

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
Dec. 9, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kansas City Royals Baseball Corporation
v.
Anschutz Manchester Hockey, LLC

Opposition No. 91163833
to application Serial No. 76510382
filed on April 29, 2003

Jonathan Z. King of Cowan, Liebowitz & Latman, P.C. for
Kansas City Royals Baseball Corporation.

Christopher C. Larkin of Seyfarth Shaw LLP for Anschutz
Manchester Hockey, LLC.

Before Quinn, Hairston, and Grendel, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Introduction

In this opposition proceeding, Kansas City Royals
Baseball Corporation is the opposer, and Anschutz Manchester
Hockey, LLC is the applicant.

Applicant seeks registration on the Principal Register of the mark depicted below:



for goods and services identified in the application as

clothing related to a professional ice hockey team, namely, t-shirts, hats, baby creepers; and cloth baby bibs, in Class 25; and

live entertainment services in the nature of individuals in costume¹ who appear and perform at ice hockey games and exhibitions; entertainment services, namely, professional ice hockey games and exhibitions; and charitable services, namely, providing youth hockey instruction, and teaching children the importance of goal setting and healthy lifestyles, in Class 41.²

¹ The word "costume" is misspelled as "cost" in the Office's automated database. In this opinion, we shall disregard the misspelling in future quotations of the identification of goods and services.

² The application is based on use in commerce under Trademark Act Section 1(a). June 2001 is alleged in the application to be the date of first use anywhere and the date of first use in commerce as to both classes of goods and services.

Opposition No. 91163833

Opposer has opposed registration of applicant's mark, alleging a claim of priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d), as its ground of opposition.³ Specifically, in paragraphs 1-3 of the notice of opposition, opposer has alleged:

1. Opposer is the owner of the renowned KANSAS CITY ROYALS MAJOR LEAGUE BASEBALL club.

2. Since long prior to June, 2001, Applicant's claimed first use date, Opposer, its affiliates, licensees and/or sponsors have used trademarks and service marks comprising a lion with crown character, alone or with other word, letter or design elements (collectively, Opposer's Lion With Crown Marks), for a sports mascot named SLUGGERRR used in connection with Opposer's baseball game and exhibition services, live entertainment and charitable services, and a variety of goods and other services, including, but not limited to, apparel, novelties, collectibles, sporting goods, printed matter and toys.

3. Since long prior to June, 2001, Applicant's claimed first use date, Opposer and its predecessors and/or their affiliates, licensees and/or sponsors have promoted and advertised the sale and distribution of goods and services bearing Opposer's Lion With Crown Marks, including in connection with baseball game and exhibition services, live entertainment and charitable services, and a variety of goods and other services, including, but not limited to, apparel, novelties, collectibles, sporting goods, printed matter and toys, and have sold or distributed such goods and rendered such services in commerce.

³ In the notice of opposition, opposer also alleged a Section 2(a) "false suggestion of a connection" ground of opposition, but has presented no argument in support of such ground in its trial briefs. We therefore deem opposer to have waived that ground and we shall give it no further consideration.

Opposition No. 91163833

Opposer has not pleaded or proven ownership of any registration pertaining to its pleaded SLUGGERRR mascot mark, and relies only on its claimed common law rights.

Applicant filed an answer to the notice of opposition by which it denied the salient allegations thereof.

The evidence of record includes the parties' pleadings, and the file of applicant's involved application. Trademark Rule 2.122(b), 37 C.F.R. §2.122(b). Both parties presented evidence at trial.

As its evidence at trial, opposer submitted (1) the testimony deposition of Byron Shores (who performs as opposer's Sluggerrr Mascot), together with opposer's trial exhibits OTE 1-7 and applicant's trial exhibits ATE 1-12 (Shores Test. Depo.);⁴ (2) the testimony deposition of Kimberly Hillix Burgess (opposer's Senior Director of Marketing), together with opposer's trial exhibits OTE 8-52 and applicant's trial exhibit ATE 13 (Burgess Test. Depo.); (3) opposer's notice of reliance on portions of the Rule 30(b)(6) discovery deposition of applicant's President Jeffrey Eisenberg, and exhibits thereto (Eisenberg Disc. Depo.); (4) opposer's notice of reliance (pursuant to stipulation) on portions of the third-party discovery deposition of Tom Sapp (President of Real Characters, Inc.,

⁴ In this opinion, we, as do the parties, shall refer to opposer's trial exhibits as "OTE ____" and to applicant's trial exhibits as "ATE ____."

Opposition No. 91163833

the designer of Sluggerrr and Max), and exhibits thereto (Sapp Disc. Depo.); opposer's notice of reliance (pursuant to stipulation) on portions of the third-party discovery deposition of Craig Payne (who performs as applicant's Max Mascot), and exhibits thereto (Payne Disc. Depo.); (5) opposer's notice of reliance on applicant's responses to opposer's interrogatories and requests for admissions; (6) opposer's notice of reliance on printed publications; and (7) opposer's rebuttal notice of reliance on portions of the Rule 30(b)(6) discovery deposition of Kimberly Hillix Burgess.

Applicant's evidence at trial consists of (1) the testimony deposition of applicant's President Jeffrey Eisenberg, together with applicant's exhibits ATE 15-21 and opposer's exhibits OTE 55-64 (Eisenberg Test. Depo.); (2) applicant's notice of reliance on portions of the Rule 30(b)(6) discovery deposition of Kimberly Hillix Burgess, and exhibits thereto (Burgess Disc. Depo.); (3) applicant's notice of reliance on portions of the Rule 30(b)(6) discovery deposition of Byron Shores, and exhibits thereto (Shores Disc. Depo.); (4) applicant's notice of reliance (pursuant to stipulation) on portions of the third-party discovery deposition of Craig Payne, and exhibits thereto; (5) applicant's notice of reliance (pursuant to stipulation)

on portions of the discovery deposition of Tom Sapp, and exhibits thereto; (6) applicant's rebuttal notice of reliance on portions of the Rule 30(b)(6) discovery deposition of applicant's President Jeffrey Eisenberg, and exhibits thereto (Eisenberg Disc. Depo.); (7) applicant's notice of reliance on opposer's interrogatory responses and requests for admissions; and (8) applicant's notice of reliance on official USPTO records.

