IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRO-FOOTBALL, INC. and NFL PROPERTIES LLC, Opposers, -against- DAVID S. CAMPBELL, Applicant.	Opposition No. 91152156

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Opposers Pro-Football, Inc. (the "Washington Redskins," the "Redskins Club") and NFL Properties LLC ("NFLP") submit this Brief on the Case pursuant to TBMP § 801 and 37 C.F.R. § 2.128 for an Order denying registration of Applicant David S. Campbell's intent-to-use application for the designation WASHINGTON PIGSKINS.

PRELIMINARY STATEMENT

The Washington Redskins franchise is one of the most celebrated and revered sports franchises in the history of professional sports. As such, the Redskins Club is the owner of service marks and trademarks that are among the most famous in this country. For more than half a century, the Redskins Club has developed its national reputation by competing under the name and mark WASHINGTON REDSKINS. Applicant is a self-professed fan of the Washington Redskins football team and is attempting to capitalize on a cancellation proceeding brought against the Washington Redskins by Native Americans. Applicant selected the designation WASHINGTON PIGSKINS because of its similarity to marks owned by the Washington Redskins. Accordingly, the application opposed herein should be refused because (1) it is confusingly similar to marks owned by the Washington Redskins; (2) it falsely suggests a connection between Applicant and Opposers; and (3) it will dilute the distinctive quality of the famous marks owned by the Washington Redskins.

DESCRIPTION OF THE RECORD

The evidence of the record consists of David S. Campbell's Intent-to-Use Application, Serial No. 76/021,469, for the mark WASHINGTON PIGSKINS ("WASHINGTON PIGKINS Application"); pleadings filed with the Board by the parties; and the testimonial depositions of Opposers' witnesses, David M. Proper and Susan Rothman, including Opposers' Exhibits 1 through 991. While Applicant purported to introduce Applicant's Notice of Reliance, Opposers filed a Motion to Strike Applicant's Notice of Reliance on September 22, 2003. Opposers have not received a response to their Motion and thus, Opposers respectfully request that the Board grant their motion as unopposed.

STATEMENT OF THE ISSUES

- Whether the application opposed herein should be refused because it is confusingly similar to marks owned by the Washington Redskins.
- Whether the application opposed herein should be refused because it falsely suggests a connection between Applicant and Opposers.
- Whether the application opposed herein should be refused because it will dilute the distinctive quality of the famous marks owned by the Washington Redskins.

RECITATION OF THE FACTS

The Washington Redskins Franchise

Opposer Pro-Football, Inc. has owned and operated the Washington Redskins football franchise in the Washington, D.C. area since 1937. (Proper Dep. at 9:14-9:17.) The Washington Redskins franchise is one of the most fabled sports franchises in the history of professional sports, and, as such, the Redskins Club is the owner of service marks and trademarks that are among the most famous in this country. (Proper Dep. at 43:14-43:19; 44:4-45:5.) As at least one court has recognized that the team has developed its national reputation by competing under the name and mark WASHINGTON REDSKINS for over seventy years, in that time winning three Super Bowl championship games and attracting "millions of impassioned fans who root fervently for their Redskins every Sunday in the fall." Pro-Football, Inc. v. Harjo, 57 U.S.P.Q.2d 1140, 1141 (D.D.C. 2000). Similarly, the Trademark Trial and Appeal Board has recognized the Redskins' "continuous renown in the sport of football" from at least the 1940s to the present. Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999) (see also Proper Dep. at 9:18-9:21).

Opposers' trademarks include Registration No. 836,122 for the mark THE REDSKINS (Opposers' Ex. 2; Proper Dep. at 9:22-11:5); Registration No. 978, 824 for the mark WASHINGTON REDSKINS (Opposers' Ex. 6; Proper Dep. at 15:24-17:11); Registration No. 986,668 for the mark THE WASHINGTON REDSKINS and Design (Opposers' Ex. 7; Proper Dep. at 17:12-19:3); Registration No.

987,127 for the mark THE REDSKINS and Design (Opposers' Ex. 5; Proper Dep. at 14:8-15:23); Registration No. 1,085,092 for the mark REDSKINS (Opposers' Ex. 4; Proper Dep. at 12:19-14:7); Registration No. 1,606,810 for the mark REDSKINETTES (Opposers' Ex. 3; Proper Dep. at 11:6-12:18); State of Maryland Registration No. 1993-7586 for the mark HOGS (Opposers' Ex. 8; Proper Dep. at 19:6-20:16); State of Maryland Registration No. 1993-7588 for the mark SKINS (Opposers' Ex. 9; Proper Dep. at 20:18-22:15); State of Maryland Registration No. 1995-S3361 for the mark REDSKINS (Opposers' Ex. 10; Proper Dep. at 22:16-23:25); State of Maryland Registration No. 1995-S3362 for the mark SKINS (Opposers' Ex. 11; Proper Dep. at 24:1-25:14); State of Maryland Registration No. 1995-7745 for the mark SKINS (Opposers' Ex. 12; Proper Dep. at 25:15-27:9); State of Maryland Registration No. 1995-7748 for the mark WASHINGTON REDSKINS (Opposers' Ex. 13; Proper Dep. at 27:10-29:8); State of Maryland Registration No. 1995-7747 for the mark REDSKINS (Opposers' Ex. 14; Proper Dep. at 29:9-31:1); State of Maryland Registration No. 1995-7746 for the mark HOGS (Opposers' Ex. 15; Proper Dep. at 31:2-32:18); State of Virginia Registration File No. 3718 for the mark HOGS (Opposers' Ex. 16; Proper Dep. at 32:19-34:7); State of Virginia Registration File No. 78 for the mark REDSKINS (Opposers' Ex. 17; Proper Dep. at 34:8-35:19); State of Virginia Registration File No. 6290 for the mark WASHINGTON REDSKINS (Opposers' Ex. 18; Proper Dep. at 35:20-37:2); State of Virginia Registration File No. 0064 for the mark REDSKINS (Opposers' Ex. 19; Proper Dep. at 37:3-38:8); State of Virginia Registration File No. 0065 for the mark SKINS (Opposers Ex. 20; Proper Dep. at 38:9-39:17) (collectively, the "WASHINGTON REDSKINS Marks"). See Pro Football, Inc. v. Harjo, No. 99-1385, slip op. at 12-16 (D.D.C. Sept. 30, 2003) (discussing history of certain WASHINGTON REDSKINS Marks).

