

This Opinion is Not a
Precedent of the TTAB

Mailed: January 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wilson Sporting Goods Co.
v.
Christopher S. Dahlander

Opposition No. 91267335

Oliver D. Yang of Yang Law, LLC and Terence P. O'Brien of Amer Sports Americas
for Wilson Sporting Goods Co.

Christopher S. Dahlander, pro se.

Before Wolfson, Adlin, and Lynch, Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Christopher S. Dahlander (“Applicant”) seeks registration on the Principal Register of the mark RUNNER GUNNER SLUGGER DERBY in standard characters, with a disclaimer of DERBY, for “Organizing sporting events, namely, baseball or softball tournaments, camps, minicamps, derbys, and clinics” in

International Class 41.¹ By its Notice of Opposition, Wilson Sporting Goods Co. (“Opposer”) opposes registration based on an alleged likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer relies on prior registrations, discussed in more detail below. The Notice of Opposition also purports to plead common law rights in the marks LOUISVILLE SLUGGER and SLUGGER, but because it does not set out the specific goods and services for which such rights are claimed, we consider the pleaded common law rights to be co-extensive with Opposer’s registration rights.²

In his Answer, Applicant denies Opposer’s salient allegations regarding likelihood of confusion, but makes various admissions discussed below. Applicant did not submit any evidence, but is not required to do so. The burden rests on Opposer to establish its statutory entitlement to oppose and to prove its claim by a preponderance of the evidence. *See B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015) (“The party opposing registration bears the burden of proof, see [Trademark Rule] § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b).”).

¹ Application Serial No. 88805914 was filed on February 21, 2020 based on Applicant’s alleged first use of the mark at least as early as December 13, 2019, and use of the mark in commerce at least as early as February 20, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

² 1 TTABVUE 3-4 (referring to Opposer’s “exceptionally strong common law rights associated with” the marks, which Opposer alleges are used with “a large variety” of branded goods and services,” in the case of LOUISVILLE SLUGGER and “a large variety of SLUGGER branded goods,” in the case of SLUGGER).

The opposition is fully briefed. On September 20, 2022, the Board issued an order that reiterated the October 6, 2022 deadline for requesting an optional oral hearing.³ After that deadline passed and the case was submitted for final decision, Opposer submitted a request for oral hearing on October 11, 2022, providing no acknowledgement of or explanation for the late request.⁴ Applicant submitted an objection “as the deadline for the request has passed.”⁵ We deny Opposer’s untimely request for an oral hearing.

For the reasons set forth below, we dismiss the opposition.

I. Record and Evidentiary Matters

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed application. During its trial period, Opposer introduced a testimony declaration with exhibits from Pat Ryan, its Global Product Director for Baseball.⁶ Although Applicant’s Brief includes a list of six “objections,” they are not evidentiary objections, but instead detail what Applicant contends are speculative or unfounded assertions made by Opposer.⁷ Therefore, we do not address these as evidentiary objections.

³ 13 TTABVUE (deadline originally set in July 27, 2022 Order at 9 TTABVUE).

⁴ 16 TTABVUE.

⁵ 17 TTABVUE.

⁶ 7 TTABVUE.

⁷ 11 TTABVUE 7-8.

A. Ryan Declaration

With regard to Mr. Ryan's declaration, we consider his factual testimony, but disregard his conclusory testimony as to legal issues in this proceeding such as the similarity of the marks at issue, or that Opposer's "brand is so well-known as to be considered 'famous,' meaning that it is widely recognized by the general U.S. consuming public as a designation of the source of [Opposer's] goods and/or services."⁸ See *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013) ("we have disregarded any opinion testimony regarding the ultimate disposition of the claims asserted herein") *aff'd*, 565 Fed. Appx. 900 (Fed. Cir. 2014) (mem.). Similarly, we discount his conclusions and characterizations, for which no foundation was laid, of alleged consumer recognition and awareness.

