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28 February 2007
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Baltimore Ravens Limited Partnership and
NFL Properties LLC
v.
12TH Man/Tennessee LLC

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Opposition No. 91157082
to application Serial No. 78026554

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Jessica A. Rose of Quinn Emanuel Urquhart Oliver & Hedges LLP for the Baltimore Ravens Limited Partnership and NFL Properties LLC.

James H. Harris III of Harris, Martin, Jones, Shrum, Bradford & Wommack, P.A. for 12TH Man/Tennessee LLC.

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Before Rogers, Drost and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 19, 2000, 12TH Man/Tennessee LLC (applicant) applied to register on the Principal Register the mark 12TH RAVEN (in typed or standard character form) for:

Jewelry in Class 14

Bumper stickers in Class 16

Insulated beverage containers in Class 21

Towels in Class 24

Clothing for informal wear, namely, pants, jackets, shirts, t-shirts, sweatshirts, shorts in Class 25

Ornamental novelty buttons in Class 26.

The application (No. 78026554) is based on applicant's assertion of a bona fide intention to use the mark in commerce.

On June 18, 2003, the Baltimore Ravens Limited Partnership and NFL Properties LLC (opposers) filed a notice of opposition to the registration of applicant's 12TH RAVEN mark.

Opposers allege that applicant's mark is similar to numerous marks owned by opposers and that there is a likelihood of confusion of consumers under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). Opposers claim ownership of several registrations but ultimately they rely on the one set out below:

I. No. 2,177,214
Mark: BALTIMORE RAVENS (typed)
For: Posters, calendars, trading cards, books relating to football, magazines relating to football, notepads, stickers, and bumper stickers in Class 16

Men's, women's and children's clothing used in the promotion of a professional football team by the name of the Baltimore Ravens, namely, fleece tops and bottoms, caps, T-shirts, sweatshirts, shorts, tank tops, sweaters, pants, jackets, turtlenecks, jumpsuits, jerseys, warm up suits, swimwear, wind resistant jackets, parkas; sleepwear, namely, robes and pajamas; gloves, scarves, aprons, boots and sneakers in Class 25

Athletic bags sold empty, golf bags, bowling balls, golf balls, bowling bags, footballs, golf club covers in Class 28

Entertainment services, namely, professional football games and exhibitions in Class 41.
Issued: July 28, 1998

Disclaimer: Baltimore
Status: Affidavits under Sections 8 and 15 accepted or acknowledged

Opposers allege that they "have used the trademarks RAVENS, BALTIMORE RAVENS and various other marks (hereinafter, the RAVENS Marks) in connection with their business of organizing, conducting and promoting the Baltimore Ravens football franchise and the NFL" prior to the filing date of the opposed application. Notice of Opposition at 2. Furthermore, opposers maintain that "the RAVENS Marks are famous to the public because of the widespread use of said marks, the great popularity of NFL football and the Ravens Club, and the extensive media coverage of the NFL, and, in particular, the Ravens Club." Notice of Opposition at 3. In addition, opposers allege that the "widespread use by the Ravens Club, the NFL, and authorized licensees of the RAVENS Marks when referring to the Baltimore Ravens football franchise has contributed to the strong public association of the RAVENS Marks with the Baltimore Ravens, and such use inures exclusively to the benefit of Opposers." Id. Opposers also maintain that applicant's goods are "a type consistent with the ancillary goods licensed by professional sports teams." Notice of Opposition at 4.

In addition, opposers also argue that registration to applicant should be refused because applicant's marks

falsely suggest a connection between applicant and opposers under Section 2(a) of the Trademark Act. 15 U.S.C. § 1052(a). Finally, opposers allege that applicant's mark, when used, "will dilute the distinctive and famous quality of the RAVENS marks." Notice of Opposition at 6.[1]

Applicant denied the salient allegations of opposers' notice of opposition.[2]

The Record

The record consists of the pleadings; the file of the involved application; the testimonial deposition of Jeffrey Ringelstein, applicant's principal, with exhibits; the stipulated testimonial affidavit of David M. Proper, opposers' Counsel of Legal and Business Affairs, with exhibits; the testimonial deposition, with exhibits, of David M. Proper; the rebuttal testimonial deposition, with exhibits, of Peter Quaglierini, opposers' manager for

[1] NFL Properties LLC is also opposing the registration of a second application of applicant for the mark 12TH BEAR (Serial No. 78023394). Opposition No. 91150925. The other opposer in that case is the Chicago Bears Football Club, Inc. Because the opposers are not the same, the marks are different, and the facts are not the same, we have chosen to issue separate decisions in these cases.