Business Activities of Opposer NFL Properties

To fulfill its obligations as the exclusive trademark licensee of the Washington Redskins, NFLP has entered into license agreements with manufacturers and distributors of merchandise to use the WASHINGTON REDSKINS Marks and related marks on a wide variety of goods. (Proper Dep. at 8:17-9:2; Rothman Dep. at 7:7-7:19; 11:13-12:6; 13:5-14:15; 18:19-18:25.) These goods include, amongst

others, trading cards, sports balls, posters, magazines, and books regarding football, postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper cups, tablecloths, paper napkins, paper towels, notepads, paper hats, party goods, greeting cards, stationary supplies, pens, pencils, back to school products, calendars, bar supplies, bottle cap tops, key chains, lithographs, mugs, glasses, tailgating equipment and paraphernalia, aprons, hats, and men's and women's clothing and footwear. (Rothman Dep. at 11:13-12:6; 13:5-14:15; 18:19-18:25). On behalf of the Washington Redskins, NFLP controls and monitors the quality and style of officially-licensed products bearing the WASHINGTON REDSKINS Marks. (Rothman Dep. at 18:5-18:18; Proper Dep. at 39:18-40:8.) The NFL enjoys in excess of $3 billion dollars in annual retail sales in merchandise bearing the marks of the member clubs of the NFL, including the WASHINGTON REDSKINS Marks. (Rothman Dep. at 16:7-17:17.)

Opposers and their licensees have devoted substantial resources to the production, marketing, promotion and distribution of merchandise bearing the WASHINGTON REDSKINS Marks and have established a significant consumer demand for these items through such efforts. (Rothman Dep. at 15:11-18:4.) Licensees advertise merchandise bearing the WASHINGTON REDSKINS Marks through a wide variety of media, including over the Internet, on television, via radio, in print magazines and newspapers, in publications sold in the stadium, and in various direct-mail catalogs. (Rothman Dep. at 10:4-11:8.) Licensees distribute merchandise bearing the WASHINGTON REDSKINS Marks throughout the United States in interstate commerce, where the products are sold in a wide variety of retail outlets such as JCPenney, Sears, Kohl's Department Stores, Federated Department Stores, The May Department Store Company, Dillard's, Foot Locker, Champs, The Sports Authority and Modell's. Additional trade channels used for the sale of products include the Internet, direct-mail catalogs, and kiosks at the Washington Redskins' stadium. (Rothman Dep. at 7:7-9:16; 11:9-11:12.) Due to the long, widespread and continuous use of the WASHINGTON REDSKINS Marks by Opposers, consumers readily identify merchandise bearing the WASHINGTON REDSKINS Marks as being sponsored and approved by the Washington Redskins and NFLP.

Applicant David S. Campbell's Trademark Application

David S. Campbell is a self-professed fan of the Washington Redskins football team and has been for over thirty years. (Opposers' Ex. 893 at 1.) In an attempt to capitalize on a cancellation proceeding brought against the Redskins and the attendant publicity surrounding the team's name, Applicant admittedly "committed to the discovery and development of a new team name and logo for the Washington D.C. football franchise." (Id. at 2.) Applicant selected the designation WASHINGTON PIGSKINS as "the appropriate new successor name for the Redskins." (Id.) As Applicant admits, he selected the designation WASHINGTON PIGSKINS because "WASHINGTON PIGSKINS is a very similar mark and does not stray to far from the current team name. It has the same number of syllables and the same number of letters. It rhymes with 'Washington Redskins.'" (Id.) He also selected the designation because WASHINGTON PIGSKINS could share the same abbreviated trademark already adopted by fans for Opposers' WASHINGTON REDSKINS Marks: the Skins. (Id.) He chose the syllable "pig" in part because the Redskins are already associated with pigs: "Washington's NFL team already has a history of porcine affinity ... the offensive front line has been known as the 'Hogs' for decades. A popular group of male fans raise money for charity by dressing up as pigs, calling themselves the Hogettes. The snout nose costume has apparently more appeal for Washington fans than war paint, headdresses, spears, and eagle feathers." (Id.) As Applicant's own statements make clear, he selected the designation WASHINGTON PIGSKINS because of its similarity to Opposers' WASHINGTON REDSKINS Marks and its ability to trade off the goodwill of the Washington Redskins.

Moreover, Applicant admits that his intention in filing a trademark application for the designation WASHINGTON PIGSKINS was not to use the designation as an association with his own goodwill, but rather in association with that of Opposers:

> [M]y intention has always been to help "my" team, the Redskins, with a solution to the controversial and difficult name problem. I believe that ultimately the team and the league will see the value of owning the name WASHINGTON PIGSKINS as a potential successor name to the current one.

(Id. at 4.) Thus, the only goods or services that Applicant intended to offer in connection with the designation WASHINGTON PIGSKINS was the designation itself.

ARGUMENT

The application opposed herein should be refused because (1) it is confusingly similar to Opposers' WASHINGTON REDSKINS Marks; (2) it falsely suggests a connection between Applicant and Opposers; and (3) it will dilute the distinctive quality of Opposers' famous WASHINGTON REDSKINS Marks.

I. APPLICANT'S WASHINGTON PIGSKINS DESIGNATION LIKELY WILL CAUSE CONFUSION, MISTAKE OR DECEPTION

The undisputed facts demonstrate that Applicant's WASHINGTON PIGSKINS designation so resembles Opposers' WASHINGTON REDSKINS Marks "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. §1052(d). Whether a likelihood of confusion exists is a question of law based on underlying factual determinations. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 945, 55 U.S.P.Q.2d 1842, 1843-44 (Fed. Cir. 2000). The Board determines the likelihood of confusion on a case-by-case basis applying the factors set out in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).[1] An analysis of each of the relevant factors[2] in light of the undisputed facts shows that confusion is likely.

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[1] The thirteen DuPont factors are: (1) similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) similarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use; (3) similarity of established, likely-to-continue trade channels; (4) conditions under which and buyers to whom sales are made; (5) fame of the prior mark; (6) number and nature of similar marks in use on similar goods; (7) nature and extent of any actual confusion; (8) length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) variety of goods on which a mark is or is not used; (10) market interface between applicant and the owner of a prior mark; (11) extent to which applicant has a right to exclude others from use of its marks on its goods; (12) extent of potential confusion; and (13) any other established fact probative of the effect of use. In re E.I. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567.

A. Applicant Intends to Trade on the Valuable Goodwill of Opposers' WASHINGTON REDSKINS Marks

As his own admissions make clear, Applicant recognizes the valuable goodwill in Opposers' WASHINGTON REDSKINS Marks and has knowingly and wrongfully adopted a designation similar to Opposers' WASHINGTON REDSKINS Marks with the intention of capitalizing on the similarity. Applicant's bad faith intent is a central consideration in the Board's likelihood of confusion analysis. See Roger & Gallet S.A. v. Venice Trading Co., No. 69,575, 1987 WL 123807, at *3, 1 U.S.P.Q.2d 1829, 1831-32 (T.T.A.B. 1987) (requiring consideration of evidence of applicant's intent to adopt mark that suggests to purchasers successful mark already in use). Applicant admittedly adopted the designation WASHINGTON PIGSKINS because of the public's likelihood to associate that designation with Opposers. (Opposers' Ex. 893 at 2.) Such free riding poses a threat to famous marks that should not be permitted. See Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992).