The case is fully briefed.

After careful consideration of all of the evidence of record and the arguments of counsel, we find that opposer has failed to carry its burden of proving that a likelihood of confusion exists. We therefore dismiss the opposition.

Opposer and its Sluggerrr Mascot

Opposer owns and operates a Major League Baseball professional baseball team, the Kansas City Royals, located in Kansas City, Missouri (hereinafter "the Royals," or "opposer"). The Royals' primary business is providing entertainment services in the nature of a professional baseball team which competes in Major League Baseball games and exhibitions. (Burgess Test. Depo. at 15.)

Like many other professional sports teams, the Royals have an official team mascot. The Royals' team mascot is "Sluggerrr," an anthropomorphized lion character with a

Opposition No. 91163833

crown formed as the top of his head, who wears a replica of the team's Royals baseball uniform (see depictions below). Opposer adopted and began using its Sluggerrr mascot mark in 1996. (Burgess Test. Depo. at 28.)

Generally, like other professional sports team mascots, Sluggerrr serves as and is recognized as the public face of his team, a friendly character who personifies and promotes the team, serves as a liaison between the team and its fans (especially children), and serves as the team's goodwill ambassador to the community. He is an "extension" of the team. (Burgess Test. Depo. at 31-37; Shores Test. Depo. at 14-15.)

Opposer uses its Sluggerrr mascot mark as a live costumed character and also in various two-dimensional photographic and cartoon depictions of the live costumed character. Examples of Sluggerrr appearing in costume as a live mascot character wearing a Royals baseball uniform are depicted in the following photographs:



(OTE 20; OTE 12.)

Although not depicted in these photographs, the record establishes that Sluggerrr's costume also includes the name SLUGGERRR appearing on the back of his jersey in capital letters, in the same manner as a Royals player's name would appear on the back of the team's baseball jersey. (Shores Disc. Depo. at 53; Shores Test. Depo. at 110-111; ATE 9.)

Opposition No. 91163833

When appearing as a live costumed character, Sluggerrr engages in the activities in which sports team mascots typically engage. He entertains the crowd at Royals baseball games and exhibitions. (Shores Test. Depo. at 17-22.) He entertains children as the "silent spokesman" of the Royals' youth fan club, the Blue Crew. (Shores Test. Depo. at 77-78.) In the past, he has performed in costume as Sluggerrr at other teams' games together with the other teams' mascots (including occasional (fewer than ten) appearances at professional ice hockey games prior to 2001). (Shores Disc. Depo. at 17, 20.) He has appeared in costume with other sports team mascots at various other sports events such as Major League Baseball All-Star games, at mascot competitions, and at charitable events. (Shores Test. Depo. at 26-52, 59-62.) He makes personal appearances in the Kansas City, Missouri area and in surrounding states to promote the team and opposer's baseball entertainment services. (Burgess Test. Depo. at 86-95; Shores Test. Depo. at 74-75.) He makes personal appearances in the Kansas City area on behalf of the team at events like store grand openings to promote local businesses who are sponsors of the team. (Burgess Test. Depo. at 78-80; Shores Test. Depo. at 71-72.) He makes personal appearances on behalf of the team at private events such as birthday parties, weddings and corporate parties. (Id.) He appears and represents the

Opposition No. 91163833

team at community events such as parades and fun runs. (Id.) Serving as the goodwill ambassador of the team, he also appears at charitable events in the community, including visits to hospitals and to local schools where he participates in educational activities such as teaching children the dangers of drugs. (Shores Test. Depo. at 15-16, 69-70; Burgess Test. Depo. at 80-86.)

At all of his appearances as a live character, whether at opposer's baseball games, at other sports events, or at personal appearances in the community, Sluggerrr always wears his Royals uniform, or at least the uniform jersey bearing the "Royals" script on the chest and his name SLUGGERRR on the back. (Burgess Disc. Depo. at 26-27; Shores Test. Depo. at 15-16, 91-92, 124; opposer's answers to applicant's Requests for Admissions Nos. 27-28, 30-36.) He has never appeared without other word, design, and letter elements, i.e., as a "naked" lion. (Burgess Disc. Depo. at 35.)⁵

On this point, opposer contends that Sluggerrr's jersey is not always visible during Sluggerrr's public appearances at games and at schools. On this record, however, we find that such occasions are de minimis. Occasionally at opposer's baseball games (as few as five times per year

⁵ Thus, opposer's allegation in the notice of opposition that it uses "trademarks and service marks comprising a lion with crown

Opposition No. 91163833

(Shores Test. Depo. at 111)), Sluggerrr engages in between-inning skits for which he dons other costumes which obscure his Royals jersey (such as Luke Skywalker, or a karate outfit). (Burgess Test. Depo. at 54-61; Shores Test. Depo. at 17-24; OTE 1.) However, he wears these other costumes only for a short time, and always otherwise wears his Royals uniform. (Shores Test. Depo. at 91-92.) Even when he is wearing these other costumes and the name SLUGGERRR on the back of his jersey is obscured, opposer intends for him to be recognized, and he is recognized, as being Sluggerrr. (Shores Test. Depo. at 92.)

Likewise, when Sluggerrr appears at schools, he always arrives in full costume. (Shores Test. Depo. at 16-17, 126-27). He stays in full costume when other of opposer's employees are there to speak to the children. (Burgess Disc. Depo. at 249). Mr. Shores, the man who wears the Sluggerrr costume, testified that when he appears alone at schools and speaks to the children himself, he will remove the lion head so he can speak. (Shores Test. Depo. at 17.) He testified that he sometimes also removes the upper part of the costume, including the Sluggerrr jersey. (Id.) However, his testimony on this last point is vague, and at best it indicates that such occasions are de minimis. And even when he takes the jersey off, he intends to be

character, alone or with other word, letter or design elements"

recognized and is recognized as being Sluggerrr. (Shores Test. Depo. at 126-27.)

