

This Opinion is Not a
Precedent of the TTAB

Mailed: May 8, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Council of Ivy Group Presidents
v.
IV League Nurse Concierge, Inc.

Opposition No. 91285794

Jennifer Insley-Pruitt and Luke M. Reilly of Dechert LLP,
for Council of Ivy Group Presidents.

Maria Rosado Lightfoot of IV League Nurse Concierge, Inc., pro se.

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


Opinion by Stanley, Administrative Trademark Judge:

IV League Nurse Concierge, Inc. (“Applicant”) seeks registration on the Principal

Register of the composite mark  for “intravenous (IV) hydration therapy services” in International Class 44.¹

¹ Application Serial No. 97198302 was filed on December 31, 2021, based upon Applicant’s allegation of use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging September 20, 2020 as the date of first use anywhere and first use in commerce. The application includes the following description of the mark: “The mark consists of the gold wording ‘IV LEAGUE NURSE’. The letter ‘I’ is represented by a gold syringe. Below this wording is the teal wording ‘CONCIERGE, INC.’ All the white in the mark is merely background and is not claimed as a feature of the mark.” The colors teal and gold are claimed as a feature of the mark. “NURSE CONCIERGE, INC.” is disclaimed.

Council of Ivy Group Presidents (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark based on likelihood of confusion and dilution by blurring under Trademark Act Sections 2(d) and 43(c), 15 U.S.C. §§ 1052(d) and 1125(c).² Opposer asserts that it is an unincorporated association consisting of Brown University, Columbia University, Cornell University, Dartmouth College, Harvard University, University of Pennsylvania, Princeton University and Yale University, and it claims ownership of the following twelve registered marks comprising or consisting of the phrase THE IVY LEAGUE or IVY LEAGUE:³

-  for “educational and entertainment services, namely conducting educational activities such as courses, seminars and conferences and sporting events at the college and university levels,” in International Class 41;⁴
- THE IVY LEAGUE, in standard characters, for “educational services, namely, conducting distance learning instruction at the college and university level; providing information about education; arranging and conducting athletic competitions; providing collegiate athletic and sporting events; providing news and information in the field of sports; providing a website featuring non-downloadable videos in the field of sports,” in International Class 41;⁵

² Opposer also purported to plead a claim of false suggestion of a connection under Trademark Act Section 2(a), 15 U.S.C. §1052(a), but that claim was stricken by the Board as insufficiently pleaded in an order dated August 4, 2023. 6 TTABVUE 7.

Citations in this opinion refer to TTABVUE, the Board’s online docketing system. Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear


³ Notice of Opposition at ¶¶ 1, 7-8, 1 TTABVUE 6-9.

⁴ Registration No. 1616111; issued October 2, 1990; renewed.

⁵ Registration No. 6164286; issued September 29, 2020. “LEAGUE” is disclaimed.

- THE IVY LEAGUE, in typeset form,⁶ for “educational and entertainment services namely, conducting educational activities such as courses, seminars and conferences and sporting events at the college and university level,” in International Class 41;⁷



-  for “printed matter and publications; namely, books, pamphlets and brochures in the field of intercollegiate athletics,” in International Class 16;⁸
- THE IVY LEAGUE, in typeset form, for “clothing, namely, shirts,” in International Class 25;⁹
- THE IVY LEAGUE, in typeset form, for “information services, namely, providing historical, educational and sports information via a global telecommunications network,” in International Class 42;¹⁰
- THE IVY LEAGUE, in typeset form, for “jewelry,” in International Class 14;¹¹
- THE IVY LEAGUE, in typeset form, for “mugs,” in International Class 21;¹²

⁶ Prior to November 2, 2003, “standard character” drawings were known as “typed” or “typeset” drawings. *See In re Viterra Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012) (“[U]ntil 2003, ‘standard character’ marks formerly were known as ‘typed’ marks[.]”). A typed or typeset mark is the legal equivalent of a standard character mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.03(i) (Nov. 2024).

As part of an internal Board pilot program, this opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion uses citations to the LEXIS legal database and cites only precedential decisions, unless otherwise noted. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03(a)(2) (2024) for acceptable citation forms to TTAB cases.

⁷ Registration No. 2442152; issued April 10, 2001; renewed. “LEAGUE” is disclaimed.

⁸ Registration No. 1851426; issued August 30, 1994; renewed.

⁹ Registration No. 2096273; issued September 16, 1997; renewed.

¹⁰ Registration No. 2138949; issued February 24, 1998; renewed.

¹¹ Registration No. 2217365; issued January 12, 1999; renewed.

¹² Registration No. 2375558; issued August 8, 2000; renewed.

- THE IVY LEAGUE, in typeset form, for “printed matter and publications, namely, newsletters, pamphlets and brochures in the field of intercollegiate athletics” in International Class 16;¹³
- IVY LEAGUE, in standard characters, for “shirts; sweaters; jackets; headwear” in International Class 25;¹⁴
- IVY LEAGUE, in typeset form, for “paper products, namely, folders; pens” in International Class 16;¹⁵ and
- IVY LEAGUE, in typeset form, for “baseballs and golf balls” in International Class 28.¹⁶

Opposer also pleads ownership of prior common law rights for the mark THE IVY LEAGUE and other IVY LEAGUE-formative marks for educational services at the university level.¹⁷

In its Answer, Applicant denies the salient allegations in the Notice of Opposition.¹⁸

The case is fully briefed.¹⁹ Opposer, as plaintiff in the opposition proceeding, bears the burden of establishing its entitlement to a statutory cause of action and

¹³ Registration No. 2475096; issued August 7, 2001; renewed. “LEAGUE” is disclaimed.