Knowingly adopting a variation on the name of a sports team with the hope of capitalizing on a future change in the team's name constitutes bad faith. Nat'l Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 518, 229 U.S.P.Q. 785, 792-93 (D.N.J. 1986). In New Jersey Giants, the defendant adopted the designation NEW JERSEY GIANTS with the hope that the New York Giants, a football team that plays its home games in New Jersey, would eventually change its name to

(...continued)

[2] The Board need only consider the relevant factors, see Cunningham, 222 F.3d at 964-47, 55 U.S.P.Q.2d at 1845, and may place greater weight on one or more factors, see In re E.I. DuPont, 476 F.2d at 1361-62, 177 U.S.P.Q. at 567. This brief does not address the third, seventh, and eighth DuPont factors because Applicant has not yet used any marks in commerce or established any trade channels. See Presto Prods. Inc. v. Nice-Pak Prods. Inc., 9 U.S.P.Q.2d 1895, 1898 (T.T.A.B. 1988) (noting that where applicant has engaged in very limited, if any, sales or promotion of its goods, actual confusion is of little significance). This brief also does not consider the tenth DuPont factor because no "market interface" of the type described in DuPont is at issue here. Cunningham, 222 F.3d at 949, 55 U.S.P.Q.2d at 1847 (finding no error where market interface argument not raised). Examples of market interface include "(1) consent to register or use; (2) contractual provisions designed to preclude confusion; (3) assignment; and (4) laches and estoppel attributable to the challenger that would indicate lack of confusion." Id.

reflect the location of its home games. Id. at 509, 229 U.S.P.Q.2d at 785. The court held that the defendant's adoption of the designation NEW JERSEY GIANTS for this purpose manifested a bad faith intent to confuse and raised a presumption that a likelihood of confusion would arise from the sale of merchandise bearing the designation. Id. at 518, 229 U.S.P.Q.2d at 792-93.

The circumstances here are analogous to those in New Jersey Giants. As a long-time Washington Redskins fan who has attended many Redskins games, Applicant is well aware of the strong connection of the WASHINGTON REDSKINS Marks with the Redskins and NFL football. (Opposers' Ex. 893; Proper Dep. at 51:5-56:9.) This strong connection was created by Opposers' widespread and extensive use, licensing and marketing of the WASHINGTON REDSKINS Marks in connection with a variety of goods, and the millions of uses by the media of the WASHINGTON REDSKINS Marks when referring to the football franchise. (Opposers' Exs. 22 through 890; Proper Dep. at 45:8-46:2; Opposers' Exs. 895 through 984; Proper Dep. at 57:12-58:7.) See Johnny Blastoff, Inc. v. Los Angeles Rams Football Co., 188 F.3d 427, 434-35, 51 U.S.P.Q.2d 1920, 1925 (7th Cir. 1999) (holding use of mark by media inures to benefit of mark owners and establishes public identification of mark with product or service). Applicant admits that he chose the designation WASHINGTON PIGSKINS because of its similarity to the WASHINGTON REDSKINS Marks. (Opposers' Ex. 893 at 2; Opposers' Ex. 894; Proper Dep. at 56:10-57:11.) Applicant has specifically stated that he intends to use his WASHINGTON PIGSKINS designation "as a potential successor name" for the Redskins. (Opposers' Ex. 893 at 4.) In fact, Applicant sent Opposers a mug that has the WASHINGTON PIGSKINS designation and a football on it and employs the colors burgundy and gold – the exact same colors that the Redskins Club has been using for decades. (Opposers' Ex. 894; Proper Dep. at 56:10-57:10.) Applicant's letters and mug sent to Opposers therefore constitute admissions of his bad faith and raise a presumption that likelihood of confusion exists. See New Jersey Giants, 637 F. Supp. at 518, 229 U.S.P.Q. at 792-93.

B. Applicant's WASHINGTON PIGSKINS Designation Is Virtually Identical to Opposers' WASHINGTON REDSKINS Marks

Applicant's WASHINGTON PIGSKINS designation is indisputably similar to Opposers' WASHINGTON REDSKINS Marks in appearance, sound, and connotation. As Applicant admits, the marks have the same number of syllables and the same number of letters. (Opposers' Ex. 893 at 2.) Visually, they are nearly identical. See In re Lamson Oil Co., 6 U.S.P.Q.2d 1041, 1042 (T.T.A.B. 1987) (finding similarity in appearance between TRUCOOL and TURCOOL sufficient for determination of likelihood of confusion, notwithstanding differences between marks in sound and meaning). Although Applicant's WASHINGTON PIGSKINS designation substitutes the syllable "pig" for "red", marks may be confusingly similar in appearance notwithstanding the addition, deletion or substitution of letters or even whole words. See New Jersey Giants, 637 F. Supp. at 517, 229 U.S.P.Q. at 791-92 (finding likelihood of confusion between NEW JERSEY GIANTS and NEW YORK GIANTS); see also Cunningham, 222 F.3d at 947, 55 U.S.P.Q.2d at 1845 (finding confusion likely between LASER and LASERSWING); In re Riddle, 225 U.S.P.Q. 630, 632 (T.T.A.B. 1985) (finding confusion likely between RICHARD PETTY'S ACCU TUNE and ACCU-TUNE); In re United States Shoe Corp., 229 U.S.P.Q. 707, 709 (T.T.A.B. 1985) (finding confusion likely between CAREER IMAGES and CREST CAREER IMAGES); In re Toyo Tire & Rubber Co., Ltd., No. 76/313,168, 2003 WL 21774649, at *4 (T.T.A.B. July 28, 2003) (finding confusion likely between GRAPPLER and NITRO TERRA GRAPPLER). Significantly, the first part of Applicant's WASHINGTON PIGSKINS designation is the same in appearance and sound as Opposers' WASHINGTON REDSKINS Marks. "[I]t is most often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." See Presto Prods. Inc., 9 U.S.P.Q.2d at 1897; In re Valley Research, Inc., No. 76/241,557, 2003 WL 22134772, at **2-3 (T.T.A.B. Sept. 10, 2003) (same). This similarity is particularly notable in this case because Applicant does not reside in Washington. (WASHINGTON PIGSKINS Application.) Thus, Applicant has no argument that this part of his designation is merely geographically descriptive.

