

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

jk

Mailed: May 7, 2015

Opposition No. 91219497

SSG Baseball, LLC d/b/a Select Sport
Group Baseball and d/b/a SSG
Baseball

v.

Select Sports Group, LLC

By the Board:

Select Sports Group, LLC. (“Applicant”) filed two applications on June 10, 2014, to register the following marks for “personal and business management services for professional athletes; business services provided to professional athletes, namely, the negotiation and execution of contracts with professional sports franchises; marketing of endorsement services provided by professional athletes; public relations services” in International Class 35:¹

- 1) SELECT SPORTS GROUP (standard characters, SPORTS GROUP disclaimed)



- 2) (application includes the description “The mark consists of capital letters ‘S’, ‘S’, and ‘G’, arranged to resemble three sides of a cube.”).

¹ The applications are: Serial No. 86305173, alleging a date of first use anywhere and date of first use in commerce of June 6, 2003; and Serial No. 86305177, alleging a date of first use anywhere and date of first use in commerce of November 23, 2004.

SSG Baseball, LLC /d/b/a Select Sport Group Baseball and d/b/a SSG Baseball (“Opposer”) filed two notices of opposition against the applications, alleging, respectively, ownership of two applications to register the following marks for “personal and business management and agency services, namely, sports agents representing professional sport athletes” in International Class 35:²

- 1) SELECT SPORTS GROUP BASEBALL (standard characters)
- 2) SSG BASEBALL (standard characters).

In lieu of filing an answer, Applicant filed a motion to dismiss the notices of opposition for failure to state a claim upon which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6). The motion is fully briefed.

APPLICANT’S MOTION TO DISMISS

Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *See* TBMP § 503.02 (2014), and cases cited therein. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that 1) the plaintiff has standing to maintain the proceeding, and 2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982).

² The applications are: Serial No. 86333501, alleging a date of first use anywhere and date of first use in commerce of January 22, 2010, and Serial No. 86333492, alleging a date of first use anywhere and date of first use in commerce of January 22, 2010.

See also TBMP § 503.02 (2014). Specifically, “a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007).

The Board has reviewed the notice of opposition in its entirety, as well as all arguments set forth in support of and in defense of the motion to dismiss. For brevity, the Board does not restate all of the arguments herein.

Standing

Applicant does not challenge Opposer’s standing in its motion to dismiss. Nevertheless, for completeness, the Board addresses this issue.

Opposer alleges, *inter alia*, that it is a professional sports agency representing professional baseball players (not. of opp., para. 6), that it has filed two applications to register the marks SELECT SPORTS GROUP BASEBALL and SSG BASEBALL (not. of opp., para. 7, 8, 9), and that when the parties’ respective marks are applied to the respective services there is a

likelihood of confusion that will result in damage and detriment to Opposer (not. of opp., para. 12).

Based on these assertions in the pleadings, Opposer has set forth allegations which, if proven, would establish its standing to bring this proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Grounds

Applicant argues that “[O]pposer has not, and cannot, allege priority under Section 2(d)” (motion, p. 5), and that “[O]pposer does not allege that it was the first used (sic) of SELECT SPORTS GROUP or the SSG Logo, nor could it” (motion, p. 6). Contesting the motion, Opposer argues that “[A]pplicant states that Opposer has not and cannot, allege priority under Section 2(d). Opposer has not alleged this, nor is Opposer required to allege this” (Opposer’s brief, p. 5).

Opposer’s argument is incorrect. To state a claim under Trademark Act § 2(d), Opposer must sufficiently allege that 1) it has standing, *and* 2) it has registered or previously used a mark; *and* 3) contemporaneous use of the parties’ respective marks on or in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733,

1735 (TTAB 2001). Accordingly, whether Opposer sufficiently alleges priority is, indeed, an essential inquiry in determining the sufficiency of the notices of opposition.