¹⁴ Registration No. 4327405; issued April 30, 2013; renewed.

¹⁵ Registration No. 2663674; issued December 17, 2002; renewed.

¹⁶ Registration No. 2719083; issued May 27, 2003; renewed.

¹⁷ Notice of Opposition at ¶¶ 3, 6, 1 TTABVUE 7.

¹⁸ Answer, 4 TTABVUE 2-5. Applicant also purported to plead eleven affirmative defenses. *Id.* at 6-7. In the August 4, 2023 order, the Board struck Applicant’s first (failure to state a claim), third through seventh (laches, estoppel, waiver, acquiescence, and unclean hands), and eleventh (lack of entitlement) defenses as improper or insufficiently pleaded. 6 TTABVUE 7-11. The Board further found that Applicant’s second, eighth, and ninth defenses were mere amplifications of Applicant’s denials in the answer, not true affirmative defenses. *Id.*

¹⁹ Opposer’s main brief is at 22 TTABVUE, Applicant’s brief is at 27 TTABVUE, and Opposer’s reply brief is at 28 TTABVUE. On February 12, 2025, the Board granted Opposer’s motion to extend time to file its main brief and denied Applicant’s motion to strike Opposer’s main brief. 26 TTABVUE.

substantive claim by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, Can. No. 92042871, 2007 TTAB LEXIS 47, at *7 (TTAB 2007). We have considered all of the admissible evidence of record and arguments made by the parties. For the reasons set forth below, we sustain the opposition on the dilution claim, and do not reach the likelihood of confusion claim.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Applicant's application file. In addition, Opposer introduced the following testimony and evidence.

1. Opposer's First Notice of Reliance: Dictionaries and other reference works.²⁰
2. Opposer's Second Notice of Reliance: Internet documents.²¹
3. Opposer's Third Notice of Reliance: Printed publications.²²
4. Trial Declaration with exhibits of Robin Harris, Executive Director for Opposer ("Harris Declaration").²³

Applicant did not introduce any evidence, but it was not required to do so. *See Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 TTAB LEXIS 383, at *3 (TTAB 2022) (citing *Yazhong Inv. Ltd. v. Multi-Media Tech. Ventures, Ltd.*, Can. No. 92056548, 2018 TTAB LEXIS 168, at *12 n.13 (TTAB 2018)). Nor did Applicant object to any of Opposer's evidence.

²⁰ Opposer's First Notice of Reliance ("NOR"), 16 TTABVUE.

²¹ Opposer's Second NOR, 17 TTABVUE.

²² Opposer's Third NOR, 18 TTABVUE.

²³ Harris Decl., 19, 20 TTABVUE.

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes proceeding. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 1274 (Fed. Cir. 2014); *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, Opp. No. 91234244, 2022 TTAB LEXIS 91, at *19 (TTAB 2022). "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. § 106[3], and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark." *JNF LLC v. Harwood Int'l Inc.*, Can. No. 92070634, 2022 TTAB LEXIS 328, at *5 (TTAB 2022) (citing *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 1070 (Fed. Cir. 2022) and *Corcamore*, 978 F.3d at 1303).

Opposer properly made of record TSDR printouts showing the current status and title of its pleaded registrations for its IVY LEAGUE-formative marks.²⁴ Because Opposer's registrations are of record, Opposer has established its statutory entitlement to bring a Section 2(d) claim that is not wholly without merit.²⁵

²⁴ Ex. CD to Harris Decl., 20 TTABVUE 215-55.

²⁵ Relying on the case *Hunt v. Wash. State Apple Adver. Comm'n*, 432 U.S. 333 (1977), Applicant argues that Opposer lacks statutory entitlement because it is an unincorporated association, and as an unincorporated association, Opposer has not proven that it may seek relief on behalf of its members. Applicant's Br., 27 TTABVUE 7-9. Applicant's arguments are misplaced. An unincorporated association may own a trademark application or registration, *see* TMEP § 803.03(c), and Opposer is identified as the owner of the pleaded registrations. *See* Ex. CD to Harris Decl., 20 TTABVUE 215-55 (TSDR printouts of Opposer's pleaded registrations). Applicant did not counterclaim to cancel any of Opposer's pleaded registrations, and Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register "shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, **of the owner's**

Cunningham v. Laser Golf Corp., 222 F.3d 943, 945 (Fed. Cir. 2000); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, Opp. No. 91217095, 2016 TTAB LEXIS 604, at *6 (TTAB 2016) (entitlement established based on pleaded registration made of record).

Once statutory entitlement is sufficiently alleged (and established) for one claim, it is established for all claims, including Opposer's dilution claim. *Corporacion Habanos SA v. Rodriguez*, Can. No. 92052146, 2011 TTAB LEXIS 258, at *15 (TTAB 2011); *Enbridge, Inc. v. Excelerate Energy LP*, Opp. No. 91170364, 2009 TTAB LEXIS 642, at *21 n.10 (TTAB 2009) (citation omitted).

III. Dilution by Blurring

Dilution by blurring is an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." Trademark Act Section 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). The Federal Circuit has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

- (1) [the plaintiff] owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark became famous; and

ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." (emphasis added).

- (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach Servs. v. Triumph Learning LLC, 668 F.3d 1356, 1372 (Fed. Cir. 2012).

