

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

GCP

Mailed: March 28, 2012

Opposition No. 91199922

Christopher A. McGrath

v.

Nike, Inc.

**Before Wellington, Bergsman, and Shaw,  
Administrative Trademark Judges.**

**By the Board:**

Nike, Inc. ("applicant") seeks to register the mark

The logo consists of the characters "20XI" in a bold, italicized, sans-serif font. The number "0" is white with a red dot in the center, and the "X" is white with a red dot in the center. The "2" and "I" are solid black.

for the following goods and services:

"Bags, namely, all-purpose sports bags, tote bags, duffle bags, messenger bags, backpacks, purses, umbrellas, luggage, cosmetic and toiletry cases sold empty" in International Class 18;

"Footwear; apparel, namely, pants, shorts, shirts, t-shirts, pullovers, sweat shirts, sweat pants, underwear, sports bras, dresses, skirts, sweaters, jackets, socks, sweatbands, gloves, belts, hosiery, armbands, coats, vests, headwear, namely, hats, caps; cleats for playing football, baseball, softball, golf, cricket" in International Class 25;

"Sports balls; bags for sporting equipment, namely, balls; bats, namely, baseball, softball, cricket; gloves used in baseball, softball, golf; golf clubs, golf balls, golf club grips, golf bags, golf tees, head covers for golf clubs,

golf ball markers; protective padding for playing baseball, football, hockey, softball, cricket, basketball; hockey sticks, baseball mitts, softball mitts, personal exercise mats, snowboards, skateboards, stumps for playing cricket" in International Class 28; and

"Retail store services in the field of apparel, headwear, footwear, bags of all kinds, accessories made of leather and imitation leather, umbrellas, sports equipment, golf equipment, and accessories for all the aforesaid goods; advertising and marketing" in International Class 35.<sup>1</sup>

Opposer has opposed registration of applicant's mark on the following grounds: (1) priority and likelihood of confusion, (2) dilution, including injunctive relief, (3) violation of opposer's trade name rights under Article 8 of the Paris Convention, as implemented by § 44(g) of the Lanham Act, (4) willful infringement, (5) ownership of a United Kingdom trademark registration for the mark 20XII THE HONOR OF SPORT, and (6) a claim based upon the Federal Circuit's decision in *First Niagara Ins. Brokers Inc. v. First Financial Group, Inc.*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007).

Applicant, in lieu of filing an answer, filed a motion to dismiss opposer's pleading for failure to state a claim upon which relief may be granted. In response, opposer filed an amended notice of opposition setting forth the same grounds for opposition, as well as a response to applicant's

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<sup>1</sup>Application Serial No. 85053714, filed on June 3, 2010, based an allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

motion.<sup>2</sup> In turn, applicant filed a renewed motion to dismiss opposer's amended notice of opposition under Fed. R. Civ. P. 12(b)(6). Opposer responded to applicant's renewed motion to dismiss, but only in regard to statements made by applicant concerning the issue of when opposer first became aware of applicant's involved mark. Opposer did not respond substantively to the merits of applicant's renewed motion to dismiss. Notwithstanding, because opposer has filed a response to applicant's renewed motion to dismiss, it is clear that opposer opposes the motion. Accordingly, we will not treat applicant's renewed motion to dismiss as conceded, but will entertain it on its merits.

A plaintiff may amend its complaint as a matter of course 21 days after service of a motion under Fed R. Civ. P. 12(b). See Fed. R. Civ. P. 15(b). Opposer filed his amended pleading within 21 days of the filing of applicant's motion to dismiss. Insofar as opposer could amend his notice of opposition as of right, we accept opposer's amended notice of opposition as the operative pleading in this case, and now consider applicant's renewed motion to dismiss with respect to opposer's amended

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<sup>2</sup>The Board notes that opposer included his response to applicant's motion to dismiss within the body of his amended notice of opposition. This is not proper Board procedure. Opposer should have filed a separate response to applicant's motion in addition to his amended pleading.

pleading and determine whether the amended complaint asserts proper claims.

To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S.662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for the opposition exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010).

