

This Opinion is Not a
Precedent of the TTAB

Mailed: July 17, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Opposition Nos. 91220066 (parent) & 91221745

Lile Inc.
v.
BCS Properties, LLC


James R. Hastings and Lisa A. McAndrews
of Collen IP Intellectual Property Law PC for Lile Inc.

Steven P. Hollman of Sheppard Mullin Richter & Hampton LLP
for BCS Properties, LLC

Before Taylor, Wellington, and Lynch
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Applicant has filed applications to register as marks the following (more fully set forth, *infra*):

Application Serial No. 85919900 for the mark  **COLLEGE FOOTBALL PLAYOFF**; and

Application Serial No. 85888764 for the mark COLLEGE FOOTBALL PLAYOFF (standard characters).

I. Background

This consolidated proceeding includes two oppositions brought by Lile Inc. (“Opposer”) against BCS Properties, LLC (“Applicant”).¹ The cases are fully briefed. Applicant is an intellectual property holding company related to the entity that administers the NCAA Division I Football Bowl Subdivision postseason football tournament. As of the 2014-15 season, the tournament transitioned from the prior “Bowl Championship Series” to a four-team playoff format known as the “College Football Playoff.”² With the new tournament format and name, Applicant sought trademark protection for various marks for numerous goods and services.

Applicant already owns the following registrations, among others:



Registration No. 4748471 for the mark **COLLEGE FOOTBALL PLAYOFF**, with COLLEGE FOOTBALL PLAYOFF disclaimed, for:

Entertainment services in the nature of television sports programs featuring college football games, exhibitions and tournaments; entertainment services, namely, organizing and staging college football games, exhibitions and tournaments; and providing entertainment, information, news and programming, polls, scores, standings, statistics,

¹ Upon consolidation, 6 TTABVUE, Opposition No. 91220066 became the “parent” case, in which all filings except the pleadings reside. Unless otherwise indicated, TTABVUE citations are to the record of the parent case.

² 61 TTABVUE 858 (Hancock Declaration).

and history and background, all in the field of the sport of football, via the internet in International Class 41.³



Registration No. 5335688 for the mark **COLLEGE FOOTBALL PLAYOFF**, with FOOTBALL disclaimed, for “collectible toys, namely, collectible full-sized replica footballs” in International Class 28.⁴



A. Opposition No. 91220066 —



In this proceeding, on the grounds of mere descriptiveness and lack of bona fide intent to use the mark,⁵ Opposer opposes registration of Applicant’s applied-for mark



**COLLEGE FOOTBALL
PLAYOFF**

for the following goods:

Metal key chains in International Class 6;

Video game software; digital media, namely, pre-recorded DVDs, downloadable audio and video recordings, and CDs featuring college football games, exhibitions and tournaments, and promoting the sport of football; downloadable software in the nature of a mobile application software for mobile phones and tablet computers for providing entertainment, information, news and programming, polls, scores, standings, statistics, and

³ 63 TTABVUE 20-27. *See also* Opposer’s Brief, 72 TTABVUE 16.

⁴ *See also* Opposer’s Brief, 72 TTABVUE 17-18.

⁵ 36 TTABVUE 2-10 (Amended Notice of Opposition). A likelihood of confusion ground included in the Notice of Opposition was subsequently withdrawn. 45 TTABVUE.

history and background, all in the field of the sport of football in International Class 9;

Jewelry, watches, pendants, rings, medallions, collectible coins in International Class 14;

Printed publications in the form of game programs, media guides and commemorative books in the field of sports and entertainment; bumper stickers, decals and paper pennants in International Class 16;

Wallets, billfolds in International Class 18;

Plastic novelty license plates; vinyl flags in International Class 20;

Mugs and beverage glassware in International Class 21;

Men's, women's, and children's clothing, namely, t-shirts, sweat shirts, sweat pants, caps, hats, pullovers, jerseys, and jackets, visors, shorts, socks, sweatbands, scarves, and sweaters in International Class 25;

Rugs in International Class 27; and

Toy novelty items, namely, foam fingers and hands; sports equipment, namely, footballs and kicking tees; collectible toys, namely, full-sized replica football helmets and mini collector football helmets, collectible full-sized replica footballs in International Class 28.⁶