A. Does Opposer Own a Famous Mark?

A threshold question in a federal dilution claim is whether the plaintiff's mark is "famous." *Coach Servs.*, 668 F.3d at 1372. A mark is famous for dilution purposes "if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Trademark Act Section 43(c)(2)(A), 15 U.S.C. § 1125(c)(2)(A).

Opposer must show that when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Coach Servs.*, 668 F.3d at 1373 (quoting *Toro Co. v. ToroHead, Inc.*, Opp. No. 91114061, 2001 TTAB LEXIS 823, at *56-57 (TTAB 2001)).²⁶ A famous mark is one that has become a "household name." *Id.* (internal citations omitted). Although fame for likelihood of confusion is a matter of degree along a continuum, fame for dilution "is an either/or proposition" – it either exists or it does not. *Id.* (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005), and cited in *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017)).

²⁶ "Although the Board's *Toro* decision predates the [Trademark Dilution Revision Act of 2006], its discussion of fame for dilution purposes remains relevant." *Coach Servs.*, 668 F.3d at 1373 n.8.

In addition, “a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services, i.e., devoid of its trademark context.” *Toro*, 2001 TTAB LEXIS 823, at *40 (citing H.R. Rep. No. 104-374, at 3 (1995) (“the mark signifies something unique, singular, or particular”)).

There are four non-exclusive factors to consider when determining whether a mark is famous:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A); *see also* *Coach Servs.*, 668 F.3d at 1372-73; *McDonald’s Corp. v. McSweet LLC*, Opp. No. 91178758, 2014 TTAB LEXIS 351, at *51-52 (TTAB 2014).

Opposer alleges that THE IVY LEAGUE and IVY LEAGUE marks are “famous for educational services.”²⁷ The Harris Declaration, and the exhibits thereto, establish the following undisputed facts. The term “Ivy League” was coined in the 1930s by a sportswriter to collectively refer to Brown University, Columbia

²⁷ Notice of Opposition at ¶ 38, 1 TTABVUE 13.

University, Cornell University, Dartmouth College, Harvard University, the University of Pennsylvania, Princeton University, and Yale University (collectively, the “Member Institutions”).²⁸ In 1945, the Member Institutions formally adopted “The Ivy League” as the name of their intercollegiate football conference, and in 1954, the Ivy League conference was expanded to include all intercollegiate athletics at these institutions.²⁹ Since the first “Ivy Group Agreement” was signed in 1945, the Member Institutions have maintained common practices in academic standards, eligibility requirements, and financial aid.³⁰

Although the Ivy League was initially founded as an athletic conference, the Member Institutions now coordinate closely in many areas, including undergraduate admissions announcements, academic research, bands, job fairs, alumni relations, and sustainability initiatives.³¹ The Member Institutions are some of the oldest and most prestigious academic institutions in the United States, and they are known around the country and worldwide for their excellence.³² Collectively, the Member

²⁸ Harris Decl. at ¶ 4, 19 TTABVUE 3; *see also* Ex. A to Harris Decl., *id.* at 18 (Internet printout of the timeline of the Ivy League).

²⁹ Harris Decl. at ¶ 5, *id.*; *see also* Exs. A-E to Harris Decl., *id.* at 17-41 (Internet printouts describing the history of the Ivy League).

³⁰ Harris Decl. at ¶ 6, *id.*; *see also* Ex. F to Harris Decl., *id.* at 42-212 (the 2023-204 Ivy Manual, which includes the 1954 Ivy Group Agreement).

³¹ Harris Decl. at ¶ 7, *id.* at 4.; *see also* Exs. G-L to Harris Decl., *id.* at 213-41 (Internet printouts showing coordination between Member Institutions in various fields).

³² Harris Decl. at ¶ 11, *id.*; *see also* Exs. M-N to Harris Decl., *id.* at 242-54 (Internet printouts describing Ivy League schools).

Institutions have educated millions of students from around the world, and have millions of living alumni.³³

The Ivy League and the Member Institutions have continuously and extensively used and promoted the marks THE IVY LEAGUE, IVY LEAGUE, and other marks incorporating IVY LEAGUE and IVY throughout the decades since the association was founded.³⁴ Both the Ivy League itself and all of the Member Institutions use THE IVY LEAGUE and IVY LEAGUE marks in connection with educational services.³⁵ Each of the Member Institutions offers undergraduate and/or graduate degrees in a broad range of disciplines.³⁶ The Member Institutions use THE IVY LEAGUE and IVY LEAGUE marks in a variety of contexts, including in order to identify themselves as members of the Ivy League, to compare themselves with other members of the Ivy League, and to identify the educational and extracurricular activities that they provide.³⁷ Each Member Institution is commonly referred to by the public as an “Ivy League” school, the students who attend these institutions are commonly referred to as “Ivy Leaguers,” “Ivy League students,” or “Ivy League graduates,” and the

³³ Harris Decl. at ¶ 13, *id.* at 5; *see also* Exs. O-S to Harris Decl., *id.* at 255-78 (Internet printouts regarding admissions and enrollment to Ivy League schools).

³⁴ Harris Decl. at ¶ 8, *id.* at 4.

³⁵ Harris Decl. at ¶ 19, *id.* at 6.