Moreover, the designation WASHINGTON PIGSKINS sounds the same as Opposers' WASHINGTON REDSKINS mark. Of the five syllables of the designation, four are identical to those of the mark WASHINGTON REDSKINS. Applicant admits that he chose the designation WASHINGTON PIGSKINS in part because "[i]t rhymes with 'Washington Redskins.'" (Opposers' Ex. 893 at 2.) The designation WASHINGTON PIGSKINS also has the same connotation as Opposers' WASHINGTON REDSKINS Marks. Both Applicant's designation and Opposers' marks connote football. Opposers' marks connote football because they have become famous in association with an NFL football team. (See discussion infra Parts I.E. and III.A.) Applicant's designation connotes football for several reasons. First, its inclusion of the words "Washington" and "Skins" brings to mind the Washington Redskins football franchise. Second, Applicant's designation is intended to be used on goods "regarding football." (WASHINGTON PIGSKINS Application.) Third, as Applicant admits, the designation WASHINGTON PIGSKINS "incorporates the nickname for a football: a pigskin." (Opposers' Ex. 893 at 2.)

Another reason that Applicant's designation shares the same connotation with Opposers' marks is that the Washington Redskins franchise has historically been associated with pigs. Applicant admits that "the offensive front line has been known as the 'Hogs' for decades" and that a "popular group of male fans raise money for charity by dressing up as pigs, calling themselves the Hogettes." (Opposers' Ex. 893 at 2.) Indeed, according to Applicant, "[t]he snout nose costume has apparently more appeal for Washington fans than war paint, headdresses, spears, and eagle feathers." (Opposers' Ex. 893 at 2.) In fact, Opposers are the owners of many trademark registrations for the mark HOGS, as "HOGS" is the nickname for the offensive line of the Washington Redskins. (Opposers' Ex. 8; Proper Dep. at 19:6-20:16; Opposers' Ex. 15; Proper Dep. at 31:2-32:18; Opposers' Ex. 16; Proper Dep. at 32:19-34:7.)

Thus, by Applicant's own admission, the WASHINGTON PIGSKINS designation is virtually identical to Opposers' WASHINGTON REDSKINS Marks in appearance, sound, and connotation. Applicant chose the designation because of these similarities. (Opposers' Ex. 893 at 2.) These similarities alone constitute sufficient evidence of likelihood of confusion to bar registration of Applicant's designation. See Gen. Foods Corp. v. Wis. Bottling, Inc., 190 U.S.P.Q. 43, 45 (T.T.A.B.

1976) ("[I]t is well established that similarity in any one of the elements of sound, appearance, or meaning is sufficient to indicate likelihood of confusion.").

C. The Goods Identified in Applicant's Application Are Identical to the Goods Sold by Opposers

The goods identified in Applicant's application encompass products on which Opposers have long used the WASHINGTON REDSKINS Marks. Applicant, like Opposers, plans to use his designation in connection with sports, and specifically, football. (Opposers' Ex. 893; Proper Dep. at 51:5-56:9.) Applicant seeks registration of the mark WASHINGTON PIGSKINS for use on "trading cards, posters, magazines, and books regarding football, postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper towels, poster books, note pads, paper hats, and greeting cards . . . men's, women's, and children's clothing and footwear, namely coaches caps, wool hats, painters caps, baseball caps, visors, headbands, ear muffs, knit face masks, belts, wrist bands, t-shirts, tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, braces, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweat pants, jeans, pants, knickers, socks, underwear, bathing suits, and leg warmers." (WASHINGTON PIGSKINS Application.) Opposers use the WASHINGTON REDSKINS Marks on the exact same goods. (Rothman Dep. at 11:13-12:6; 13:5-14:15; 18:19-18:25.)

The Board has held that the goods need not be identical, or even competitive, to find a likelihood of confusion, but that it is sufficient that the goods and services are related in some manner. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 1568, 223 U.S.P.Q. 1289, 1291 (Fed. Cir. 1984) (finding confusion likely between MARTIN'S for bread and MARTIN'S for cheese); In re Diet Ctr. Inc., 4 U.S.P.Q.2d 1975, 1976 (T.T.A.B. 1987) (finding confusion likely between SVELTE for frozen desserts and VEGETABLE SVELTES for crackers). In fact, if the marks are virtually identical, as here, there need only be a "viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia Int'l Forwarding Corp., 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983); In re Lehman Bros. Inc., No. 76/226,454, 2003 WL 22174261, at *2 (T.T.A.B. Sept. 12, 2003). In

this case, where the goods are identical and competitive, this factor weighs strongly in favor of finding a likelihood of confusion.

D. The Goods Sold By Opposers And That Applicant Intends to Sell, Are Inexpensive and Easily Replaceable Items

The goods sold by Opposers and that Applicant intends to sell, are inexpensive and easily replaceable items and as such the likelihood that Applicant's goods will be confused for Opposers goods is high. (Rothman Dep. at 12:7-13:4; 14:16-15:10.) Opposers license a broad range of inexpensive apparel products and "hard line" products. (Rothman Dep. at 11:16-15:9.) Items licensed by NFLP are marketed and sold with a broad range of target consumers in mind, and priced in a manner such that numerous of these items can be, and are, replaced on a regular basis. (Rothman Dep. at 9:17-10:3; 11:16-15:9; 17:18-18:4.) The success of this approach is evidenced by the consistently robust sales revenue generated by NFLP licensed merchandise. (Rothman Dep. at 16:22-17:17.) The Board has long held that purchasers of inexpensive or easily replaceable goods exercise a lesser standard of purchasing care. See In re Majestic Drilling Co., Inc., 315 F.3d 1311, 1316, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003); Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000) (finding that consumers may confuse FRITO-LAY for snack food and FIDO LAY for dog food in "hasty, economically painless, transactions"); Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 672, 223 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984) (finding confusion likely between SPICE VALLEY and SPICE ISLANDS, both for tea, where products "relatively inexpensive, comestible goods subject to frequent replacement"). Accordingly, this factor favors Opposers.

E. Opposers' Famous WASHINGTON REDSKINS Marks Enjoy a Wide Scope of Protection

As discussed in detail infra Part III.A., Opposers' WASHINGTON REDSKINS Marks enjoy great fame and should therefore be accorded the greatest protection. See In re E.I. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567 (fifth factor). Famous marks, especially, as in this case, ones that have been in use for nearly seventy years, enjoy greater legal protection than weak marks. See Kenner Parker Toys Inc., 963 F.2d at 353, 22 U.S.P.Q.2d 1456 ("a mark with extensive public recognition and renown

deserves and receives more legal protection than an obscure or weak mark"); Nike, Inc. v. Pleasures of The Table, Inc., No. 75/240,563, 2003 WL 21653639, at *4 (T.T.A.B. July 10, 2003) (famous marks receive greater level of protection than lesser known marks). Merchandise bearing the WASHINGTON REDSKINS Marks generates tens of millions of dollars in retails sales each year. (Rothman Dep. at 16:4-17:17.) The WASHINGTON REDSKINS Marks are seen on television and the Internet in millions of homes across the United States on a regular basis. (Proper Dep. at 41:19-45:4.) The marks are thus unquestionably famous. Therefore, there is "no excuse for even approaching the well-known trademark of a competitor . . . and [] all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer." Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 1074, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir. 1989) (quoting Specialty Brands, Inc., 748 F.2d at 674, 223 U.S.P.Q. at 1285).