In short, and contrary to opposer's contention, we find that the occasions in which Sluggerrr appears in public without his "Royals" jersey with the SLUGGERRR name on the back are de minimis.

Sluggerrr does not wear and has never worn another sports team's uniform or jersey. (Shores Test. Depo. at 89-90.) He has never worn a hockey jersey. (Shores Test. Depo. at 114.) He has never worn a uniform or jersey depicting the letter "M." (Shores Test. Depo. at 123-24.) The letter "M" has no significance in relation to the Royals, to Kansas City, or to Sluggerrr himself. (Id.; Burgess Test. Depo. at 230-31.)

In addition to the live costumed character who appears as Sluggerrr at games and in the community, opposer uses various two-dimensional cartoon depictions of its Sluggerrr mascot mark. These cartoon marks are used on the Royals' marketing and promotional literature, on stadium signage, on collateral goods like clothing, and in similar ways. In three of these cartoon versions of the Sluggerrr mascot mark, he is depicted in a Royals baseball uniform in baseball action poses (OTE 15):

is unproven with respect to the claimed use of a lion "alone."



Another cartoon version of the mark depicts Sluggerrr, in a Royals jersey and holding a baseball, in a circle bearing the words "Kansas City Royals" (OTE 15):



Another two-dimensional version of the mark (upon which opposer especially relies in this case) is the following cartoon depiction of Sluggerrr, in the "open arms" pose.



Opposer uses this "open arms" cartoon depiction of Sluggerrr as a trademark and service mark on items such as game

Opposition No. 91163833

scorecards (OTE 44), t-shirts (OTE 32), popcorn tubs (OTE 33), kids' collector cards (OTE 17), applications and newsletters for the Blue Crew youth fan club (OTE 19, 20, 22), a print advertisement for a Sluggerrr birthday party (OTE 41), a "kids corner" section and birthday advertisement in opposer's Gameday Magazine (OTE 42), fan club advertisements in opposer's Yearbook (OTE 43), and brochures advertising Sluggerrr's availability for personal appearances (OTE 11). In all of these uses of the "open arms" cartoon depiction of Sluggerrr, the name "Sluggerrr" prominently appears in close conjunction with the cartoon.

As is apparent, in each of these various cartoon renderings of Sluggerrr, as with the live costumed character, other of opposer's marks appear, such as the "Royals" script logo on the baseball uniform jersey, the "KC" logo on the uniform sleeve, or the "Kansas City Royals" wording in the circle mark.⁶ As with the live costumed character, in none of these cartoon depictions of the mark does Sluggerrr wear another team's uniform or jersey, nor does the letter "M" appear.

As discussed more fully below, we agree with opposer's contention that each of these manifestations and depictions of Sluggerrr, as a live costumed character and in his

⁶ On clothing and other goods sold to the public which bear these licensed cartoon marks, the official Major League Baseball logo also appears. (Burgess Test. Depo. 42-44; OTE 15.)

various cartoon versions, inform and reinforce the other depictions and that together they are perceived as a single, unitary mark, i.e., the Kansas City Royals team mascot, Sluggerrr.

Applicant and its Max Mascot

Applicant, Anschutz Manchester Hockey, LLC, provides entertainment services in the nature of a professional ice hockey team, the Manchester Monarchs, located in Manchester, New Hampshire (hereinafter "the Monarchs," or "applicant"), which competes in professional ice hockey games and exhibitions. The Monarchs are a minor league affiliate of the Los Angeles Kings, of the National Hockey League. (Eisenberg Test. Depo. at 22-25, 46.)

In 2001, applicant adopted and began using an official team mascot, an anthropomorphized lion named "Max." (Eisenberg Test. Depo. at 48.) He wears a crown, and a shirt or jersey depicting an "M" with a crown. Max is depicted in the drawing in applicant's application for registration as follows:



Max, like Sluggerrr and other professional sports team mascots, is an “animated personification of the team” (Eisenberg Test. Depo. at 38), serving as a promotional and marketing vehicle for the team, as a liaison between the team and its fans (especially children), and as the team’s goodwill ambassador to the community. (Id; Eisenberg Disc. Depo. at 123-129.) Like Sluggerrr and other mascots, Max is an extension of his team.

Applicant uses its Max mascot as a live costumed character who appears at applicant’s ice hockey games and in the community. Applicant also uses various two-dimensional depictions of the live costumed character, including the “open arms” pose depicted in applicant’s application drawing, on marketing materials, clothing and other items.

Opposition No. 91163833

As a live costumed character, Max engages in the usual activities of sports team mascots. He entertains the crowd at applicant's ice hockey games. (Payne Disc. Depo. at 15-18.) He appears at events and activities involving applicant's youth fan club, the Monarch Kids Club. (Eisenberg Disc. Depo. at 173). Occasionally in the past he has been joined at applicant's games by the mascots of other professional sports teams, including the mascot of a local minor league baseball team. (Payne Disc. Depo. at 32-33.) He occasionally has appeared with other sports team mascots at their games, including appearances at minor league baseball games with the baseball team's mascot. (Payne Disc. Depo. at 26-29.) He makes personal appearances in the Manchester, New Hampshire community to promote the team. (Payne Disc. Depo. at 36-40; OTE 25.) These include events such as private birthday parties and store grand openings. (Eisenberg Disc. Depo. at 216-218.) They also include appearances at community events and venues such as parades and fairs, at community centers such as the Boys and Girls Club, at schools, and at hospitals. (Payne Disc. Depo. at 36-45; OTE 25.) Additionally, he has appeared at various charity functions such as Breast Cancer Walks and at events to benefit organizations like the March of Dimes and the Special Olympics. (Id.; Eisenberg Disc. Depo. at 216-218.) All of these are the same types of events and venues at

Opposition No. 91163833

which other sports team mascots appear, including baseball team mascots like Sluggerrr. (Payne Disc. Depo. at 39-40, 43-44.) Max wears his "M" jersey when appearing in public. (Payne Disc. Depo. at 48-49.)