B. Pledged Registrations

In the Notice of Opposition, Opposer claims ownership of 33 registrations that consist of or include LOUISVILLE SLUGGER or SLUGGER for various goods, such as clothing, sports equipment and athletic bags, and for services in International Class 41, such as operation of a baseball bat and baseball museum, providing sports and recreation facilities, and conducting field trips, classes, and lectures relating to the manufacture of baseball bats. Opposer attached to the Notice of Opposition copies of 33 registration certificates, but such copies are not the type of registration records that include the requisite current status and title information for receipt into the

⁸ 7 TTABVUE 6.

record under Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d). See *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039 (TTAB 2014) (“Here, opposer merely attached as exhibits to its notice of opposition copies of the original certificates of its pleaded registrations which issued years earlier. The Board has routinely held that the submission of such a copy of a pleaded registration, by itself, is insufficient for purposes of establishing the continuing subsistence and the current title of the registration and, therefore, does not suffice to make the registration of record.”) (citations omitted); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with “simple and clear’ directives of Trademark Rule 2.122(d)” by submitting plain copy of registration attached to notice of opposition – registration not of record); *Ind. Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947-48 (TTAB 1983) (photocopy of registration without status and title information insufficient to establish prima facie showing); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of registration certificate insufficient). Opposer did not subsequently introduce status-and-title copies of the registrations.

Nonetheless, Applicant made numerous admissions regarding the pleaded registrations. In his Answer, Applicant admitted – either explicitly or by failing to deny⁹ – Opposer’s allegations of ownership of the pleaded registrations. In answering

⁹ Federal Rule of Civil Procedure 8(b)(6) deems an allegation admitted “if a responsive pleading is required and the allegation is not denied.”

the numbered paragraphs of the complaint, Applicant also admitted for each pleaded registration what the mark is, the goods and/or services in the registration, the applicable filing dates of the underlying applications, the date of first use in commerce shown, and that they predate Applicant's filing date. Applicant further admitted that "[t]rue and correct copies of the Registration Certificate for [each pleaded registration] are attached" to the complaint "and made of record." In addition, Opposer having defined its pleaded "LOUISVILLE SLUGGER® Registrations"¹⁰ and its pleaded "SLUGGER® Registrations,"¹¹ Applicant admitted:

Opposer is the owner of and relies upon the LOUISVILLE SLUGGER® Registrations [and] the SLUGGER® Registrations.... The LOUISVILLE SLUGGER® Registrations and the SLUGGER® Registrations are valid, subsisting, unrevoked and un-canceled.

In view of Applicant's admissions as to title, status and authenticity of the registration certificate copies attached to the Notice of Opposition, we consider them part of the record. *See Tiffany & Co. v. Columbia Ind., Inc.*, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972).

C. Plead Applications

Two registrations that were not among those listed when Opposer defined "the LOUISVILLE SLUGGER® Registrations" and "the SLUGGER® Registrations," but

¹⁰ As defined by Opposer, "The LOUISVILLE SLUGGER® Registrations" are: Registration Nos. 379405, 512675, 0511742, 1131403, 1326931, 1328693, 1352409, 2111291, 2144755, 2340147, 2354632, 2401296, 2414509, 2421681, 2537792, 2840949, 2856119, 3274641, 3406690, 3655349, 4289335, 4790970, 4790971, 5022786, 5105479 and 5233098.

¹¹ As defined by Opposer, "The SLUGGER® Registrations" are: Registration Nos. 1867098, 3619985, 4682605, 5418848, and 5794764.

which were addressed in the briefing, present different evidentiary issues than the registrations discussed above. In the Notice of Opposition, Opposer claimed ownership of two then-pending applications, one for SLUGGER and the other for LOUISVILLE SLUGGER, both for services in Class 35 and Class 41, including “arranging and conducting athletic competitions” and “arranging and conducting athletic events and sports competitions.”

In his Answer, Applicant admitted for each that Opposer is the owner of the application, the services covered by the application, the filing date of the application, that its filing date predates Applicant’s application filing date, and that Opposer’s attachments to the Notice of Opposition were “a true and correct copy of the status” of Opposer’s application from the USPTO’s TSDR database.¹² “Such an admission, however, does not dictate that the resulting registration is automatically of record whenever it should issue.” *UMG Recordings, Inc., v. O’Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009). Rather, “[a] plaintiff which pleads ownership of an application in its complaint must, in order to rely on the subsequently issued registration, make the registration of record.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2022).

During the pendency of this opposition, but before Opposer’s trial period, the applications apparently matured into Registration Nos. 6329137 (SLUGGER) and 6329138 (LOUISVILLE SLUGGER). Opposer did not introduce the registrations into the record, but its Brief refers to the registration numbers in listing the registrations

¹² 4 TTABVUE 6.

