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Mailed: January 18, 2017

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*In re Deutscher Fußball-Bund (DFB) e.V.*

Serial No. 79144840

Mark Harrison of Venable for Deutscher Fußball-Bund (DFB) e.V.

Matthew J. McDowell, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Adlin, Hightower and Larkin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Deutscher Fußball-Bund (DFB) e.V. (“Applicant”) filed a request for extension of protection of International Registration No. 1197623 for the mark shown below



for a wide variety of goods and services in International Classes 12, 18, 24, 25, 28 and 41.<sup>1</sup> The relevant goods and services for purposes of this appeal are those in Classes 25, 28 and 41:

Clothing, namely, sports pants, sports shirts, sports jerseys, sport stockings, sports jackets, training suits, socks, T-shirts, polo shirts, sweatshirts, pullovers, underwear, swimwear, shorts, shawls, scarves, rainwear, nightwear, trousers, jackets, coats, infant wear and gloves; footwear; headgear, namely, hats and caps in International Class 25;

Games, namely, tabletop games, table soccer games and arcade games; toys, namely, action figure toys, bath toys, collectable toy figures, inflatable toys, infant toys and toy cars; playthings, namely, soccer goals; stuffed toys; balls for games; toy figurines; playing cards; gymnastic and sporting articles, namely, body protectors for soccer, goalkeepers' gloves, soccer balls; decorations for Christmas trees in International Class 28; and

Providing of soccer training; entertainment in the nature of soccer games and soccer camps; entertainment in the nature of providing an informational and entertainment website in the fields of sports and fitness; entertainment services, namely, participation in soccer events; organizing sporting events, namely, soccer games; presentation of live sports performances; organization or conducting of educational exhibitions, sports courses and entertainment events, all in the field of soccer; publication of printed matter and electronic publications, other than for advertising purposes; ticket agency services for sports or entertainment events in International Class 41.

According to the application, “[t]he English translation of ‘DEUTSCHER FUSSBALL-BUND’ in the mark is ‘German Soccer Federation.’”

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<sup>1</sup> Application Serial No. 791144840, filed May 8, 2013 under Trademark Act § 66(a), 15 U.S.C. § 1141f(a).

Based on this translation, the Examining Attorney found that DEUTSCHER FUSSBALL-BUND is merely descriptive of the goods in Classes 25 and 28, and the services in Class 41, under Section 2(e)(1) of the Trademark Act. Although Applicant agreed to disclaim that wording for the services in Class 41, it declined to do so for the Class 25 and 28 goods, and the Examining Attorney therefore refused registration. After the refusal became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.

### **The Evidence**

According to Wikipedia, Applicant “is the governing body of football [soccer] in Germany ... [Applicant] has jurisdiction on the German football league system [including professional leagues] and is in charge of the men’s and women’s national teams.” Germany’s<sup>2</sup> national soccer team has been quite successful, winning the European championship in 1972, 1980 and 1996, and the World Cup in 1954, 1974, 1990 and 2014. Office Action of March 12, 2015. Applicant’s mark is displayed in connection with the sale of its Class 25 goods, and perhaps on the goods themselves:

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<sup>2</sup> West Germany won the identified tournaments in and prior to 1990. Germany won the championship tournaments which followed the reunification of West Germany and East Germany in 1991.

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Germany 2014 Home Soccer Jersey	Germany 2014 Youth Away Soccer Jersey	Germany 14/15 Mesut Ozil Home Soccer Jersey (4 Stars)	Germany 14/15 GÖTZE Home Soccer Jersey (4 Stars)

*Id.*



The remaining relevant evidence of record consists of Applicant's and third-party registrations for marks which either the Examining Attorney or Applicant contend are analogous to Applicant's involved mark, for goods which are the same as or similar to the Class 25 and 28 goods for which Applicant seeks registration. The Examining Attorney specifically relies on Applicant's cancelled Registration No. 2233174 for the mark shown below






the literal element of which is identical to the literal element in the involved application, and which was translated in the cancelled registration as “German Football-Association.” The cancelled registration covered many of the same clothing items (including sweatshirts, footwear and headwear) and sporting goods (including balls and protective padding for playing soccer) as the involved application. Applicant disclaimed DEUTSCHER FUSSBALL-BUND with respect to all goods and services in the cancelled registration, including those in Classes 25 and 28. Office Action of October 15, 2015. The Examining Attorney also relies on the following third-party registrations, among others:<sup>3</sup>