Applicant also uses the two-dimensional "open arms" cartoon version of Max (as depicted in applicant's application) on applicant's promotional literature, including materials associated with applicant's youth fan club, the Monarch Kids Club. (Eisenberg Test. Depo. at 56-57, 106-108; OTE 20, 58-60; applicant's Response to opposer's Request for Admissions No. 2, and Exh. 2 to applicant's Responses to opposer's Second Request for Admissions.) This cartoon mark also is used on collateral goods like clothing.

Opposer's Standing and Priority

Initially, we find that opposer has proven that it owns and uses its SLUGGERRR mascot mark in connection with its pleaded goods and services, and that opposer's first use of its mark was in 1996, prior to applicant's claimed first use of its MAX mascot in 2001. Accordingly, we find that opposer has standing to oppose, and that it has Section 2(d) priority based on its prior common law use of its pleaded mark. Applicant has conceded as much. (Applicant's trial brief at 1-2.)

Likelihood of Confusion

To prevail on its Section 2(d) ground of opposition, opposer also must prove that there is a likelihood of confusion, i.e., that applicant's use of its MAX mascot mark in connection with the goods and services identified in the application is likely to cause confusion vis-à-vis opposer's prior common-law use of its SLUGGERRR mascot mark in connection with opposer's goods and services.

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 (the *du Pont* factors). 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.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Comparison of the Goods and Services, Trade Channels, and Purchasers

We begin our analysis with the second and third *du Pont* factors, which require us to determine the similarity or

Opposition No. 91163833

dissimilarity of the parties' respective goods and services on or in connection with which the parties' mascot marks are used, the trade channels in which those goods and services are marketed, and, relatedly, the purchasers to whom the goods and services are marketed.

It is settled that it is not necessary that the goods or services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods or services themselves, but rather whether they would be confused as to the source of the goods or services. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the goods or services be related in some manner, or that the circumstances surrounding their use be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Opposition No. 91163833

At the outset, we note that opposer in this case is relying solely on its common law rights in its Sluggerrr mascot mark, which extend only to those goods and services on or in connection with which opposer actually has made common law use of Sluggerrr, i.e., goods and services connected to opposer's professional baseball team.

Applicant's goods and services, as identified in the application, are:

clothing related to a professional ice hockey team, namely, t-shirts, hats, baby creepers; and cloth baby bibs,
in Class 25;

and

live entertainment services in the nature of individuals in costume who appear and perform at ice hockey games and exhibitions; entertainment services, namely, professional ice hockey games and exhibitions; and charitable services, namely, providing youth hockey instruction, and teaching children the importance of goal setting and healthy lifestyles,
in Class 41.

We begin with the services identified in the application as "entertainment services, namely, professional ice hockey games and exhibitions." The record establishes that opposer, for its part, renders entertainment services in the nature of a professional baseball team which competes in Major League Baseball games and exhibitions. Under the second *du Pont* factor (similarity or dissimilarity of the services), we find that applicant's services and opposer's

services are similar, generally, in that they both are entertainment services in the nature of professional sports teams. However, the parties' professional sports team entertainment services are dissimilar to the extent that they involve two different teams in two different sports, ice hockey and baseball. There is no evidence that opposer or any other Major League Baseball team operates or has any source or licensing affiliation with a professional ice hockey team. There is no evidence that any professional ice hockey team operates or has a source or licensing affiliation with a Major League Baseball team. On balance, we find that the parties' professional sports team entertainment services are similar and related, at a general level. But we do not disregard the fact that, at a more specific level, the parties operate two different teams, in two different sports. In sum, we find that the second *du Pont* factor weighs slightly in favor of a finding of likelihood of confusion as to applicant's "entertainment services, namely, professional ice hockey games and exhibitions."

Under the third *du Pont* factor (similarity or dissimilarity of trade channels), we find that the purchasers and trade channels for the parties' respective professional sports team entertainment services are the same or overlapping. Initially, we presume, for purposes of this

proceeding and in view of applicant's geographically unrestricted application, that applicant's hockey team could relocate to Kansas City and thus share the same fan base and the same media market as opposer's team.

We find that the normal trade channels in which applicant's sports entertainment services could be marketed encompass the trade channels in which opposer markets its services. These include television, radio and print advertising, television and radio broadcasts of their games, Internet websites, co-promotions with other local teams and businesses, and promotional and charitable appearances in the community by their mascots.

Likewise, we find that the purchasers and prospective consumers of the parties' respective baseball team entertainment services and ice hockey team entertainment services are overlapping. The primary purchasers of the parties' respective sports team entertainment services are likely to be sports fans, both adults and children. The evidence establishes that baseball fans may also be hockey fans, especially when the two teams are in the same geographic area. For example, applicant's president Mr. Eisenberg testified that fans of applicant's Manchester, New Hampshire hockey team also are likely to be fans of Major League Baseball's Boston Red Sox. (Eisenberg Test. Depo. at 46-47, 78-79.) In addition to sports fans, we find that to

the extent that the parties promote and market their sports entertainment services by having their mascots make personal appearances in the community, the services are likely to be encountered by the same types of purchasers, including general consumers and children.

For these reasons, we find that the parties' trade channels and purchasers are overlapping, and that the third *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion as to applicant's "entertainment services, namely, professional ice hockey games and exhibitions."

We turn next to applicant's services recited in the application as "entertainment services in the nature of individuals in costume who appear and perform at ice hockey games and exhibitions." Opposer's Sluggerrr mascot appears and performs primarily at opposer's professional baseball games and exhibitions. The parties' services therefore are generally similar to the extent that they both involve in-game mascot entertainment services. Moreover, the evidence establishes that mascots for local professional baseball teams have appeared with Max at applicant's ice hockey games, and that Max has appeared with the baseball team mascots at their baseball games. The record also establishes that up until 2001 (when Kansas City's minor league hockey team, the Blades, folded), Sluggerrr

occasionally (no more than ten times) appeared and performed at ice hockey games as well.

