

This Opinion is not a
Precedent of the TTAB

Mailed: August 1, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

New York Yankees Partnership

v.

Matthew Kirschbaum

Opposition No. 91284783

Dale M. Cendali of Kirkland & Ellis LLP
For New York Yankees Partnership.

Todd Wengrovsky of Law Offices of Todd Wengrovsky PLLC
for Matthew Kirschbaum.

Before Zervas, Goodman, and Elgin,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Matthew Kirschbaum (“Applicant”) seeks registration on the Principal Register of the mark DANKEES (in standard characters)¹ identifying “Beanies; T-shirts; Hats; Hoodies; Socks; Sweatpants; Sweatshirts” in International Class 25.

¹ Application Serial No. 97327195 was filed on March 23, 2022 based on Applicant’s assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

New York Yankees Partnership (“Opposer”) opposes registration on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and on the ground of dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c). Opposer pleads ownership of numerous registrations for YANKEES (and YANKEES composite) marks (hereinafter “YANKEES marks”) in International Classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 34, 36, and 41.² Opposer also alleges prior use of YANKEES marks in connection with a wide variety of goods and services, including baseball games and exhibitions and clothing.³

In his answer, Applicant denies the salient allegations in the notice of opposition and asserts various affirmative defenses.⁴ Applicant did not submit any evidence or pursue these defenses during briefing. Accordingly, we deem these defenses waived or forfeited. *JNF LLC v. Harwood Int’l Inc.*, 2022 TTAB LEXIS 328, at *4 n.8 (TTAB 2022); *Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, 2022 TTAB LEXIS 383, at *3 n.5 (TTAB 2022) (citation omitted) (defenses waived because not pursued at trial or briefing).

Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 TTAB LEXIS 199, at *4 n.1.

² Opposer does not set out the registrations or identify the marks separately in the notice of opposition but provides a list: Registration Nos. 1032767, 1073346, 1161865, 1550798, 1542501, 1671731, 2886760, 2843353, 2575644, 2994114, 3022847, 3022848, 3320068, 3320069, 3320070, 3326223, 3326224, 3326225, 3331059, 3345306, 3718515, 4102184, 4189215, and 4210824. Notice of opposition paragraph 3, 1 TTABVUE. The registrations are set out in the ESTTA coversheet which forms part of the pleading. See “Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice,” 81 Fed. Reg. 69950, 69957 (Oct. 7, 2016) (The ESTTA cover sheet is considered part of the complete opposition pleading).

³ Notice of opposition, paragraph 4, 1 TTABVUE.

⁴ Answer, 5 TTABVUE.

Each party filed a trial brief and Opposer filed a reply brief.⁵

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved application. In addition, Opposer introduced the declaration testimony of three witnesses with exhibits, and a notice of reliance: 22-25, 27-32, 33-35 TTABVUE. Confidential declaration testimony is at 26 and 33 TTABVUE, and a confidential exhibit for the notice of reliance is at 36 TTABVUE.⁶

Applicant did not submit any testimony or other evidence during his testimony period. His failure to submit testimony or other evidence in connection with the opposition is not a concession of the case. *Shenzhen IVPS Tech. Co.*, 2022 TTAB LEXIS 383, at *3 (citation omitted).

As plaintiff in the opposition, Opposer bears the burden of proving its entitlement to a statutory cause of action and its Section 2(d) and dilution claims by a preponderance of the evidence. *See B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 144 (2015) (“The party opposing registration bears the burden of proof, see § 2.116(b), and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b)”); *Genesco Inc. v. Martz*, 2003 TTAB LEXIS 123, at *22 (TTAB 2003) (“Opposer, as plaintiff in ... [this] opposition proceeding, bears the burden of

⁵38, 39 and 41 TTABVUE. Opposer’s confidential trial brief and reply brief are at 37 and 40 TTABVUE.

⁶ As extended, Opposer’s testimony period was set to close on November 9, 2024. This was a Saturday. Opposer timely filed its testimony and evidence on November 12, 2024, the next business day after the Veteran’s Day holiday. Trademark Rule 2.196, 37 C.F.R. § 2.196.

proving, by a preponderance of the evidence, its asserted grounds of (i) priority and likelihood of confusion and (ii) dilution.”).

Preliminary matters

As indicated, Opposer pleaded ownership of numerous YANKEES (and YANKEES composite) registrations in the notice of opposition.⁷ During its testimony period, Opposer submitted exhibit A under notice of reliance (Plaintiff’s “NOR” 35 TTABVUE), identifying this exhibit as copies of its pleaded registrations obtained from the USPTO database. However, the copies were neither a current printout from a United States Patent and Trademark Office (“USPTO”) database showing the current status and title of these registrations, nor an “original or photocopy of the registration[s] prepared and issued by the USPTO showing the current status and current title to the registration[s].” Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2). Rather, the registrations submitted are plain copies and have not been made of record under the notice of reliance. *Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 2009 TTAB LEXIS 70, at *9-10 (TTAB 2009) (copy of the certificate of registration issued by the USPTO is not competent evidence to show the “current status of and current title to the registration”). Therefore, Opposer’s registrations for YANKEES marks are not of record by virtue of the plain copies being submitted under the notice of reliance.⁸

⁷ 1 TTABVUE. No exhibits were attached to the notice of opposition.

⁸ We note that none of the certificates of registration were issued reasonably contemporaneous with this proceeding. *Cf. Hard Rock Cafe Int’l (USA) Inc. v. Elsea*, 2000

Opposer's witnesses also testified about Opposer's ownership of "YANKEES marks" but did not testify as to the current status of the pleaded registrations.⁹ This testimony does not establish the current status of Opposer's registrations and is insufficient to make the registrations of record.