[2] Opposers also allege that applicant has applied to register other marks that are associated with NFL teams such as 12TH RAM, 12TH TEXAN, 12TH COWBOY, 12TH BILL, 12TH JAGUAR, 12TH BRONCO, 12TH BUCCANEER, 12TH STEELER, 12TH 49ER, 12TH CHIEF, 12TH DOLPHIN, 12TH EAGLE, 12TH PACKER, 12TH REDSKIN, 12TH VIKING and 12TH SEAHAWK. Notice of Opposition at 5-6. Except for the 12TH BEAR mark (Opposition No. 91150925), the other marks are either no longer active or suspended awaiting the outcome of the 12TH BEAR and 12th RAVEN oppositions. Applicant admits to filing "for the registration of other marks utilizing the concept of the fan as the 12th player in connection with the goods." Answer at 2.

trading cards and memorabilia; the rebuttal deposition of David Proper including a supplemental deposition by written questions, with exhibits[3]; and applicant's list of federal applications and registrations.

Preliminary Matters

We begin by noting that Registration No. 2,177,214 is owned by the Baltimore Ravens Limited Partnership. The NFL Properties LLC (NFLP) "is the licensing agent of the NFL and its Member Clubs and has three primary functions: (1) to license the trademarks of the NFL and its Member Clubs ("NFL Trademarks") to third parties for commercial use; (2) to protect the NFL Trademarks from infringement; and (3) to promote the interests of the NFL and its Member Clubs by engaging in approved publishing, promotional and marketing activities." Proper affidavit at 3-4. "The NFL and the Baltimore Ravens have licensed all of their respective trademarks to NFLP for use by NFLP pursuant to these directives." Proper affidavit at 4.

Because of opposers' proof of ownership or licensed use of the registered BALTIMORE RAVENS mark, we find that opposers each have established their standing to oppose. See Chemical New York Corp. v. Conmar Form Systems, Inc., 1

[3] The parties "had a stipulation that both parties entered into that the testimony in the 12TH Bear matter that the rebuttal testimony could be used in the 12TH Raven matter." Proper dep. at 50.

USPQ2d 1139, 1142 (TTAB 1986) ("It is obvious that opposer Chemical New York, as owner of the "PRONTO" marks and registrations, and opposer Chemical Bank, as licensee and user of the marks, have such a 'real interest' in this proceeding"). See also William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1870, 1873 n.2 (TTAB 1994).

Opposers have provided evidence of the use of the terms BALTIMORE RAVENS and RAVENS. "The Ravens Club has competed in NFL games since 1996" and it won the Super Bowl in 2001. Proper affidavit at 3. Furthermore, opposers' witness has testified that opposers have licensed a "wide variety of merchandise, including apparel items such as shirts, T-shirts, sweatpants, pants, shorts, jackets and other apparel; novelty items, such as bumper stickers and ornamental novelty buttons, home products, such as towels and insulated beverage containers; gift items, such as jewelry and pins; sporting goods, toys and games, and many other items. NFLP licenses the Ravens Club Marks in connection with all of the above officially licensed NFL products." Proper affidavit at 5. Furthermore, the "Ravens Club Marks were in use years before the filing date of the application at issue here." Proper affidavit at 13. Indeed, sales of merchandise bearing the Ravens Club marks have generated millions of dollars in revenue beginning in 1996. Opposers have also included examples from websites of

use of the Ravens marks on various items including insulated beverage containers, jewelry, watches, ornamental buttons, towels, clothing items, and bumper stickers. Proper Exhibits 6 and 7.

There is no evidence that applicant has used its 12TH RAVEN mark on any of the identified goods prior to the application's filing date. Therefore, applicant must rely on its application's filing date (September 19, 2000) as its constructive use date. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights"). See also Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application").