F. No Other Registrants Have Adopted Similar Marks for Use on Similar Goods

Searches of the records of the Patent and Trademark Office reveal that no other registrant has adopted marks containing the words "Washington" and "Skins" for goods and services virtually identical to those sold by Opposers under the WASHINGTON REDSKINS Marks without challenge by Opposers. (Opposers' Ex. 21; Proper Dep. at 40:11-41:18); see In re E.I. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567 (sixth factor). The absence of third-party registrations containing the words "Washington" and "Skins" on goods typically used to promote football franchises (as well as Opposers' advertising and promotional efforts discussed above) demonstrates the strength of Opposers' WASHINGTON REDSKINS Marks. See Hunt Foods and Indus., Inc. v. Gerson Stewart Corp., 367 F.2d 431, 436, 151 U.S.P.Q. 350, 353 (C.C.P.A. 1966); In re Starcraft Corp., 18 U.S.P.Q.2d 1162, 1165 (T.T.A.B. 1990).

G. Opposers Use the WASHINGTON REDSKINS Marks on a Wide Variety of Goods and Services

Opposers use the WASHINGTON REDSKINS Marks on a broad range of goods and services, including but not limited to, entertainment services related to professional football contests, trading cards, sports balls, posters, magazines, and books regarding football, postcards, calendars, wrapping paper,

paper gift boxes, paper stickers, paper cups, tablecloths, paper napkins, paper towels, notepads, paper hats, party goods, greeting cards, stationary supplies, pens, pencils, back to school products, calendars, bar supplies, bottle cap tops, key chains, lithographs, mugs, glasses, tailgating equipment and paraphernalia, aprons, hats, and men's and women's clothing and footwear. (Rothman Dep. at 11:13-12:6; 13:5-14:15; 18:19-18:25); see In re E.I. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567 (ninth factor). Marks that are used on a wide variety of goods and services leave little room for others to permissibly use a similar or identical mark. See Turner Entm't Co. v. Nelson, 38 U.S.P.Q.2d 1942, 1945 (T.T.A.B. 1996) (finding confusion likely where mark GILLIGAN'S ISLAND used by opposer on wide variety of goods).

H. Applicant Has No Right to Exclude Others from Using His WASHINGTON PIGSKINS Designation

Having never used the WASHINGTON PIGSKINS designation, Applicant has no right whatsoever to exclude others from its use. See In re E.I. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567 (eleventh factor). Applicant owns no federal registrations for the WASHINGTON PIGSKINS designation or any similar marks. Applicant possesses no common law rights in the WASHINGTON PIGSKINS designation or any similar marks. Applicant is not part of, or an official sponsor or licensee of, Opposers. (Opposers' Ex. 892; Proper Dep. at 49:20-51:4; Opposers' Ex. 985; Proper Dep. at 58:8-59:21; 64:12-64:19.) To recognize any rights in Applicant with regard to the WASHINGTON PIGSKINS designation will be to permit Applicant to participate in the unlawful infringement of Opposers' WASHINGTON REDSKINS Marks. See In re Shell Oil Co., 992 F.2d 1204, 1208, 26 U.S.P.Q.2d 1687, 1690 (Fed. Cir. 1993) ("The registrant/senior user is safeguarded by the trademark law, as is the consuming public, from likelihood of confusion caused by the entry of a junior user of a confusingly similar mark.").

I. Confusion Between Applicant's WASHINGTON PIGSKINS Designation and Opposers' WASHINGTON REDSKINS Marks Will Be Considerable

The extent of potential confusion will be substantial, not *de minimis*. See In re E.I. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567 (twelfth factor). As discussed, Applicant intends to trade on Opposers'

goodwill, the marks are virtually identical, the goods are virtually identical, and the channels of trade are likely to be identical. All of these factors increase not only the likelihood of confusion but the extent of confusion that would arise. See Cunningham, 222 F.3d at 949, 55 U.S.P.Q.2d at 1847.

J. Any Doubt Should Be Resolved in Favor of Opposers

Any doubt as to likelihood of confusion should be resolved against Applicant. See Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 878, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 U.S.P.Q.2d 1025, 1026 (Fed. Cir. 1988); Nike, Inc., 2003 WL 21653639, at *4. The newcomer "has the opportunity of avoiding confusion, and is charged with the obligation to do so," In re Shell Oil Co., 992 F.2d at 1209, 26 U.S.P.Q.2d at 1691, especially when the prior mark is famous, Century 21 Real Estate Corp., 970 F.2d at 878, 23 U.S.P.Q.2d at 1701. Opposers used the WASHINGTON REDSKINS Marks in commerce long before Applicant filed his applications. (See discussion supra at Factual Background; Rothman Dep. at 11:13-12:6; 13:5-14:15; 18:19-18:25.) Therefore, any doubt as to whether a likelihood of confusion exists between Applicant's WASHINGTON PIGSKINS designation and Opposers' WASHINGTON REDSKINS Marks should be resolved against Applicant.

II. APPLICANT'S WASHINGTON PIGSKINS DESIGNATION WILL FALSELY SUGGEST A CONNECTION BETWEEN APPLICANT AND OPPOSERS

Applicant's WASHINGTON PIGSKINS designation will falsely suggest a connection between Applicant and Opposers. See 15 U.S.C. § 1052(a); In re Sloppy Joe's Int'l Inc., 43 U.S.P.Q.2d 1350, 1353 (T.T.A.B. 1997) (upholding refusal to register based on false suggestion of connection). Applicant's WASHINGTON PIGSKINS designation falsely suggests a connection with Opposers because (1) the mark is the same as, or a close approximation of, Opposers' WASHINGTON REDSKINS Marks; (2) the marks will be recognized as such; (3) Opposers are not connected with Applicant's goods; and (4) Opposers' WASHINGTON REDSKINS Marks are of sufficient fame or reputation that, when it is used as part or all of a mark, a connection with Opposers likely will be made by consumers. See Sloppy Joe's Int'l Inc., 43 U.S.P.Q.2d at 1353; In re Sauer, 27 U.S.P.Q.2d 1073, 1074 (T.T.A.B. 1993).