Lastly, Opposer also submitted under notice of reliance Applicant's responses to requests for admissions.¹⁰ Applicant admitted in response to a request for admissions that Opposer is the owner of the identified registrations.¹¹ However, Opposer has not obtained admissions as to the current status of its registrations—that they are valid and subsisting. This admission does not establish the status of Opposer's registrations. Therefore, we find the pleaded registrations are not of record.

We also note that exhibit G (Plaintiff's NOR, 36 TTABVUE) of the notice of reliance consists of the discovery deposition transcript of Applicant. The entirety of the discovery deposition transcript has been designated as confidential, although the exhibits have been provided unsealed. As much (if not all) of this testimony is not confidential, this is an overdesignation. Therefore, in rendering our decision, we will

TTAB LEXIS 577, at *21 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous with filing of notice of opposition).

⁹ Declaration of Sarah Horvitz, Senior Vice President and Head Counsel, Business and Technology for the Office of the Commissioner of Baseball and Senior Vice President, Assistant Secretary for MLB Advanced Media, Inc. (Horvitz declaration) paragraph 6, 22 TTABVUE; Declaration of Denis Nolan, Senior Vice President and Head Counsel, Business and Technology for the Office of the Commissioner of Baseball and Senior Vice President, Assistant Secretary for MLB Advanced Media, Inc., (Nolan declaration), paragraph 7, 27 TTABVUE; Declaration of Lonn A. Trost, Chief Operating Officer of New York Yankees Partnership, owner of the New York Yankees Major League Baseball club, (Trost declaration), paragraph 5, 31 TTABVUE.

¹⁰ Plaintiff's NOR, 35 TTABVUE 75, 80, exhibits D & E.

¹¹ *Id.* (response to request for admissions no. 1).

not be bound by this designation; in this opinion, we will treat only testimony and evidence that is truly confidential or commercially sensitive as confidential. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 2010 TTAB LEXIS 84, at *6-8 (TTAB 2010).

Other testimony relating to commercially sensitive or confidential information of Opposer has been redacted from Opposer's witnesses' testimony and filed publicly, with unredacted declarations filed confidentially. We refer to this redacted information generally. See e.g., *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 2016 TTAB LEXIS 100, at *11 n.21 (TTAB 2016).

II. Statutory Entitlement

In every inter partes case, the plaintiff must establish its statutory entitlement to bring an opposition or cancellation proceeding. To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, at *4 (Fed. Cir. 2020). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at *7-8.

Opposer's three witnesses testified that "[f]or over 100 years, Opposer and its predecessors, and their affiliated and related entities, licensees and/or sponsors, have extensively and continuously used trademarks comprising or containing the word

YANKEES in connection with baseball games and exhibition services, as well as a wide variety of goods and other services, including apparel.”¹²

Opposer’s witness testimony is sufficient to establish Opposer’s direct commercial interest and real interest in the proceeding and its reasonable belief in likely damage, establishing its entitlement to oppose registration of Applicant’s trademark under Section 2(d). *See, e.g., Panda Travel, Inc. v. Resort Option Enters.*, 2009 TTAB LEXIS 708, at *13-14 (TTAB 2009) (testimony that opposer has used the mark PANDA TRAVEL continuously since June 1981 to identify its travel agency services sufficient to prove entitlement to bring Section 2(d) claim); *Automedx, Inc. v. Artivent Corp.*, 2010 TTAB LEXIS 343, at *5 (TTAB 2010) (testimony that opposer has been manufacturing and selling portable ventilators sufficient to prove [entitlement] to bring 2(d) claim).¹³ Once statutory entitlement is sufficiently alleged (and established) for one claim, it is established for all asserted claims. *Corporacion Habanos SA v. Rodriguez*, 2011 TTAB LEXIS 258, at *15 (TTAB 2011).

¹² Horvitz declaration, paragraph 5, 22 TTABVUE. *See also* Trost declaration, paragraph 4, 31 TTABVUE (“Since 1920, ... Opposer and its predecessors, and their affiliated and related entities, licensees, and/or sponsors have extensively and continuously used trademarks comprising or containing the word YANKEES in connection with baseball games and exhibition services, as well as a wide variety of goods and other services, including apparel.”); Nolan declaration, paragraph 6, 27 TTABVUE (“Since at least 1921, ... Opposer and its predecessors, and their affiliated and related entities, licensees, and/or sponsors have extensively and continuously used trademarks comprising or containing the word ‘Yankees’ in connection with baseball games and exhibition services, as well as a wide variety of goods and other services, including apparel and headwear.”). Also, Applicant admitted in his answer that “Opposer is the owner of the renowned NEW YORK YANKEES MAJOR LEAGUE BASEBALL club (the ‘Club’).” Notice of opposition, paragraph 1; 1 TTABVUE; Answer, paragraph 1, 5 TTABVUE.

¹³ Prior terminology referred to statutory entitlement as standing.

III. Priority

In an opposition under Section 2(d), priority may be satisfied with a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002).

As indicated, Opposer's pleaded registrations are not of record but Opposer also pleaded common law rights. To establish its priority, Opposer must establish its ownership and prior use, under common law, of a distinctive, inherently or otherwise, mark in connection with its pleaded goods and services ("baseball games and exhibition services and a wide variety of goods and services, including, but not limited to, clothing, hats, caps, hoodies, jerseys, shirts, sweatshirts, t-shirts, socks, and footwear").¹⁴ *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, (CCPA 1981). Because there is no argument or evidence of record to indicate otherwise, we find Opposer's YANKEES marks are inherently distinctive. *DowntownDC Bus. Improvement Dist. v. Clarke*, 2024 TTAB LEXIS 412, at *37 (TTAB 2024).