Regarding priority, it is not an issue to the extent that opposer Baltimore Ravens Limited Partnership owns a registration for the mark BALTIMORE RAVENS for football exhibition services, clothing, sporting goods, and paper goods. See King Candy Co. v. Eunice King's Kitchen, 496

F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Furthermore, it is clear that opposers have used the mark BALTIMORE RAVENS mark for entertainment services, namely, professional football games since 1996, which is well prior to applicant's constructive use date. This mark has been licensed to the NFLP. Proper affidavit at 4. Therefore, opposers have established priority of use of the mark. We add further that the sale of merchandise bearing the Ravens Club mark has resulted in millions of dollars in revenue since 1996. Opposers' evidence of the licensing and use of its goods and services convinces us that opposers have priority for these goods. We add that:

> It is therefore held that, as between the parties herein opposer is the prior user of the mark "PROTECT" and that, as such, is entitled to preclude the registration of the same or a similar mark not only for the like or similar goods, but for any goods which purchasers might mistakenly assume emanate from it.

La Maur Inc. v. International Pharmaceutical Corporation, 199 USPQ 612, 617 (TTAB 1978). The record demonstrates that consumers are likely to believe that such items as jewelry, insulated beverage containers, towels and ornamental novelty buttons are likely to come from opposers inasmuch as opposers are the source of these goods as well as football exhibition services, sporting goods, clothing, and paper goods.

Likelihood of Confusion

The next issue is whether there is a likelihood of confusion between applicant's 12TH RAVEN mark and opposers' BALTIMORE RAVENS mark. In likelihood of confusion cases, we consider whether there is confusion by analyzing the facts as they relate to the thirteen factors set out in such cases as In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Because the parties' goods, as will be discussed subsequently, are either in part identical, or otherwise closely related, the key issue in this case is whether applicant's mark is confusingly similar to opposers' BALTIMORE RAVENS mark.

This "first DuPont factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting du Pont, 177 USPQ at 567). In this case, applicant's mark is 12TH RAVEN while opposers' mark is BALTIMORE RAVENS. The marks are similar to the extent that they both contain the word RAVEN(S). The term "Ravens" is the dominant feature of the BALTIMORE RAVENS mark, where Baltimore identifies the location of the

Ravens football team. In applicant's mark, the term "Raven" dominates applicant's mark because the only other feature of the mark is the term 12th. This numerical designation does not distinguish the marks inasmuch as it reinforces the connection with the Baltimore Ravens football team by specifically identifying a particular Raven, i.e., the twelfth Raven.[4] Therefore, the term "Raven" is the dominant feature of the marks. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable").

Furthermore, we cannot attribute much trademark significance to the difference in the plural and singular form of the word "Raven" in the marks. Wilson v. Delauney, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark").

[4] "Each football team has eleven players on the playing field at any one time." Proper affidavit at 13. Applicant admitted that its "12TH" marks utilize "the concept of the fan as the 12TH player in connection with the goods in order to specify and to involve the team sports fan who is … the twelfth on a football team." Answer at 2. Applicant further admitted that "12TH

To the extent that the singular/plural difference is noticed by consumers, it would not likely be significant because, as viewed in applicant's mark, the singular form of the word would merely be seen as identifying someone that is associated with the RAVENS. Moreover, applicant's mark would be suggestive of a group, as is opposers' mark, because implicit in the concept of a 12th Raven is that there are at least 11 others.

The geographically descriptive term "Baltimore" would not be as significant as the term "Ravens" in distinguishing the marks. Baltimore identifies the primary location where the RAVENS football team provides its services. The 12TH RAVEN mark suggests a connection with those football services. See In re Chatam International Incorporated, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("GOLD, in the context of tequila, describes either a characteristic of the good – its color – or a quality of the good commensurate with great value or merit … In sum, the Board had good reason to discount ALE, JOSE, and GOLD as significant differences between the marks"). They are similar in sound, appearance, meaning, and commercial impression. National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 229 USPQ 785, 791 n.1 (D.N.J. 1986)("Defendant's mark 'New Jersey GIANTS' is similar to

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designated a football fan that's universally known." Ringelstein

the Giants' registered marks 'New York Giants' and 'Giants' and the dominant element of the mark – 'Giants' – is identical, rendering those marks particularly confusing"). See also Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club Limited Partnership, 34 F.3d 410, 31 USPQ2d 1811, 1817 (7th Cir. 1994) (parenthetical omitted):

> [W]e cannot say that the district judge committed a clear error in crediting the major findings of the Jacoby study and inferring from it and the other evidence in the record that the defendants' use of the name "Baltimore CFL Colts" whether for the team or on merchandise was likely to confuse a substantial number of consumers [with the INDIANAPOLIS COLTS]. This means … that the judge's finding concerning likelihood of confusion required that the injunction issue.

