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

Proceeding	91202562
Party	Defendant Velocity, LLC
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Attachments	Applicant's Trial Brief.pdf(22598 bytes)

fold; specifically, Applicant prints and embroiders products for third parties as a manufacturer and Applicant produces its own products under its marks.

Applicant, in its capacity as a manufacturer, produced shirts for Opposer in 2009-2010, none of which contained any reference to Applicant's mark. Applicant did so as a manufacturer only and not as a licensee. Applicant has never been a licensee of Opposer. See *Fleming Deposition 22*: 1-21. Applicant had one discussion with Opposer about potentially becoming a licensee of the BOSTON MARATHON and BAA Logo marks, but was told that such an arrangement was not possible because of an exclusive license to adidas AG. See *Fleming Deposition 22*: 1-21. Applicant never sought to license any other terms or marks from Opposer. See *Fleming Deposition 22*: 1-21.

Opposer is the Boston Athletic Association which is the organization that is responsible for managing the running of several races, including the Boston Marathon as well as running training programs and clinics. *Fleming Deposition 13*: 7-10.

ARGUMENTS

A. Applicant's Trademark Does Not Suggest a Connection with the BAA in Violation of Section 2(a) of the Lanham Act.

The BAA's opposition must fail because Applicant's mark does not falsely suggest a connection with the BAA in violation of Section 2(a) of the Lanham Act. The four factor test that is used to establish that a mark falsely suggests a connection with an institution is set out as follows:

1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;

(2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;

(3) the institution named by the mark is not connected with the activities performed by the applicant under the mark; and

(4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

See, *In re: Jackson International Trading Co.*, 103 U.S.P.Q.2d 1417, 1419 (TTAB 2012); and *Buffett*. 226 U.S.P.Q. 428, 429; see also, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 U.S.P.Q. 505, 508-10 (Fed. Cir. 1983).

The first two prongs of the above test clearly state what must be assessed in a claim under §2(a) is the name or identity of the person or institution. *Univ. of Notre Dame du Lac* at 1375-1377 (“A reading of the legislative history with respect to what became §2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical “trademark” or “trade name” upon which an objection could be made under §2(d)...Although not articulated as such, it appears that the drafters sought by §2(a) to embrace concepts of the right to privacy...”). A party may prevail on a false suggestion of a connection claim when its right to control the use of its identity, in which it has a protectable interest, is violated. When the mark at issue does not contain the literal name of the party opposing it, the Board will consider whether the applicant's mark is the same as or a close approximation of the opposer's identity. *The Board of Trustees of The University of Alabama and Paul W. Bryant, Jr. v. William Pitts, Jr. and Christopher Blackburn*, 2013 TTAB LEXIS 370, 385, 107 U.S.P.Q.2d 2001, 2025 (TTAB 2013). The identity in which the Opposer has a protectable interest under §2(a) is Boston Athletic Association.

Courts have recognized that nicknames of marks or trade names created by the public can give rise to rights in the owners of the mark or trade name that was so modified by the public. *Id.*, citing *Dallas Cowboys Football Club, Ltd. v. America's Team Properties, Inc.*, 616 F. Supp.

2d 622, 633, 92 USPQ2d 1325, 1330 (N.D. Tex. 2009). However, the record herein does not show that the term BOSTON MARATHON is a nickname for the BAA. The Boston Marathon is a race event organized by the BAA, it is not an alter ego or nickname for the BAA.

Throughout its brief, the Opposer inaccurately states without substantiation in the record that its identity is both BOSTON MARATHON and Boston Athletic Association. Applicant argues that this is akin to a concert promoter claiming that its name is the nickname of the band whose concerts are scheduled. Based upon the lack of evidence to the contrary in the record before the Board, the proper identity and name for purposes of the assessment of the asserted §2(a) claim is only the Boston Athletic Association.

1. Opposer has not established that the applied for mark is “the same as or a close approximation” of Opposer’s previously used name or identity

The first prong of the test is an important question here, namely whether “the mark in question is the same as, or a close approximation of, a person or institution’s previously used name or identity.” *Buffett*, 226 U.S.P.Q. 428, 429. The determination of whether a mark is a “close approximation” of an institution’s identity is a stringent test. *Red Sox Baseball Club Limited Partnership v. Brad Francis Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008).

In order to prevail in this first prong, Opposer, must establish that MARATHON MONDAY is a close approximation of its name, identity or persona “Boston Athletic Association.” Despite all of the materials presented by it, Opposer offers no evidence to support a contention that MARATHON MONDAY is the same or a close approximation of its identity or persona, Boston Athletic Association.

The Boston Marathon is a marathon that is run on a Monday and that ends in the city of Boston. See *Fleming Deposition, Exhibit 10; Opposer's Responses to Applicant's First Set of Interrogatories No. 1*. However, none of the materials entered into evidence by Opposer mention MARATHON MONDAY in reference to the Boston Athletic Association. Cf., *Buffett, 226 U.S.P.Q. 428, 435* (“Various press clippings refer to opposer as “Jimmy “Margaritaville” Buffett, “the Monarch of Margaritaville” and the “Poet of Margaritaville””Such evidence is sufficient to raise a genuine issue of material fact as to whether the term “MARGARITAVILLE” is so uniquely and on mistakably associated with opposer as to constitute opposer’s name and identity such that when applicant’s mark is used in connection with its services, a connection with opposer would be assumed.”). As discussed above, the Opposer tries to create an argument that its identity is also the term BOSTON MARATHON but Opposer does not offer any evidence that this is the case in the eyes of the public from whom such a nickname would grow.