In determining whether Opposer has shown prior use, "one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use." *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 1125-26 (Fed. Cir. 1994). "Oral [or declaration] testimony, if sufficiently probative, is normally satisfactory to establish priority of use ... and the testimony of

¹⁴ Notice of opposition, paragraph 4, 1 TTABVUE.

a single witness may be adequate to establish priority.” *DeVivo v. Ortiz*, 2020 TTAB LEXIS 15, at *8 (TTAB 2020) (citations omitted). *See also Araujo v. Framboise Holdings Inc.*, 99 F.4th 1377, 1380-81 (Fed. Cir. 2024) (declaration testimony sufficiently “clear, convincing, and uncontradicted” to establish priority date).

Applicant relies on his intent-to-use application filing date, the constructive use date, as his priority date.¹⁵ *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 2013 TTAB LEXIS 439, at *13 (TTAB 2013). Therefore, Opposer’s burden is to demonstrate by a preponderance of the evidence proprietary rights in YANKEES marks prior to the March 23, 2022 filing date of Applicant’s application. *Standard Knitting Ltd. v. Toyota Jidosha K.K.*, 2006 TTAB LEXIS 9, at *40 (TTAB 2006),

All of Opposer’s witnesses provided much testimony relating to Opposer’s long use for over a century of YANKEES marks in connection with baseball games,¹⁶ including Mr. Trost, who testified about Opposer’s extensive and continuous use of trademarks comprising or containing the word YANKEES in connection with baseball games and exhibition services.¹⁷ Opposer’s witness Mr. Nolan discussed the many decades long successful and ongoing merchandising and licensing program for Opposer’s YANKEES marks for a variety of merchandise, including apparel (i.e., t-shirts, hats, beanies, socks, sweatshirts, sweatpants, and hoodies) and headwear goods, also

¹⁵ As indicated, Applicant did not submit any trial evidence to establish an earlier priority date.

¹⁶ Horvitz declaration, paragraphs 5, 9, 10, 13, 16-26, 28-31, 22 TTABVUE and exhibits; Trost declaration, paragraphs 4, 6-9, 12, 14, 16, 18-26, 31 TTABVUE and exhibits; and Nolan declaration, paragraphs 6, 8, 27 TTABVUE and exhibits.

¹⁷ Trost declaration, paragraphs 7-9, 12, 14-20, 22-23, 25-26, 28-29, 31 TTABVUE and exhibits.

discussing sponsorships across industries involving the YANKEES marks.¹⁸ Mr. Nolan provided representative examples of internet websites selling merchandise, including apparel, offered in connection with YANKEES marks between 2010 and 2024, as well as catalogs dating back to 1990 that were selling or offering to sell licensed YANKEES branded merchandise including apparel and headwear.¹⁹ Opposer's witness Ms. Horvitz also testified as to her awareness (since 2009) of Opposer selling a wide variety of YANKEES branded apparel (including caps, short- and long-sleeve shirts, jackets, jerseys, sweatshirts, sweatpants, hoodies, sweaters, hats, headbands, socks, and other apparel).²⁰ She provided examples of this use and total sales information (confidential) for apparel goods between the years 2010-2023 from the Yankees Shop website.²¹ Mr. Trost also discussed Opposer's selling of apparel bearing YANKEES marks through Major League Baseball-affiliated websites, third-party retailers, and Yankees Team Store retail outlets.²²

In addition, Applicant admitted Opposer's rights in Opposer's YANKEES marks predate the filing date of his application,²³ and Applicant's discovery deposition testimony indicates his awareness of Opposer's use of YANKEES in connection with

¹⁸ Nolan declaration paragraphs 10, 11, 12, 13, 14, 27 TTABVUE.

¹⁹ Nolan declaration paragraphs 16, 17, 18, and exhibits, 27 TTABVUE.

²⁰ Horvitz declaration, paragraphs 3, 45, 46, 22 TTABVUE.

²¹ Horvitz declaration, paragraphs 39, 45, 46, 22 TTABVUE.

²² Trost declaration, paragraphs 28, 29, 30, 31, 31 TTABVUE. Mr. Trost's declaration includes images of the Yankees retail store from the exterior showing clothing being displayed for purchase inside the store.

²³ Plaintiffs, NOR 35 TTABVUE 75 and 80.

baseball games, t-shirts, and hats prior to Applicant's application filing date.²⁴ We consider this testimony to be an acknowledgement of Opposer's prior rights in YANKEES marks in connection with baseball games, t-shirts and hats.

In sum, the probative testimony and evidence as a whole relating to Opposer's use of YANKEES marks before Applicant's March 23, 2022 filing date, as well as Applicant's admissions of Opposer's prior use as to baseball games, t-shirts, and hats, is sufficient to establish Opposer's priority in connection with baseball and apparel (including t-shirts, hats, beanies, socks, sweatshirts, sweatpants, and hoodies) and headwear goods.

IV. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors").

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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."). We discuss the *DuPont* factors for which there is relevant argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019) (the Board considers each

²⁴ Kirschbaum discovery deposition, Plaintiff's NOR, 36 TTABVue (confidential).

DuPont factor for which there is evidence and argument); *see also Herbko Int'l*, 308 F.3d at 1164 (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”).

A. Similarity or Dissimilarity of the Goods

Under the second *DuPont* factor we consider the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont* 476 F.2d at 1361.

Where, as here, Opposer is relying on common law use of its YANKEES marks, consideration of the question of likelihood of confusion must be confined to the specific goods or services on which the mark has been used. *See DowntownDC Bus. Improvement Dist.*, 2024 TTAB LEXIS 412, *71. Thus, we base our evaluation on Opposer’s prior established use of YANKEES marks on goods that overlap with the goods identified in Applicant’s application, which in this case, are apparel goods and headwear. It is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

As discussed above, Opposer has established prior use of YANKEES marks with t-shirts, hats, beanies, socks, sweatshirts, sweatpants, and hoodies. Applicant’s

identified goods are “Beanies; T-shirts; Hats; Hoodies; Socks; Sweatpants; Sweatshirts.” The parties’ goods are identical.²⁵

This factor supports a conclusion that confusion is likely.

