at opposer's constituent member schools who noted the ivy covered buildings that are prevalent on their campuses (Orleans Dep. at 15). In 1945, these schools formally adopted "The Ivy League" as the name of their intercollegiate football conference (Orleans Dep. at 15-16). In 1954, the Ivy League conference was expanded to include all intercollegiate athletics at these institutions (*Id.* at 16). Since that time, opposer's constituent schools have continuously used The Ivy League to identify their athletic conference and events (*Id.*). The Ivy League currently offers 33 different sports involving over 8,000 athletes per year (*Id.* at 9). Opposer displays its IVY LEAGUE and THE IVY LEAGUE marks at all of its athletic events in arenas, stadiums, flags, plaques, programs, and other printed materials (*Id.* at 16-26, Exhibits 1-5). Opposer currently spends nearly 25% of its annual budget on publicizing and promoting its athletic events (Orleans Dep. at 241-42, 251-52).<sup>8</sup> Opposer uses its IVY LEAGUE and THE

---

<sup>8</sup> The dollar amount that opposer annually expends on such promotions was submitted under seal. In general terms, we may comment that the amount is not, by itself, so substantial as to be a highly significant factor in our determination with regard to the fame of opposer's marks.

**Opposition No. 91161051**

IVY LEAGUE marks on printed publications relating to its athletic events and provides such publications to students, prospective students, parents, alumni, faculty and coaches, as well as members of the media and general public (*Id.* at 31-34, 126, 129, 148, 158, 161, 166, 169). Opposer further uses its IVY LEAGUE and THE IVY LEAGUE marks during television and radio broadcasts of its athletic events, including NCAA basketball tournaments (*Id.* at 75-76). Opposer's football and basketball games are televised on local, cable and satellite stations to up to sixty million potential viewers (*Id.* at 46-47, 61-62).<sup>9</sup>

The record further establishes that opposer's constituents, i.e., Brown University, Columbia University, Cornell University, Dartmouth College, Harvard University, University of Pennsylvania, Princeton University and Yale University, are eight of the oldest and most prestigious colleges and universities in the United States (Opp. 2<sup>nd</sup> notice of reliance). Each member school is known for its highly selective admissions criteria and for providing rigorous academic programs in a broad range of undergraduate and/or graduate disciplines (*Id.*, Orleans Dep. at 13). Each

---

<sup>9</sup> We note, however, that opposer does not submit testimony or evidence regarding the actual number of television viewers of its athletic events. As a result, this testimony is not particularly helpful because there is no context by which we can weigh the probative value thereof. See *Bose Corp. v. QSC Audio Products Inc.*, *supra* ("some context in which to place raw statistics is reasonable").

**Opposition No. 91161051**

institution receives an average of 20,000 applications per year and accepts between 10-15 percent of its applicants (*Id.*, Orleans Dep. at 34-35, 37). Opposer's constituent schools are considered to be among the most exclusive post-secondary schools in the United States (Opp. 2d notice of reliance). Opposer's constituent schools routinely use IVY LEAGUE and THE IVY LEAGUE in relation to their academic and educational activities on their Internet websites, calendars, bulletins, alumni magazines, brochures, and application forms (*Id.* at 31-34, 52). As a result, opposer's member schools are commonly referred to as "Ivy League Schools" or "Ivies," their students are known as "Ivies," "Ivy Leaguers" or "Ivy League graduates," and the education obtained thereby is known as an "Ivy League degree" or "Ivy League education" (Opp. 2<sup>nd</sup> - 5<sup>th</sup> notices of reliance). In addition, since 1995 opposer has licensed its IVY LEAGUE and THE IVY LEAGUE marks on a wide variety of clothing items, which are available through campus bookstores, retail stores, and the Internet (*Id.* at 93, 95, 124).

Opposer's academic and athletic programs under the IVY LEAGUE and THE IVY LEAGUE marks have received extensive media coverage on national television and radio broadcasts such as *ABC News, NBC News, Fox News, 60 Minutes, CBS Sports, ESPN, National Public Radio, MSNBC, and The Oprah*

**Opposition No. 91161051**

*Winfrey Show* (Orleans Dep. at 75; Opp. 2<sup>nd</sup> notice of reliance). Print media coverage of opposer's academic and athletic programs under its IVY LEAGUE and THE IVY LEAGUE marks is widespread. Articles concerning opposer's academic and athletic programs under the IVY LEAGUE and THE IVY LEAGUE marks appear in such major market newspapers as The New York Times; The Washington Post; Los Angeles Times; The Boston Globe; and Chicago Tribune. (Opp. 5<sup>th</sup> notice of reliance).

