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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Baxley

Mailed: April 15, 2010

Opposition No. 91183196

Opposition No. 91183698

Board of Regents, The  
University of Texas System

v.

Southern Illinois Miners, LLC

Before Quinn, Kuhlke, and Mermelstein,  
Administrative Trademark Judges

By the Board:

Southern Illinois Miners, LLC ("applicant") seeks to register the mark MINERS in standard character form<sup>1</sup> and SOUTHERN ILLINOIS MINERS and design in the following form,



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<sup>1</sup> Application Serial No. 77034407, filed November 14, 2006, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

<sup>2</sup> Application Serial No. 77043344, filed November 14, 2006, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). The application includes a disclaimer of SOUTHERN ILLINOIS and a statement that "[t]he mark consists of a stylized coal miner holding a baseball bat."

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for "books in the field of professional baseball; brochures about professional baseball; bulletins concerning professional baseball; charts in the field of professional baseball; informational letters concerning professional baseball; newsletters in the field of professional baseball; printed calendars; printed charts; printed emblems; printed guides in the field of professional baseball for media use; printed informational cards in the field of professional baseball; printed materials, namely, press releases featuring information on topics related to professional baseball; printed paper signs; printed products, namely, professional baseball trading cards, professional baseball game programs, bumper stickers, calendars, paper coasters, decals, desk calendars, pennants and scorecards; pencils; pens; printed tickets; prints in the nature of professional sports photographs; souvenir programs concerning professional baseball" in International Class 16; "professional baseball imprinted clothing, namely, athletic uniforms, golf shirts, headgear, namely, hats, caps, visors, infant and toddler one piece clothing, jerseys, knit shirts, ponchos, short-sleeved or long-sleeved t-shirts, short-sleeved shirts, sweat shirts, t-shirts, wind shirts" in International Class 25; and "entertainment in the nature of professional baseball games" in International Class 41.

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In Opposition No. 91183196, The Board of Regents, The University of Texas System ("opposer") opposes registration of the mark in application Serial No. 77034407 ("the '407 application") in International Classes 16 and 25 only on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with its previously registered mark MINERS in typed form for "printed programs for college sporting events and media guides" in International Class 16;<sup>3</sup> "college imprinted clothing, namely, shirts, hats and baby shirts" in International Class 25;<sup>4</sup> "miniature basketballs" in International Class 28;<sup>5</sup> and "entertainment services-namely, sponsoring and conducting college athletic exhibitions and competitions" in International Class 41.<sup>6</sup> In Opposition No. 91183698, opposer opposes registration of the mark in application Serial No. 77043344 ("the '344 application") on the ground of likelihood of confusion under Trademark Act Section 2(d),

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<sup>3</sup> Registration No. 1590813, issued April 10, 1990, alleging June 1950 as the date of first use anywhere and date of first use in commerce, renewed twice.

<sup>4</sup> Registration No. 1590965, issued April 10, 1990, alleging June 1984 as the date of first use anywhere and date of first use in commerce, renewed twice.

<sup>5</sup> Registration No. 1591100, issued April 10, 1990, alleging April 1986 as the date of first use anywhere and date of first use in commerce, renewed twice.

<sup>6</sup> Registration No. 1228753, issued February 22, 1983, alleging 1914 as the date of first use anywhere and date of first use in commerce, renewed.

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15 U.S.C. Section 1052(d), with its previously registered mark MINERS and additional design marks, which include the following:



for "clothing, namely shirts, hats, baby shirts and baby pants" in International Class 25; and "educational services, namely providing college and graduate level courses of instruction, continuing education courses and seminars, and opportunities for students to participate in research programs; entertainment services, namely college sport games and events rendered live and through the media of radio and television, musical concerts and entertainment, and performances of dramatic works" in International Class 41,<sup>7</sup> and



for "shirts, jackets, warm-up suits, sweat shirts, sweat pants, caps, bandanas, shorts, scarves, ponchos, raincoats, tank tops, sweat bands, cloth baby bibs, baby panties and dresses, wrist bands, belts, socks, wind suits" in

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International Class 25.<sup>8</sup> Opposer also attempted to plead dilution claims in the notices of opposition. However, because opposer has not alleged that any of its pleaded marks were famous prior to the constructive use filing date of applicant's involved applications, opposer's dilution claims are legally insufficient. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Applicant denied the salient allegations of the notices of opposition in its answers. The above-captioned proceedings have been consolidated since the issuance of a May 19, 2008, Board order.