In paragraph 10 of each of the notices of opposition, Opposer alleges as follows:

Opposer and its predecessor-in-interest, SSG Baseball, L.P., have owned and held the unconditional right to use the marks “SSG Baseball” and “Select Sports Group Baseball” (“Opposer’s marks”) since at least January 2010. Throughout that almost five-year period, Opposer and its predecessor have operated their baseball agencies under those marks with Applicant’s specific knowledge and consent, from common office space shared with Applicant in Houston, Texas. Thus, commencing long prior to Applicant’s filing date, Applicant agreed and consented to Opposer’s exclusive use of the Opposer’s Marks in connection with Opposer’s agency business and representation of professional baseball clients. Applicant represents other professional sports athletes in sports other than baseball.

Upon a reading of this paragraph, as well as the remainder of the notices of opposition, Opposer has not pleaded priority, that is, that it acquired trademark rights prior to Applicant, by way of a sufficient pleading that it has proprietary rights that arise from, for example, a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to allege proprietary rights. *See Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981). Opposer did not plead ownership of and make of record an existing and valid registration pursuant to Trademark Rule 2.122(d)(1). *See King*

Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). As a general rule, the earliest date upon which an applicant may rely for priority purposes is its constructive use date, that is, the filing date of its application. *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (“applicant may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority.”). In the pleadings, Opposer refers to a specific date in connection with its use of its marks only in restating the filing date of its applications (not. of opp., para. 8), in stating that it and its predecessor-in-interest “held the unconditional *right to use* the marks...since at least January 2010” (not. of opp., para. 10; emphasis added), and in restating the date of first use alleged in its applications (not. of opp., para. 9) as well as that it has invested in its mark and services “since its initial use almost five (5) years ago” (not. of opp., para. 11). These allegations do not constitute an allegation of Opposer’s actual prior rights in a mark, and fail to place Applicant on adequate notice of the factual basis for this necessary element of a § 2(d) claim.

Based on the record and these findings, the notices of opposition fail to set forth allegations of Opposer’s prior rights in a mark.

Contesting the motion, Opposer additionally argues that “[C]ontrary to Applicant’s assertion, equitable defenses such as estoppel and laches can justify an opposition and even the denial of a trademark registration” (motion, p. 5). Opposer’s argument is incorrect. Laches, acquiescence,

estoppel and unclean hands are affirmative defenses, not grounds for opposition. *See Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n. 39 (TTAB 1994). The case³ upon which Applicant relies does not overcome the application of this principle.

In view of these findings, Applicant's motion to dismiss for failure to state a claim pursuant to § 2(d) is granted. Fed. R. Civ. P. 12(b)(6).

For completeness, the Board notes that Opposer lists on the filing cover sheet to its pleadings the following additional three grounds for opposition: 1) false suggestion of a connection, 2) dilution, and 3) "other" identified further as "Breach of contract." Opposer fails to state a claim for false suggestion of a connection pursuant to Trademark Act § 2(a),⁴ and fails to state a claim for dilution pursuant to Trademark Act § 43(c).⁵ Lastly,

³ The case relied upon is *Annie M. Malone v. Proctor & Gamble Co.*, 17 USPQ 554 (CCPA 1933).

⁴ To set forth a claim that the mark falsely suggests a connection pursuant to Trademark Act § 2(a), a plaintiff must sufficiently allege that: 1) the mark that is registered is the same as, or a close approximation of, the name or identity previously used by another person or institution, 2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution, 3) the person or institution identified in the mark is not connected with the goods sold by defendant under the mark, and 4) the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when defendant's mark is used on its goods. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508-10 (Fed. Cir. 1983); *Buffet v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