<u>Mark</u>	<u>Registration No./ Owner</u>	<u>Relevant Goods/Services/ Class</u>	<u>Disclaimer/ 2(f)Claim/ Supplemental Register</u>
	2459891 Major League Soccer, L.L.C.	Shirts (25) Sport balls, soccer equipment, namely, balls (28)	Disclaimer of MAJOR LEAGUE SOCCER

<sup>3</sup> We have only included in the chart those third-party registrations which tend to support the disclaimer requirement in this case. In our estimation, the other third-party registrations introduced by the Examining Attorney support neither the Examining Attorney’s nor Applicant’s position.



<u>Mark</u>	<u>Registration No./ Owner</u>	<u>Relevant Goods/Services/ Class</u>	<u>Disclaimer/ 2(f)Claim/ Supplemental Register</u>
	<p>3038798</p> <p>The Rangers Football Club Limited</p>	<p>T-shirts, hats and caps, shoes, training shoes, football boots (25)</p> <p>Games, namely, board games, balls for sport, namely, footballs, soccer balls (28)</p>	<p>Disclaimer of FOOTBALL CLUB</p>
	<p>4033044</p> <p>Celtic F.C. Limited</p>	<p>Clothing, namely ... pants and shirts ... sports clothing, namely, t-shirts, polo shirts, football shirts, football shorts ... all of the foregoing goods used in connection with or for the promotion of the sport of British football or of Celtic Football Club (25)</p> <p>Sporting articles, namely, articles for use in the games of football/soccer and rugby ... all of the foregoing goods used in connection with or for the promotion of the sport of British football or of Celtic Football Club (28)</p>	<p>Disclaimer of FOOTBALL CLUB and 1888</p>

<u>Mark</u>	<u>Registration No./ Owner</u>	<u>Relevant Goods/Services/ Class</u>	<u>Disclaimer/ 2(f)Claim/ Supplemental Register</u>
HARDER GERMAN- JUNIOR- MASTERS (standard characters)	3418467  J.B. Harder Verwaltung GmbH & Co. KG	Clothing, namely, shirts, t-shirts ... tennis wear ... (25)  Goods for physical education and sports, as far as contained in this class, namely, golf clubs, golf balls ... tennis rackets (28)	Disclaimer of GERMAN-JUNIOR-MASTERS
 HSIF International Hand-to-hand Fighting Sport Federation	3799661  Soyuz Obschestvennih Objedineniy; “MEZHDUNAR ODNAYA FEDERATSIYA; RUKOPASHNO GO BOYA”	Clothing, namely, t-shirts, suits including suits for hand-to-hand fighting; footwear, namely, boots for sports including for hand-to hand fighting;  Body-training apparatus (28)	Disclaimer of UNION OF PUBLIC ASSOCIATIONS and INTERNATIONAL HAND-TO-HAND FIGHTING SPORT FEDERATION
IIHF INTERNATIONAL ICE HOCKEY FEDERATION (standard characters)	4047716  International Ice Hockey Federation (IIHF)	Footwear; headgear, namely hats; shirts; jerseys (25)  Sport balls; tables for table ice hockey (28)	Disclaimer of FEDERATION  2(f) claim as to INTERNATIONAL ICE HOCKEY FEDERATION
International Kendo Federation (FIK)	4545825  General Incorporated Foundation All Japan Kendo Federation	Sport shirts; polo shirts; shirts; neckties; kendo outfits (25)	Disclaimer of INTERNATIONAL KENDO FEDERATION