³⁶ Harris Decl. at ¶ 20, *id.*

³⁷ Harris Decl. at ¶ 21, *id.*; *see also* Exs. T-AK to Harris Decl., *id.* at 279-381 (Internet printouts from websites of the Member Institutions).

academic programs that these institutions provide are commonly referred to as an “Ivy League” education or an “Ivy League” degree.³⁸

The Member Institutions also are well-known for excellence in the medical field.³⁹ All of the Member Institutions offer courses of study that prepare undergraduate students for medical education, and with the exception of Princeton University, each of the Member Institutions operates a medical school.⁴⁰ Three of the Member Institutions also offer nursing programs: the University of Pennsylvania, Columbia, and Yale.⁴¹ The medical and nursing education programs offered by these Member Institutions are among the most highly respected and well-known in the country and the world.⁴² The Member Institutions use THE IVY LEAGUE and IVY LEAGUE marks to identify and promote their services in the area of medical education, nursing education, hospital care, and other health-related goods and services.⁴³ Third parties likewise use THE IVY LEAGUE and IVY LEAGUE marks to refer to the Member Institutions’ provision of medical and health-related services and medical, nursing, and health-related education.⁴⁴

³⁸ Harris Decl. at ¶ 22, *id.* at 6-7; *see also* Exs. AL-BD to Harris Decl, *id.* at 382-570 (printouts of articles from various Internet websites).

³⁹ Harris Decl. at ¶ 23, *id.* at 7.

⁴⁰ Harris Decl. at ¶¶ 24-25, *id.*

⁴¹ Harris Decl. at ¶ 26, *id.*

⁴² Harris Decl. at ¶ 27, *id.*

⁴³ Harris Decl. at ¶ 28, *id.*; *see also* Exs. BE-BG to Harris Decl., *id.* at 571-587 (printouts from the websites of Member Institutions); Exs. BH-BQ to Harris Decl., 20 TTABVUE 2-69 (same).

⁴⁴ Exs. 10-29 to Opposer’s Second NOR, 17 TTABVUE 11-150 (printouts of articles from various Internet websites).

THE IVY LEAGUE and IVY LEAGUE marks have been used in a broad array of publications, including on the Ivy League website at ivyleague.com.⁴⁵ The Ivy League website has been active since 1997, and has received millions of visitors since its launch.⁴⁶ THE IVY LEAGUE and IVY LEAGUE marks have also been promoted through social media accounts, including Twitter, Instagram, and Facebook.⁴⁷ The Ivy League's social media accounts attract millions of viewers per year. For example, its X (formerly Twitter) account averages over 22.9 million impressions per year, its Instagram account averages about 97.2 million impressions per year, and its Facebook account averages about 3.7 million impressions per year.⁴⁸ All of these social media accounts use the handle @IvyLeague and feature THE IVY LEAGUE and IVY LEAGUE marks.⁴⁹ Through these publications, the Ivy League promotes the Ivy League's athletic events, recognizes the achievements of its athletes, and publicizes the philosophy that guides its athletic program.⁵⁰ These publications also promote the Ivy League's overall educational mission by highlighting the academic, professional, and public service achievements of its students, coaches, and alumni.⁵¹

⁴⁵ Harris Decl. at ¶ 30, 19 TTABVUE 8; *see also* Ex. BR to Harris Decl., 20 TTABVUE 70-80 (printouts from ivyleague.com).

⁴⁶ Harris Decl. at ¶ 33, 19 TTABVUE 8-9.

⁴⁷ Harris Decl. at ¶ 34, *id.*

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ Harris Decl. at ¶ 30, *id.* at 8; *see also* Exs. BR-BT to Harris Decl., 20 TTABVUE 70-153 (printouts from ivyleague.com).

⁵¹ Harris Decl. at ¶ 30, *id.* at 8.

For decades, Ivy League athletic events have been widely seen and heard on television and radio, and THE IVY LEAGUE and IVY LEAGUE marks have been featured during such broadcasts.⁵² In 2018, the Ivy League reached a 10-year deal with ESPN to show Ivy League athletic events on a variety of ESPN platforms.⁵³ Ivy League athletic events are also shown on DirecTV, a satellite television service operating in the United States.⁵⁴ In addition, many of the Member Institutions have made arrangements with local television and/or radio stations that cover a variety of sporting events, including football and men's and women's basketball.⁵⁵ These events are seen and heard on stations that operate in the cities and towns where the Ivy League schools are located.⁵⁶ THE IVY LEAGUE and IVY LEAGUE marks are featured during the course of each broadcast, and in the promotional materials produced by both the Ivy League and its radio and television partners.⁵⁷

The Ivy League has also licensed THE IVY LEAGUE and IVY LEAGUE marks for use in a broad range of consumer product categories.⁵⁸ Since at least as early as

⁵² Harris Decl. at ¶ 36, *id.* at 9.

⁵³ Harris Decl. at ¶ 37, *id.*; *see also* Exs. BU to Harris Decl., 20 TTABVUE 174-81 (press release announcing ESPN partnership), BV to Harris Decl., *id.* at 182-87 (printout of ESPN schedule for 2023).

⁵⁴ Harris Decl. at ¶ 39, 19 TTABVUE 10; *see also* Exs. BW-BX to Harris Decl., 20 TTABVUE 188-98 (printouts from the DirecTV website advertising Ivy League athletic events).

⁵⁵ Harris Decl. at ¶ 41, 19 TTABVUE 10; *see also* Ex. BZ to Harris Decl., 20 TTABVUE 201-02 (printout from Harvard website showing local radio stations on which 2023 Ivy League games were broadcast).

⁵⁶ Harris Decl. at ¶ 41, 19 TTABVUE 10.

⁵⁷ Harris Decl. at ¶ 42, 19 TTABVUE 10; *see also* Ex. CA to Harris Decl., 20 TTABVUE 203-14 (printout from ESPN Ivy League football homepage).

⁵⁸ Harris Decl. at ¶ 44, 19 TTABVUE 11.

