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PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

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Mailed: September 30, 2009

Opposition No. 91178960

Nike, Inc.

v.

Gregory A. Bordes

**Before Walters, Rogers and Mermelstein,  
Administrative Trademark Judges.**

**By the Board:**

Gregory A. Bordes ("applicant") seeks to register the mark B-MORE (in standard character form) on the Principal Register for "clothing, namely shirts, sweatshirts, athletic jerseys, shorts, and hats" in International Class 25.<sup>1</sup>

Nike, Inc. ("opposer") has filed a notice of opposition to the registration of applicant's mark on the ground that applicant's mark is primarily geographically descriptive of the identified goods in the subject application under Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(e)(2). Opposer further alleges that, since as early as 2004, it has used and

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<sup>1</sup>Application Serial No. 76552822, filed on October 20, 2003, based on an allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), asserting a date of first use anywhere since January 10, 2001 and date of first use in commerce since February 7, 2002.

is using the term "B MORE" in interstate commerce in connection with the description and promotion of certain athletic apparel, and intends to continue such use.

Applicant, in his answer, has denied the salient allegations of the notice of opposition. As affirmative defenses, applicant asserts that (1) the notice of opposition is barred by the doctrines of judicial estoppel, laches and unclean hands, (2) opposer lacks standing to maintain this proceeding and (3) registration of applicant's mark is consistent with prior registrations.

This case now comes up for consideration of (1) opposer's motion for summary judgment on its pleaded claim of geographic descriptiveness pursuant to Section 2(e)(2) of the Trademark Act and on the ground that applicant's asserted affirmative defenses should be dismissed inasmuch as they are defective and/or inapplicable as a matter of law and (2) applicant's cross-motion for summary judgment on opposer's lack of standing to maintain this case. The motions are fully briefed.

We first turn to applicant's cross-motion for summary judgment for lack of standing. In support thereof, applicant contends that opposer has failed to demonstrate, as a matter of law, that it has sufficient interest in the use of the term "B MORE" as a geographically descriptive term for its own goods to form a basis to oppose applicant's application or

that the registration of applicant's mark will impair opposer's ability to continue to use the term in a geographically descriptive manner. Specifically, applicant argues that opposer does not use and is not in a position to use the term "B MORE" to describe the origin of any of its goods and services inasmuch as opposer's goods and services do not originate from Baltimore, Maryland. Instead, applicant contends that opposer merely wishes to reference the fact that one of its endorsers is from Baltimore, Maryland, as part of its marketing and promotional strategy and that this type of ornamental or suggestive use of the term to refer to Baltimore could be achieved in any number of ways other than the use of the term "B MORE." Furthermore, applicant argues that opposer is a junior user of the mark "B MORE" and, as such, cannot have standing to oppose applicant's mark. Accordingly, applicant concludes that such use is not as an indicator of the geographic source or origin of opposer's goods and/or services and, therefore, opposer has failed to meet the minimum legal threshold to show that it has standing to pursue this opposition proceeding.

In opposition to applicant's motion, opposer initially notes that the Board, by order dated January 31, 2008, denied applicant's motion to dismiss this case on the ground that opposer failed to plead sufficiently its standing to pursue this opposition proceeding holding that "opposer has

sufficiently alleged its standing in paragraph 2 of the notice of opposition that it has used and is using the term 'B-MORE' in interstate commerce in connection with athletic apparel." See Board order dated January 31, 2008. As affirmative proof of its standing, opposer refers to the declaration of Joseph Quigley, submitted in support of its own motion for summary judgment, which opposer contends establishes the absence of genuine issues about the following facts:

Since at least as early as 2004, Nike has used and is using the term "B MORE" in interstate commerce in connection with the description and promotion of certain athletic apparel, and intends to continue such use. (Quigley Decl. ¶ 4);

Nike began using "B MORE" in connection with products developed and marketed as part of an endorsement relationship with Carmelo Anthony, a professional basketball player who grew up in Baltimore, Maryland. (Quigley Decl. ¶ 5);

Nike chose to use "B MORE" in this fashion as a way to reference Mr. Anthony's hometown through a commonly known nickname for the city. (Quigley Decl. ¶ 5);

An article from the Rocky Mountain News recognized that Nike's use of "B MORE" on a shoe in fact referred to the city of Baltimore. (Quigley Decl. ¶ 5, Ex. A);  
and

Nike would be damaged if B-MORE became registered, as applicant would obtain at least a prima facie exclusive right to use the term in certain contexts, which would cloud Nike's right to continue using B MORE in its own endeavors. (Quigley Decl. ¶ 7).