B. Similarities or Dissimilarities in Channels of Trade, Classes of Consumers and Conditions of Sale

We consider the “similarity or dissimilarity of established, likely-to-continue trade channels,” and the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361.

As to trade channels and classes of consumers, because Opposer relies on its common law rights, for purposes of this analysis, Opposer can claim only those channels of trade and classes of consumers which it has established on the record. *DowntownDC Bus. Improvement Dist.*, 2024 TTAB LEXIS 412, at *72-73. We cannot rely on a presumption that because apparel and headwear goods of the parties are identical they move in the same channels of trade and are provided to the same classes of purchasers. *Bell’s Brewery, Inc. v. Innovation Brewing*, 2017 TTAB LEXIS 452, at *12 (TTAB 2017) (no presumptions attach to unregistered common law mark).

According to witness testimony, Opposer’s consumers are baseball fans who are part of the general public.²⁶ Applicant’s interrogatory response indicates that his target market will be “any consumers interested in T-shirts, sweatshirts, hoodies,

²⁵ In Applicant’s discovery deposition, he acknowledged that at least “hats” were identical goods and that the apparel sold by Opposer is “similar” to his listed goods. Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

²⁶ Horvitz declaration, paragraphs 23 and 34, 22 TTABVUE.

pants, hats, and socks.”²⁷ Additionally, in his discovery deposition testimony, Applicant confirmed that his clothing could be sold to all ages, genders and “sold to anyone.”²⁸

Opposer’s witnesses testified that its apparel goods are offered through catalogs, the Major League Baseball website, websites of individual Major League Baseball clubs, in-stadium concessionaries, New York Yankees Team store retail outlets, and third-party retail locations (online and brick and mortar), including, among others, national chains such as Walmart, Target, JC Penney, and Dick’s Sporting Goods.²⁹

Applicant’s interrogatory response states that Applicant plans to offer the goods online and possibly in brick and mortar retail locations.³⁰ During Applicant’s discovery deposition testimony, Applicant agreed that the same type of clothing as his identified goods could be sold online and in brick and mortar locations.³¹

Applicant argues he is not a competitor, and that he never intended to sell his goods at Opposer’s stadium nor “at the same places as Opposer’s products.”³²

However, Applicant’s identification is unrestricted as to trade channels and classes of consumers. When an application’s identification of goods does not limit how the goods are sold or to whom, we presume that they are sold “in all normal trade

²⁷ Plaintiff’s NOR, interrogatory response no. 12, 35 TTABVUE 62.

²⁸ Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

²⁹ Horvitz declaration, paragraph 34, 22 TTABVUE; Nolan declaration, paragraph 15, 27 TTABVUE.

³⁰ Plaintiff’s NOR, interrogatory response no. 15, 35 TTABVUE 63.

³¹ Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

³² Def’s brief, 39 TTABVUE 12.

channels to all the normal classes of purchasers” for such goods. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1308 (Fed. Cir. 2018) (citation omitted). Therefore, we must presume that that Applicant offers his clothing goods identified in the application to all potential consumers (i.e., adults and children) and in all the normal trade channels such as brick and mortar retail locations where clothing is sold and online retailers where clothing is sold. Applicant acknowledges this in his testimony and interrogatory responses.

We find that the parties’ trade channels and classes of consumers overlap. *Look Cycle Int’l v. Kunshan Qiyue Outdoor Sports Goods Co.*, 2024 TTAB LEXIS 289, *13 (TTAB 2024) (common law trade channels overlap with Respondent’s presumed trade channels).

Turning to conditions of sale, we must make our determination based on the least sophisticated consumer. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014) (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires consumer care for likelihood of confusion decision to be based “on the least sophisticated potential purchasers”). A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992). Conversely, impulse purchases of inexpensive items may tend to have the opposite effect, increasing the likelihood of confusion. *Recot Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000).

Opposer argues this factor weighs in its favor because clothing is inexpensive and subject to impulse purchasing,³³ while Applicant argues that this factor is neutral “because Kirschbaum’s proposed goods are not [impulse] items that a consumer would quickly grab at a supermarket checkout or the like, the consumers will certainly have time to see the differences between the respective marks before placing online orders.”³⁴ Applicant also argues regardless of the pricing of the goods, consumers would recognize the differences in the marks and Applicant would not use imagery associated with Opposer.³⁵ Opposer responds that Applicant does not have support for his position that the goods are not impulse items.³⁶

As to Opposer’s apparel and headwear goods, Opposer’s witnesses did not provide any testimony as to the pricing but the internet pages show on their face the prices which would be provided to consumers. As to purchasing conditions, Opposer’s witness did not discuss purchasing conditions, and Applicant’s discovery deposition testimony on this point is not illuminating.³⁷

Although Mr. Kirchbaum did testify about the potential price range for some of his products (t-shirts and hats),³⁸ our consideration of this factor is based on the goods

³³ Pl’s brief, 38 TTABVUE 34.

³⁴ Def’s brief, 39 TTABVUE 15. Another of Applicant’s interrogatory responses stated that “[g]iven the prices at which the products would be sold, and given the way that they would be sold, consumers would be sophisticated enough to not think that there is any affiliation between the Applicant and the Opposer.” Plaintiff’s NOR, interrogatory response no. 23, 35 TTABVUE 66.

³⁵ Def’s brief, 39 TTABVUE 15.

³⁶ Pl’s reply brief, 41 TTABVUE 17.