<u>Mark</u>	<u>Registration No./ Owner</u>	<u>Relevant Goods/Services/ Class</u>	<u>Disclaimer/ 2(f)Claim/ Supplemental Register</u>
	<p>4359707</p> <p>Federation Internationale de Bobsleigh et de Tobogganing (FIBT)</p>	<p>Action skill games utilizing snow sleds, bob sleds and skeleton sleds ... snow sleds, bob sleds, skeleton sleds for recreational use (28)</p>	<p>Disclaimer of INTERNATIONAL BOBSLEIGH &amp; SKELETON FEDERATION<sup>4</sup></p>
<p>AGBC AMERICAN GERMAN BUSINESS CLUB (standard characters)</p>	<p>4024676</p> <p>Association of American-German Business Clubs e.V.</p>	<p>Clothing, namely, shirts, pants, socks (25)</p>	<p>Disclaimer of AMERICAN GERMAN BUSINESS CLUB</p>
	<p>3930369</p> <p>Federacion Internacional Para la Orientacion Familiar (IFFD)</p>	<p>Clothing, namely, shirts, pants and jackets; footwear; headwear (25)</p>	<p>Disclaimer of INTERNATIONAL FEDERATION FOR FAMILY DEVLEOPMENT</p>
<p>U.S. HUNG FUT KUNG FU FEDERATION</p>	<p>3263316</p> <p>Tai L. Yim</p>	<p>Clothing, namely Kung Fu uniforms (25)</p>	<p>Supplemental Registration</p> <p>Disclaimer of HUNG FUT KUNG FU FEDERATION</p>
	<p>2202896</p> <p>T.S.F. Recreation, Inc.</p>	<p>Products used in the game of shuffleboard, namely, wax and lubricants (28)</p>	<p>Disclaimer of THE SHUFFLEBOARD FEDERATION</p>

<sup>4</sup> The Examining Attorney also relies on another FIBT registration for a related mark with similar characteristics, including the same disclaimer.




<u>Mark</u>	<u>Registration No./ Owner</u>	<u>Relevant Goods/Services/ Class</u>	<u>Disclaimer/ 2(f)Claim/ Supplemental Register</u>
	4777610  Bagwell Entertainment, LLC	Hats, caps ... t-shirts, sweat shirts ... golf shoes, golf cleats (25)  Board games ... golf clubs, golf clubs ... golf balls golf clubs (28)	Disclaimer of GOLFERS' ASSOCIATION OF AMERICA
	4200434  Kentucky High School Athletic Association	Clothing, namely, caps, hats, wind resistant jackets, t-shirts ... (25)  Game balls; mini toy sports balls; novelty foam fingers and hands (28)	2(f) as to KENTUCKY HIGH SCHOOL ATHLETIC ASSOCIATION  Disclaimer of ATHLETIC ASSOCIATION
NATIONAL BASKETBALL ASSOCIATION (typed)	2216096  NBA Properties, Inc.	Toys and sporting goods, namely, basketballs, golf balls, playground balls, sports balls ... (28)	2(f) as to entire mark  Disclaimer of BASKETBALL ASSOCIATION
NATIONAL BASKETBALL ASSOCIATION (typed)	2183983  NBA Properties, Inc.	Clothing, namely, hosiery, footwear, t-shirts ... (25)	2(f) as to entire mark

*Id.*; Office Action of March 13, 2015.

Applicant relies on the following third-party registration:<sup>5</sup>

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<sup>5</sup> Applicant also relies on another Federacion Mexicana De Futbol registration for essentially the same mark for insurance, financial and other services in Class 36, in which only A.C. is

<u>Mark (translation)</u>	<u>Registration No./ Owner</u>	<u>Relevant Goods/Services/Class</u>	<u>Disclaimer/ 2(f) Claim</u>
 <p>“The foreign wording in the mark translates into English as ‘Mexican Soccer Federation’”</p>	<p>3119262</p> <p>Federacion Mexicana De Futbol Assoc. A.C.</p>	<p>Footwear and sporting footwear; men’s women’s and children’s clothing, namely ... T-shirts, sweatshirts ... (25)</p> <p>Toys and sporting goods, namely ... soccer balls ... (28)</p>	<p>Disclaimer of A.C. only</p>

Office Action response of October 16, 2014.