Opposer claims to own.¹³ In its Reply Brief, Opposer lists Registration No. 6329137 in support of its statement that “the Louisville Slugger Trademarks upon which this proceeding is based include six registrations for the word ‘Slugger®,’ alone.”¹⁴

Applicant approaches each of the two newly issued registrations differently. In its Brief, Applicant never acknowledges or refers to Registration No. 6329138 (LOUISVILLE SLUGGER). In contrast, Applicant’s Brief addresses, and even emphasizes Registration No. 6329137 (SLUGGER). For example, Applicant states:

As such, this is the key aspect of the board’s decision – is the singular, standalone word slugger protectable under the definitions and terms of the USPTO. Stated differently: does Wilson Sporting Goods’ U.S. Trademark Reg. No. 6329137 grant exclusive use, ownership, and dominion of the singular, standalone word slugger in all cases associated with baseball?

The only registration that is applicable to the board’s decision is that of U.S. Trademark Reg. No. 6329137 for the individual, standalone word, slugger in IC 035 and IC 041.¹⁵

One of the three reasons Applicant contends the opposition should be dismissed is that “[Opposer] has not faithfully protected U.S. Trademark Reg. No. 6329137.”¹⁶

Because Opposer did not introduce Registration No. 6329138 (LOUISVILLE SLUGGER), and Applicant did not refer to it in briefing or make admissions regarding the issued registration, we do not consider it. *See* 37 C.F.R. § 2.122(d);

¹³ 10 TTABVUE 6-7 (Opposer’s Brief).

¹⁴ 14 TTABVUE 4 & n.1 (Opposer’s Reply Brief).

¹⁵ 11 TTABVUE 5-6 (Applicant’s Brief).

¹⁶ 11 TTABVUE 4 (Applicant’s Brief).

UMG Recordings, 92 USPQ2d at 1046. However, as to Registration No. 6329137 (SLUGGER), given Applicant's admissions in the Answer regarding the application and given that Applicant's Brief treats the registration as of record and at issue, and explicitly states that Opposer owns this registration for the word SLUGGER for services in International Classes 35 and 41, we consider the registration. *See West Point-Pepperell, Inc. v. Borlan Ind.*, 191 USPQ 53, 54 (TTAB 1976).

Registration No. 6329137 recites the following services:

Online retail store services and retail store services featuring baseball and softball equipment, apparel, headwear, footwear and accessories; online retail store services featuring instructional training content in the fields of baseball and softball, in International Class 35; and

Sports training services in the field of baseball; providing personal physical fitness training for baseball pitchers, softball pitchers, baseball hitters and softball hitters; Educational services in a wide variety of fields, namely, providing instruction and training for baseball hitting, softball hitting, baseball fielding, softball fielding, baseball pitching, softball pitching, baseball catching, softball catching, baseball base-running and softball base-running; arranging and conducting athletic competitions; coaching in the field of sports; personal training services, namely, strength and endurance training; providing a website featuring information on exercise, sports and fitness; providing a website featuring information on organizing and conducting athletic competitions; providing a website featuring information on coaching in the field of sports; entertainment services, namely, arranging and conducting athletic events and sports competitions; recreational services in the nature of providing baseball fields, softball fields, batting cages, and weight training facilities; recreational services, namely, providing sports facilities; organizing sporting events, namely, baseball competitions, and softball competitions, in International Class 41.

D. Hyperlinks and New Evidence in Briefs

Turning to attempts to introduce evidence through briefing, we do not consider the hyperlinks and the discussion of their contents in Opposer's Brief or Applicant's Brief.¹⁷ This evidence is untimely as it was not submitted during the parties' trial periods, and because it consists of hyperlinks, it is in improper form regardless. *See Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at *2 (TTAB 2019); *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013) (providing hyperlinks to Internet materials is insufficient to make linked materials of record); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n.3 (TTAB 2012) (The Board "will not utilize a link or reference to a website's internet address to access the site to consider whatever content may appear therein."). *See also In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (evanescent nature of web content makes it particularly important that a copy of the relevant material be submitted in the record).¹⁸

Additionally, Applicant's Brief improperly includes screenshots and excerpts from books, screenshots of internet searches and websites, and stills from films. As noted above, Applicant did not submit any evidence during his trial period. Evidence submitted outside of the trial periods, including evidence embedded in a brief, is untimely, and will not be considered. *See* Trademark Rule 2.121(a), 37 C.F.R.