In his amended notice of opposition, opposer alleges, *inter alia*, the following:

1. Opposer is a citizen of the United Kingdom and has filed the instant proceeding on the basis of his alleged ownership of the mark 20XII THE HONOR OF SPORT (Amended Notice of Opposition "NOP" ¶ 2);
2. Opposer alleges ownership of a United Kingdom registration for the mark 20XII THE HONOR OF SPORT for clothing, footwear, and headgear, as well as various advertising and business services, including sponsoring and licensing athletic competitions. (Amended NOP ¶ 5);
3. Opposer alleges that he holds the trade name 20XII, in use in the United States since October 2007, and both the United States and elsewhere since January 2008 (Amended NOP ¶ 3);
4. Opposer alleges that his claim of prior use of 20XII as a trade name in the United States is based, in part, on the purchase of various domain names incorporating the term 20XII through a US domain name registrar, i.e., GoDaddy.com, beginning in 2007. Opposer further alleges that use of 20XII as a domain name functions as a trade name (Amended NOP ¶¶ 8, 15, and 16);
5. Opposer also bases his prior use on a video clip posted on YouTube on November 25, 2008 showing use of his 20XII mark (Amended NOP ¶ 31);
6. Opposer alleges that he has granted a worldwide trading license to McG Productions, Ltd. to use opposer's 20XII mark as a clue in connection with an international online treasure hunt game entitled GoldenKeyQuest.com which, in turn, opposer contends functions as a unique way to introduce his sports brand 20XII The Honor of Sport into the market. (Amended NOP ¶¶ 2, 21-25)
7. Opposer alleges relief under Article 8 of the Paris Convention based upon his alleged trade name use of the mark 20XII (Amended NOP 10-13);
8. Opposer alleges likelihood of confusion between the involved marks by virtue of his use of his pleaded 20XII mark as a trade name through the

registration of the mark as a domain name  
(Amended NOP ¶¶ 14-16, 34, 42);

9. Opposer alleges that applicant sought to trade on opposer's reputation or to cause dilution of "the famous mark" (Amended NOP ¶ 41)

We now turn to the sufficiency of each of opposer's pleaded claims.

#### Dilution

The Board set forth the standard for properly pleading a claim of dilution under Section 43(c) of the Trademark Act as amended in *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001) ("*Toro*"). Under *Toro*, the pleading must include allegations that opposer's mark is famous and that such fame was acquired before applicant began commercial use of its mark or before the filing date of the involved intent-to-use application.

After a careful review of opposer's amended pleading, the Board finds that opposer's dilution claim is legally insufficient because there is no affirmative claim that opposer's pleaded mark acquired fame prior to the filing date of applicant's intent-to-use application. See *Toro, supra.*; and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). Moreover, the Board does not have jurisdiction to provide any form of injunctive relief. The Board's jurisdiction is limited solely to determining the right to register in an opposition proceeding. See

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Trademark Act § 17, Trademark Act § 18, Trademark Act § 20,  
Trademark Act § 24, 15 U.S.C. § 1067, 15 U.S.C. § 1068, 15  
U.S.C. § 1070, 15 U.S.C. § 1092.

In view thereof, applicant's motion to dismiss  
opposer's pleaded dilution claim is granted to the extent  
noted below.

Article 8 of the Paris Convention

Article 8 of the Paris Convention, on which opposer  
relies as an independent claim for relief based on his  
alleged use of his trade name 20XII, provides:

A trade name shall be protected in all countries of the  
Union without the obligation of filing or registration,  
whether or not it forms part of a trademark.

Paris Convention, Art. 8.

In turn, Section 44(b) of the Lanham Act provides that

[a]ny person whose country of origin is a party to any  
convention or treaty relating to trademarks ... to  
which the United States is also a party ... shall be  
entitled to the benefits of this section under the  
conditions expressed herein to the extent necessary to  
give effect to any provision of such convention, treaty  
or reciprocal law, in addition to the rights to which  
any owner of a mark is otherwise entitled by this Act.

15 U.S.C. 1126(b) (emphasis added).

Section 44(g) of the Lanham Act provides that

Trade names or commercial names of persons described in  
subsection (b) of this section shall be protected  
without the obligation of filing or registration  
whether or not they form parts of marks.