1995, the Ivy League has licensed THE IVY LEAGUE and IVY LEAGUE marks for use on clothing, including t-shirts, polo shirts, sweatshirts, shorts, and hats, and IVY LEAGUE-branded products are sold through the Ivy League's website and at campus bookstores and at retail stores in the cities and towns where the Member Institutions are located.⁵⁹ The Ivy League also has used THE IVY LEAGUE and IVY LEAGUE marks on a number of non-clothing consumer products, including baseballs, golf balls, pens, folders, mugs, pins, and jewelry.⁶⁰

THE IVY LEAGUE and IVY LEAGUE marks have also received extensive unsolicited media coverage. Numerous third parties have used THE IVY LEAGUE and IVY LEAGUE marks to refer to the Ivy League and the Member Institutions. These sources include third-party media from around the United States and the world, including: (1) national television and radio broadcasts, such as *ABC News*, *NBC News*, *Fox News*, *60 Minutes*, *CBS Sports*, *ESPN*, *National Public Radio*, and the *Oprah Winfrey Show*;⁶¹ (2) Internet websites and printed publications, including newspapers such as the *New York Times*, *Washington Post*, *Boston Globe*, *Los Angeles Times*, *Detroit News*, *Milwaukee Journal Sentinel*, *St. Louis Post Dispatch*, *Denver Post*, *Seattle Times*, *San-Jose Mercury News*, *San Diego Union Tribune*, *Daily Oklahoman*, *Austin-American Statesman*, *New Orleans Times-Picayune*, *Charlotte*

⁵⁹ Harris Decl. at ¶¶ 45-46, *id.*; see also Ex. CB to Harris Decl., 20 TTABVUE 154-63 (printout of the Ivy League online store).

⁶⁰ Harris Decl. at ¶ 48, 19 TTABVUE 11.

⁶¹ Harris Decl. at ¶ 51, *id.* at 12.

Observer, and *Orlando Sentinel*;⁶² and (3) popular press aimed at a wide variety of audiences, including *Cosmopolitan*, *Glamour*, *Vogue*, *Playboy*, *Reader's Digest*, and *Motor Trend* magazines.⁶³

Millions of consumers in the United States have been exposed to THE IVY LEAGUE and IVY LEAGUE marks through media coverage of the Ivy League's educational programs and athletic events, through television and radio broadcasts of Ivy League events, and through the Ivy League's licensing and promotional programs.⁶⁴ The interest in the Ivy League has continued year over year and decade after decade. A June 25, 2024 search on the Lexis database revealed 368,864 references to the Ivy League in the United States press since January 1, 1975.⁶⁵ As a result of the decades of extensive use of THE IVY LEAGUE and IVY LEAGUE marks, the marks have become inextricably linked with the Ivy League, the Member Institutions, and the goods and services that they provide.

Opposer also aggressively protects its IVY LEAGUE brand. Opposer has secured a number of federal registrations for THE IVY LEAGUE and IVY LEAGUE marks, including the registrations identified *supra* at pp. 2-4. Opposer also enforces its rights in THE IVY LEAGUE and IVY LEAGUE marks. Among other steps, Opposer has

⁶² Harris Decl. at ¶¶ 52-53, *id.*; *see also* Exs. 30-70 to Opposer's Second NOR, 17 TTABVue 151-450 (Internet printouts); Exs. 71-100 to Opposer's Third NOR, 18 TTABVue 7-145 (printed publications, dated between 1975 and 2022).

⁶³ Harris Decl. at ¶ 50-54, 19 TTABVue 12.

⁶⁴ Harris Decl. at ¶ 15, *id.* at 5.

⁶⁵ Harris Decl. at ¶ 56, *id.* at 12-13; *see also* Ex. CC to Harris Decl., 20 TTABVue 164-73 (screenshots of Lexis search).

filed a number of trademark oppositions and cancellations against parties who sought to seek to register marks that Opposer alleged violated its rights in THE IVY LEAGUE and IVY LEAGUE marks.⁶⁶

Finally, we note that the term “Ivy League” is listed in several dictionaries and other reference works as the proper collective name for the Member Institutions and as an adjective used to describe anything related to these institutions.⁶⁷ A typical definition of “Ivy League” follows:

n.

An association of eight universities and colleges in the northeast United States, comprising Brown, Columbia, Cornell, Dartmouth, Harvard, Princeton, the University of Pennsylvania, and Yale.

adj.

Of or resembling the traditions of the Ivy League.⁶⁸

“When a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous.” *B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 728

⁶⁶ Harris Decl. at ¶ 59, *id.* at 13; *see also* Ex. CE to Harris Decl., 20 TTABVUE 256-464 (notices of oppositions and petitions to cancel filed by Opposer and related documents reflecting the resolution of the proceedings). We note that of the seven Board proceedings identified by Opposer, all of them resulted in the challenged application or registration ultimately being abandoned. *Id.* Only one, however, reached a final decision on the merits, namely Opposition No. 91161051, wherein the Board found that the applicant’s applied-for standard-character mark IVY LEAGRO for goods and services in Classes 16, 25, and 41 was likely to cause confusion with Opposer’s pleaded THE IVY LEAGUE and IVY LEAGUE marks. *Id.* at 391-422. The Board there did not reach the merits of Opposer’s dilution claim.

⁶⁷ Opposer’s First NOR, 16 TTABVUE 5-6 (dictionary.com), 7-8 (The American Heritage Dictionary), 9-11 (Britannica), 12-13 (Britannica Dictionary), 14-18 (Collins English Dictionary), 19-20 (Cambridge English Dictionary), 21-23 (Oxford Advanced Learner’s Dictionary), 24-35 (World Atlas), 36-38 (Merriam-Webster Dictionary).