Based on these facts, we find that applicant's in-game mascot entertainment services are similar and related to opposer's mascot entertainment services. We also find that the parties market and render their mascot entertainment services in the same trade channels, to the same consumers, including sports fans and others attending the parties' games. The second and third *du Pont* factors weigh in favor of a finding of likelihood of confusion as to applicant's services recited as "entertainment services in the nature of individuals in costume who appear and perform at ice hockey games and exhibitions."

Next, applicant's recitation of services includes "charitable services, namely, providing youth hockey instruction, and teaching children the importance of goal setting and healthy lifestyles." As written, we read this recitation of services to encompass two types of charitable services, i.e., "youth hockey instruction" and "teaching children the importance of goal setting and healthy lifestyles."

There is no evidence that opposer provides youth hockey instruction services, or sports instruction services for any sport, including baseball. We find that the second and

Opposition No. 91163833

third *du Pont* factors weigh against a finding of likelihood of confusion as to applicant's "youth hockey instruction."

Applicant's recited charitable services also include "teaching children the importance of goal setting and healthy lifestyles." The record establishes that opposer provides essentially the same charitable and educational services. We therefore find that applicant's and opposer's charitable and educational services are similar. We also find that these charitable services of the parties' would be rendered in the same trade channels, such as schools and community centers, and to the same consumers, such as children, their teachers, and their parents. We therefore find that second and third *du Pont* factors weigh in favor of a finding of likelihood of confusion as to applicant's "teaching children the importance of goal setting and healthy lifestyles."

Finally, applicant seeks registration of its mark for goods identified in the application as "clothing related to a professional ice hockey team, namely, t-shirts, hats, baby creepers; and cloth baby bibs." The record establishes that opposer, for its part, uses its two-dimensional Sluggerrr cartoon marks, including the "open arms" cartoon mark, on clothing items including hats and t-shirts. We find that the parties' goods are similar to that extent.

Opposition No. 91163833

Moreover, we are not persuaded by applicant's argument that the goods are dissimilar because applicant's clothing items specifically are identified as being "related to a professional ice hockey team." We find that this purported limitation or restriction fails to distinguish the parties' goods for purposes of the second *du Pont* factor. Nothing in the record establishes that there is a separate genus comprising t-shirts and hats "related to a professional ice hockey team." Applicant's argument might be more persuasive if applicant's goods were identified as "hockey jerseys" or other items which in fact are specifically related to ice hockey, but they are not so identified. Likewise, there is nothing about applicant's mark itself which depicts ice hockey specifically, or an ice hockey team.

For these reasons, we find that the parties' Class 25 goods are similar and indeed legally identical, notwithstanding the purported limiting language in applicant's identification of goods. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion as to applicant's Class 25 goods.

We also find that applicant's and opposer's respective clothing goods would move in the same types of trade channels such as local sporting goods or other retail stores, and that they would be marketed to the same classes of purchasers, primarily the teams' fans but also to general

Opposition No. 91163833

consumers. Accordingly, the third *du Pont* factor weighs in favor of a finding of likelihood of confusion, as to applicant's Class 25 goods.

In summary as to the second and third *du Pont* factors, we find that the parties' goods and services, trade channels and purchasers generally are similar and overlapping to the extent that Sluggerrr and Max both are professional sports team mascots, who serve the same purposes and engage in the same types of mascot-related activities for their respective teams. Like all professional sports team mascots, Sluggerrr and Max are extensions of their teams. As summarized earlier in this opinion, each serves as a marketing and promotional tool for his team, primarily by entertaining fans and customers (and potential fans and customers) at the team's sports events and by making personal appearances in the community on behalf of the team at both public and private events. Each also serves as the team's representative and goodwill ambassador to the community by making personal appearances on behalf of the team in connection with various charitable and educational activities.

Based on the general similarities in the parties' goods and services, we find that the second and third *du Pont* factors weigh generally in favor of a finding of likelihood of confusion in this case. However, in making this general

finding, we keep in mind that, at a more specific level, the parties' mascot-related goods and services are marketed in connection with two different professional sports teams, in two different sports (baseball and ice hockey), as to which there is no evidence of common team ownership, mascot cross-licensing, or other source affiliation. As stated at the outset of this discussion, opposer is limited to its common law rights which extend only so far as those goods and services on or in connection with which opposer actually has made common law use of Sluggerrr, i.e., goods and services specifically connected to opposer's baseball team.

Conditions of Purchase

Under the fourth *du Pont* factor, we consider evidence pertaining to the conditions of purchase for the goods and services, including the sophistication of purchasers and the care with which the purchasing decisions would be made.

In general, the record shows that the primary consumers of goods and services related to a professional sports team are the fans of that team. (Eisenberg Test. Depo. at 66-69.) We specifically find that the consumers of opposer's and applicant's mascot-related goods and services primarily are fans of their respective teams, both adults and kids (including members of each team's youth fan club). These fans are likely to be familiar with their team's mascot and

Opposition No. 91163833

well aware of the source of the team's mascot-related goods and services. Opposer made this very contention to the Office in 1997 when it was attempting to register SLUGGERRR as a word mark for its newly-adopted mascot. Responding to a Section 2(d) refusal, opposer contended that "[t]he Examiner must consider that those who will purchase Applicant's goods are fans of the Kansas City Royals baseball club and are thus well-aware of the Club's marks and mascot." (July 24, 1997 response to Office action in Application Serial No. 75133245, made of record here by applicant's notice reliance.) We agree, and find that these knowledgeable fans, both adults and children, know who Sluggerrr is and recognize him by his "Royals" baseball uniform. As discussed below, they would not be likely to think that a lion wearing an "M" jersey is Sluggerrr, or that he would have anything to do with the Royals.

At page 17 of its reply brief, opposer argues that

...Applicant has no evidence to support its speculation that "team jerseys" will always distinguish the parties' mascot marks. A child at a parade or an attendee at a grand opening where Applicant's Mascot appears is not necessarily a knowledgeable fan seeking out his or her favorite team, but simply a passive consumer confronting a mascot mark confusingly similar to Opposer's Mascot mark. Such circumstances are rife with potential for confusion."