15 U.S.C. 1126(g).

It appears therefore that opposer, as an independent basis for opposition, is contending that Article 8 of the Paris Convention, as implemented by Sections 44(b) and 44(g) of the Lanham Act, provides opposer with additional substantive rights for its alleged 20XII trade name beyond those specifically enumerated in the Lanham Act.

Opposer's position, however, has been effectively rejected by U.S. courts. For example, the Eleventh Circuit in *Int'l Café, S.A.L. v. Hard Rock Café Int'l Inc.*, 252 F.3d 1274, 1277-78 (11<sup>th</sup> Cir. 2001) held that

We agree that Section 44 of the Lanham Act incorporated to some degree the Paris Convention. But we disagree that the Paris Convention creates substantive rights beyond those independently provided in the Lanham Act. As other courts of appeals have noted, the rights articulated in the Paris Convention do not exceed the rights conferred by the Lanham Act. Instead, we conclude that the Paris Convention, as incorporated by the Lanham Act, only requires "national treatment."

*Int'l Café*, 252 F.3d at 1277-78. See also *Empressa Cubana Del Tabaco v. Culbro Corp.*, 399 F.3d 462, 484 (2<sup>nd</sup> Cir. 2005) ("The Paris Convention requires that 'foreign nationals be given the same treatment in each of the member countries as that country makes available to its own citizens.'") quoting *Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633, 640 (2<sup>nd</sup> Cir. 1956), cert. denied, 352 U.S. 871 (1956).

Notwithstanding the foregoing, we further note that it is well settled that the Paris Convention, in and of itself, is not self-executing, i.e., it does not have direct effect

absent specific congressional implementation, and, therefore, cannot provide an independent basis for an *inter partes* proceeding. See *In re D. Matthias Rath*, 402 F.3d 1207, 1210, 74 USPQ2d 1174, 1176 (Fed. Cir. 2005); *In re The Government of the District of Columbia*, 101 USPQ2d 1588 (TTAB 2012); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1591 (TTAB 2009); and *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1603 (TTAB 2002).

Accordingly, applicant's motion to dismiss opposer's claim for relief under Article 8 of the Paris Convention is granted and said claim is dismissed with prejudice.

Ownership of a Foreign Registration

An allegation of ownership of a foreign registration of mark, in and of itself, does not constitute a ground for opposition. See *Aktieselskabet of 21. November 2001 v. Fame Jeans*, 77 USPQ2d 1861, 1864 (TTAB 2006) ("[p]riority of trademark rights in the United States depends solely upon prior use in the United States, not on priority of use anywhere in the world."). Accordingly, applicant's motion to dismiss is granted to the extent opposer asserts ownership of his United Kingdom registration for the mark 20XII THE HONOR OF SPORT as a stand alone basis for opposition and such claim is dismissed with prejudice.

Willful Trademark Infringement

In Paragraphs 35-39 of his amended notice of opposition, opposer alleges willful trademark infringement by applicant. The Board notes, however, that it does not have jurisdiction to entertain claims of willful trademark infringement.<sup>3</sup> See TBMP § 102.01 (3d ed. 2011) and cases cited therein. Accordingly, applicant's motion to dismiss is granted to the extent that opposer's pleaded claim of willful trademark infringement is dismissed with prejudice.

Claim Based Upon *First Niagara Insurance Brokers Inc.* Case

We note that opposer asserts a stand alone claim for opposition based solely on the U.S. Court of Appeals for the Federal Circuit's decision in *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 81 USPQ2d 1375 (Fed. Cir. 2007). While this decision may be relevant for purposes of opposer establishing prior use in his likelihood of confusion claim, it does not create a separate and distinct ground for opposition under the Lanham Act. The Federal Circuit merely clarified in *First Niagara* that a foreign entity may pursue a claim of likelihood of confusion under Section 2(d) of the Lanham Act by

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<sup>3</sup>The Board also notes that it does not have jurisdiction to entertain a claim of unfair competition under Section 43(a) of the Trademark Act. *Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n. 2 (TTAB 1999).

demonstrating any type of prior use, including intrastate use, of its mark in the United States and that the foreign party was not required to establish prior use rendered in commerce lawfully regulated by Congress. *Id.* at 1378.