⁶⁸ *Id.* at 8 (The American Heritage Dictionary).

(Fed. Cir. 1988); *see also Nasdaq Stock Mkt., Inc. v. Antartica, S.R.L.*, Opp. No. 91121204, 2003 TTAB LEXIS 391, at *66-67 (TTAB 2003) (“The dictionary references, newspaper and magazine articles, and daily reports on opposer’s stock market in print and broadcast media evidence very widespread recognition [of the NASDAQ mark].”).

Based upon the undisputed evidence of record described above, we find that THE IVY LEAGUE and IVY LEAGUE are household names, and for the purposes of dilution, famous marks.

B. Is Applicant Using a Mark That Allegedly Dilutes Opposer’s Mark?

Applicant seeks registration of Applicant’s mark under Section 1(a) of the Trademark Act, based on alleged use of the mark in commerce.⁶⁹ Although there is no evidence of use of Applicant’s mark in the record, Opposer may rely on the filing date of Applicant’s application as Applicant’s constructive use date, thereby satisfying this second element. *See Chanel, Inc. v. Makarczyk*, Opp. No. 91208352, 2014 TTAB LEXIS 217, at *37 (TTAB 2014) (“[O]pposer is entitled to rely on applicant’s filing date as applicant’s date of constructive use. Opposer has therefore satisfied this second prong”).

C. Was Opposer’s Mark Famous Before Applicant’s First Use of Applicant’s Mark?

Having found THE IVY LEAGUE and IVY LEAGUE marks famous for dilution purposes, we must now determine whether that fame attached to the marks prior to

⁶⁹ *See supra* at note 1.

any date upon which Applicant may rely. Because there is no evidence that Applicant has started using the subject mark, the earliest date upon which Applicant may rely is December 31, 2021, the filing date of the application. *See Nike, Inc. v. Maher*, Opp. No. 91188789, 2011 TTAB LEXIS 234, at *29-30 (TTAB 2011) (citing *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, Opp. No. 91177415, 2010 TTAB LEXIS 40, at *12 n.13 (TTAB 2010), *aff'd*, 637 F.3d 1344 (Fed. Cir. 2011)).

Opposer has established that it has continuously used THE IVY LEAGUE and IVY LEAGUE marks for decades prior to the filing date of Applicant's application, and the unsolicited media of record, discussed above, demonstrates that the marks became famous well before Applicant's filing date.⁷⁰

D. Is Applicant's Use of Applicant's Mark Likely to Cause Dilution by Blurring?

The final element of the dilution analysis assesses whether Applicant's mark is likely to dilute Opposer's THE IVY LEAGUE and IVY LEAGUE marks. As noted above, dilution by blurring occurs when a substantial percentage of consumers, on seeing the junior party's use of a mark on its goods or services, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods or services come from the famous mark's owner. *N.Y. Yankees P'ship v. IET Prods. & Servs.*, Opp. No. 91189692, 2015 TTAB LEXIS 96, at *25-26 (TTAB 2015) (citing *UMG Recordings Inc. v. Mattel Inc.*, Opp. No. 91176791, 2011 TTAB LEXIS 286, at *63 (TTAB 2011)). The concern

⁷⁰ *See, e.g.*, text accompanying notes 28-68.

is that “the gradual whittling away of distinctiveness will cause the trademark holder to suffer ‘death by a thousand cuts.’” *Nat’l Pork Bd. v. Supreme Lobster and Seafood Co.*, Opp. No. 91166701, 2010 TTAB LEXIS 225, at *61 (TTAB 2010) (citation omitted); *see also Enter. Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 1339-40 (Fed. Cir. 2003) (“[D]ilution law is intended to protect a mark’s owner from dilution of the mark’s value and uniqueness”). Blurring may occur “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, Opp. No. 91197504, 2016 TTAB LEXIS 99, at *20 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)(1)).


To determine whether Applicant’s use of its mark is likely to cause dilution by blurring, we may consider:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

1. The Degree of Similarity Between the Marks

In the dilution context, “the similarity between the famous mark and the allegedly blurring mark need not be substantial in order for the dilution by blurring claim to succeed.” *TiVo Brands LLC v. Tivoli, LLC*, Opp. No. 91221632, 2018 TTAB LEXIS 439, at *50-51 (TTAB 2018) (citations omitted). “[I]n determining the similarity or dissimilarity of the marks, ‘we will use the same test as for determining the similarity or dissimilarity of the marks in the likelihood of confusion analysis, that is, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.’” *Id.* (quoting *Maheer*, 2011 TTAB LEXIS 234, at *42). “While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists.” *Id.* Ultimately, we must determine whether Applicant’s mark is sufficiently similar to Opposer’s famous mark as to “trigger consumers to conjure up” Opposer’s mark. *Maheer*, 2011 TTAB LEXIS 234, at *42 (citing *Nat’l Pork*, 2010 TTAB LEXIS 225, at *62).

With these principles in mind, we compare Applicant’s mark  with Opposer’s THE IVY LEAGUE and IVY LEAGUE marks.