A. Applicant's WASHINGTON PIGSKINS Designation is the Same as, or a Close Approximation of, Opposers' WASHINGTON REDSKINS Marks

Applicant's WASHINGTON PIGSKINS designation is unquestionably "the same as or a close approximation" of Opposers' WASHINGTON REDSKINS Marks. See In re Sauer, 27 U.S.P.Q.2d at 1074. As discussed supra Part I.B., and as Applicant admitted in his correspondence with Opposers, Applicant's WASHINGTON PIGSKINS designation is extremely similar in appearance, sound, connotation and commercial impression to Opposers' marks.

B. Applicant's WASHINGTON PIGSKINS Designation Points Uniquely and Unmistakably to Opposers

The public will associate Applicant's WASHINGTON PIGSKINS designation uniquely and unmistakably with Opposers. See Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 428, 429-30 (T.T.A.B. 1985). Opposers' WASHINGTON REDSKINS Marks are used prominently in connection with Opposers' extensive marketing and promotion of the Washington Redskins football franchise, including merchandise sold at the Washington Redskins' stadium, on the Internet and in retail stores nationwide such as JCPenney, Sears, Kohl's Department Stores, Federated Department Stores, The May Department Store Company, Dillard's, Foot Locker, Champs, The Sports Authority and Modell's. (Proper Dep. at 46:3-46:11; Rothman Dep. at 7:7-9:16; 11:9-12:6; 13:5-14:15; 18:19-18:25); see Bd. of Trustees of the Univ. of Ala. v. BAMA-Werke Curt Baumann, 231 U.S.P.Q. 408, 411 (T.T.A.B. 1986) (finding that merchandise sold at opposer's football stadium bearing word "Bama" demonstrates that mark BAMA points uniquely to University of Alabama's football team). Further, as discussed infra Part III.A., the print and broadcast media have made millions of references to Opposers' WASHINGTON REDSKINS Marks. (Opposers' Exs. 895 through 984; Proper Dep. at 43:20-44:3; 45:6-46:2; 57:12-58:7); see In re Urbano, 51 U.S.P.Q.2d 1776, 1778 (T.T.A.B. 1999) (finding that news articles and other media references demonstrate that mark SYDNEY 2000 points uniquely to Official Olympic Games). Applicant's WASHINGTON PIGSKINS designation, which is a close approximation of Opposers' identity, therefore points uniquely and unmistakably to Opposers. Applicant's intent to exploit the goodwill carried in

Opposers' identity, discussed supra Part I.A., is also evidence that the public will associate Applicant's WASHINGTON PIGSKINS designation solely with Opposers.

C. Opposers Are Not Connected with the Goods Applicant Intends to Sell

Applicant is not a part of, nor an official sponsor or licensee of, Opposers. (Opposers' Ex. 892; Opposers' Ex. 985; Proper Dep. at 49:20-51:4; 58:8-59:21; 64:4-64:19); see In re Urbano, 51 U.S.P.Q.2d at 1779 (finding no connection where "[a]pplicant does not contend that it is a part of, or an authorized sponsor or licensee of the official Olympic Games"); In re Sloppy Joe's Int'l Inc., 43 U.S.P.Q.2d at 1353-54 (finding false connection between Ernest Hemingway and applicant for mark HEMINGWAY'S where original owner was friend but not business partner of Ernest Hemingway). As discussed supra Part I.A., Applicant has adopted his WASHINGTON PIGSKINS designation with the sole intent of exploiting Opposers' goodwill to extract a financial windfall from the true trademark owner. Applicant is not affiliated with Opposers in any manner, deeming registration of the mark improper. (Opposers' Ex. 892; Opposers' Ex. 985; Proper Dep. at, 49:20-51:4; 58:8-59:21; 64:4-64:19.)

D. Due to the Fame of Opposers, Applicant's Connection with Opposers Will Be Presumed

As discussed infra Part III.A., Opposers' identities and marks are unquestionably famous. Furthermore, each of the goods Applicant intends to sell — trading cards, posters, magazines, and books regarding football, postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper towels, poster books, note pads, paper hats, and greeting cards; men's, women's, and children's clothing and footwear, namely coaches caps, wool hats, painters caps, baseball caps, visors, headbands, ear muffs, knit face masks, belts, wrist bands, t-shirts, tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, braces, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweat pants, jeans, pants, knickers, socks, underwear, bathing suits, and leg warmers, (WASHINGTON PIGSKINS Application), are the sort of goods that consumers expect Opposers to sell, see In re Urbano, 51 U.S.P.Q.2d at 1779-80 (finding that consumers will reasonably assume that Official Olympic Games

offers same advertising services offered by applicant); In re Cotter & Co., 228 U.S.P.Q. 202, 205 (T.T.A.B. 1985) (finding shotguns and rifles offered by applicant to be sort of goods customers will associate with the United States Military Academy), and the sort that Opposers indeed sell. Notably, products bearing the WASHINGTON REDSKINS Marks amount to tens of millions of dollars in annual retail sales. (Rothman Dep. at 11:13-12:6; 13:5-14:15; 16:4-17:17,18:19-18:25.) Therefore, consumers likely will take for granted that the products sold by Applicant under Applicant's WASHINGTON PIGSKINS designation are connected with Opposers, when in fact they are not.

III. APPLICANT'S WASHINGTON PIGSKINS DESIGNATION WILL DILUTE THE DISTINCTIVE QUALITY OF OPPOSERS' FAMOUS WASHINGTON REDSKINS MARKS

The undisputed facts support a finding that Applicant's WASHINGTON PIGSKINS designation will dilute the distinctive quality of Opposers' famous WASHINGTON REDSKINS Marks. See 15 U.S.C. §§ 1063(a), 1125(c). Indeed, Applicant has stated his intention to offer his designation as a "politically correct" alternative to Opposers' marks, thus tarnishing Opposers' marks by suggesting that they are racially offensive. (Proper Dep. at 55:2-55:23.) The Board has delineated five factors necessary for an opposer to show dilution. See Toro Co. v. ToroHead Inc., 61 U.S.P.Q.2d 1164, 1173 (T.T.A.B. 2001).[3] An analysis of each of the relevant factors shows that dilution will occur.

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[3] To demonstrate dilution under Toro, a plaintiff must provide sufficient evidence of (1) the other party's use in commerce; (2) the other party adopted its mark after the plaintiff's mark became famous; (3) the mark is famous; (4) the other party diluted the mark; and (5) the mark is distinctive. 61 U.S.P.Q.2d at 1173. The first factor is not considered herein because Applicant has not yet used the WASHINGTON PIGSKINS designation in commerce. The third and fifth factors, fame and distinctiveness, will be considered together, as they were in Toro. Id. at 1175-76.