³⁷ Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

³⁸ Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

as identified in the application which are unrestricted. Therefore, we must assume that Applicant's unrestricted goods are sold at all prices ranges, from very inexpensive to expensive, and to all types of buyers. Applicant's interrogatory response does indicate that there is an "ordinary level" of care for purchasers of clothing.³⁹

The purchasers of the parties' respective clothing goods comprise the general public, and these ordinary consumers would use nothing more than ordinary care in making their purchasing decisions. The price range mentioned by Applicant for some of the clothing items is relatively inexpensive and may be bought on impulse by these consumers. *Recot*, 214 F.3d at 1329 (products that are relatively low-priced and subject to impulse buying); *Sock It To Me, Inc. v. Fan*, 2020 TTAB LEXIS 201, at *25 (TTAB 2020) (goods identified as "socks" are purchased by general consumers and encompass "socks that are relatively inexpensive" and may be subject to impulse purchases).

Because of the lack of price restrictions in Applicant's identification, which could include inexpensive clothing items, there is the potential for "impulse purchasing" of products at a relatively low price point by ordinary consumers.

The factors relating to trade channels, classes of consumers and sophisticated purchasers support a conclusion that confusion is likely.

³⁹ Plaintiff's NOR, interrogatory response no. 13, 35 TTABVUE 62-63.

C. Strength

1. Commercial Strength

The fifth factor considers the fame of the prior mark (sales, advertising, length of use). *DuPont* 476 F.2d at 1361. Opposer asserts that its YANKEES marks are famous.⁴⁰

Fame for likelihood of confusion purposes arises as long as a significant portion of the relevant consuming public recognizes the mark as a source indicator. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1375 (Fed. Cir. 2005). “[L]ikelihood of confusion fame varies along a spectrum from very strong to very weak.” *Id.* at 1375 (internal quotation and citation omitted). “A mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992).

Strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods and services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods and services identified by the marks; and the general reputation of the goods and services. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 2014 TTAB LEXIS 2, at *18-19 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength).

⁴⁰ Pl’s brief, 38 TTABVUE 35.

Opposer, the owner of the New York Yankees Major League Baseball Club (the Club), has used the name New York Yankees since 1913 and used trademarks comprising or containing the word YANKEES (“YANKEES marks”) since 1920 in connection with baseball and exhibition games.⁴¹ The Club is extremely successful, having made forty-one World Series championship appearances and won twenty-seven World Series titles; it is consistently ranked as one of the most valuable sports team franchises (\$1.77 billion in value).⁴² According to Mr. Trost, the Club is “the winningest franchise in MAJOR LEAGUE BASEBALL history and of all professional sports in the United States.”⁴³

In addition to the millions of fans over the years who have watched the Club’s games in person, for decades, millions more fans have been reached through radio and television broadcasting.⁴⁴ Many of the Club’s televised games are nationally broadcast, and the Club’s games are also available through various streaming platforms, providing massive consumer exposure.⁴⁵ The YANKEES marks are extensively used and displayed in a variety of ways during the games at the stadium

⁴¹ Horvitz declaration, paragraphs 5, 9, 10, 13, 16, 22 TTABVUE; Nolan declaration, paragraph 6, 27 TTABVUE; Trost declaration, paragraph 4, 31 TTABVUE.

⁴²) Horvitz declaration, paragraph 12, 22 TTABVUE; Nolan declaration, paragraphs 8, 20, 27 TTABVUE.

⁴³ Trost declaration, paragraph 8, 31 TTABVUE.

⁴⁴ Horvitz declaration, paragraphs 23, 24, 26, 22 TTABVUE; Trost declaration, paragraphs 19, 20, 31 TTABVUE.

⁴⁵ Horvitz declaration, paragraphs 23-31, 22 TTABVUE; Trost declaration, paragraphs 20, 22, 31 TTABVUE.

and through the various broadcast platforms.⁴⁶ The Club and its games are routinely covered by national and local broadcasts and cable programs that feature sports news coverage (ESPN, FOX, CBS, NBC, ABC and CNN), as well as dedicated sports news programs and channels.⁴⁷ The Club also has had frequent unsolicited media coverage through local and national print media such as The New York Times, Sports Illustrated, the Washington Post, other major newspapers, and national magazines, including Esquire and People.⁴⁸ References to the Club have often appeared in film, television programs, and the dramatic arts.⁴⁹ The Club's success and recognition has contributed to a high nationwide demand by fans for baseball games and merchandise associated with the Club.⁵⁰ Fans show their support and allegiance with the Club by owning or wearing clothing bearing Opposer's YANKEES marks.⁵¹

For decades, the YANKEES Marks have been licensed in connection with national and local sponsorships spanning numerous industries, which accounts for tremendous revenue.⁵² Apparel is the largest category of licensed merchandise sold, and the Club is consistently in the top three of Major League Baseball Clubs in terms

⁴⁶ Trost declaration, paragraphs 14-16, 22-26, 31 TTABVUE; Horvitz declaration, paragraphs 26, 29, 22 TTABVUE.

⁴⁷ Trost declaration, paragraph 22, 31 TTABVUE.

⁴⁸ Trost declaration, paragraph 18, 36, 31 TTABVUE.

⁴⁹ Trost declaration, paragraph 37, 31 TTABVUE.

⁵⁰ Horvitz declaration, paragraph 12, 22 TTABVUE; Nolan declaration, paragraph 10, 27 TTABVUE; Trost declaration, paragraph 32, 31 TTABVUE.

⁵¹ Nolan declaration, paragraph 10, 27 TTABVUE.