We find that it is opposer, not applicant, that is engaging in speculation here. As noted above, whenever Sluggerrr

appears in public, including appearances at a parade or a store grand opening, he always wears at least his "Royals" jersey with his name SLUGGERRR on the back. He does not and would not wear an "M" jersey. Opposer's argument, which is based on the alleged perceptions of a "passive consumer,"⁷ is too speculative and hypothetical to serve as a basis for finding that there is a likelihood, as opposed to a mere possibility, of confusion. "[The Board] is not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world with which the trademark laws deal." *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

For these reasons, we find that the fourth *du Pont* factor does not weigh in favor of a finding of likelihood of confusion in this case, but rather is neutral in our analysis.

Comparison of the Marks

We turn next to the critical first *du Pont* factor, under which we determine the similarity or dissimilarity of

⁷ Moreover, it is doubtful that opposer's hypothetical (and arguably oxymoronic) "passive consumer" is even a relevant purchaser of the parties' goods and services, for purposes of our likelihood of confusion analysis.

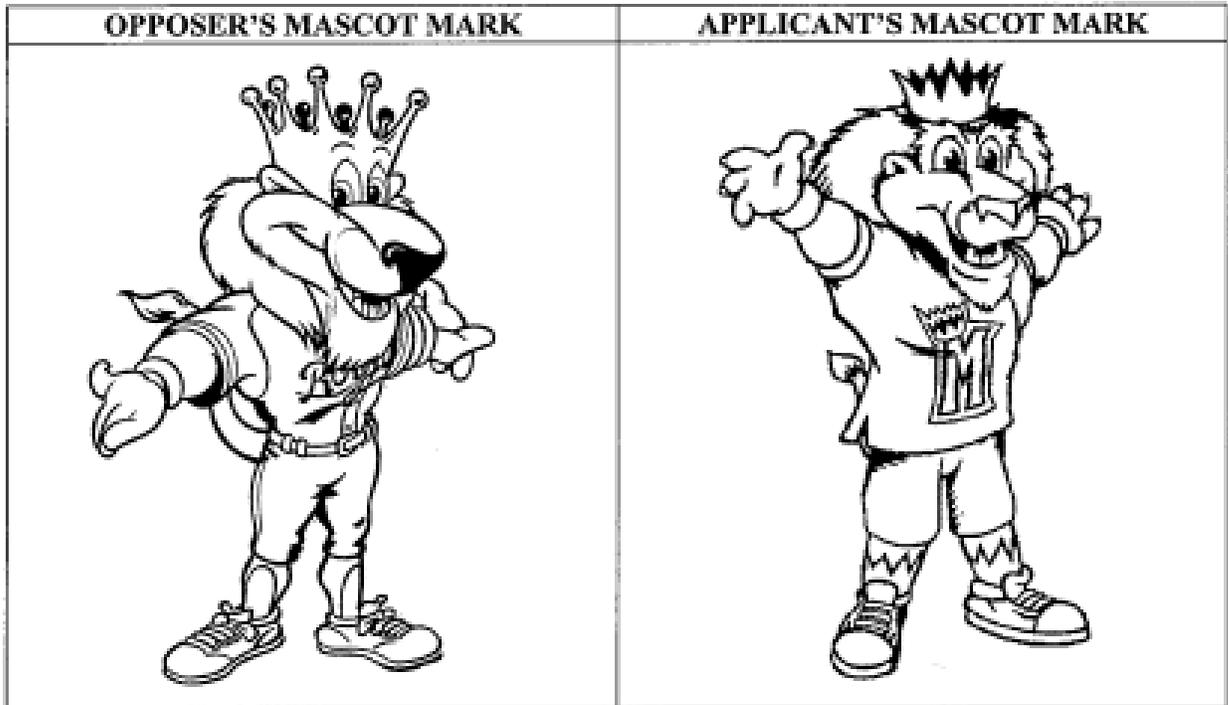
Opposition No. 91163833

the parties' marks when viewed in their entirety in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc., supra.*

Before we compare the parties' marks, we first must determine just what opposer's mark is, for purposes of the comparison. As noted above, opposer does not own a registration, and therefore is entitled to base its likelihood of confusion claim only on its common law rights in, and its actual manner of usage of, its mascot mark.

As discussed above, we agree with opposer's contention that its Sluggerrr mascot mark, though used both as a live costumed character and in various two-dimensional cartoon forms, is a single, unitary mark, i.e., the mascot Sluggerrr. Each of the different depictions and manifestations of the mark informs and reinforces the others.

For obvious reasons in this case, opposer's argument on the issue of the similarity of the parties' marks is based most heavily (if not exclusively) on a comparison of opposer's "open arms" cartoon rendering of Sluggerrr and the "open arms" cartoon rendering of Max depicted in applicant's application:



Opposer contends that this "open arms" cartoon depiction of Sluggerrr is its "primary" mascot mark.

We disagree. We cannot conclude on this record that opposer uses this "open arms" cartoon version of the mark any more frequently than the others. Moreover, we find that if there can be said to be a "primary" Sluggerrr mark, it is the live costumed character who performs in public; the live costumed character is Sluggerrr. All of the cartoon versions of Sluggerrr, including the "open arms" pose, immediately would be recognized as and understood to be merely depictions of the live costumed character himself, who wears the team's baseball uniform which includes the

jersey prominently displaying opposer's "Royals" script logo on his chest and his name SLUGGERRR on the back.

Nonetheless, because the record shows that opposer has used the "open arms" cartoon rendering of Sluggerrr as a mark, and because the "open arms" pose obviously provides opposer with its best argument on the issue of the similarity of the marks, we shall focus our analysis under the first *du Pont* factor largely on a comparison of the parties' respective "open arms" depictions of their marks.

However, in analyzing the "open arms" cartoon version of Sluggerrr, we reject opposer's contention that the "Royals" script logo mark on Sluggerrr's jersey should be accorded diminished significance because it is somewhat obscured. Because Sluggerrr is a unitary mark, as opposer contends, and because the live costumed character version of the mark and the "open arms" version of the mark therefore refer back to and reinforce each other, we find that the "Royals" script logo on Sluggerrr's jersey in the "open arms" pose would readily be recognized and perceived as such, notwithstanding the fact that it is somewhat obscured when compared to the way it appears on the live costumed character's jersey.