Finally, we note that the term "Ivy League" is listed in numerous dictionaries (Opp. 2<sup>nd</sup> notice of reliance). A typical definition of "Ivy League" follows:

1. a group of colleges and universities in the northeastern U.S., consisting of Yale, Harvard, Princeton, Columbia, Dartmouth, Cornell, the University of Pennsylvania, and Brown, having a reputation for high scholastic achievement and social prestige.
2. of, pertaining to, or characteristic of Ivy League colleges or their students or graduates.<sup>10</sup>

"When a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous." *B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988).

Based upon this undisputed evidence of record, we find that opposer's IVY LEAGUE and THE IVY LEAGUE marks are

famous for purposes of the fifth *du Pont* factor.<sup>11</sup> Such fame must be accorded dominant weight in our likelihood of confusion analysis. See *Recot, supra*, at 1327. See also *Miss Universe L.P., LLLP v. Community Marketing, Inc.*, \_\_USPQ2d\_\_ (TTAB 2007).

The Marks

Next, we consider the first *du Pont* factor, i.e., whether applicant's IVY LEAGRO mark and opposer's IVY LEAGUE and THE IVY LEAGUE marks are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*. The test, under the first *du Pont* factor, 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 terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. Because the involved goods and services would be marketed to the general public, our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

---

<sup>10</sup> Random House Webster's College Dictionary (2d ed. 1997).

Applicant has introduced the testimony, with exhibits, of Dr. Geoffrey Nunberg, a professor of linguistics. Dr. Nunberg testifies, *inter alia*, that the term "LEAGRO" in applicant's mark is a coined, portmanteau<sup>12</sup> term created by combining the words "LEAGUE" and "NEGRO" (Nunberg Dep. at 12-14). Dr. Nunberg further testifies that the "RO" suffix at the end of applicant's mark is not a suffix in English language words (*Id* at 13-14). Dr. Nunberg testifies in addition that, as a result of the coined nature of "LEAGRO" and the unfamiliarity of the "RO" suffix, consumers will be able to easily distinguish applicant's mark from those of opposer. Dr. Nunberg also testifies that because IVY LEAGRO connotes the term NEGRO with its numerous racial overtones, applicant's mark is not likely to be confused with those of opposer (*Id* at 56). Dr. Nunberg's testimony and accompanying exhibits on these and other issues in this case have been accorded probative value to which they are entitled. We note, however, that applicant has not presented evidence, by survey or other means, by which we

---

<sup>11</sup> We need not and do not consider the issue of whether opposer's mark is famous for purposes of its dilution claim, because as discussed below, we are not reaching that claim.

<sup>12</sup> A "portmanteau" term is "a new term formed by joining two others and combining their meanings; 'smog' is a blend of 'smoke' and 'fog', 'motel' is a portmanteau word made by combining 'motor' and 'hotel', 'brunch' is a well-known portmanteau [syn: blend]." *Dictionary.com* based on *WordNet 3.0* (2006). We may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982); *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

**Opposition No. 91161051**

might consider either the impression of applicant's mark on the consuming public or a comparison thereof with opposer's marks. In other words, there is no evidence in the record regarding whether or to what extent consumers will either perceive the derivation or significance of the term "LEAGRO" or distinguish applicant's mark from those of opposer based upon such perceptions. Thus, applicant's arguments regarding the significance of his mark are based upon his own testimony (Gray Dep. at, e.g., 4, 26-27, 29) as the individual who coined the mark and that of Dr. Nunberg, a professional linguist whom, it may be presumed, possesses superior knowledge than that of the average consumer regarding the derivation of words and the impression conveyed thereby.

In this case, we find that applicant's mark, IVY LEAGRO, is highly similar to opposer's marks, IVY LEAGUE and THE IVY LEAGUE. We note initially that the word THE in registrant's THE IVY LEAGUE mark is merely a definite article "used before singular or plural nouns and noun phrases that denote particular, specified persons or things" *American Heritage Dictionary*, 4<sup>th</sup> Ed. 2006. As such, the word THE is devoid of trademark significance and simply points to the remaining wording IVY LEAGUE in registrant's THE IVY LEAGUE mark. Both applicant's IVY LEAGRO mark and registrant's marks IVY LEAGUE and THE IVY LEAGUE contain the

**Opposition No. 91161051**

word IVY as the first term, or in the case of opposer's THE IVY LEAGUE mark, the first distinctive term, thereof.