⁵² Horvitz declaration, paragraph 32, 22 TTABVUE; Nolan declaration, paragraph 21, 27 TTABVUE.

of merchandise sales.⁵³ The Club has licenses with numerous apparel sponsors.⁵⁴ In addition, aside from apparel, due to high consumer demand, an immense range of other goods have been also sold under YANKEES Marks.⁵⁵ Since 2010, Opposer has spent very large sums (confidential) on brand paid and in-kind trade advertising, including television, digital, out-of-home, print outlets, and radio.⁵⁶ The Club maintains a website that is heavily trafficked and maintains a social media presence on Facebook, X (formerly Twitter), Instagram, SnapChat and TikTok.⁵⁷ Opposer has successfully enforced the Club's rights in opposition proceedings against third parties seeking to register trademarks confusingly similar to YANKEES marks.⁵⁸

In addition, Applicant has admitted that "Opposer is well known"⁵⁹ and Applicant's brief states:

Kirschbaum admits that some of the Opposer's marks are famous. Kirschbaum likewise admits that many consumers have been exposed to Opposer's marks for many years." ... Likewise, Kirschbaum does not dispute that Opposer's mark has been widely-promoted.⁶⁰

⁵³ Horvitz declaration, paragraph 46, 22 TTABVUE; Nolan declaration, paragraph 13, 27 TTABVUE.

⁵⁴ Horvitz declaration paragraphs 33, 35, 22 TTABVUE; Nolan declaration, paragraphs 11, 14, 27 TTABVUE; Trost declaration, paragraphs 38, 39, 31 TTABVUE.

⁵⁵ Horvitz declaration, paragraph 47, 22 TTABVUE; Nolan declaration, paragraphs 12, 17, 27 TTABVUE; Trost declaration, paragraph 27, 31 TTABVUE.

⁵⁶ Trost declaration, paragraph 32, 31 TTABVUE.

⁵⁷ Horvitz declaration, paragraphs 38-40, 42, 44, 22 TTABVUE; Trost declaration, paragraphs 34-35, 31 TTABVUE.

⁵⁸ Horvitz declaration, paragraphs 48-50, 22 TTABVUE.

⁵⁹ Plaintiff's NOR, (response to request for admission no. 4), 35 TTABVUE 75, 80.

⁶⁰ Def's brief, 39 TTABVUE 13.

Most of the fame evidence centers on the YANKEES baseball team. Based on the entirety of the evidence of record, the YANKEES mark is commercially strong, falling on the higher end of the spectrum. Considering the volume and nature of the fame evidence, we further find that the fame of the YANKEES mark extends beyond just baseball and transfers to the apparel goods we find most relevant to this proceeding.

This factor supports a conclusion that confusion is likely.

2. Third-party Registrations or Third-party Use

The sixth *DuPont* factor considers “the number and nature of similar marks in use on similar goods [or services].” *DuPont*, 476 F.2d at 1361. Opposer argues this factor weighs in its favor.⁶¹

Because Applicant did not submit any evidence, the record includes no current third-party use evidence of YANKEES or other similar marks in connection with similar goods and services that could detract from the strength of Opposer’s common law YANKEES marks. Applicant also presents no arguments concerning the conceptual strength of Opposer’s common law YANKEE marks.

Lacking any relevant evidence, this factor is neutral. *L.C. Licensing, Inc. v. Berman*, 2008 TTAB LEXIS 756, at *20 (TTAB 2008).

D. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor focusing on the similarity or dissimilarity of the marks, keeping in mind that commercially strong marks receive a broader scope of protection than other marks. *Kenner Parker Toys Inc.*, 963 F.2d at 353 (“A

⁶¹ Pl’s brief, 38 TTABVUE 39-40.

strong mark ... casts a long shadow which competitors must avoid. ... Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls."). Given the commercial strength of Opposer's YANKEES mark, the Trademark Act's tolerance for similarity between the marks is low.

We consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps.*, 396 F.3d at 1371 (citing *DuPont*, 476 F.2d at 1361). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re Davia*, 2014 TTAB LEXIS 214, at *4 (TTAB 2014). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) The focus is on the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 2014 TTAB LEXIS 166, at *17 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 1975 TTAB LEXIS 236, at *6 (TTAB 1975).

Additionally, we bear in mind that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion

of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992).

Opposer’s common law rights are for the mark as actually used, *DowntownDC Bus. Improvement Dist. v. Clarke*, 2024 TTAB LEXIS 412, at *67, which is in a simple block font or cursive lettering styles, sometimes with a design, and often with other letters or wording, such as shown below:⁶²



We focus on Opposer’s YANKEES marks without additional wording or design as those are closest to Applicant’s mark.

Applicant’s mark is DANKEES and Opposer’s mark is YANKEES.

Applicant’s mark is in standard character format, not limited to any particular font style, size, or color, and might well be displayed in the lettering styles used by

⁶² Trost declaration, paragraph 34, 40, 31 TTABVUE and exhibits; Horvitz declaration, 22 TTABVUE 51, and exhibits; Nolan declaration, Exhibit A, 27 TTABVUE.

Opposer. Trademark Rule 2.52, 37 C.F.R. § 2.52; *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1349 (Fed. Cir. 2011).

Both marks share the same the six letters “ANKEES,” differing only by the first letter in each mark (“Y” and “D”) and appear similar. As to similarity of sound, it is reasonable to conclude that the marks may be pronounced similarly because they share a similar structure and could well be accorded a similar sound and cadence. Regardless of the pronunciation of the first letter in each mark, the remainder of the marks will be pronounced the same; Applicant admits the marks rhyme.⁶³

As noted above, the average purchaser normally retains a general rather than a specific impression of trademarks, and marks must be considered in light of the fallibility of memory. *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (citation omitted). Although Applicant argues that the marks differ in sound and appearance due to the beginning letter in each mark,⁶⁴ we find the marks similar in appearance and sound. *See e.g., Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 731 (CCPA 1968) (BEEP and VEEP phonetically similar and visually similar); *Am. Cyanamid Co. v. U.S. Rubber Co.*, 356 F.2d 1008, 1008 (CCPA 1966) (CYGON and PHYGON phonetically similar in sound and similar in spelling); *Inter IKEA Sys. B.V. v. Akea, LLC*, 2014 TTAB LEXIS 166, at *20 (IKEA and AKEA similar); *Apple Computer v. TVnet.net Inc.*, 2007 TTAB LEXIS 80, at *9-10 (TTAB 2007) (letter “v”