Also with respect to the unitary nature of the mascot mark, we note that the back of Sluggerrr's jersey, upon which the name SLUGGERRR appears prominently on the jersey

actually worn by the live costumed character, is not visible in the "open arms" cartoon depiction of the mark. However, the record shows that when opposer uses the "open arms" cartoon version of Sluggerrr as a mark, the name "Sluggerrr" prominently appears in close proximity to the cartoon depiction of Sluggerrr. This manner in which opposer makes common law use of the "open arms" cartoon mark would reinforce the connection between the cartoon character mark and the name "Sluggerrr," and increases the likelihood that consumers will recall and consider that name in their perception of the mark, even though it does not appear in the "open arms" cartoon pose per se.⁸

We turn now to a comparison of the marks. First, it is settled that although the marks at issue must be considered in their entireties, one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Applying this principle in the present case, we find, for the following reasons, that the

⁸ In support of its claim of rights in the "open arms" Sluggerrr pose per se, opposer relies (reply brief at 5) on OTE 17, which is a photograph of a Sluggerrr plush doll in the "open arms" pose. We note that the name SLUGGERRR appears on the back of the doll's jersey.

dominant source-indicating feature in the commercial impression created by each party's mascot mark is the jersey each mascot wears, rather than the lion character wearing it.

The record establishes that Sluggerrr and Max, like all sports team mascots, are representatives and extensions of their particular teams, both at the team's games and in their appearances in the community at non-sports events. The mascot identifies its team; that is the reason for and the whole point of a mascot's existence. The mascot's function is to represent and promote its team, not itself. (Payne Disc. Depo. at 55.) The mascot's value to its team and its source-indicating significance to the public lies not in the fact that it is a lion (or another common animal mascot, e.g., a bird, a tiger, a bear, a wildcat, or a bulldog), but rather in the fact that it is a symbol for its particular team. Whether appearing at the teams' games or in the community in non-sports events, the mascot has no significance apart from its role as a representative of its team.

For that reason and to that end, a sports team mascot typically wears the team's jersey, hat, or other team indicia, by which the mascot and the mascot's team can be readily distinguished from other teams and their mascots.

(Shores Test. Depo. at 91.) See, e.g., opposer's OTE 3, a photograph of numerous mascots at the 1998 "Mascot Day" at opposer's baseball stadium, in which every one of the mascots is wearing its team's jersey or hat or other team indicia:



See also opposer's OTE 11, depicting Sluggerrr and the mascot of the St. Louis Cardinals, both in their teams' jerseys:



There is no evidence that Sluggerrr or any other team's mascot ever wears another team's jersey or uniform; indeed, that would defeat the whole source-identifying purpose of having a mascot who symbolizes and is a representative of one specific team.

For these reasons, we find that for purposes of our comparison of the marks, the dominant source-indicating feature of each of the parties' mascot marks is the uniform or jersey each wears. We do not disregard the other elements of the marks, i.e., the lion characters themselves, but we find that it is the jersey that each wears which is entitled to more weight in our comparison of the marks.

We turn now to a comparison of the parties' mascot marks in terms of appearance, sound, connotation and overall commercial impression.

In terms of appearance, we find that when the "open arms" mascot marks Max and Sluggerrr are compared without reference to their respective jerseys, the anthropomorphized lion characters themselves are similar in many respects. However, they are not identical. Significantly, Max wears a traditional crown on the top of his head, but Sluggerrr's crown is integrated into and forms the top of his head down to his muzzle, with his eyes looking out from the crown itself. Sluggerrr's designer, Mr. Sapp, intended this to be a unique and distinguishing feature of Sluggerrr's design. (Sapp. Disc. Depo. at 130-31, 191-92.) Finally, the two marks obviously look dissimilar to the extent that Sluggerrr is wearing a baseball uniform with opposer's "Royals" script logo mark on its chest, whereas Max is wearing a jersey or shirt bearing the letter "M" with a crown on its chest. Comparing the marks in their entireties, we find that the similarity of the lion characters is outweighed by the dissimilarity of the jerseys the lions are wearing, and that the marks overall are dissimilar in terms of appearance.

In terms of sound and to the extent that these cartoon versions of the parties' mascot marks would be verbalized, we find that they are somewhat similar to the extent that in

their entireties they might be perceived and pronounced as something like "a lion with a 'Royals' [or 'M'] jersey." But the marks sound dissimilar to the extent that "Royals" and "M" sound different. The marks also sound dissimilar to the extent that opposer's mascot, but not applicant's mascot, would be recognized as and referred to verbally by his name, "Sluggerrr." This is so especially when Sluggerrr appears in person as the live costumed character with his "SLUGGERRR" jersey. It also would be likely when Sluggerrr is depicted in the "open arms" cartoon form because, as previously noted, when opposer uses the "open arms" cartoon version of Sluggerrr as a common law mark, the name "Sluggerrr" always appears in close proximity to the cartoon.

In terms of connotation, we find that neither of these marks has any particular meaning or connotation per se, apart from their overall commercial impressions.

In terms of overall commercial impression, we find that the two marks are similar to the extent that they both would be perceived as "lion" sports team mascots, and as similar lions at that. However, when we consider the marks in their entireties, we find that the marks create different overall commercial impressions in that Sluggerrr, because of his "Royals" jersey and baseball uniform, would be perceived to be a mascot for a baseball team named the "Royals," while

Opposition No. 91163833

Max, because of the "M" on his jersey, would be perceived to be a mascot of a sports team for which the letter "M" has some significance.