While we have taken into consideration the difference between 12TH and BALTIMORE, this difference does not result in the marks not being similar. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) ("It is the similarity of commercial impression between SPICE VALLEY and SPICE ISLANDS that weighs heavily against the applicant").

Therefore, the marks BALTIMORE RAVENS and 12TH RAVEN have similar meanings and commercial impressions. Also, the addition of the term 12th does not result in the marks having significantly different appearances or pronunciation inasmuch as these marks are dominated by the term "Raven" and the term 12th reinforces the "Raven" feature of the

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dep. at 36.

marks. The similarities between 12TH RAVEN and BALTIMORE RAVENS in sound, appearance, meaning, and commercial impressions outweigh their differences.

Next, we must consider whether the goods and services of the parties are related. The involved goods are in part virtually identical. Applicant's goods include clothing for informal wear, namely, pants, jackets, shirts, t-shirts, sweatshirts, and shorts as well as bumper stickers. Opposers' clothing includes identical items of "men's, women's and children's clothing used in the promotion of a professional football team by the name of the Baltimore Ravens" such as T-shirts, sweatshirts, shorts, pants, and jackets. Both applicant's and opposer's identifications of goods include bumper stickers. When "marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

When we are dealing with an opposition to register as with other board proceedings, we must compare the goods as described in the application and the registrations to determine if there is a likelihood of confusion. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). As a result, we must

assume that applicant's jewelry, bumper stickers, insulated beverage containers, towels, clothing items, and ornamental novelty buttons encompass all goods of that type. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

Furthermore, applicant's goods are a variety of consumer items including jewelry, bumper stickers, insulated beverage containers, towels, pants, jackets, shirts, t-shirts, sweatshirts, shorts, and ornamental novelty buttons. Opposers' testimony and evidence indicates that these are the type of goods that would be associated with a professional football team and applicant's goods are related to opposers' goods. We point out that:

> [I]t has often been said that goods or services need not be identical or even competitive in order to

> support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could 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 producer or that there is an association between the producers of each [party's] goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

Therefore, applicant's and opposers' goods are in part identical and to the extent they are not identical, we conclude that they are related. Purchasers seeing applicant's mark on its goods are likely to believe that there is an association between those goods and opposers' goods.

Regarding the factors concerning potential purchasers and channels of trade, these factors would also favor opposers. We have already determined that many of applicant's goods are identical to opposers' goods. Because many of the goods are identical, we must assume that the channels of trade and purchasers are the same. Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same

classes of purchasers through the same channels of trade"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Furthermore, applicant has made it clear that it intends to actually market its goods to purchasers who would be identical to opposers' fans and purchasers. Applicant admits that "it intends to advertise, promote and/or sell goods or services bearing 12TH Man Designations to fans of professional football teams that play in the NFL." Proper Exhibit 54 at 2.

Of course, opposers' "target consumers of the Baltimore Ravens and of goods and services bearing the Ravens Club Marks are fans of Baltimore Ravens football and football fans in general." Proper affidavit at 4. In effect, the potential purchasers of applicant's and opposers' goods, in addition to being legally identical, actually overlap to the extent that both applicant and opposers target fans of football as potential purchasers.

Opposers have identified its channels of trade as follows (Proper Affidavit at 6):

> NFL products are sold in a wide variety of retail trade locations, including, inter alia, department stores, discount stores, drug stores, fan shops, footwear specialty stores, grocery stores, and sporting goods stores. Specific examples of companies that distribute NFL products include, inter alia, K-Mart, Target, Wal-

> Mart, Sears, JC Penney, Dillard's, Foot Locker, Champs, Sports Authority, and Modell's Sporting Goods.

Opposers also sell these goods through "the Internet Web site of the Official Baltimore Ravens Online eStore" and through the "Internet Web sites of various retail outlets for officially licensed NFL products." Proper affidavit at 12. Opposers' actual broad channels of trade would again likely overlap applicant's channels of trade, if applicant actually sold its goods in commerce. In addition, the price of opposers' goods indicates that many of these items (such as posters, auto and bike tags, mugs, and T-shirts) would not involve careful or sophisticated purchasers. Proper affidavit at 6 (The price points for opposers' goods begin at just "a few dollars"). On the contrary, these items must be considered impulse purchases.