A party has standing to oppose a particular application when it demonstrates that it has a real interest in the proceeding, and a reasonable basis for the belief that it will

be damaged by the issuance of a registration. *Herbko International v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses.

*Federal Glass Co. v. Corning Glass Works*, 162 USPQ 279, 282-83 (TTAB 1969); see also McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:11 (4<sup>th</sup> ed. 2004) ("Standing is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business.").

After a careful review of the record, the Board finds that opposer has sufficiently demonstrated, by way of the declaration of Joseph Quigley, the absence of any genuine issue of fact that it has used and continues to use the term

"B MORE" in connection with certain athletic apparel and, therefore, has established its standing, as a matter of law, to pursue this opposition proceeding. In addition, and contrary to applicant's arguments, opposer does not need to prove priority in this case because the issue is geographic descriptiveness and not likelihood of confusion. *Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1449 (Fed. Cir. 1990) ("There is one point on which we fully agree with the board. It appears in footnote 6 of the board opinion and reads: The emphasis each party has given to the first use of 'TRAVEL CARE' by defendant in terms of priority is not warranted. The issue here is descriptiveness ... and therefore priority of use is not an element in proving the case."). Also, opposer does not need to show it is using the mark. "It is enough to show such interest as will justify the conclusion that damage to it will ensue if the use of such term by it or its customers to describe their goods is denied." *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 805, 120 USPQ 293, 294 (CCPA 1959).

Inasmuch as opposer has established its standing in this proceeding, the Board denies applicant's cross-motion for summary judgment for lack of standing and grants the motion in favor of opposer as the non-moving party.

We now turn to opposer's motion for summary judgment. By way of its motion, opposer seeks judgment, as a matter of law, as to its pleaded claim that applicant's mark is primarily geographically descriptive of the identified goods.

Additionally, opposer seeks dismissal of applicant's asserted affirmative defenses inasmuch as opposer purports that the defenses are defective and/or inapplicable as a matter of law.

In support of its motion, opposer contends that there exists overwhelming evidence which demonstrates that the primary significance of the term B-MORE is geographic. Specifically, opposer asserts that dictionaries and reference works, as well as everyday speech and writing, define B-MORE as a geographic reference to the city of Baltimore, Maryland. Moreover, opposer argues that applicant's own statements and admissions are consistent with the geographic nature of the term B-MORE. In particular, opposer states that, in response to opposer's requests for admissions, applicant admitted that the term B-MORE is derived, in part, from the slang nickname for the city of Baltimore, Maryland, and that applicant's business is based in Baltimore, Maryland. Furthermore, opposer contends that applicant, in response to an office action during the prosecution of the subject application herein, unequivocally stated the following: (1) applicant "is the owner and proprietor of B-MORE, a Baltimore, Maryland-based sole proprietorship in the business of selling apparel

targeted toward youth and urban markets and hopes to use its apparel to, among other things, promote the City of Baltimore," (2) applicant is "focused on selling clothing to the local Baltimore, Maryland, urban and youth market," and (3) applicant admits that "applicant's B-MORE mark was chosen because it is a slang nickname for the City of Baltimore." Additionally, opposer asserts that the USPTO has routinely treated the term B-MORE as geographically descriptive by requiring disclaimers of the term or relegating marks containing the term to the Supplemental Register. In further support of its position, opposer contends that the submitted declaration of Ronald R. Butters, a purported distinguished scholar in the fields of linguistics and lexicology, confirms that the primary significance of the meaning of B-MORE to the general public in the United States, including consumers of apparel, is as a geographic description of the city of Baltimore, Maryland.

In support of its motion, opposer has submitted the declaration of Joseph Quigley, Assistant General Counsel of opposer. Through his declaration, Mr. Quigley has submitted a copy of an article from the *Rocky Mountain News* which purportedly recognizes that opposer's use of B-MORE on a shoe in fact referred to the city of Baltimore, Maryland. Additionally, opposer has submitted the declaration of Michelle Calkins, an attorney with the law firm of Leydig,

Voit & Mayer, Ltd. which is representing opposer in this proceeding (hereinafter "the Calkins Declaration"). Ms. Calkins, through her declaration, has submitted (1) copies of third-party registrations and pending applications which, in part, have required a disclaimer of the term B-MORE on the ground that the term is geographically descriptive, as well as copies of office actions issued by examining attorneys who have found that the term B-MORE is geographically descriptive, (2) applicant's response to an office action dated May 29, 2007, as well as a copy of the original specimen submitted with applicant's application, and (3) copies of applicant's responses to opposer's first request for admissions, dated March 11, 2008. Finally, opposer has submitted the declaration of Ronald R. Butters, Ph.D., Professor Emeritus of Duke University who at various times chaired both the English and Linguistics programs while at Duke University. By way of his declaration and exhibits attached thereto, Dr. Butters attests to the geographic significance of the phrase "B-MORE" as being a well-known nickname used to designate the city of Baltimore, Maryland.