⁶³ Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

⁶⁴ Def’s brief, 39 TTABVUE 10. Applicant’s interrogatory response states: “The difference in spelling is sufficient to distinguish the marks, and the difference in sound is sufficient to distinguish the mark.” Plaintiff’s NOR, interrogatory response nos. 18 and 19, 35 TTABVUE 64-65.

in VTUNES is insufficient to distinguish the dominant portions of the parties' ITUNES and VTUNES marks); *Interlego AG v. Abrams/Gentile Ent. Inc.*, 2002 TTAB LEXIS 200, at *3 (TTAB 2002) (many adults and children would not notice the very minor difference between LEGO and MEGO).

As to connotation and commercial impression, Opposer's mark is a known word, while Applicant's mark is coined term with no dictionary meaning.⁶⁵ Applicant explained that his mark will cause the user to think of "dank," which is a slang term meaning cool, and the addition of "ee" is a diminutive, or playful ending that creates a different connotation from Opposer's mark.⁶⁶ Opposer put evidence into the record that "dank" is slang for marijuana and infringing third-parties (for which Opposer took enforcement action) have used DANKEES, some with cannabis references.⁶⁷ Applicant argues in his brief that differences in connotation of the parties' marks should be enough for a determination of no likelihood of confusion.⁶⁸

However, although the marks have different connotations (or for Applicant's mark, no connotation), "similarity in any one of the elements of sound, appearance, meaning, or commercial impression is sufficient to support a determination of

⁶⁵ Applicant's interrogatory response is that "[t]he term has no particular meaning." Plaintiff's NOR, interrogatory response no. 7, 35 TTABVUE 61.

⁶⁶ Def's brief, 39 TTABVUE 12. Applicant testified: "[I]t basically came from the word dank; and then we just — like if we were like referring to someone wearing something, you know, nice, they walked in the park, we'd just call them Dankees, you know. We'd say, Oh, that's dank, so Dankees." Kirschbaum discovery deposition, Plaintiff's NOR, 36 TTABVUE (confidential).

⁶⁷ Dictionary definition, Dictionary.com, Plaintiff's NOR, 35 TTABVUE, 8, 86; Horvitz declaration paragraph 50, 22 TTABVUE.

⁶⁸ Def's brief, 39 TTABVUE 11, 12.

likelihood of confusion.” See *Krim-Ko Corp.*, 390 F.2d at 731-32 (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion”; BEEP and VEEP have different connotations, and slightly different spellings but the “dominant factor for consideration is the likelihood of confusion arising from the similarity in sound of the two words when spoken”); *In re White Swan, Ltd.*, 1988 TTAB LEXIS 37, at *3 (TTAB 1988) (“In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar’”) (citations omitted)); *Gen. Foods Corp. v. Wis. Bottling, Inc.*, 1976 TTAB LEXIS 17, at *8 (TTAB 1976) (TING and TANG similar; although the words “have specifically different meanings, they obviously look alike and sound alike, the only difference being the vowels ‘i’ and ‘a.’”).

Moreover, even assuming the marks convey completely different meanings, we find that given the commercial strength of Opposer’s YANKEES marks, the similarities in appearance and sound outweigh any differences in meaning. Lastly, as noted above, where the goods are legally identical as they are here, the similarity between the marks which is necessary to support a finding that the marks are similar is less than it would be if the goods were less similar. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d at 877.

The first factor supports a conclusion that confusion is likely.

E. Actual Confusion

Both parties indicate that there has been no actual confusion. Applicant argues that this factor weighs in his favor,⁶⁹ while Opposer argues this factor is not relevant because Applicant has not meaningfully used the mark.⁷⁰

The eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361. We “look at actual market conditions, to the extent there is evidence of such conditions of record.” *See In re Guild Mtg. Co.*, 2020 TTAB LEXIS 17, at *19 (TTAB 2020). If there has been appreciable and continuous use by an applicant of its mark for a significant period of time in the same markets as those served by an opposer, absence of any reported instances of confusion is probative. *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 2010 TTAB LEXIS 40, at *50 (TTAB 2010).

Applicant’s interrogatory response indicates that he made sample shirts at the time he filed his trademark application for DANKEES.⁷¹ He sold this DANKEES branded merchandise samples (hats and t-shirts) at popup events in Manhattan, New York around that time.⁷² Aside from the limited clothing sale of the sample items, Applicant has not done any other product development, other than look up wholesale pricing.⁷³

⁶⁹ Def’s brief, 39 TTABVUE 15.

⁷⁰ Pl’s reply brief, 41 TTABVUE 20.

⁷¹ Plaintiff’s NOR, Interrogatory response no. 14, 35 TTABVUE 36.

⁷² Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential)

⁷³ Kirschbaum discovery deposition, Plaintiff’s NOR, 36 TTABVUE (confidential).

Because of the more limited nature of Applicant's activities, we find the evidence of concurrent use based on actual market conditions does not indicate a significant opportunity for confusion to occur. *Keystone Consol. Indus. v. Franklin Inv. Corp.*, 2024 TTAB LEXIS 290, at *78-79 (TTAB 2024); *In re Guild Mortg.*, 2020 TTAB LEXIS 17, at *25 ("there is a lack of evidence that in the actual marketplace, the same consumers have been exposed to both marks for the respective services, such that we could make a finding as to the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion").

This factor is neutral.

F. Variety of Goods on which the Mark is Used

The ninth *DuPont* factor considers "[t]he variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)." *DuPont*, 476 F.2d at 1361.