Fame, the fifth du Pont factor, is another factor that favors opposer. Applicant admits that opposers' mark is famous. Applicant's Brief at 3 ("There are some things that are not at issue in this case. No one denies that the Baltimore Ravens are a well known professional football team or that the Baltimore Ravens is a famous service mark for that team"). See also Proper Exhibit 53 at 2, Applicant's Response to Requests for Admissions ("Applicant admits that "Baltimore Ravens" is a famous mark, as applied to professional football games and exhibitions").

Opposers have also submitted evidence of the fame of the BALTIMORE RAVENS mark. With regard to the services, opposers began using the Ravens mark in association with football exhibition services in 1996 and the Baltimore Ravens won Super Bowl XXXV in 2001. Proper affidavit at 3. As a result of a 1998 agreement with CBS, ABC, FOX and ESPN, "every Baltimore Ravens game is broadcast live by one of these NFL broadcast partners." Proper affidavit at 8. In the local Baltimore broadcast market, the Baltimore Ravens have enjoyed considerable success. For example, in 2002, "an estimated 334,693 viewers were watching each Ravens game." Id. at 8 (punctuation mark deleted). Total attendance at the eight Ravens Club home games in 2003 was 556,634. Id. at 9. Opposers' total annual sales from NFL merchandise is approximately $2-3 billion at retail and "the percentage of sales of NFL merchandise attributable to goods bearing the Ravens Club Marks ranged from at least 0.54 percent to 3.92 percent during the time period from 1996 through 2002." Id. at 7. These figures indicate that sales of the Ravens merchandise were at least $10 million per year. Opposers' witness testified that "millions of dollars have been spent cumulatively advertising and promoting the Ravens Club and its marks, and millions of dollars worth of merchandise bearing the Ravens Club Marks have been sold through NFLP's Licensees." Id. at 7.

In addition, opposers also submitted several media surveys of articles that reference the Ravens Club Marks.

> On Opposers' behalf, a search was performed in the "News Sources, Combined" database of the LEXIS/NEXIS on-line research service for references to "RAVENS w/2 football" for the five-year period from January 1, 1996 to December 31, 2000. The LEXIS/NEXIS search disclosed 1,539 news articles that contained the search term during this five-year time period. A representative sample of 39 articles throughout the time frame was then obtained by arranging the articles chronologically and selecting every 40th article from the search results. Of this 39 article sample, 36 articles (or 92%) refer directly to the Baltimore Ravens.

Proper affidavit at 10-11.

A similarly constructed survey of articles for the search "RAVENS w/2 fan" produced similar results – 98% of the articles refer directly to the Baltimore Ravens. Proper affidavit at 11. Another survey of "RAVENS w/2 NFL" resulted in every article referring to the Baltimore Ravens. Proper affidavit at 11.

Applicant maintains that "as an organization, the Baltimore Ravens are known to the public only as a football team; that is their fame and reputation. The sale of a sweatshirt or a pair of pants under the 12TH Raven label does not suggest a connection with a football team nor does it traffic upon the name Baltimore Ravens. In fact, there is no connection between the two marks and their simple existence does not suggest any." Brief at 7.

We cannot agree with applicant's argument that opposers' BALTIMORE RAVENS mark has achieved fame only as a

mark for the football team. It is certainly clear that opposers' BALTIMORE RAVENS mark has achieved fame for football exhibition services, and applicant has admitted this fact. The Baltimore Ravens football team games are broadcast on television and their games in the Baltimore area have significant television ratings. However, in addition to the fame for their football services, opposers have shown that it has a registration for the words BALTIMORE RAVENS for clothing, sporting goods, and paper products. Furthermore, they have also submitted evidence that they use the marks BALTIMORE RAVENS and RAVENS alone for a variety of goods. Therefore, because of the television exposure, advertising, and merchandise sales, we cannot agree with applicant that the fame of the Ravens Club Mark is limited to football exhibition services.

The evidence of record convinces us that the opposers' BALTIMORE RAVENS mark has acquired significant fame and public recognition for the football exhibition services as well as for the related products. Under these circumstances, fame "of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21 Real Estate Corp., 23 USPQ2d at 1701, quoting, Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal

protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY and FRITO-LAY confusingly similar even though the respective goods at issue were "natural agricultural products, namely, edible dog treats" and snack foods).

The Federal Circuit and its predecessor have held that "there is no excuse for even approaching the well-known trademark of a competitor and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), *quoting*, Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc., 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) (internal punctuation marks omitted). Therefore, inasmuch as opposers' mark has achieved significant recognition and renown, this factor weighs heavily in opposers' favor.