This case now comes up for consideration of applicant's motion (filed November 23, 2009) for summary judgment dismissing the above-captioned oppositions. Opposer has filed a brief in response thereto.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's*

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<sup>7</sup> Registration No. 2992329, issued September 6, 2005, alleging August 1999 as the date of first use anywhere and date of first use in commerce.

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*Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

After reviewing the parties' arguments and evidence, we find that there are genuine issues of material fact that render inappropriate disposition of these proceedings by summary judgment. Applicant sets forth a lengthy side-by-side comparison of the mark in its '344 application and two of opposer's pleaded design marks at issue in an effort to distinguish those marks. However, the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison; rather, the test is whether the marks, as they are used in connection with the goods and/or services at issue, so resemble one another as to be likely to cause confusion. *See Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd* in unpublished opinion, Appeal No. 92-1086 (Fed. Cir. June 5, 1992). Keeping in mind that the shirts and hats in the identification of goods of both applicant's '344 application and opposer's pleaded

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<sup>8</sup> Registration No. 3397296, issued March 18, 2008, and alleging August 2004 as the date of first use anywhere and date of first use in commerce.

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Registration No. 2992329 are legally overlapping,<sup>9</sup> there are genuine issues of material fact as to the similarity or dissimilarity of the marks in applicant's '344 application and opposer's pleaded Registration No. 2992329 and the scope of protection to which that registration is entitled. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Further, we note that the mark in applicant's '407 application is identical to opposer's pleaded MINERS mark, which is the subject of four of opposer's pleaded registrations.<sup>10</sup> Where the marks at issue are identical, there need not be as great a similarity in the goods and/or services as would be required where the marks are arguably

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<sup>9</sup> The question of likelihood of confusion must be determined in accordance with the identification of goods and/or services in applicant's application and opposer's pleaded registrations. Where there are no restrictions therein, it may be presumed for our purposes that the parties sell all types of the particular goods and/or services through all of the normal channels of trade therefor. See *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987). Where the goods and/or services at issue are legally overlapping, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between those goods and/or services. See *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

<sup>10</sup> We note in addition that the word portion of the mark in applicant's '344 application includes MINERS, the same word comprising the entirety of some of opposer's pleaded marks. The mark in applicant's '344 application includes a design and the additional disclaimed wording SOUTHERN ILLINOIS. When a mark consists of a word portion and a design portion, the word portion is often more likely to be impressed upon a purchaser's memory and to be used in calling for the goods. *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). Further, while disclaimed matter, such as the wording SOUTHERN ILLINOIS in applicant's mark is not disregarded in determining likelihood of confusion, disclaimed matter is often "less significant in

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different. See *Warnaco, Inc. v. Adventure Knits, Inc.*, 210 USPQ 307 (TTAB 1981). Even if opposer's printed programs, media guides and clothing items are marketed in connection with college sports, whereas applicant's "souvenir programs concerning professional baseball," "printed guides in the field of professional baseball for media use," and clothing items are marketed in connection with professional sports, the goods at issue need not be directly competitive for us to find a likelihood of confusion. Rather, the goods at issue need only be related in a manner that could give rise to a mistaken belief that they come from the same source. See *Textron Inc. v. Lawn King, Inc.*, 215 USPQ 340 (TTAB 1982). As such, we find that there is a genuine issue as to whether the parties' goods in International Classes 16 and 25 are related in a manner that could give rise to source confusion.<sup>11</sup>

Based on the foregoing, applicant's motion for summary judgment is denied.<sup>12</sup> Proceedings herein are resumed. Remaining dates are reset as follows.

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creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001).

<sup>11</sup> Although the Board has identified only a few genuine issues of material fact in denying the motion for summary judgment, the parties should not construe such identification as meaning that these are the only issues remaining for trial.

<sup>12</sup> The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss &*

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Plaintiff's Pretrial Disclosures	4/29/10
Plaintiff's 30-day Trial Period Ends	6/13/10
Defendant's Pretrial Disclosures	6/28/10
Defendant's 30-day Trial Period Ends	8/12/10
Plaintiff's Rebuttal Disclosures	8/27/10
Plaintiff's 15-day Rebuttal Period Ends	9/26/10

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.

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*Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993);  
*Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).