Applicant argues that “dilutive impairment” is “reduce[d]” because “[t]he marks in question contain different elements, with the opposer’s marks consisting of ‘The

Ivy League’ and ‘Ivy League,’ while the applicant’s mark prominently features the term ‘IV League Nurse’ with additional descriptive elements.”⁷¹

Applicant’s argument is unpersuasive. The phrase “IV LEAGUE” in Applicant’s mark is the dominant portion of the mark, as the words “NURSE CONCIERGE, INC.” are all disclaimed as descriptive of Applicant’s services.⁷² Wording that is descriptive of identified services and that has been disclaimed is typically less significant or less dominant when comparing marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997)); *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *48-49 (TTAB 2022); *see also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:45 (5th ed. Feb. 2025 update) (“The fact that in a registration, certain descriptive or generic terms are disclaimed indicates that those terms are less significant and the other parts of the mark are the dominant parts that will impact most strongly on the ordinary buyer.”).

Turning to Opposer’s marks, the definite article “THE” at the beginning of Opposer’s THE IVY LEAGUE mark has no source identifying significance. *See In re Thor Tech Inc.*, Serial No. 78634024, 2009 TTAB LEXIS 253, at *3 (TTAB 2009) (“The addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods. Inc.*, Serial No. 329339, 1984 TTAB LEXIS 52, at *2 (TTAB 1984) (the inclusion of the definite article “the” is

⁷¹ Applicant’s Br., 27 TTABVUE 9.

⁷² *See supra* at note 1.

“insignificant in determining likelihood of confusion”). If anything, the article “the” “simply emphasizes” the words immediately following, which are “IVY LEAGUE.” *See Thor Tech*, 2009 TTAB LEXIS 253, at *3.

Thus, Applicant’s mark and Opposer’s THE IVY LEAGUE and IVY LEAGUE marks share the phonetically identical dominant elements “IV LEAGUE” and “IVY LEAGUE,” respectively, thereby making them similar in sound. *See In re 1st USA Realty Prof’ls, Inc.*, Serial No. 78553715, 2007 TTAB LEXIS 73, at *16 (TTAB 2007) (finding the marks FIRST USA and 1ST USA to be “identical in pronunciation and connotation”); *Centraz Indus. v. Spartan Chem. Co.*, Opp. No. 91159335, 2006 TTAB LEXIS 20, at *11 (TTAB 2005) (“the similarity in sound [between ICESHINE and ISHINE] is so substantial that it outweighs any differences in appearance and meaning”); *cf. Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 732 (CCPA 1968) (similarity in sound alone may be sufficient for a finding of likelihood of confusion).

The stylized font and use of a syringe design as the “I” in the “IV” portion of Applicant’s mark does not detract from “IV LEAGUE” being the dominant portion of Applicant’s mark. The words “IV LEAGUE” are more important than the design in Applicant’s mark because they will be used to call for Applicant’s services and more clearly and readily identify the source of Applicant’s services than the design. *See, e.g., Viterra*, 671 F.3d at 1366 (“[T]he verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co.*, Serial No. 423405, 1987 TTAB LEXIS 47, at *3 (TTAB 1987) (holding that “if one of the marks comprises both

a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services”).

Furthermore, the syringe design standing for the letter “I” is difficult to decipher, and the stylized “IV LEAGUE NURSE” text is presented in a larger font than “CONCIERGE, INC.”, drawing a consumer’s attention more to the first words of Applicant’s mark, “IV LEAGUE” and reinforcing its dominant position. *See In re Guild Mortg. Co.*, Serial No. 86709944, 2020 TTAB LEXIS 17, at *5 (TTAB 2020) (finding GUILD the dominant term “[d]ue to its large size and prominent placement, [and because it] is the most visually striking element of Applicant’s mark”).

Additionally, because certain of Opposer’s registered THE IVY LEAGUE marks for educational services are in standard-character format, they could be displayed in any lettering style, color or font, and Opposer could display its mark in a font similar to the literal element “IV LEAGUE” in Applicant’s mark, heightening the similarity of the marks in appearance. *See Nike, Inc. v. Bauman-Buffone*, Opp. No. 91234556, 2019 TTAB LEXIS 65, at *18 (TTAB 2019) (“The stylization of Applicant’s mark is essentially irrelevant, because Opposer’s mark is registered in standard characters and typed forms, and could be displayed in any font or size, including in a manner similar to Applicant’s [mark]. ... Nor is the small, minor design element in Applicant’s mark sufficient to distinguish it from Opposer’s mark.”) (internal citation omitted).

In short, we find that Applicant’s mark and Opposer’s THE IVY LEAGUE and IVY LEAGUE marks are similar because they share the same phonetically identical dominant terms, “IV LEAGUE” in Applicant’s mark and “IVY LEAGUE” in Opposer’s

marks. *See, e.g., TiVo Brands*, 2018 TTAB LEXIS 439, at *51 (finding Applicant's marks TIVOTAPE and TIVOBAR similar to TIVO "in appearance and pronunciation due to the shared term 'TIVO' in each mark"); *Nat'l Pork*, 2010 TTAB LEXIS 225, at *62 (finding THE OTHER RED MEAT sufficiently similar to THE OTHER WHITE MEAT in dilution case because they "hav[e] the same structure and cadence and three of the same words"). To be clear, the letters "IV" alone (without or without a design element) in connection with "IV hydration therapy services" are not the issue. Applicant argues that Applicant's mark "is a clear reference to intravenous (IV) therapy[.]"⁷³ That may be true for the letters "IV," but Applicant chose to pair the letters "IV" with the word "League," which appears to be arbitrary in relation to Applicant's services. When paired together to create "IV LEAGUE" as the dominant portion of Applicant's mark, Applicant's mark is sufficiently similar to Opposer's THE IVY LEAGUE and IVY LEAGUE marks to conjure up Opposer's mark. *See Maher*, 2011 TTAB LEXIS 234, at *42 ("Upon encountering applicants' mark, consumers will be immediately reminded of opposer's JUST DO IT mark and associate applicants' mark with opposer's mark.").