One of applicant's principal arguments relates to the sixth du Pont factor concerning the number and nature of similar marks in use on similar goods.

> [T]here were approximately 204 live "raven" trademarks listed in the Trademark Electronic Search System (Tess). All of these marks enjoy trademark protection. Additionally, there are approximately four college football teams that call themselves "Ravens." While these numbers are well short of the 1827 live "bear" trademarks and twenty-three "bear" football teams, they still reflect that the use of the word "raven" as a trademark is far from rare.

Brief at 4.

According to Exhibit 7 (Proper dep. on written questions), the following colleges are nicknamed the "Ravens": Benedictine College, Franklin Pierce College, Anderson University, and St. Meinrad College. Mr. Proper was specifically asked whether an "Anderson Ravens" shirt infringed any NFL trademarks. He responded: "I do not know." Proper deposition on written questions at 6.

Regarding the other uses of the term "Ravens," it is not clear whether the witness was aware of the other uses by the colleges of the term Ravens and with the exception of the Anderson Ravens clothing, there is no evidence of the use of these nicknames by the colleges or their teams. While applicant has also submitted copies of several websites that use "Baltimore Ravens" marks, these sites were sites that seem to be fan-type sites that discuss the performance of the Baltimore Ravens football team.[5] It is not clear why these websites would support applicant's arguments that its mark for 12TH RAVEN is not confusingly similar to opposers' BALTIMORE RAVENS mark used on the same or very similar goods. Applicant is not seeking registration of the mark for website-related services. Even if there was some relevance to these websites, we note that

[5] We add that Mr. Proper, when asked if these sites were sanctioned by the NFL, responded "yes" or "I do not know." Dep. on Written Questions at 1-5.

"it is entirely reasonable for the opposer to object to the use of certain marks in use on some goods which it believes would conflict with the use of its marks on its goods and services while not objecting to use of a similar mark on other goods which it does not believe would conflict with its own use." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1899-1900 (TTAB 1989).[6]

While the word "Raven" is not a unique term in the United States, its use in association with football teams is hardly common. Applicant's evidence does not convince us that opposers' marks are only entitled to a limited scope of

[6] While applicant has submitted a printout from the USPTO's database that shows that there are more than 180 applications and registrations that contain the word "Raven," we give this evidence little weight. In re Carolina Apparel, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record"). Applicant's list is particularly unpersuasive inasmuch as there is no indication of the goods or services for which the marks are registered and there are numerous unregistered marks on the list. We note that applicant has also included 5 registrations that contain the word "raven" or a translation of that word. Third-party registrations "may be used to demonstrate that a portion of a mark is suggestive or descriptive, [but] they cannot be used to justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them"); Dolfin Corporation v. Jem Sportswear, Inc., 218 USPQ 201, 207 (C.D. Cal. 1982) ("The mere citation of third party registrations, without proof of actual usage on related products do[es] not weaken the mark in issue"); Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1659 n.20 (TTAB 2002) ("Third-party registrations are not evidence that the marks used therein are in use in commerce or that the public is familiar with them, for purposes of the sixth du Pont factor"). These registrations, which often contain additional words or are for different goods and services, hardly

protection. The University of Georgia was able to enforce its trademark rights in its Bulldog mark despite the "fact that many other colleges, junior colleges, and high schools use an English bulldog as a symbol." University of Georgia Athletic Association v. Laite, 756 F.2d 1535, 225 USPQ 1122, 1129 (11th Cir. 1985). In that case, the schools the defendant referenced included: "twenty-six high schools, fourteen junior colleges, and sixteen colleges that use an English bulldog as a mascot. The list includes the Citadel, Drake University, Fresno State University, Mississippi State University, Louisiana Tech University, and Yale University." Id. at 1129 n.25. See also Dolfin, 218 USPQ at 207 (The fact that there "are others who have used DOLFIN trade names or marks in non-competing products or, even infringed plaintiff's rights does not weaken plaintiff's case").

Applicant also argues that "12TH Man does not intend to mislead the consumer as to the origin of the 12TH Raven product, but rather to offer an alternate means in which individuals may show allegiance to their sport team or teams. The 12TH Raven label will not seek an allegiance with any specific team. Instead, 12TH Man seeks to open an avenue for Ravens fans to demonstrate their allegiance to their team or teams by wearing and/or displaying emblems which evince that allegiance." Brief at 16.