In response to opposer's motion, applicant contends that there remain genuine issues of material fact as to whether the phrase B-MORE is primarily geographically descriptive of applicant's identified goods. Applicant asserts that it has presented evidence, principally through its own expert

witness, which purportedly demonstrates that the term B-MORE is not generally known throughout the country as being geographically equivalent to the City of Baltimore. Moreover, applicant argues that its goods are not principally manufactured in the City of Baltimore and are not identified in applicant's marketing as being a product of Baltimore. Further, applicant contends that it chose the B-MORE mark because of its susceptibility to multiple meanings, including the aspirational message "Be more!". Finally, applicant argues that its use of the B-MORE mark is entirely consistent with the statements made by applicant in its arguments to the Office in response to an office action during examination of his application and, based on those arguments, applicant asserts that his mark is not primarily geographically descriptive in nature.

In support of its response, applicant has submitted the Declaration of Dr. Michael Israel, Associate Professor of Language at the University of Maryland, College Park (hereinafter the "Israel Declaration"). By way of his declaration, Dr. Israel attests to the significance of the term B-MORE and opines, in part, that, while some evidence exists that the term B-More is used as an abbreviation for the city of Baltimore, it is not one of the more common abbreviations for that city; rather, the term B-MORE is likely to be associated with the aspirational phrase "Be More."

In reply, opposer contends that applicant does not contest its own admissions that the term B-MORE is derived, in part, from a slang nickname for the City of Baltimore, Maryland, or that its business is based in Baltimore, Maryland. Moreover, opposer asserts that applicant does not explain his own unequivocal statements to the USPTO that he "is the owner and proprietor of B-MORE, a Baltimore, Maryland-based sole proprietorship in the business of selling apparel targeted toward youth and urban markets and hopes to use its apparel to, among other things, promote the City of Baltimore." Further, opposer argues that applicant does not take issue with the USPTO's purported treatment of the phrase B-MORE as a geographically descriptive term. Additionally, opposer contends that the Israel Declaration, submitted in support of applicant's response to opposer's motion for summary judgment, is largely in agreement with opposer's position and the opinions of opposer's own expert. In particular, opposer claims that Dr. Israel candidly declares, in part, that that the term B-MORE would make a perfect ad hoc abbreviation for the city of Baltimore and that in some communities within Baltimore, and for some speakers outside of Baltimore familiar with these communities, the term B-MORE is used as a sort of affectionate slang nickname for the city.

Finally, opposer argues that, by failing to address opposer's arguments that applicant's affirmative defenses are

inapplicable and/or defective as a matter of law, applicant has conceded that opposer is also entitled to summary judgment on the applicant's affirmative defenses of judicial estoppel, laches, unclean hands and prior registrations.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to summary judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine dispute with respect to material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As stated above, the issue presented by opposer's motion for summary judgment is whether there is a genuine issue of material fact as to whether applicant's B-MORE mark is primarily geographically descriptive of the goods identified in the subject application.

A term is deemed to be primarily geographically descriptive, and thus unregistrable under Trademark Act

Section 2(e)(2), 15 U.S.C. § 1052(e), where it is shown that (1) the primary significance of the term sought to be registered is that of a geographical place and, if so, that (2) purchasers would make a goods/place or services/place association between the goods or services at issue and the geographical place named in the mark, i.e., they would believe that the goods or services originate in that place. *See, e.g., In re International Taste Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1450 (TTAB 1994).

Initially, the Board finds that opposer has carried its burden in establishing that there exist no genuine issues of material fact as to whether the primary significance of applicant's proposed mark, B-MORE, is that of a geographical place, i.e., it is a nickname of the city of Baltimore, Maryland. Indeed, the overwhelming evidence of record, including applicant's own statements and admissions, clearly demonstrates that the general consuming public or, at a minimum, the residents of Baltimore, Maryland, and the surrounding metropolitan area, would perceive the primary significance of the term B-MORE to be a geographic designation for the city of Baltimore, Maryland. The Board notes, however, that while some of the evidence of record, in particular, Dr. Michael Israel's declaration, suggests that the salient association of the phrase B-MORE is likely