¹⁷ 10 TTABVUE 6, 11; 11 TTABVUE (passim).

¹⁸ For the same reason, in Opposer's Declaration of Pat Ryan, we do not consider "[m]ore examples" from Opposer's website, for which a hyperlink is included in the declaration, to the extent they are not included in the declaration and its exhibits. *See* 7 TTABVUE 5-6.

§ 2.121(a); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008); *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *2 (TTAB 2020) (“A brief may not be used as a vehicle for the introduction of evidence.’ ... The Board will not consider evidence and other evidentiary materials attached to the briefs unless they were properly made of record during the time assigned for taking testimony.”).

However, the dictionary entries included by Applicant in his Brief for “slugger” from the online Merriam-Webster Dictionary and Dictionary.com (sourced from the Random House Dictionary) are appropriate subject matter for judicial notice. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

Accordingly, we have given no consideration to the untimely evidence included in Applicant’s Brief, except for the dictionary definitions of “slugger,” of which we take judicial notice.¹⁹

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)).

¹⁹ 11 TTABVUE 8-9.

A party in the position of plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020).

Opposer's reasonable belief in damage proximately caused by the registration of the mark shown in Applicant's pending application is established through Opposer's pleaded registrations, for which status and title are established. The registrations support Opposer's plausible likelihood of confusion claim against the involved application, thereby showing its real interest in this proceeding, and a reasonable basis for its belief of damage. Opposer has demonstrated a statutory entitlement to oppose. *See Coach Servs.*, 101 USPQ2d at 1727-28; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

III. Priority

We consider the registrations Opposer defined as "the LOUISVILLE SLUGGER® Registrations," "the SLUGGER® Registrations," and Registration No. 6329137, and Applicant has not counterclaimed to cancel any of them. Therefore, priority is not an issue as to the marks and goods and services covered by those registrations. *See Top Tobacco LP v. N. Atl. Op. Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (citing *King Candy, Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974)); *see also Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) ("prior use need not be shown by a plaintiff relying on a

registered mark unless the defendant counterclaims for cancellation”); *Itel Corp. v. Ainslie*, 8 USPQ2d 1168, 1169 (TTAB 1988) (“because of the existence of opposer’s valid and subsisting registration, it need not prove prior use as to the services recited therein”).

Although Opposer’s Notice of Opposition generally referred to common law rights, Opposer’s Brief does not assert or point to evidence of priority based on common law rights as to any goods and services not already covered by the registrations under consideration. Therefore, we need not address priority or likelihood of confusion based on common law rights.

IV. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

We focus the analysis on Opposer's Registration No. 6329137 for SLUGGER for services that overlap with Applicant's because it consists only of the word shared with Applicant's mark, on which Opposer relies to argue similarity of the marks.²⁰ While we have kept in mind that, as discussed below, LOUISVILLE SLUGGER for bats is commercially stronger than SLUGGER, in this analysis, the degree of strength reflected in the record would not make enough of a difference to overcome the further distinction added by the initial term LOUISVILLE and the different goods and services covered. In other words, when we consider the pleaded marks, their strength, and the relevant goods and services, SLUGGER for overlapping services is the pleaded mark most likely to be confused with Applicant's. If there is no likelihood of confusion as to SLUGGER, there would not be likely confusion as to Opposer's other marks such as, for example, LOUISVILLE SLUGGER, LOUISVILLE SLUGGER SPORTS COMPLEX, or LOUISVILLE SLUGGER FIELD.

Our decision must focus on the identification of services in the application and in Opposer's Registration No. 6329137. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). It is sufficient for a finding of likelihood of confusion as to a particular class if relatedness is established for any item of identified services within that class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

²⁰ *E.g.*, 7 TTABVUE 7 (Ryan Declaration, stating that similarity of the marks stems from them "contain[ing] the dominant word 'slugger.'").

A. Relatedness of the Services

Applicant's recited services are "organizing sporting events, namely, baseball or softball tournaments, camps, minicamps, derbys, and clinics." Opposer's registration includes some services that overlap with Applicant's. For example, Opposer's "arranging and conducting athletic competitions" and "organizing sporting events, namely, baseball competitions, and softball competitions"²¹ encompass Applicant's "organizing ... baseball or softball tournaments." The services therefore are legally identical in part.