### Analysis

Under Section 6(a) of the Act, “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable,” such as a component which is merely descriptive under Section 2(e)(1). Failure to comply with a disclaimer requirement is a basis for refusing registration. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399-1400 (Fed. Cir. 2006); *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

In considering descriptiveness, we typically assess whether the mark in question immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the *goods for which it is used*. *In re Bayer Aktiengesellschaft*, 488 F.3d 960,

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disclaimed, but this registration is of little relevance here, where the goods in question are clothes in Class 25 and sporting goods, games and toys in Class 28.

82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (quoting *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009)); *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). In this case, however, the disclaimer requirement is based primarily on the Examining Attorney's finding that DEUTSCHER FUSSBALL-BUND describes not the goods themselves, but rather the *source* of the goods in Classes 25 and 28. See, e.g., *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001) ("It is well-established that a term which describes the provider of goods or services is also merely descriptive of those goods and services.... Certainly, 'doctor's diet' for a diet plan would be understood by consumers as describing a diet designed or provided by a doctor, even though 'doctor' does not describe the qualities or mechanics (e.g., low fat, low carbohydrate) of the diet plan."); see also *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012) (finding NATIONAL CHAMBER merely descriptive of providing information about Chambers of Commerce and in the field of business, and administering a discount program).

For the most part, Applicant does not quarrel in its Appeal Brief with the proposition that a term which is descriptive of the goods' provider is merely descriptive. Rather, Applicant takes issue with the Examining Attorney's third-party registration evidence, and argues that the Mexican Soccer Federation registration identified above which does not include a disclaimer or 2(f) claim as to MEXICAN SOCCER FEDERATION is "the most relevant," i.e. most analogous, third-party registration of record.

We do not view the registrations of record the way Applicant does. First, and perhaps most significantly, Applicant already disclaimed DEUTSCHER FUSSBALL-BUND, the exact term in question, in connection with: (1) its cancelled Registration No. 2233174, which identified goods in Classes 25 and 28 identical to those in the involved application; and (2) the Class 41 services in the involved application. The disclaimer in Registration 2233174 constitutes a concession that DEUTSCHER FUSSBALL-BUND is merely descriptive of at least some of the Class 25 and 28 goods in the involved application. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013), *aff'd*, 565 Fed. Appx. 900 (Fed. Cir. 2014); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.* 89 USPQ2d 1844, 1851 (TTAB 2008). And even if it did not, the record reveals no reason why DEUTSCHER FUSSBALL-BUND would be descriptive of Applicant's soccer-related services in Class 41 (as evidenced by the disclaimer of the term for the Class 41 services in the involved application) but not Applicant's soccer-related goods in Classes 25 and 28.

Second, the third-party registrations reveal that in the overwhelming majority of cases, terms such as those at issue here are disclaimed or the subject of Section 2(f) claims<sup>6</sup> for goods such as those Applicant identified in Classes 25 and 28. Indeed, even if we agreed with Applicant that the registration including the Spanish words which translate to MEXICAN SOCCER FEDERATION was most analogous to the

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<sup>6</sup> Where "an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive." *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

involved mark, this is only one registration out of more than 17 of record. Included among the remaining 16 registrations listed above are disclaimers of or Section 2(f) claims as to: MAJOR LEAGUE SOCCER, GERMAN-JUNIOR-MASTERS, UNION OF PUBLIC ASSOCIATIONS and INTERNATIONAL HAND-TO-HAND FIGHTING SPORT FEDERATION, INTERNATIONAL ICE HOCKEY FEDERATION, INTERNATIONAL KENDO FEDERATION, INTERNATIONAL BOBSLEIGH & SKELETON FEDERATION, AMERICAN GERMAN BUSINESS CLUB, INTERNATIONAL FEDERATION FOR FAMILY DEVELOPMENT, GOLFERS' ASSOCIATION OF AMERICA, KENTUCKY HIGH SCHOOL ATHLETIC ASSOCIATION and NATIONAL BASKETBALL ASSOCIATION. While Applicant has established that the Office has not required disclaimers or Section 2(f) showings for analogous terms in every single case, the record reveals that at the very least the Office has been relatively consistent in treating terms such as GERMAN SOCCER FEDERATION as merely descriptive of Applicant's goods or analogous goods.