Accordingly, opposer's reliance on the *First Niagara* case as a stand alone basis for opposition is improper and unsubstantiated. Accordingly, applicant's motion to dismiss is granted to the extent that opposer is relying on this decision as a ground for opposition.

Priority and Likelihood of Confusion

In order to properly state a claim of likelihood of confusion, opposer must plead that (1) the opposer's mark, as applied to its goods or services, so resembles the applicant's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. *See* Fed. R. Civ. P. 8; and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In support of his likelihood of confusion claim, opposer has alleged his priority of use based upon use of his 20XII trade name as a registered domain name beginning in 2007, as well as a clue on the online treasure hunt game since 2008 which opposer alleges also serves to promote brand recognition for his 20XII mark in the world of sports, with the view to

building an international sports brand. See Amended NOP ¶ 23.<sup>4</sup> Opposer further alleges that the use of his 20XII mark in a video clip posted on YouTube also serves the same promotional purpose of his emerging sports brand. See Amended NOP ¶ 31. Additionally, opposer has alleged that he will be damaged by the registration of applicant's mark because the marks at issue are so obviously similar as to cause confusion for the buying public. See Amended NOP ¶ 34.

In its motion, applicant contends that opposer's allegation regarding registration and use of his domain names does not rise the level of a claim of prior trademark or trade name use in the United States. Applicant also argues that opposer's use, through his licensee, of his pleaded 20XII mark as a clue for an online treasure hunt game also does not amount to prior use as either a trademark or trade name in the United States.

After a careful review of opposer's amended pleading, we find, contrary to applicant's objections, that opposer has provided sufficient notice pleading of his claim of priority and likelihood confusion which raises a right to relief above the speculative level. We note that applicant's arguments go

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<sup>4</sup>While we note that opposer has alleged use of its 20XII THE HONOR OF SPORT as a trademark in connection with an online store featuring clothing (Amended NOP §§ 45-50), this use was subsequent to the filing date of applicant's involved intent-to-use application and therefore does not provide opposer with any rights prior to applicant's constructive use date.

the merits of opposer's pleaded claim of priority and likelihood of confusion and not to the sufficiency of the pleading itself. Whether opposer's allegations support his claim of priority of use and claim of likelihood of confusion, however, is a matter for proof at trial and not whether a pleading sufficiently states a claim of priority and likelihood of confusion. *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) ("A motion to dismiss does not involve a determination of the merits of a case..."). See also TBMP § 503.02 (3d ed. 2011).

Accordingly, applicant's motion to dismiss opposer's claim of likelihood of confusion is denied.

#### Standing

We finally turn to the issue of standing. To establish his standing, opposer must prove that he has a "real interest" in the proceeding and a "reasonable basis" for his belief of damage. To plead a "real interest" in the case, he must allege a "direct and personal stake" in the outcome of the proceeding, and the allegations in support of his belief of damage must have a reasonable basis in fact. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); TBMP § 309.03(b) (3d ed. 2011).

In its motion, applicant essentially argues that opposer lacks standing because he has neither pleaded use nor

registration of his mark in the United States, nor otherwise pleaded any trademark or trade name rights in his mark.

AS noted above, however, opposer has alleged that use of his 20XII as a clue on the online treasure hunt game also serves to promote brand recognition for his 20XII mark in the world of sports, with the view to building an international sports brand. See Amended NOP ¶ 23.

Additionally, opposer further alleges that the use of his 20XII mark in a video clip posted on YouTube also serves the same promotional purpose of his emerging sports brand. See Amended NOP ¶ 31. Again, we make no findings on the merits of such alleged use; however, these allegations, at the very least, demonstrate that opposer is not a mere intermeddler and that he has a commercial interest in his pleaded mark and that registration of applicant's involved mark may impede on this commercial interest, as well as cause economic damage to opposer. See *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (standing based on commercial interest in the mark); *Young v. AGB Corp.*, 152 F3d 1377, 47 USPQ2d 1752 (Fed. Cir. 1998) (economic damage is relevant to the issue of standing). See also *Ritchie v. Simpson, supra*. Accordingly, we find that opposer has sufficiently pleaded his standing to bring this proceeding. In view thereof, applicant's motion to dismiss, as it relates to opposer's standing, is denied.