B. Trade Channels and Classes of Consumers

Because Applicant's services overlap with Opposer's, we must presume that they travel in some of the same channels of trade to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd mem.*, (No. 18-2236) (Fed. Cir. September 13, 2019) ("Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.").

²¹ We take judicial notice of the entry for "tournament" in the online Merriam-Webster Dictionary, which includes the definition, "a series of games or contests that make up a single unit of competition (as on a professional golf tour), the championship playoffs of a league or conference, or an invitational event." Merriam-Webster.com/dictionary, accessed January 24, 2023. The definition makes clear that Opposer's "competitions" could include "tournaments" such as Applicant's.

C. Strength of Opposer's Marks

In determining the strength of a mark, we consider conceptual strength, based on the nature of the mark itself, and commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). “A mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)).

Opposer asserts that all of its “Louisville Slugger Trademarks”²² should be considered famous, so as to entitle them to a broad scope of protection, even extending to what it refers to as “the ‘Slugger’ name in baseball.”²³ We consider Opposer’s contentions of fame of LOUISVILLE SLUGGER and SLUGGER as background to our focus in our likelihood of confusion analysis, explained above, on Opposer’s Registration No. 6329137 of SLUGGER.

First, as to SLUGGER standing alone, we find that Opposer’s SLUGGER mark is not entitled to a broad swath of protection for sports-related goods and services. To

²² Opposer defined this term as including all of its pleaded registrations. 10 TTABVUE 6-8 (Opposer’s Brief).

²³ 10 TTABVUE 21 (Opposer’s Brief).

the contrary, the dictionary entries indicate that in the baseball context, a “slugger” is a hard-hitting batter or “a player who frequently gets extra-base hits.”²⁴ Opposer’s webpage for its museum and factory features an article titled “Signing the Greatest Since 1905” about baseball players who signed contracts with Opposer’s predecessor to make signature bats for the players. Using “slugger” descriptively to refer to baseball players, the article states, “Today’s sluggers know they’re teaming up not only with our heritage but also our cutting-edge, current day research and technology.”²⁵ Thus, these hard-hitting “sluggers” who contract with Opposer apparently are among the intended users and serve as the endorsers of Opposer’s goods and services. SLUGGER is conceptually weak in the context of Opposer’s baseball-related goods and services, and we find its appropriate scope of protection is quite narrow.

Turning next to Opposer’s LOUISVILLE SLUGGER mark, it combines the term SLUGGER with the geographic place name LOUISVILLE, where Opposer’s museum and factory is located. Therefore, LOUISVILLE SLUGGER also is conceptually weak in the context of baseball-related goods and services.²⁶

²⁴ 11 TTABVUE 7-8.

²⁵ 7 TTABVUE 74.

²⁶ The registration certificates submitted by Opposer reflect that its oldest LOUISVILLE SLUGGER registrations (including those for bats) issued with claims of acquired distinctiveness under Trademark Act Section 2(f), and so the mark was not treated as inherently distinctive. *E.g.*, 1 TTABVUE 39-42; *see also id.* at 49 (later registration under Section 2(f)). Later registrations (including for bats) issued with claims of acquired distinctiveness in part as to LOUISVILLE. *E.g.*, *id.* at 50-52. Other registrations for LOUISVILLE SLUGGER issued without any claim of acquired distinctiveness.

Turning to commercial strength, we find it where “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps.*, 73 USPQ2d at 1694). This type of strength of a mark is measured “along a spectrum from very strong to very weak.” *Id.* (internal citations omitted). Commercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the marks, and other factors such as length of time of use of the marks; widespread critical assessments; notice by independent sources of the goods identified by the marks; and the general reputation of the goods. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength).

As previously noted, we give no probative weight to conclusory testimony with no underlying factual basis, such as that Opposer’s products are “ubiquitous” and “synonymous with the sport of baseball.”²⁷ Surprisingly, Opposer did not provide any sales or advertising figures to support its asserted fame, but offered some fact-based testimony on this factor. Specifically, Mr. Ryan declared:

Some of the Louisville Slugger Marks were registered as early as the 1940s with use in commerce dating back to 1893. For example, U.S. Trademark Registration No. 379405 was filed on July 9, 1940, and U.S. Trademark Registration Nos. 511742 and 512675 were filed on March 29, 1946. With respect to the word mark “SLUGGER®,” it