A. Opposers' WASHINGTON REDSKINS Marks Are Distinctive and Famous

Each of the relevant factors the Board may consider in determining whether a mark is distinctive and famous, see 15 U.S.C. § 1125(c)(1), supports a finding that Opposers' WASHINGTON REDSKINS Marks are "distinctive and famous."[4]

1. Opposers' WASHINGTON REDSKINS Marks Are Inherently Distinctive and Have Acquired Secondary Meaning

The "degree of inherent or acquired distinctiveness of the mark" favors Opposers. 15 U.S.C. § 1125(c)(1)(A). "The general rule regarding distinctiveness is clear: An identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning." Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769, 23 U.S.P.Q.2d 1081, 1084 (1992); In re MBNA Am. Bank, N.A., 340 F.3d 1328, 1332, 67 U.S.P.Q.2d 1778, 1780 (Fed. Cir. 2003).

The WASHINGTON REDSKINS Marks are inherently distinctive for several reasons. First and foremost, the federally registered WASHINGTON REDSKINS Marks are incontestable as they have been in use for more than five years and have complied with statutory formalities. See 15 U.S.C. §§ 1065, 1115(b). (Opposers' Ex. 2; Proper Dep. at 9:22-11:5; Opposers' Ex. 3; Proper Dep. at 11:6-12:18; Opposers' Ex. 4; Proper Dep. at 12:19-14:7; Opposers' Ex. 5; Proper Dep. at 14:8-15:23; Opposers' Ex. 6; Proper Dep. at 15:24-17:11; Opposers' Ex. 7; Proper Dep. at 17:12-19:3.) Therefore, the marks are "conclusively presumed [to be] non-descriptive, or if descriptive, ha[ve] acquired secondary meaning." 2

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4 According to the Lanham Act, "[i]n determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to — (A) the degree of inherent or acquired distinctiveness of a mark; (B) the duration and extent of use of the mark in connection with the goods and services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register." 15 U.S.C. § 1125.

J. Thomas McCarthy, McCarthy On Trademarks and Unfair Competition § 11:44 (4th ed. 2003); accord Park' N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 205, 224 U.S.P.Q. 327, 334 (1985). As such, Applicant may not claim that the WASHINGTON REDSKINS Marks lack inherent distinctiveness. McCarthy, § 11:44; see Park' N Fly, Inc., 469 U.S. at 205, 224 U.S.P.Q. at 334.

Second, Opposers' WASHINGTON REDSKINS Marks are inherently distinctive because they are arbitrary with respect to the goods and services of the Washington Redskins. See Two Pesos, Inc., 505 U.S. at 768, 23 U.S.P.Q.2d. at 334 (arbitrary, fanciful, or suggestive marks are "inherently distinctive" and are protected by trademark without the need to demonstrate secondary meaning); see also McCarthy, §§ 11:2, 4 (discussing inherently distinctive marks; marks that are arbitrary or fanciful are marks so strong that the requirement of secondary meaning is negated). The WASHINGTON REDSKINS Marks are arbitrary, having been developed from words and images common to the general public, but applied to goods and services unrelated to the words' common usages. See Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 464, 38 U.S.P.Q.2d 1449, 1454 (4th Cir. 1996); McCarthy, at § 11:4.

In addition to being inherently distinctive, Opposers' WASHINGTON REDSKINS Marks have acquired distinctiveness through secondary meaning. Secondary meaning attaches to a mark when the primary significance of a mark in the public mind is not the product but the producer. See Kellogg Co. v. Nat'l Biscuit Co., 305 U.S. 111, 118, 139 U.S.P.Q. 296, 299, reh'g denied, 305 U.S. 674 (1938). The WASHINGTON REDSKINS Marks have acquired secondary meaning in the minds of consumers because, among other things, since the 1930s, the print and broadcast media and the public have widely mentioned the WASHINGTON REDSKINS Marks in connection with the Washington Redskins, Opposers have advertised goods and services bearing the WASHINGTON REDSKINS Marks across the country in a variety of media, the WASHINGTON REDSKINS Marks are seen in millions of homes on television and the Internet across the United States on a regular basis and Opposers have widely sold goods and services bearing the WASHINGTON REDSKINS Marks across the country, which have generated tens of millions of dollars in retails sales each year. (Opposers' Ex. 22; Opposers' Ex. 895; Rothman Dep. at 11:13-12:6; 13:5-14:15; 16:4-17:17; 18:19-18:25; Proper Dep. at 41:19-45:4; 45:8-46:2;

57:12-58:7); see Johnny Blastoff, 188 F.3d at 434-35, 51 U.S.P.Q.2d at 1924-25; In re Urbano, 51 U.S.P.Q.2d at 1778.

2. Opposers Have Widely Used the WASHINGTON REDSKINS Marks in Connection With Their Goods and Services for Many Years

The "duration and extent of use of the mark in connection with the goods or services with which the mark is used" favor Opposers. 15 U.S.C. § 1125(c)(1)(B). For many years prior to the filing dates of the intent-to-use application at issue here, in fact since 1937, Opposers and their licensees have used the WASHINGTON REDSKINS Marks on or in connection with the sale of a wide variety of products and services all related to professional football. (Rothman Dep. at 11:13-12:6; 13:5-14:15; 18:19-18:25; Proper Dep. at 49:10-49:19.) In addition, the media has referred to Opposers' WASHINGTON REDSKINS Marks in connection with Opposers for many years prior to the filing of Applicant's intent-to-use application. (Opposers' Exs. 22 through 890; Opposers' Exs. 895 through 984; Proper Dep. at 45:8-46:2; 57:12-58:7); see Johnny Blastoff, 188 F.3d at 434-35, 51 U.S.P.Q.2d at 1924-25 (holding use of mark by media inures to benefit of mark owners).

3. Opposers Have Widely Advertised and Promoted the WASHINGTON REDSKINS Marks for Many Years

The "duration and extent of advertising and publicity of the mark" favor Opposers. 15 U.S.C. § 1125(c)(1)(C). During their long and widespread use of the WASHINGTON REDSKINS Marks, Opposers and their licensees have expended considerable time, effort and money in the marketing and promotion of goods and services in conjunction with the WASHINGTON REDSKINS Marks. Licensees advertise merchandise bearing the WASHINGTON REDSKINS Marks through a wide variety of media, including over the Internet, on television, via radio, in print magazines and newspapers, in publications sold in the stadium, and in various direct-mail catalogs. (Rothman Dep. at 10:4-11:8.) In fact, in 2002, more than 750,000 people in the Washington Redskins market on average watched Washington Redskins football games, bearing the WASHINGTON REDSKINS Marks, on television. (Proper Dep. at 44:4-23.) Of people that had their televisions on when Washington Redskins games were televised, on average

forty-eight percent of them were watching the Washington Redskins games. (Id.) As a direct result of these marketing and advertising efforts, merchandise bearing the WASHINGTON REDSKINS Marks generates tens of millions of dollars in retails sales each year. (Rothman Dep. at 16:4-17:17.)