Accordingly, this dilution factor favors finding a likelihood of dilution.

2. The Degree of Distinctiveness of Opposer's Mark

To prevail on its dilution claim, Opposer must establish that its mark is not only famous, but distinctive. Opposer's pleaded registered marks for educational services are registered on the Principal Register without resort to Section 2(f) of the

⁷³ Applicant's Br., 27 TTABVUE 5.

Trademark Act, 15 U.S.C. § 1052(f). In fact, none of Opposer's IVY LEAGUE-formative registrations include a Section 2(f) claim of acquired distinctiveness. There is no evidence or basis upon which to find that Opposer's mark is anything other than inherently distinctive. In any event, "[e]ven if the mark is not viewed as inherently distinctive, we found above that the mark is famous, which necessarily subsumes a finding that the mark has high acquired distinctiveness." *N.Y. Yankees*, 2015 TTAB LEXIS 96, at *29; *see also Chanel*, 2014 TTAB LEXIS 217, at *42 ("In any event, the discussion above regarding opposer's extensive evidence of fame of the CHANEL mark used in connection with clothing, fashion accessories, beauty products and boutiques more than sufficiently establishes that opposer's CHANEL mark has acquired a high degree of distinctiveness among consumers.").

This factor also weighs in favor of finding a likelihood of dilution.

3. The Extent to Which Opposer is Engaging in Substantially Exclusive Use of Its Mark

Opposer has shown that it vigilantly enforces its rights to THE IVY LEAGUE and IVY LEAGUE marks, and Ms. Harris attests that "no other party holds a registration of any mark consisting of or incorporating the term IVY LEAGUE or IV LEAGUE."⁷⁴ Applicant has not proffered any evidence refuting Ms. Harris' testimony or otherwise indicating that Opposer's use of THE IVY LEAGUE and IVY LEAGUE marks is not substantially exclusive.

This dilution factor also favors a finding of likelihood of dilution.

⁷⁴ Harris Decl. at ¶¶ 58-60, 19 TTABVUE 13; *see also* Ex. CE to Harris Decl., 20 TTABVUE 256-464.

4. Degree of Recognition of Opposer's Mark

Although we have determined that Opposer's THE IVY LEAGUE and IVY LEAGUE marks are famous for dilution purposes, the statute requires us to further consider the degree of the famous mark's recognition. We have no direct evidence, e.g., a survey, showing a level of recognition of Opposer's marks. However, Opposer's evidence of strong and consistent presence over many years in print media, television advertising, and Internet media, as well as unsolicited media coverage and inclusion of the "Ivy League" as a defined term in many dictionaries and references works, proves that THE IVY LEAGUE and IVY LEAGUE marks have attained a significant level of recognition.

We find that THE IVY LEAGUE and IVY LEAGUE marks are publicly associated with Opposer's educational services such that these marks are "now primarily associated with the owner of the mark[s] even when [they are] considered outside of the context of the owner's goods and services." *Toro*, 2001 TTAB LEXIS 823, at *59-60. "When the public encounters [THE IVY LEAGUE and IVY LEAGUE] mark[s] in almost any context, it associates the term[s], at least initially, with the mark's owner [i.e., the association consisting of the Member Institutions]." *Id.* at *56-57.

Accordingly, this dilution factor also favors a finding of likelihood of dilution.

5. Whether Applicant Intended to Create an Association with Opposer's Mark

There is no evidence that suggests that Applicant intended to create an association with Opposer's THE IVY LEAGUE and IVY LEAGUE marks. In view thereof, this dilution factor is neutral. *Maher*, 2011 TTAB LEXIS 234, at *43 (finding

likelihood of dilution despite “no direct evidence that applicants intended to create an association with opposer’s famous mark”).

6. Whether Any Actual Association Exists Between Applicant’s Mark and Opposer’s THE IVY LEAGUE and IVY LEAGUE Marks

There is no evidence of any actual association between the parties’ marks. This dilution factor is neutral. *Id.* at *42 (finding likelihood of dilution despite “no actual association between the parties’ marks”); *Chanel*, 2014 TTAB LEXIS 217, at *45 (finding likelihood of dilution despite “no evidence” regarding an association between the parties’ marks).

7. Conclusion

All of the factors in regard to Opposer’s Section 43(c) dilution by blurring claim weigh in Opposer’s favor or are neutral. Opposer’s THE IVY LEAGUE and IVY LEAGUE marks became famous prior to Applicant’s first use of its mark, and remain famous and inherently distinctive. They are sufficiently similar to Applicant’s mark that an association between the parties’ marks likely to impair the distinctiveness of Opposer’s famous marks is established. The fact that there is no evidence of Applicant’s intent to create an association with Opposer’s marks or that an actual association exists between the marks do not outweigh the other dilution factors.

Viewing the evidence as a whole, we find that Applicant’s mark is likely to dilute Opposer’s THE IVY LEAGUE and IVY LEAGUE marks under Trademark Act 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B).

IV. Decision

The opposition is sustained on the ground of dilution by blurring. Because we have found for Opposer on its dilution claim, we need not reach the merits of its claim under Section 2(d) of the Trademark Act. *See N.Y. Yankees*, 2015 TTAB LEXIS 96, at *47 (“Because we have found for Opposer on its dilution claims, we need not reach the merits of its claims under Sections 2(a) and 2(d) of the Trademark Act.”).