²⁷ 7 TTABVUE 5 (Ryan Declaration).

was first used in commerce in 1986 and was first registered on Dec. 15, 1993 (see U.S. Trademark Registration No. 1867098). The marks have been in continuous use since that time.²⁸

Many professional athletes, including Major League Baseball players, use Louisville Slugger baseball bats and equipment.... For example, current Major League Baseball stars, such as Ronald Acuna Jr., Vladimir Guerrero Jr., Eloy Jiminez, Evan Longoria, and Kyle Schwarber, use Louisville Slugger-branded baseball bats during professional baseball games.²⁹ Today, Major League Baseball players use Louisville Slugger baseball products during nearly every game.³⁰

Louisville Slugger-branded bats have appeared in countless baseball games, including at the World Series and in the Baseball Hall of Fame.³¹

Louisville Slugger baseball bats and baseball equipment have been sold nationwide for over a century.³²

[Opposer's] 2015 purchase of the brand was featured on the front page of many nationally distributed newspapers, including the Wall Street Journal and USA Today [excerpted in the declaration].³³

On this limited record, we cannot place Opposer's marks at the far end of the spectrum of fame. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) ("Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame

²⁸ *Id.* at 4.

²⁹ *Id.* at 5. We do not consider "[m]ore examples" allegedly provided at the hyperlink in Opposer's Brief, as discussed in the Evidentiary Matters section, above.

³⁰ *Id.* at 6.

³¹ *Id.* at 5.

³² *Id.* at 6.

³³ *Id.*

plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it.”). As to SLUGGER standing alone, Opposer essentially offered no commercial strength evidence, except for the reference to length of use and registration. *See Bose Corp.* 63 USPQ2d at 1308-09 (where independent fame allegations are made for a mark often used in tandem with another term, “it should not be a great burden to substantiate the point,” and consumer awareness and “nature and context of promotion” of the standalone mark are appropriate measures). We therefore do not find any degree of commercial strength for SLUGGER as a standalone mark.

However, as to the LOUISVILLE SLUGGER mark, in connection with bats, the evidence regarding Opposer’s long use and longtime registration, the use of its bats by professional baseball players, the reputation of its products, and notice by independent sources,³⁴ reflect commercial strength. However, particularly given the lack of sales or advertising figures and context, Opposer’s showing falls short of fame. *See Bose Corp.* 63 USPQ2d at 1309 (referring to sales and advertising numbers as “our historic indicia of fame,” and noting that evidence of widespread unsolicited publicity may lend “confirmatory context”). Although the record does not rise to the level of showing fame, it supports commercial strength through consumer exposure to LOUISVILLE SLUGGER for bats. Also, the record includes no third-party use or registration evidence of other similar marks in connection with similar goods that might decrease commercial strength.

³⁴ *Id.* at 3-7 and corroborating exhibits.

Ultimately, we find both marks conceptually weak, and on this record, we cannot find that SLUGGER has any degree of commercial strength, but we find that LOUISVILLE SLUGGER for bats has commercial strength.

D. Similarity of the Marks

Although both Opposer's mark and Applicant's mark include the term "slugger," we do not find them similar overall. Visually and phonetically, Applicant's mark includes three other words, with SLUGGER appearing third, and its less conspicuous placement in the middle of the mark renders it less likely to stand out and be remembered by consumers. *Cf. Palm Bay Imps.*, 73 USPQ2d at 1692; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) ("the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"). Overall, the marks do not look or sound alike because of the additional elements in Applicant's mark.

We also find the marks' connotations and commercial impressions different. The dictionary entries indicate that in the baseball context, a "slugger" refers to a hard-hitting batter or "a player who frequently gets extra-base hits."³⁵ Opposer's witness states that "[t]he words "Runner," "Gunner," and "Derby" also are common baseball terms."³⁶ According to Opposer's Global Product Director for Baseball:

[I]n baseball, the player occupying a base is referred to as a "runner." A baseball fielder who throws hard is said to "gun down" a "runner" and can be referred to as a "gunner."

³⁵ 11 TTABVUE 7-8.

³⁶ 7 TTABVUE 8 (Ryan Declaration).

In baseball, a hitting contest is commonly called a Home Run Derby, or a “derby.”