Similarly, nowhere in the deposition of Opposer’s Director of Marketing and Communications, John Fleming is the term MARATHON MONDAY used in relation to or as a reference to the Boston Athletic Association. See, *Fleming Deposition, 10:5*. Mr. Fleming states that the term MARATHON MONDAY is used to identify a marathon run in Boston on a Monday, but Mr. Fleming then goes on to indicate that the term MARATHON MONDAY is “synonymous” with the term BOSTON MARATHON. *Fleming Deposition, 10:6-13, 29:13-14*. Mr. Fleming does not indicate that the term MARATHON MONDAY is “synonymous” with the Boston Athletic Association. In fact, Mr. Fleming pairs only BOSTON MARATHON and MARATHON MONDAY many times throughout his deposition. See, *Fleming Deposition, 32: 11-18; 33: 19-21; 38: 5-7; 40: 18-23; and 45: 4-8*. At no time however, does Mr. Fleming pair or equate the terms MARATHON MONDAY and Boston Athletic Association.

We note as indicated above that Mr. Fleming, is the Director of Marketing and Communications for Opposer and he was identified as the person most knowledgeable about the use of the term MARATHON MONDAY. *Opposer's Responses to Applicant's First Set of Interrogatories Nos. 1 and 19*. It stands to reason that Mr. Fleming would have provided under oath what he believed was the most accurate information that was also most beneficial to support his employer's position. Despite this, Mr. Fleming never makes any connection between the term MARATHON MONDAY and the Boston Athletic Association. Nothing in the materials relied upon by Opposer demonstrates that the term MARATHON MONDAY is a close approximation of, or used in any way interchangeably with, its name and identity, Boston Athletic Association.

2. Opposer has not established that the applied for mark points uniquely and unmistakably to Opposer

The burden is on the Opposer to establish that a mark points uniquely to itself. *Calvin Klein Industries Inc. v. Calvins Pharmaceuticals Inc.*, 8 USPQ2d 1269, 1272 (TTAB 1988) (“Opposer had the burden of establishing that CALVINS points uniquely to opposer.”). In this case, the BAA has not met this burden.

In assessing this prong, the question is whether, as used on the goods or services in question, consumers would view the mark as pointing uniquely and unmistakably to Opposer, so that a connection with Opposer would be assumed. See *Buffett*, 226 U.S.P.Q. 428, 435 (“Various press clippings refer to opposer as “Jimmy “Margaritaville” Buffett, “the Monarch of Margaritaville” and the “Poet of Margaritaville”).

The term MARATHON MONDAY is used and has been used in relation to other marathons and races and to running activities and training generally. See *Applicant's Trial*

Exhibits 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 13, 14, 19, 20, 21 and 22. None of these uses were or are controlled by the Opposer. See, *Opposer's Responses to Applicant's First Set of Interrogatories Nos. 10, 14, and 25; Opposer's Response to Applicant's First Set of Requests for Production of Documents and Things Nos. 4, 6, and 9.* Opposer is not the owner of record of the domain names *www.marathonmonday.com / .net / .org*, which have been owned by an unrelated third party since 2006. See *Applicant's Trial Exhibits 31, 32, and 33; Opposer's Responses to Applicant's First Set of Interrogatories Nos. 21, 22.* The Opposer does not offer any information that it has controlled the use of the term MARATHON MONDAY or otherwise stopped its use in relation to other races, marathons or running related activities. By pointing at other running events and activities, including marathons, the term MARATHON MONDAY does not point uniquely and unmistakably to Opposer.

3. Opposer has not established its fame or reputation such that, when the mark is used with the applicant's goods or services, a connection with the Opposer would be presumed.

There is nothing in the record to prove that Opposer's name, Boston Athletic Association, has any fame or reputation. There is information in the record that the BAA has organized the Boston Marathon for decades, and that the BOSTON MARATHON race receives press coverage. However, nothing in the record or in the arguments presented by Opposer speaks to any fame of the name or identity of the Boston Athletic Association. Accordingly, this prong of the test has not been met.

CONCLUSION

If there is doubt remaining as to whether the elements of a false suggestion of an association or connection have been met, then such doubt should be resolved in the Applicant's favor. *In re: White*, 73 USPQ2d 1713, 1722 (TTAB 2004); see also, *In re: Over Our Heads Inc.*, 16 USPQ2d 1653, 1655 (TTAB 1990). In the instant case, there is significant doubt whether there is any actual association or connection between the BAA and the term MARATHON MONDAY, there is doubt as to whether the term MARATHON MONDAY points uniquely and unmistakably to the Opposer and accordingly, the claim of false association must fail.

Even if assuming for the sake of argument that the foregoing two prongs of the test were met, the Opposer has not established such fame in its identity that the term MARATHON MONDAY when used in relation to the Applicant's casual clothing products will create a presumption of association of the Opposer with such goods.

For the reasons set forth above, Applicant, Velocity LLC respectfully requests the Board to deny Opposer's opposition and register Applicant's mark on the Principal Register.

VELOCITY, LLC.

By its attorneys,

/Andrea J. Mealey/

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CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of February 2014, I served a true and accurate copy of the foregoing Trial Brief of Applicant Velocity, LLC, via first class mail, postage prepaid upon Counsel for Opposer, Michael J. Bevilacqua, Wilmer Cutler Pickering Hale & Dorr LLP, 60 State Street, Boston Massachusetts 02109.

/Andrea J. Mealey/ _____
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