to be to the aspirational phrase "Be more!," the Board does not find that such evidence creates a genuine issue of material fact regarding the geographic significance of the phrase B-MORE. Dr. Israel himself concedes that (1) in some communities within Baltimore, and for some speakers outside of Baltimore familiar with these communities, the term B-MORE is used as an affectionate slang nickname for the city and (2) for those speakers familiar with it, the word B-MORE offers a way of simultaneously referring to the city of Baltimore and expressing a kind of solidarity with the city, or with a particular sub-culture within the city. See Israel Declaration, ¶¶ 13, 22, and 43-44. Indeed, the test is whether the mark is *primarily* geographically descriptive, not solely a geographic designation. See *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1607 (TTAB 1992) (While London has surname significance, it remains primarily geographically descriptive); see also *In re The Cookie Kitchen, Inc.*, 228 USPQ2d 873, 874 (TTAB 1986). Thus, the fact that the B-MORE mark may have some other connotation does not necessarily create a genuine issue of material fact as to its *primary* significance. In view of the foregoing, opposer has established the absence any genuine issue of fact concerning the first prong of the Section 2(e)(2) test.

Turning next to the second prong of the Section 2(e)(2) test, the Board similarly finds that there is no genuine issue of material fact as to whether applicant's business is located in Baltimore, Maryland. Indeed, applicant admitted, through his response to opposer's request for admissions, that his business is based in Baltimore, Maryland. See Applicant's Response to Request for Admission ¶ 3, attached as Exhibit G to the Calkins Declaration. Further, in response to an office action, applicant stated, among other things, that it is the owner and proprietor of B-MORE, a Baltimore, Maryland-based sole proprietorship in the business of selling apparel targeted toward youth and urban markets and hopes to use its apparel to, among other things, promote the City of Baltimore. See Exhibit F attached to the Calkins Declaration. Accordingly, a goods/place association is presumed. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998). Thus, opposer has established the absence of any genuine issue of material fact regarding the second prong of the Section 2(e)(2) test.

In view of the foregoing, no genuine issues of material fact exist and we conclude that applicant's B-MORE mark is primarily geographically descriptive of the goods identified in his application. The Board now turns its attention to applicant's affirmative defenses and will address each one separately.

Lack of Standing

As discussed above, the Board has found that opposer has demonstrated its standing to pursue this opposition proceeding. Accordingly, applicant's affirmative defense of lack of standing is dismissed.

Laches

The Board notes that the affirmative defense of laches is inapplicable in opposition proceedings. *See National Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). In view thereof, applicant's affirmative defense of laches fails, as a matter of law, and is also dismissed.

Judicial Estoppel

In determining whether judicial estoppel applies in Board proceedings, four factors are considered: (1) judicial acceptance of the previously asserted position; (2) risk of inconsistent results; (3) effect of the pleading party's actions on the integrity of the judicial process; and (4) perception that the tribunal has been misled. *See Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999). In this instance, applicant has failed to allege any of these factors or how the

doctrine of judicial estoppel applies to the present case. Even if such an affirmative defense had been properly pleaded by applicant, none of the factors are present in this proceeding. The record does not demonstrate that opposer has been involved in any previous judicial action or administrative proceeding involving the geographic significance of the phrase B-MORE or that opposer has filed any application for such term. Therefore, there can be no risk of inconsistent results or any adverse effect on the integrity of the judicial process, nor a perception that any tribunal has been misled. Accordingly, applicant's affirmative defense of judicial estoppel fails as a matter of law and is therefore dismissed.

#### Unclean Hands

With respect to applicant's affirmative defense of unclean hands, the Board initially notes that applicant has failed to plead sufficient facts to support this defense or provide opposer with sufficient notice of any specific and allegedly improper actions. Further, applicant has failed to provide any affirmative proof or argument in support of this defense. Accordingly, applicant's affirmative defense of unclean hands is dismissed.

Registration of Applicant's Mark is Consistent with Prior Registrations

The Board finds that the above-identified affirmative defense is vague and does not give rise to a valid defense under any recognizable theory. Regardless, applicant has failed to provide any clarification of said defense or any affirmative proof in support thereof. Accordingly, this affirmative defense is also dismissed.

In view of the foregoing, the Board finds that no genuine issues of material fact exist in regard to applicant's asserted affirmative defenses of lack of standing, laches, judicial estoppel, unclean hands, or that registration of applicant's mark is consistent with prior registrations and opposer is, therefore, entitled to judgment in its favor on each of these defenses. It was applicant's duty, in response to opposer's motion for summary judgment, to establish that applicant has one or more valid affirmative defenses and that genuine issues of fact exist, for resolution by trial, in regard to such defenses. Applicant, however, has failed to do so.

Accordingly, opposer's motion for summary judgment is **granted** in its favor on both its asserted Section 2(e)(2) claim and on applicant's asserted affirmative defenses.

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The opposition is sustained, judgment is hereby entered against applicant, and registration to applicant is refused.