The application includes a disclaimer of COLLEGE FOOTBALL PLAYOFF for International Classes 9 and 16, and a disclaimer of FOOTBALL for International

⁶ Application Serial No. 85919900 was filed May 1, 2013, based on an alleged bona fide intention to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application contains the following description of the mark: "The mark consists of the words 'COLLEGE FOOTBALL PLAYOFF' in black below a design of a football with the outer shape of the football depicted in gold and the laces of the football in black. The color(s) black and gold is/are claimed as a feature of the mark."

Class 28. In its answer, Applicant denies the salient allegations of the amended notice of opposition.⁷

B. Opposition No. 91221745 — COLLEGE FOOTBALL PLAYOFF

On the same grounds,⁸ Opposer opposes Applicant's application to register COLLEGE FOOTBALL PLAYOFF in standard characters for the following goods, identical to those set out above, but omitting the goods in International Classes 9 and 16:⁹

Metal key chains in International Class 6;

Jewelry, watches, pendants, rings, medallions, collectible coins in International Class 14;

Wallets, billfolds in International Class 18;

Plastic novelty license plates; vinyl flags in International Class 20;

Mugs and beverage glassware in International Class 21;

Men's, women's, and children's clothing, namely, t-shirts, sweat shirts, sweat pants, caps, hats, pullovers, jerseys, and jackets, visors, shorts, socks, sweatbands, scarves, and sweaters in International Class 25;

⁷ 39 TTABVUE (Answer).

⁸ 36 TTABVUE 19-27 (Amended Notice of Opposition).

⁹ Application Serial No. 85888764 was filed March 28, 2013, based on an alleged bona fide intention to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant amended the application during prosecution to delete the goods in International Classes 9 and 16 after the Examining Attorney issued a final genericness and descriptiveness refusal as to these classes.

Opposer's Amended Notice of Opposition mistakenly recites goods in International Class 16 as part of this opposed application (and mistakenly refers to the opposed mark in this application as containing a design element). 36 TTABVUE 19-21. Applicant's Answer did not note or correct the errors. 38 TTABVUE 4.

Rugs in International Class 27; and

Toy novelty items, namely, foam fingers and hands; sports equipment, namely, footballs and kicking tees; collectible toys, namely, full-sized replica football helmets and mini collector football helmets, collectible full-sized replica footballs in International Class 28.

The application includes a disclaimer of FOOTBALL. In its answer, Applicant denies the salient allegations of the amended notice of opposition.¹⁰

C. Affirmative Defenses

In each proceeding, Applicant asserted various purported affirmative defenses in its Answer.¹¹ However, alleged lack of standing is not an affirmative defense because “[t]he facts regarding standing . . . are part of [a plaintiff’s] case and must be affirmatively proved.” *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017) (quoting *Lipton Ind., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)). With the exception of estoppel due to fraud on the USPTO, Applicant did not pursue the remaining purported affirmative defenses at trial, and they therefore are waived. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422-23 n.7 (TTAB 2014); *Alcatraz Media v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

In support of its affirmative defense of estoppel due to fraud, Applicant alleges that in Opposer’s Application Serial No. 86052371, Opposer’s misstatements about

¹⁰ 38 TTABVUE (Answer).

¹¹ 38 & 39 TTABVUE.

the date of first use and its specimen that was not in use as of the application filing date “should bar the application from maturing into registration.”¹² Opposer’s pending application, which remains suspended in examination, is not at issue in this proceeding. The Board has no jurisdiction over this application that is still pending before an examining attorney. *See, e.g., Home Juice Co. v. Runclin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986). Therefore, the affirmative defense seeks relief we cannot grant and therefore must be denied.

II. Evidentiary Record

The parties lodged a number of evidentiary objections. The Board previously denied Applicant’s motion to admit the discovery deposition testimony of Tanya Falleiro,¹³ so we have not considered it.