With respect to this factor, 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. *DeVivo*, 2020 TTAB LEXIS 15, at *44. However, evidence regarding the relationship between the goods under *DuPont* factor nine is not necessary where, as here, the goods are identical. *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *59 (TTAB 2022) ("Given the relatedness of the parties' identified goods, we find it unnecessary to rely on this factor.")

This factor is neutral. *Id.*

G. Extent of Potential Confusion

The twelfth *DuPont* factor “discusses ‘[t]he extent of potential confusion, i.e., whether de minimis or substantial.’” *DuPont* 476 F.2d at 1361.

Opposer argues “likelihood of confusion here is substantial” and references the other *DuPont* factors to support this position (the same goods, same consumers, same channels of trade, impulse purchasing, similar mark, and Opposer’s fame under *DuPont* factors 1-5).⁷⁴

Essentially, as the basis for its twelfth *DuPont* factor argument, Opposer references arguments made under the other *DuPont* factors that we have already considered. The twelfth factor is a separate factor; it is not a means to “supercharge” our findings on other factors (i.e., here the first, second, third, fourth and fifth factors). In cases where we find some factor or factors relatively more important, we simply weigh or balance them more heavily in the final step of assessing the factors to determine whether confusion is likely.

This factor is neutral.

H. Any Other Established Fact Probative of the Effect of Use

The thirteenth *DuPont* factor considers “[a]ny other established fact probative of the effect of use.” *DuPont* 476 F.2d at 1361. Under the miscellaneous thirteenth *DuPont* factor, we consider any other evidence in the record which is pertinent to our likelihood of confusion determination.

⁷⁴ Pl’s brief, 38 TTABVue 40.

Applicant argues that there is no evidence of bad faith,⁷⁵ but Opposer argues that Applicant's intent is a neutral factor.⁷⁶ However, "while evidence of bad faith adoption typically will weigh against an applicant, good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion." *Major League Baseball Players Ass'n v. Chisena*, 2023 TTAB LEXIS 117, at *72 (TTAB 2023) (quoting *Eveready Battery Co. v. Green Planet, Inc.*, 2009 TTAB LEXIS 490, at *16 (TTAB 2009)).

Opposer argues that an additional consideration is the connotation of "dank" and "dankees." As already indicated, according to Opposer, "dank" is a slang term for marijuana, which is closely related Cannabidiol (CBD), and Major League Baseball has licensed many of its marks for use with CBD products for several major league ball clubs.⁷⁷ Opposer also points to third parties attempting to use DANKEES (with some referencing marijuana use) on merchandise as a reference to the New York Yankees Club and marijuana, which Opposer stopped as infringing uses.⁷⁸ Opposer argues that the infringing third-party uses establish that the public associates DANKEES with Opposer.⁷⁹

⁷⁵ Def's brief, 39 TTABVUE 14.

⁷⁶ Pl's reply brief, 41 TTABVUE 21.

⁷⁷ Pl's brief, 38 TTABVUE 41. Dictionary definition, see note 67; Horvitz declaration, paragraph 36, 22 TTABVUE. Opposer is not listed in the Horvitz declaration as having licensed YANKEES marks for products that contain CBD.

⁷⁸ Pl's brief, 38 TTABVUE 47. Horvitz declaration, paragraph 50, 22 TTABVUE.

⁷⁹ Pl's reply brief, 41 TTABVUE 23.

However, arguments as to connotation of Applicant's mark appear more appropriately argued under the first *DuPont* factor. *See e.g., UMG Recordings, Inc. v. Mattel, Inc.*, 2011 TTAB LEXIS 286, at *55 (TTAB 2011) (addressing, under the first *DuPont* factor, witness testimony relating to the significance of the auto industry to the city of Detroit, and the possibility that to some consumers, one connotation of MOTOWN in applicant's mark in connection with toy vehicles will be the auto industry rather than a reference to the music business and Opposer's famous MOTOWN mark). And arguments that Applicant's mark DANKEES brings to mind Opposer based on examples of infringing third-party uses for DANKEES (some of which reference marijuana) appears to be evidentiary support for the dilution claim. *See e.g., New York Yankees P'ship v. IET Prods. & Servs.*, 2015 TTAB LEXIS 96, at *42 (TTAB 2015) (in connection with dilution claim, Board found applicant selected a mark sufficiently similar to "trigger consumers to conjure up" Opposer's famous THE HOUSE THAT RUTH BUILT mark).

This factor is neutral.

V. Conclusion

As a final step, we "weigh the *DuPont* factors used in [our] analysis and explain the results of that weighing." *In re Charger Ventures LLC*, 64 F.4th 1375, 1384 (Fed. Cir. 2023) (emphasis omitted).

The parties' goods are identical, the channels of trade and classes of consumers are the same. There is the potential for "impulse purchasing" of products at a relatively low price point by ordinary consumers, given the lack of price restrictions

in Applicant's identification, which could include inexpensive clothing items. Therefore the second, third, and fourth factors weigh in favor of likelihood of confusion, with the second factor weighing heavily so.

The YANKEES mark is commercially strong and falls on the high end of the spectrum. Given the commercial strength of Opposer's YANKEES mark, the similarities in appearance and sound outweigh any differences in meaning. The first and fifth factors weigh in favor of likelihood of confusion. There is no evidence of record of third-party use or registration of the YANKEES marks, making the sixth factor neutral. The eighth, ninth, twelfth and thirteen factors also are neutral. We find confusion likely.

Decision:

The opposition is sustained on the likelihood of confusion ground and registration to Applicant's application Serial No. 97327195 is refused.⁸⁰

⁸⁰ In view of our finding of likelihood of confusion, we need not consider the dilution claim. *See, e.g., Multisorb Techs., Inc. v. Pactiv Corp.*, 2013 TTAB LEXIS 616, at *3 (TTAB 2013). (“[T]he Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case.”).