We find this to be so even if (as opposer contends) consumers might not recognize or identify, unaided, the specific team (or even the specific sport) represented by Max's "M" jersey. Consumers, upon encountering Max with his "M" jersey, might think that the "M" stands for Manchester, for Monarchs, or for Max, or they might not have any idea at all what it stands for. However, they would have no reason to assume that it has anything to do with the Royals. Sluggerrr has never worn a jersey bearing the letter "M." (Shores Test. Depo. at 89-90, 123-24.) He would have no reason to do so, because the letter "M" has nothing to do with the Royals, with Kansas City, or with Sluggerrr himself. (Burgess Test. Depo. at 230-31.) Thus, even though purchasers are likely to note the similarities between the lion characters themselves, Max would not be mistaken for Sluggerrr because Sluggerrr has not worn, does not wear, and would have no reason to wear an "M" jersey. Instead, Sluggerrr always wears his "Royals" jersey.

For these reasons, we find that the parties' marks when viewed in their entireties are dissimilar in terms of overall commercial impression.

On balance, when we consider the parties' mascot marks in their entirety, we find that the visual similarity of the lion characters in themselves is outweighed by the fundamental dissimilarity of the marks which results from the fact that they are wearing different jerseys and clearly would be perceived as being the mascots for two different teams, one a team called the "Royals" and the other a team for which, unlike the Kansas City Royals, the letter "M" has some (even if unknown) significance. We therefore find that the first *du Pont* factor weighs against a finding of likelihood of confusion.

Fame of Opposer's Mark

The fifth *du Pont* factor requires us to consider evidence of the fame of opposer's mark, 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, 1309 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

We have carefully considered opposer's evidence concerning the extent of its use of its Sluggerrr mascot mark and its arguments regarding the fame of the mark. We find, however, that opposer has failed to establish that its

Sluggerrr mascot mark is famous, within the meaning of the fifth *du Pont* factor. We will assume that opposer's baseball team and its "ROYALS" team name and marks are famous.⁹ But we do not find on this record that its mascot Sluggerrr, per se and apart from the team and its other marks, is famous. The insufficiency of evidence of fame is especially pronounced with regard to the extent of opposer's use of the "open arms" cartoon version of the mark, per se, upon which opposer primarily relies in this case. The Sluggerrr mark likely is well-known to the fans of opposer's baseball team, but we find that it is not, in itself, a mark of sufficient general renown that it is entitled to the broad scope of protection accorded to a famous mark under the fifth *du Pont* factor. For these reasons, we find that the fifth *du Pont* factor is neutral in this case; if it weighs in opposer's favor, it does so only slightly.

Third-party Marks

Under the sixth *du Pont* factor (number and nature of similar marks in use on similar goods and services), we find that there is no significant evidence of actual use of lion mascot marks by third parties which would detract from the

⁹ Opposer claims that its games are broadcast on cable television networks that reach 2.1 million homes. However, there is no evidence that the number of homes served by the cable systems is necessarily the number of homes which actually view opposer's baseball games (or its kids' Saturday Blue Crew show).

strength of opposer's mark. The sixth *du Pont* factor is neutral in our likelihood of confusion analysis.

Absence of Actual Confusion

Under the seventh and eighth *du Pont* factors (actual confusion, and opportunity for actual confusion), we find that there is no evidence of any actual confusion. But we also find that the absence of such evidence is of little probative value because there has been little opportunity for such confusion to have occurred, in view of the parties' disparate geographic locations. The seventh and eighth *du Pont* factors cancel each other out and are neutral in our likelihood of confusion analysis.

Bad Faith Adoption

Opposer argues that applicant adopted its Max mascot mark in bad faith, with the intent to trade on opposer's goodwill and common law rights in opposer's Sluggerrr mascot. We shall consider this contention under the miscellaneous thirteenth *du Pont* factor.¹⁰

¹⁰ Opposer also argues in its briefs that applicant at the least adopted its Max mark with "reckless indifference to Opposer's rights" in Sluggerrr. Opposer has cited no authority for the proposition that such "reckless indifference" is a probative fact or a cognizable claim in an inter partes proceeding before the Board.

It is undisputed that Sluggerrr and Max were designed by the same designer, Mr. Sapp of Real Characters, Inc. As part of the process of designing Max, the evidence supports a finding that Mr. Sapp showed applicant his earlier mascot creations, including Sluggerrr, to illustrate certain design features that might be incorporated into Max's design.

However, we find that even if applicant was aware of Sluggerrr at the time it adopted Max, that awareness does not suffice to establish that applicant adopted its Max mascot mark in bad faith. Opposer is a Major League Baseball team in Kansas City, Missouri. Applicant, at the time it adopted its Max mascot, was (and remains) a minor league hockey team in Manchester, New Hampshire. The parties are in two different sports, in two different parts of the country. There is no basis in the record for finding, or even reasonably supposing, that applicant adopted its Max mascot because it affirmatively intended to confuse its fans or opposer's fans as to the source of its ice hockey team entertainment services, or because it otherwise intended to trade on the goodwill and common law rights opposer had developed in its Sluggerrr mascot.

Likelihood of Confusion - Conclusion

Considering and weighing all of the evidence of record as it pertains to the *du Pont* likelihood of confusion

Opposition No. 91163833

factors, we find that there is no likelihood of confusion. Even if the parties' mascot-related goods and services, trade channels and purchasers might be found to overlap (because the parties both are engaged generally in the sports entertainment business), we find that relevant consumers are likely to understand that Max and Sluggerrr are two different mascots for two different teams. One is a mascot well-known by his name "Sluggerrr" who, whether he appears at games or in the community, represents a Major League Baseball team named the "Royals." The other is a mascot for a team for which, unlike opposer's team, the letter "M" has some significance (even if that significance is unknown). Max will not be mistaken for Sluggerrr, despite the similarity of the lion characters themselves. Moreover, the record does not support a finding that relevant consumers would be likely to assume that any ownership, licensing, or other type of source connection or affiliation exists between a Major League Baseball team like opposer's and a professional ice hockey team like applicant's, just because the two teams might have lion mascots which may look similar but for their jerseys.

Again, "[The Board] is not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world with which the trademark laws deal."

Opposition No. 91163833

Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., supra.

We conclude that opposer's common law rights in its "Sluggerrr" mascot mark do not extend so far as to preclude applicant's registration of its own mascot mark for the goods and services identified in the application.

Decision: The opposition is dismissed.