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establish that applicant's mark is not confusingly similar to

Opposers argue that applicant "selected the designation '12th' or 'Twelfth,' with the singular, shortened version of the team names of twenty NFL Member Clubs, to refer to fans of each targeted NFL Member Club and to trade inappropriately on the goodwill of the selected Member Club, including the Ravens." Brief at 11. While applicant may not have intended to mislead purchasers, it is not clear how the selection of numerous marks that are each based on the name of one of twenty NFL teams could have been done in good faith. Furthermore, it is not clear how the fact that "it will not seek an allegiance with any specific team," will eliminate the likelihood of confusion. However, we decline to find that the adoption was in bad faith, particularly in this case, where the adopted mark was not identical and it is the name of a few sports teams. NASDAQ Stock Market Inc. v. Antartica S.r.l., 69 USPQ2d 1718, 1733 (TTAB 1998) ("On the other hand, merely because we decline to find that applicant adopted its mark [NASDAQ] in bad faith, it does not follow from this record that applicant has acted entirely in good faith. While the factor does not weigh in the balance against applicant, it does not weigh in its favor either").

When we analyze the relevant factors regarding the likelihood of confusion, some, such as the lack of evidence

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opposers'.

of actual confusion, are not relevant because applicant has not used its mark on the goods in the application and there would not have been an opportunity for actual confusion to occur. Others clearly favor opposers. The goods are identical or very closely related. Not only are the channels of trade for identical items legally identical but opposers actually market their goods in very broad channels of trade so that if applicant were to use its mark it would likely be in overlapping channels of trade. The evidence also makes it clear that opposers' merchandise is marketed to fans of the Baltimore Ravens football team. Applicant also intends to market its goods to football fans, which would include specifically fans of the Baltimore Ravens. Again, the potential purchasers of both applicant's and opposers' goods would at least overlap.

The central dispute concerns whether the marks are similar. We have found that the marks 12TH RAVEN and BALTIMORE RAVENS are similar. Applicant argues that its mark "may be said to generate a 'calling to mind'" (brief at 5), which is not necessarily confusion. However, more than merely calling to mind, football fans that would encounter applicant's 12TH RAVEN mark on the identified goods are likely to assume that there is an association with opposers who own the mark BALTIMORE RAVENS and use this mark on identical and very similar goods. Therefore, confusion is

likely. See DC Comics v. Pan American Grain Mfg. Co., 77 USPQ2d 1220, 1226 (TTAB 2005):

> Because opposer has used KRYPTONITE as a merchandising mark with respect to a variety of goods; because consumers recognize that, in the general marketing environment, merchandising marks are used to identify a variety of goods and services; and because opposer has used the term KRYPTONITE in connection with the promotion of certain food and beverage products, we find that… applicant's goods and opposer's goods are related. In short, based on the above, we find that consumers, seeing KRIPTONITA on prepared alcoholic fruit cocktails, are likely to believe that the mark has been licensed by opposer for such goods, and that the goods are therefore sponsored by opposer.

Finally, applicant also makes an argument (brief at 16-17) that appears to raise the issue of functionality of opposers' marks.

> At best, the 12TH Raven mark may be said to be purchased by the consumer in order to demonstrate an allegiance to the Baltimore Ravens… It was established that when goods with the school or team's insignia on them are being purchased, they are being purchased to demonstrate an individual's allegiance or identification with the group represented by the mark… What the consumer seeks when he purchases an emblem or an item that bears an emblem is the function of expression. He wants to communicate his allegiance and support of his team. He purchases a replica because that is the function of his expression. And because of the doctrine of functionality, the use of even exact replicas of a registered mark does not violate trademark law.

We have several problems with applicant's argument. First, to the extent that applicant is arguing that opposers' registered trademark is functional, we note that it is improper to raise this defense without counterclaiming or petitioning to cancel the mark on this basis. Contour

Chair-Lounge Co. v. The Englander Co., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) ("[T]his is an opposition only and in an opposition, this court has always held that the validity of the opposer's registrations are not open to [collateral] attack"); Cosmetically Yours, Inc. v. Clairol Inc., 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970) ("As long as the registration relied upon … remains uncanceled, it is treated as valid and entitled to the statutory presumptions"). IN this case, opposers own or are licensed to use the mark BALTIMORE RAVENS with the word "Baltimore" disclaimed. Even if applicant is claiming that it is only copying the functional features of opposers' mark, it would apparently be attacking the registration because "Ravens" is the only feature of that registered mark that is not disclaimed.