⁵ To set forth a claim of dilution under Trademark Act § 43(c), a plaintiff must allege that: 1) its mark is famous, 2) its mark became famous prior to the use or constructive use of the defendant's mark, and 3) that the defendant's mark is likely to blur the distinctiveness of the plaintiff's famous mark. *See Trademark Act § 43(c)*;

breach of contract is not a statutory ground for opposition inasmuch as the Board's jurisdiction is limited to determining the registrability of Applicant's mark, and does not include causes of action for breach of contract. *See* TBMP §§ 102.01 and 605.03(d) (2014). Consequently, the only evidence that will be deemed relevant to this proceeding is that which is probative of Applicant's right to register its marks for the identified services; whether Applicant's use of its marks, or of any other marks, is otherwise appropriate, is beyond the Board's jurisdiction. The Board will give no consideration to Opposer's assertion of "breach of contract."

Leave to amend

Upon granting a motion to dismiss in whole or in part, the Board may exercise its discretion to allow the plaintiff an opportunity to file an amended pleading, as appropriate. *See* TBMP § 503.03 (2014). The Board finds it appropriate to allow Opposer an opportunity to amend the pleadings. However, in view of the Board's determination that suspension pursuant to Trademark Rule 2.117(a) is appropriate (discussed below), the Board defers the filing of further pleadings until such time as the Board resumes this opposition proceeding.

OPPOSER'S MOTION TO SUSPEND

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action which may be dispositive of or may have

Nat'l Pork Board v. Supreme Lobster and Seafood Co., 96 USPQ2d 1479, 1494-95 (TTAB 2010).

a bearing on the Board proceeding. The Board may also, in its discretion, suspend pending a civil action between the parties in a state court, or another Board proceeding. The applicable authority, Trademark Rule 2.117(a), provides as follows:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

See also TBMP § 510.02(a) (2014), and cases cited therein; *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992).

To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the decision of the Board is not binding on the district court. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn 1986).

Opposer moves for suspension of this opposition pending the outcome of a civil action that it filed against Applicant on February 9, 2015 in the District Court of Dallas County, Texas (“civil action”), and which is captioned *SSG Baseball, LLC v. Select Sports Group, LLC*, Case No. DC-15-01633. Opposer submitted a copy of the complaint it filed therein.

The Board notes Applicant's request for an opportunity to brief the issue of suspension in the event that the Board considers the merits of the motion.⁶ However, suspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board. *See* TBMP § 510.02(a) (2014). The full briefing of a motion to suspend pursuant to Trademark Rule 2.117(a) is not a prerequisite to the Board's consideration of whether suspension under that provision is appropriate.

A review of the complaint filed in the civil action indicates that it involves a dispute over the parties' respective rights in their marks, and specifically, in the marks that are at issue in this opposition. In the civil action, Opposer (plaintiff, therein) seeks a declaratory judgment that, *inter alia*, it has ownership of and/or the right to use the marks "SSG Baseball" and "Select Sports Group Baseball," and that it has not infringed on the rights of Applicant (defendant, therein).

Based on this record, the Board finds that the outcome of the civil action may have a bearing on the parties' respective rights, and thus a bearing on this opposition. In view thereof, suspension is appropriate pursuant to Trademark Rule 2.117(a). Opposer's motion is granted. Accordingly, this proceeding is suspended pending final disposition of the civil action.

⁶ Applicant's March 31, 2015 submission, filed after Opposer filed its reply brief, is a surreply. The Board does not consider surreplies. *See* Trademark Rule 2.127(a); TBMP § 502.02(b) (2014).

Within twenty (20) days after the final determination of the civil action, the interested party shall so notify the Board by filing notification(s) of this herein, which should include a copy of any final judgment issued, so that the Board can call this case up for any appropriate action.⁷

During the suspension, the Board may issue periodic inquiries regarding the status of the pending civil action.

During the suspension, the parties must notify the Board of any address changes for the parties or their attorneys.

The Board is aware of the decision that Applicant discusses. The decision does not remove, or preclude application of, Trademark Rule 2.117(a).

⁷ A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.* a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed therefrom have been decided. *See* TBMP § 510.02(b) (2014).