The significance of IVY in the parties' marks is reinforced by its location as the first word in those marks. See *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). See also *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). In addition, both applicant's mark and those of opposer contain the root "LEAG" as a major portion of the final word therein. The only difference between the marks is the substitution of the letters "RO" at the end of applicant's mark for "UE" at the end of those of opposer.

With regard to sound, applicant's IVY LEAGRO mark is highly similar to opposer's IVY LEAGUE and THE IVY LEAGUE marks. It is well settled that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." See *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Nonetheless, there is no reason to suggest that the term "IVY" would be pronounced differently in applicant's mark

than in those of opposer. Further, the parties appear to agree that "LEAGRO" in applicant's mark is pronounced in two syllables, i.e., LEAG-RO. Thus, the only difference in sound between the parties' marks is the addition of the final syllable to that of applicant.

With regard to the marks' respective connotations, applicant testifies that his mark connotes, among other things, "the unique experience and values of African-American students within the white-dominated culture of the modern Ivy League" (brief at 5, Gray Dep. at 39-40). In other words, applicant's mark conveys a sense of the values and experiences of certain students at opposer's constituent schools. Thus, it appears that "Ivy Leagros" form part of a larger group known as "Ivy Leaguers." As a result, the marks IVY LEAGRO and IVY LEAGUE and THE IVY LEAGUE convey highly similar connotations, and convey highly similar overall commercial impressions.

In view of the high degree of similarity between applicant's mark and opposer's marks in appearance, sound, connotation and overall commercial impression, this *du Pont* factor heavily favors opposer.

The Goods and Services

Turning to the second *du Pont* factor, i.e., the similarity or dissimilarity and nature of the goods and services, it is well-established that the goods and services

**Opposition No. 91161051**

of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). We base our determination of the similarity or dissimilarity between the parties' respective goods and services, as we must, upon the goods and services recited in the involved application and opposer's above-noted, pleaded registrations. See *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") The issue, of course, is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

**Opposition No. 91161051**

In this case, we begin by observing that applicant identifies a wide variety of paper, writing, desk and office items in International Class 16. We find that these goods are related to the Class 16 goods identified in opposer's above-noted registrations. Specifically, applicant's "ball-point pens," "pen cases," and "drawing instruments, namely, pencils, pens and brushes" are closely related to registrant's "pens" in that all are writing and drawing implements and accessories therefor. In addition, applicant's "mechanical binder sets, including rings, dividers and folders" are closely related to registrant's "paper products, namely, folders." Further, applicant's broadly identified "catalogs, magazines and books in the field of educational services" and "printed educational and teaching materials, namely education guide books" are closely related to registrant's "printed matter and publications, namely, books, newsletters, pamphlets and brochures in the field of intercollegiate athletics" in that the subject matter of applicant's printed educational materials may be presumed to encompass opposer's printed materials on the narrower subject of intercollegiate athletics.

Turning to the goods recited in International Class 25, we find that opposer's "clothing, namely, shirts" include or are otherwise closely related applicant's various types of

**Opposition No. 91161051**

shirts, including "t-shirts," "sweat shirts," "tank tops," "jerseys," "sport shirts," and "rugby shirts." Opposer's "shirts" further are closely related to many of applicant's other items of clothing, including "sweatpants," "shorts," "sweaters," "belts," "ties," hats," "caps," "warm-up suits," "jackets," "parkas," "coats," and "pullovers" inasmuch as these are common items of clothing that often are worn together.

Turning now to the parties' services, we find that applicant's "providing information in the field of educational services via the Internet" in International Class 41 is encompassed within opposer's "informational services, namely, providing historical, educational and sports information via a global telecommunications network" in International Class 42 inasmuch as both involve providing on-line information in the field of education. Further, inasmuch as applicant's "providing on-line newsletter in the field of educational services" in International Class 41 is also concerned with providing educational information through electronic media, such services are closely related to opposer's above services. Finally, because there is no limitation as to the type of educational information provided by applicant's services, such services may be presumed to include information in the fields of courses and sporting events at the college level. As a result,

**Opposition No. 91161051**

applicant's services are related to opposer's "educational and entertainment services namely, conducting educational activities such as courses, seminars and conferences and sporting events at the college and university level" in International Class 41.