Considering Applicant’s mark as a whole in the context of his services that involve organizing baseball and softball sporting events, RUNNER GUNNER SLUGGER DERBY would be perceived as referring to a baseball skills competition event (as opposed to a baseball game). By contrast, in Opposer’s SLUGGER mark, the term stands alone, and likely would be perceived as referring to a hard hitter. As noted above, Opposer refers to professional baseball players who use its bats as “sluggers,” and as further illustration, Opposer’s museum and factory website promotes Opposer’s history, noting that its first pro bat was created for Pete Browning, “[a]nd, oh, Pete Browning’s nickname was, ‘The Louisville Slugger.’”³⁷ The overall meanings and impressions of RUNNER GUNNER SLUGGER DERBY, on the one hand, and SLUGGER, on the other hand, differ.

Considering the marks in their entirety, particularly given that Opposer’s SLUGGER mark is not entitled to a broad swath of protection for sports-related goods and services, we find that the marks at issue are not similar in appearance, sound, connotation, or commercial impression. This factor weighs strongly against likely confusion.

E. Variety of Goods and/or Services

“The ninth *DuPont* factor takes into account the variety of goods on which a mark is or is not used.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *15 (citing *DuPont*, 177 USPQ

³⁷ 7 TTABVUE 80.

at 567). “If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant’s related good under a similar mark as an extension of the plaintiff’s line.” *Id.* Given that we have focused on Opposer’s registration for services that overlap with Applicant’s, we need not consider whether related services might be viewed as an “extension” of Opposer’s line of goods and services. We find that this *DuPont* factor is neutral.

F. Other DuPont Factors

Opposer makes brief arguments under other *DuPont* factors.

We agree with Opposer that given the lack of contextual evidence, the absence of actual confusion evidence is not significant, and renders the seventh and eighth *DuPont* factors neutral. *See Cunningham*, 55 USPQ2d at 1847 (approving TTAB finding that “it could not conclude there had even been an opportunity for actual confusion”).

Under the tenth *DuPont* factor, while Opposer acknowledges the lack of evidence regarding the market interface between the parties,³⁸ Opposer argues that this factor favors likely confusion. Most decisions involving this factor address an agreement between the parties that evinces their business-driven conclusion and belief that there is no likelihood of confusion, and weighs heavily in favor of a finding that confusion is not likely. *In re Opus One Inc.*, 60 USPQ2d 1812, 1820 (TTAB 2001); *see also Bongrain Int’l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 USPQ2d

³⁸ We note Mr. Ryan’s testimony that Opposer and Applicant “have never entered into any agreement,” and Opposer “has not consented to [Applicant’s] use of its marks.” 7 TTABVUE 11.

1775, 1778 (Fed. Cir. 1987) (“[I]n trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace, ... such agreements may, depending on the circumstances, carry great weight ...”). Contrary to Opposer’s argument, the absence of such an agreement or evidence does not weigh in favor of likely confusion. We consider the factor neutral.

Under the factor concerning Applicant’s right to exclude others, Opposer points to no evidence, and essentially just argues that it owns longstanding registrations while Applicant only has a pending application. We thus consider this factor neutral. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (factors must be considered when there is evidence on them); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265 (Fed. Cir. 2002) (noting the likelihood of confusion analysis “considers all *DuPont* factors for which there is evidence of record”).

Under the twelfth factor involving the extent of potential confusion, Opposer merely rehashes its overall likelihood of confusion argument and contends the factor weighs in its favor. We consider the factor neutral.

G. Balancing the *DuPont* Factors

Taking into account the appropriate degrees of strength of Opposer’s pleaded marks, we do not find them sufficiently similar to Applicant’s mark, when used on and in connection even with their partially overlapping services, to render confusion likely. In a case where the marks are found to be sufficiently dissimilar, this factor may be dispositive, and it is here. The marks are too different for confusion to be

likely. See *Kellogg Co. v. Pack'em Ent. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive.”); see also *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (despite the fame of Opposer’s marks and virtual identity of services, court upheld Board’s finding of no likelihood of confusion based in large part upon the dissimilarity of the parties’ marks); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed Board determination of no likelihood of confusion where Board relied solely on dissimilarity of marks); *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930 (TTAB 2013) (despite the similarities in the goods, trade channels, and classes of consumers, dissimilar marks makes confusion not likely).

Weighing these factors, and considering the neutrality of the remaining factors, we conclude that confusion is unlikely.

Decision: The opposition is dismissed.