In sum, applicant's motion to dismiss is granted with regard to the following claims asserted by opposer: 1) willful trademark infringement, 2) relief under the Paris Convention, 3) any claim based solely on his ownership of a foreign registration and 4) a stand alone claim based solely on the Federal Circuit's decision in *First Niagara Insurance Brokers Inc., supra.*, and 5) dilution.

Applicant's motion to dismiss, however, is denied with regard to opposer's standing and asserted claim of priority and likelihood of confusion.

The Board, however, freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient. In view thereof, opposer is allowed until **twenty (20) days** from the mailing date of this order to file and serve a revised amended pleading which includes a proper claim of dilution and which re-alleges his approved claim of priority and likelihood of confusion consistent with the guidelines set forth above, failing which opposer's dilution claim will be dismissed with prejudice.

By this order, however, opposer is precluded from re-asserting the following claims: 1) willful trademark infringement, 2) relief under the Paris Convention, 3) any claim based solely on his ownership of a foreign registration, 4) a stand alone claim based solely on the

Federal Circuit's decision in *First Niagara Insurance Brokers Inc., supra.*, and 5) any claims for injunctive relief.

Further, opposer should not embed any evidence in support of his claims within the body of his revised amended pleading. Indeed, evidentiary matters should not be pleaded in a complaint. They are matters for proof, not for pleading. See *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959). Moreover, the revised amended pleading must include (1) a short and plain statement of the reason(s) why opposer believe he would be damaged by the registration of the opposed mark and (2) a short and plain statement of one of more grounds for opposition. See Trademark Rule 2.104(a). All averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances. See Fed. R. Civ. P. 10(b). Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded. *Id.* A paragraph may be referred to by number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint. See Fed. R. Civ. P. 10(b) and (c).

In turn, applicant is allowed **twenty (20) days** from the mailing date indicated on the certificate of service of opposer's revised amended pleading to answer or otherwise respond to opposer's amended pleading.

Proceedings are resumed. Discovery and trial dates are reset as follows:<sup>5</sup>

Deadline for Discovery Conference	6/1/2012
Discovery Opens	6/1/2012
Initial Disclosures Due	7/1/2012
Expert Disclosures Due	10/29/2012
Discovery Closes	11/28/2012
Plaintiff's Pretrial Disclosures	1/12/2013
Plaintiff's 30-day Trial Period Ends	2/26/2013
Defendant's Pretrial Disclosures	3/13/2013
Defendant's 30-day Trial Period Ends	4/27/2013
Plaintiff's Rebuttal Disclosures	5/12/2013
Plaintiff's 15-day Rebuttal Period Ends	6/11/2013

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.

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<sup>5</sup>The parties may wish to consider the Board's Accelerated Case Resolution ("ACR") procedure as a manner in which to get an expedited disposition of this case. Both parties, however, must stipulate to pursue the ACR process. Information concerning the Board's ACR procedure is available online at the Board's website.

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.

**PRO SE INFORMATION**

Applicant is reminded that he will be expected to comply with all applicable rules and Board practices during the remainder of this case. The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this opposition proceeding. Applicant should note that Patent and Trademark Rule 10.14 permits any person or legal entity to represent itself in a Board proceeding, though it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters.

If applicant does not retain counsel, then applicant will have to familiarize himself with the rules governing this proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law libraries, and may be available at some public libraries. Finally, the Board's manual of procedure will be helpful.

On the World Wide Web, applicant may access most of these materials by logging onto <http://www.uspto.gov/> and making the connection to trademark materials.

Applicant must pay particular attention to Trademark Rule 2.119. That rule requires a party filing any paper with the Board during the course of a proceeding to serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. The party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served; (2) the method of service (e.g., first class mail); (3) the person being served and the address used to effect service; and (4) the date of service.

Also, applicant should note that any paper it is required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 or 2.198 is utilized. These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations.

Files of TTAB proceedings can now be examined using TTAB Vue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.