In addition to Applicant's existing and prior disclaimers and the third-party registrations, our decisions in *Major League Umpires* and related cases support the refusal to register because DEUTSCHER FUSSBALL-BUND describes the source of the goods in Classes 25 and 28. In *In re The Phone Company, Inc.*, 218 USPQ 1027 (TTAB 1983) we affirmed a refusal to register THE PHONE COMPANY as merely descriptive of mobile telephones and related products, stating: "The Examining Attorney essentially wishes us to decide that a mark which names the type of

commercial establishment from which particular goods come is merely descriptive of those goods. We believe the Examining Attorney is correct and affirm his refusal.” *Id.* at 1028.

Applicant appears to take the position that DEUTSCHER FUSSBALL-BUND/GERMAN SOCCER FEDERATION is or may be merely descriptive of its soccer-related (Class 41) services, but is not merely descriptive of its soccer-related (Classes 25 and 28) goods. However, we have previously rejected an analogous theory. *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“We hold, furthermore, that ‘PAINT PRODUCTS CO.’ is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company.”); *see also In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1216 (TTAB 2000) (finding that PSYCHOLOGY PRESS “is merely descriptive of applicant’s books because it directly and immediately conveys to purchasers that the books originate from a ‘press,’ that is, ‘a printing or publishing establishment.’”). Moreover, it does not affect our analysis that the terms DEUTSCHER/GERMAN and BUND/FEDERATION do not, by themselves, describe Applicant’s soccer-related clothing or sporting goods. In *In re Major League Umpires* we specifically rejected the applicant’s apparent argument “that a mark which is descriptive of the provider of the goods or services must also separately be merely descriptive of a different characteristic of the goods or services.” *Major League Umpires*, 60 USPQ2d at 1060. In doing so, we relied in part on *In re Old Boone Distillery Co.*, 172 USPQ 697 (TTAB 1972), in which DISTILLER’S LIGHT

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was found merely descriptive of scotch whisky, even though “[o]bviously DISTILLER’S describes the provider of the whisky, not the whisky itself.” *Major League Umpires*, 60 USPQ2d at 1060-61.

Moreover, in *Major League Umpires* the mark conveyed that the clothing and protective equipment was designed by major league umpires. *Id.* Similarly here, the term DEUTSCHER FUSSBALL-BUND conveys that Applicant, or a related company or individual, designed Applicant’s goods in Classes 25 and 28. And, as in *Major League Umpires*, the term for which Applicant seeks registration without a disclaimer conveys that its Class 25 and 28 soccer-related goods are the same as, or at least similar to, those used by German national team players. *Id.* at 1061.

### **Conclusion**

Because there is no dispute that DEUTSCHER FUSSBALL-BUND/GERMAN SOCCER FOUNDATION merely describes the source of Applicant’s soccer-related goods in Classes 25 and 28, there is no doubt that the term is merely descriptive of those goods. Accordingly, the disclaimer requirement on the basis of descriptiveness is affirmed.

Decision: The refusal to register in the absence of a disclaimer of DEUTSCHER FUSSBALL-BUND for the goods in Classes 25 and 28 is affirmed. This decision will be set aside if, within thirty days of the mailing date of this order, Applicant submits to the Board a proper disclaimer of DEUTSCHER FUSSBALL-BUND for its goods in Classes 25 and 28. Trademark Rule 2.142(g). The disclaimer should be worded as

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follows: “No claim is made to the exclusive right to use ‘DEUTSCHER FUSSBALL-  
BUND’ in Classes 025, 028 and 041 apart from the mark as shown.”