Second, this case is not similar to the International Order of Job's Daughters case on which applicant relies. In that case:

> The TTAB gave preclusive effect to the Ninth Circuit's determination that the Job's Daughters name and emblem were merely "functional aesthetic components of the product, not trademarks," primarily as a result of the widespread merchandising of Job's Daughters jewelry by many American retail jewelers (including Lindeburg) who are independent of Job's Daughters.

International Order of Job's Daughters v. Lindeburg and Company, 727 F.2d 1087, 220 USPQ 1017, 1018-19 (Fed. Cir. 1984), discussing International Order of Job's Daughters v.

Lindeburg and Company, 633 F.2d 912, 208 USPQ 718 (9th Cir. 1980), cert. denied, 452 U.S. 941 (1981). Here, applicant has not shown that there has been widespread merchandising of the BALTIMORE RAVENS mark by independent entities.

Also, we reject applicant's argument because it apparently would allow others to register marks that are similar to registered marks in order to show support or hostility to a sports team. American case law simply does not recognize such a right.

> In light of the above, and assuming for the sake of argument that aesthetic functionality is a valid basis for opposing registration, we concur with applicant that the marks at issue are not aesthetically functional as used in connection with clothing. While, especially in the case of apparel imprinted with designs featuring "Bucky Badger," it is undisputed that many purchasers buy such garments because they find "Bucky" to be "cute" or otherwise appealing and do not care about the particular quality of the goods or whether the University sponsors or endorses them, these facts are legally immaterial. That is to say, the fact that consumers buy a T-shirt, sweatshirt or other garment because they like and want the particular "Bucky Badger," "Bucky on W" or "WISCONSIN BADGERS" design imprinted thereon does not render such designs aesthetically functional. Taken to its logical conclusion, opposers' argument would eliminate trademark protection and registrability for any popular and commercially successful design which is imprinted on clothing, irrespective of whether the design additionally is source-indicative to at least some consumers.

University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385, 1406 (TTAB 1994)(footnote omitted).

For example, despite the finding of the abandonment of the Baltimore Colts mark and the resulting anger of local

fans when the team moved to Indianapolis, another team was not permitted to use the mark BALTIMORE CFL COLTS. See, e.g., Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club Limited Partnership, 34 F.3d 410, 31 USPQ2d 1811, 1814 (7th Cir. 1994) ("The Colts' abandonment of a mark confusingly similar to their new mark neither broke the continuity of the team in its different locations -- it was the same team, merely having a different home base and therefore a different geographical component in its name -- nor entitled a third party to pick it up and use it to confuse Colts fans").

The mere fact that a trademark owner's mark is associated with a movie, television show, university, or sports team, does not mean that it is functional and available for others to use to promote their goods when the trademark owner is actively licensing the mark for related items. See In re Paramount Pictures Corporation, 217 USPQ 292, 293 (TTAB 1983) ("In the case before us, we have a mark well known as the name of a television show and a movie. In view of applicant's registration of 'STAR TREK' for a number of other goods, it is clear that it performs a trademark function and is recognizable as such to the extent that the

public would associate articles on which it appears as having a common origin").[7]

We cannot conclude that applicant has any right to register its mark simply because it attempts to market its goods to a fan who wants "to communicate his allegiance and support of his team." The trademark owner has a right to market its promotional items to those fans and to prevent others from marketing promotional items to the same fans using a confusingly similar mark.

We conclude that applicant's mark 12TH RAVEN if it were used on the identified goods, would likely cause confusion in view of opposers' registered trademark for BALTIMORE RAVENS.[8]

Decision: The opposition is sustained and registration to applicant of its mark is refused.

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[7] We add that the case of American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 204 USPQ 609, 616 (2d Cir. 1979) is distinguishable because the "trademarks registered to Universal [relating to the *Six Million Dollar Man* and *The Bionic Woman* television shows] were in the areas of T.V. entertainment and toys. This market area bears little if any relationship to footwear, and diminishes the strength of Universal's contention that it had established a right to the term 'bionic' as a fanciful mark in the field of footwear." In the present case, opposers have shown that the goods of the parties are not only related, but in some cases, identical, and that opposers have priority of use for these items unlike the party in American Footwear. Id.

[8] In view of our disposition of the case on the likelihood of confusion ground, we do not reach the falsely suggesting a connection and dilution claims.