Thus we find that, as identified, applicant's goods and services are closely related to those recited in opposer's pleaded registrations. In view of the related nature of applicant's goods and services and the goods and services recited in opposer's pleaded registrations, this *du Pont* factor also heavily favors opposer.

Channels of Trade

Because there are no recited restrictions as to the channels of trade or classes of purchasers in the goods or services identified in either opposer's pleaded registrations or the involved application, we must assume that the goods and services are available in all the normal channels of trade to all the usual purchasers for such goods and services. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the

**Opposition No. 91161051**

particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, *supra*. Thus, the parties' goods and services are presumed to be marketed to the general public through all normal trade channels therefor.

It is noted that applicant does not dispute that the parties' goods and services may travel in the same channels of trade (Applicant's brief, p. 30). Applicant asserts, however, that opposer has not established that its goods will be purchased by the same classes of purchasers as those of applicant. Applicant goes on to speculate that consumers of one party's goods will be disinclined to purchase those of the other, and vice versa. In that regard, it further is noted that, to date, applicant has made use of his IVY LEAGRO mark solely on t-shirts. Applicant has sold t-shirts bearing the IVY LEAGRO mark to students at Brown University (Gray Dep. at 26-27). Opposer sells its IVY LEAGUE and THE IVY LEAGUE shirts, *inter alia*, at the Brown University bookstore. Thus, the parties' goods in International Class 25 have been made available to the same consumers.

As a result of the foregoing, this *du Pont* factor also favors opposer.

Use of Similar Marks

In his brief, applicant refers to a number of third-party marks incorporating the terms "Ivy" and/or "League" registered in connection with various goods and services. However, there is no evidence that any of these third-party registrations are for marks that are actually in use. As a result, the probative value of registrations showing similar marks even on related goods or services is limited.<sup>13</sup> It is well settled that third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the subject marks. See *National Aeronautics & Space Administration v. Record Chemical Co.*, 185 USPQ 563, 567 (TTAB 1975). Thus, they are not evidence that customers are able to distinguish between similar marks based on only minor differences between them. See *Smith Brothers Manufacturing Co. v. Stone Manufacturing Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *Carl Karcher Enterprises Inc. v. Stars Restaurant Corp.*, 35 USPQ2d 1125, 1130-31 (TTAB 1995); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983).

Applicant has further made of record printouts from third-party Internet websites of various IVY and IVY LEAGUE

---

<sup>13</sup> We note in addition that these third-party registrations are for marks that are more dissimilar to opposer's pleaded marks than applicant's IVY LEAGRO mark. Such marks include the following: IVY, IVY LEAF, IVYWEST, IVYGLEN, and IVY LEARNING CENTER.

formative marks. However, as noted by opposer, the probative value of this evidence is very limited because applicant presented no evidence concerning the extent to which these third-party embossed designs are used in commerce. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin, supra*. Moreover, a review of the third-party websites reveals that none of the marks appearing thereupon are as similar to opposer's marks as applicant's IVY LEAGRO mark.<sup>14</sup>

Thus, applicant's evidence does not establish that there is widespread use of IVY and IVY LEAGUE formative marks such that opposer's marks are weak and entitled to only a narrow scope of protection. This factor, therefore, also favors a finding of likelihood of confusion.

#### Parody

Applicant has asserted parody as a defense to opposer's claim of likelihood of confusion. However, because we are dealing with opposer's established trademark rights in the trademarks IVY LEAGUE and THE IVY LEAGUE, any claim applicant may make to the use of his IVY LEAGRO mark as a parody will not be considered a "defense." Parody is simply another factor which is relevant to our analysis of likelihood of confusion because parody is merely another way

---

<sup>14</sup> Such marks include the following: IVY SUCCESS, IVY WEST, IVY WISE, IVY FILM FESTIVAL, and BLACK IVY ALUMNI LEAGUE.

**Opposition No. 91161051**

of arguing that confusion is not likely. In other words, unlike an affirmative defense, even if parody exists, that might not be enough to prevent likelihood of confusion. See *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 46 USPQ2d 1737, 1744 (5<sup>th</sup> Cir. 1998); and *Dr. Seuss Enterprises L.P. v. Penguin Books USA*, 109 F.3d 1394, 42 USPQ2d 1184, 1193 (9<sup>th</sup> Cir. 1977).