4. Opposers Use the WASHINGTON REDSKINS Marks in a Broad Geographic Area

The "geographical extent of the trading area in which the mark is used" favors Opposers. 15 U.S.C. § 1125(c)(1)(D). Opposers and their licensees have sold, or offered for sale, goods and services bearing the WASHINGTON REDSKINS Marks throughout the country and the world. (Rothman Dep. at 11:13-12:6; 13:5-14:15; 18:19-18:25.)

5. Opposers Use the WASHINGTON REDSKINS Marks in Numerous Channels of Trade

The "channels of trade for the goods or services with which the mark is used" favor Opposers. 15 U.S.C. § 1125(c)(1)(E). As discussed supra Part I.D., goods and services bearing WASHINGTON REDSKINS Marks are offered for sale in numerous channels of trade, including retail stores across the country, kiosks at the Washington Redskins' stadium, and the Internet. (Rothman Dep. at 7:7-9:16; 10:4-12:6; 13:5-14:15; 18:19-18:25.)

6. Opposers' WASHINGTON REDSKINS Marks are Widely Recognized in the Trading Areas and Channels of Trade

The "degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought" favors Opposers. 15 U.S.C. § 1125(c)(1)(F). Since the 1930s, the print and broadcast media and the public have used Opposers' WASHINGTON REDSKINS Marks many millions of times when referring to the Washington Redskins football franchise and its stadium. (Opposers' Exs. 22 through 890; Opposers' Exs. 895 through 984; Proper Dep. at 45:8-46:11; 57:12-58:7.) Therefore, Opposers' WASHINGTON REDSKINS Marks are widely recognized both in the Washington, D.C. area, and across the country. (Proper Dep. at 41:19-43:13.)

Opposers' widespread use of the WASHINGTON REDSKINS Marks on a variety of goods and services, Opposers' extensive marketing of such goods and services and the millions of uses by the media of the WASHINGTON REDSKINS Marks when referring to the Washington Redskins football franchise have all contributed to the strong public association of the WASHINGTON REDSKINS Marks with Opposers, and have made Opposers' WASHINGTON REDSKINS Marks famous. See Johnny Blastoff, 188 F.3d at 434-35, 51 U.S.P.Q.2d at 1924-25 (holding use of mark by media inures to benefit of mark owners and establishes public identification of mark with product or service).

B. Applicant Filed His Applications After Opposers' WASHINGTON REDSKINS Marks Became Famous

Applicant filed the application for his WASHINGTON PIGSKINS designation in April, 2000, more than sixty years after Opposers started using the WASHINGTON REDSKINS Marks and many years after the marks had become famous. (Opposers' Ex. 891; Proper Dep. at 47:12-49:9.)

C. Applicant's WASHINGTON PIGSKINS Designation Will Dilute Opposers' WASHINGTON REDSKINS Marks by Blurring and Tarnishing the Distinctiveness of Opposers' WASHINGTON REDSKINS Marks

Applicant's WASHINGTON PIGSKINS designation will blur Opposers' WASHINGTON REDSKINS Marks by weakening the capacity of the WASHINGTON REDSKINS Marks to identify and distinguish Opposers as its source. A review of the factors examined in Toro[5] establishes that blurring will result because (1) Applicant's WASHINGTON PIGSKINS designation is virtually identical to Opposers' WASHINGTON REDSKINS Marks, see discussion supra Part I.B.; (2) Opposers' WASHINGTON REDSKINS Marks are renowned, see discussion supra Part III.A.; and (3) even if target customers are not confused as to the different origins of the products — and Opposers maintain that they will be — the WASHINGTON REDSKINS Marks would still be diluted because "customers would

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[5] In Toro, the Board examined (1) the similarity of the marks; (2) the renown of the senior party; and (3) whether the target customers are likely to associate two different products with the mark even if they are not confused as to the different origins of these products. 61 U.S.P.Q.2d at 1183.

wonder why another party could use a mark that they thought would have identified a unique, singular, or particular source." Toro, 61 U.S.P.Q.2d at 1184.

Applicant's WASHINGTON PIGSKINS designation will tarnish Opposers' WASHINGTON REDSKINS Marks by causing the positive associations with such marks to be degraded. See, e.g., Deere & Co. v. MTD Prods., Inc., 41 F.3d 39, 43, 32 U.S.P.Q.2d 1936, 1938-39 (2d Cir. 1994); Acad. of Motion Picture Arts and Sciences. v. Creative House Promotions, Inc., 944 F.2d 1446, 1457, 19 U.S.P.Q.2d 1491, 1499-1500 (9th Cir. 1991). Applicant has unambiguously stated his intention to use the WASHINGTON PIGSKINS designation as a new name for Opposers' Washington Redskins football franchise because he believes the WASHINGTON REDSKINS Marks are "disparaging" to Native Americans and "constitute an ethnic slur." (Opposers' Ex. 986 at No. 16.) Should the Board permit Applicant to obtain a registration for his WASHINGTON PIGSKINS designation, Applicant will tarnish Opposers' WASHINGTON REDSKINS Marks by presenting his designation as a preferable alternative name for Opposers' football franchise, thereby denigrating Opposers' WASHINGTON REDSKINS Marks.

SUMMARY

For these reasons, Opposers respectfully request that the Board deny registration of Applicant's intent-to-use application.

Dated: New York, New York
November 21, 2003

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 2.119, I certify that I transmitted a copy of Opposers' Brief on the Case by Express Mail, to David S. Campbell, Applicant *pro se*, whose address is 6100 Uptown Blvd., N.E., Suite 500, Albuquerque, New Mexico 87110 on November 21, 2003.

Sean D. Burke

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing label number: ER 60206 7956 US

I hereby certify that this document and a check for payment of fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on this 19TH day of September, 2003.

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Re: Opposition No. 152156 - Opposers Brief on The Case

Dear Madam Commissioner:

Pursuant to 37 CFR § 2.128, I enclose the original and one copy of the Opposers Brief on the Case for Opposition No. 152156. Please stamp and return the enclosed postcard to acknowledge receipt of the Opposers Brief on the Case. Please also conduct all correspondence with regard to the above-referenced application with the undersigned.

Sincerely,

Sean D. Burke

Enclosures

cc: David Proper
Robert L. Raskopf
Jennifer Johnson Millones