As stated by the Board in *Columbia Pictures Industries, Inc. v. Miller*, 211 USPQ 816 (TTAB 1981): "The right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of the substantially same mark by another." See also *Starbucks U.S. Brands, LLC and Starbucks Corporation D.B.A. Starbucks Coffee Company v. Marshall S. Ruben*, 78 USPQ2d1741 (TTAB 2006); and *Hard Rock Café Licensing Corp. v. Pacific Graphics, Inc.*, 776 F.Supp. 1454, 1462, 21 USPQ2d 1368, 1374 (W.D. Wash. 1991).

In this case, the record does not support a finding that applicant is using the IVY LEAGRO mark in a manner intended to parody opposer's IVY LEAGUE and THE IVY LEAGUE marks. We note that applicant himself has difficulty articulating the meaning of IVY LEAGRO:

**Opposition No. 91161051**

Is an IVY LEAGRO a bourgeois black? A graduate of Howard or Spelman, AKA, Kappa, or Alpha? Well, sure.

Is an Ivy Leagro a native of Bronzeville, Oak Bluffs, Idlewilde, the Gold Coast? Probably so. But even that was not "it."

Ivy Leagro, the term, is a combination of Ivy League and Negro. That is clear, but what does that mean? A conceptualization of elitist privilege and an anachronistic term of self-identification for a marginalized group, Ivy Leagro is as American as America. These tenuous and complex relations deserve some attention and some insightful dialogue. Perhaps Ivy Leagro is part of that effort.

The gestalt that is Ivy Leagro appeals to more people than that: those who face difficulty and complexity with grace, those who recognize that is it not only impossible, but undesirable to live in absolutes, those who laugh to keep from crying. And those who like really good music, snazzy threads, and cool stuff.

(Gray Dep., Exhibit 8). Clearly, IVY LEAGRO is intended to comment upon a number of complex social issues. Applicant further indicates that he intends IVY LEAGRO to approach such issues with humor: "It was a joke." "It was kinda funny/kinda uncomfortable, like a clown crying" (Gray Dep. at 4).

However, it is not clear that applicant is using IVY LEAGRO to parody opposer or any of the goods or services identified in its marks. Rather, based upon these statements we conclude that applicant is using his IVY LEAGRO mark to poke fun and satirize something else in society, including race relations, and privilege versus

marginalization in America. As stated in 5 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 31:153 (4<sup>th</sup> ed. 2001):

[I]f defendant appropriates a trademarked symbol such as a word or picture, not to parody the product or company symbolized by the trademark, but only as a prominent means to satirize and poke fun at something else in society, this is not "parody" of a trademark.

Further, and as noted above, applicant has not introduced survey or any other evidence to support his position that potential consumers of goods and services offered under the IVY LEAGRO mark will understand applicant's asserted parodic intentions. Neither applicant's own testimony nor that of his expert witness, Dr. Nunberg, is sufficient to support a finding that consumers will "get" that IVY LEAGRO is intended to parody opposer or its marks. Thus, applicant has failed to present evidence which supports his claim of parody and we do not consider this to be a relevant factor in our determination of the issue of likelihood of confusion.

#### **Conclusion**

We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude, in view thereof, that opposer has established that consumers familiar with the goods and

**Opposition No. 91161051**

services offered by opposer under its previously used and registered IVY LEAGUE and THE IVY LEAGUE marks would be likely to believe, upon encountering applicant's IVY LEAGRO mark for its identified goods and services that those goods and services originate with or are associated with or sponsored by the same entity. In making our determination, we have balanced the relevant *du Pont* factors. The factors of the fame of opposer's IVY LEAGUE and THE IVY LEAGUE marks, the similarities between the marks and the relatedness of the parties' respective goods and services weigh strongly in opposer's favor.

To the extent that any of applicant's points raise a doubt about our conclusion, all doubt on the issue of likelihood of confusion must be resolved in favor of the prior user and against the newcomer. See *San Fernando Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977).

**Dilution**

Finally, we note that opposer also argues that given the demonstrated prior fame of its IVY LEAGUE and THE IVY LEAGUE marks, applicant's use of his IVY LEAGRO mark is likely to cause dilution of opposer's mark under the Federal Trademark Dilution Act. However, given our determination that there is a likelihood of confusion herein, we decline

**Opposition No. 91161051**

to reach a determination on the question of dilution in this proceeding.

DECISION: The opposition is sustained, and registration to applicant is refused on the ground of likelihood of confusion.