Opposer objects to Exhibits 15-19 of Applicant’s Notice of Reliance on hearsay grounds.¹⁴ Applicant responds that these materials are not offered for the truth of the matter stated in the Internet materials.¹⁵ Regarding hearsay, “[a]s a general matter, we do not treat testimony as to third-party out-of-court statements as proof of the truth of the matter asserted. The same is true for published articles [and internet website printouts]. However, such materials are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false. Accordingly, they will not be

¹² 73 TTABVUE 46 (Applicant’s Brief).

¹³ 69 TTABVUE 10-13.

¹⁴ 72 TTABVUE 41 (Opposer’s Brief, Appendix A).

¹⁵ 73 TTABVUE 50 (Applicant’s Brief, Appendix B).

excluded outright, but considered for what they show on their face.” *Harry Winston*, 111 USPQ2d at 1427-28.

Opposer objects to Exhibit 10 of Applicant’s Notice of Reliance¹⁶ as documents that Opposer produced in response to Applicant’s Request for Production of Documents that lack proper authentication.¹⁷ Applicant responds that Opposer authenticated these documents in its Rule 30(b)(6) deposition, 63 TTABVUE 542-601, and that Opposer has introduced a portion of these documents itself, 70 TTABVUE 23-210, such that this evidence can now be relied on by Applicant as well.¹⁸ Pursuant to Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii):

A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.

We find that the deposition testimony sufficiently authenticates these documents, and overrule the objection.

Opposer objects to Exhibits G-L of the Hancock Declaration¹⁹ as “unrelated trademark registrations” that were not identified or produced in discovery or pretrial disclosures.²⁰ These registrations are for marks including the term BOWL

¹⁶ 61 TTABVUE 241-407 (Applicant’s Notice of Reliance) (confidential).

¹⁷ 72 TTABVUE 41-42 (Opposer’s Brief, Appendix A).

¹⁸ 73 TTABVUE 51-52 (Applicant’s Brief, Appendix B).

¹⁹ 61 TTABVUE 1513-1550.

²⁰ *Id.* at 42.

CHAMPIONSHIP SERIES or BCS (BCS Marks), the postseason football tournament predecessor to the COLLEGE FOOTBALL PLAYOFF.²¹ The registrations are attached to the Hancock Declaration to corroborate his testimony that, in deciding what goods Applicant would include in the trademark applications at issue in this proceeding, Applicant relied on “the classes where we already had registered for protection, based on actual use, with respect to the Bowl Championship Series’s BCS mark that was the precursor to” the marks at issue.²² Applicant admits that these documents were not produced in response to discovery requests for evidence regarding the bona fide intention to use the marks at issue, but argues that the Hancock testimony was appropriate and that these public record documents merely corroborate the testimony, on which Opposer declined to conduct cross-examination.²³

The objection to these registrations is overruled. We note that in Mr. Hancock’s discovery deposition, he mentioned that in determining at least some of the goods to be included in the subject applications, Applicant may have relied “on what we had marketed with the – in the – with – for the BCS games.”²⁴ These registrations are publicly available, and Opposer was sufficiently on notice that Applicant claimed that the selection of goods in its applications was influenced by the goods on which it used its BCS Marks.

²¹ 47 TTABVUE 777 (Hancock Deposition) (confidential).

²² 61 TTABVUE 862, 808 (Hancock Declaration) (confidential).

²³ 73 TTABVUE 52 (Appendix B to Applicant’s Brief).

²⁴ 47 TTABVUE 809 (Hancock Deposition) (confidential).

Applicant objects to certain trial testimony from the Deeb Declaration on a variety of grounds such as that it is allegedly inconsistent with prior testimony, that it is “inherently unreliable,” constitutes hearsay, or is lay opinion testimony.²⁵ As indicated above in addressing Opposer’s hearsay objection, we bear in mind the hearsay rule in considering the testimony and purposes for which it is offered, but will not rule any of the Deeb Declaration inadmissible on this basis. Similarly, with the other objections regarding unreliability, inconsistency, or improper opinion testimony, “the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence. Thus, we have considered the evidence, keeping in mind the objections, and have accorded whatever probative value the testimony and evidence merits.” *United States Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006).

The record includes some evidence designated confidential, so we discuss this only in general terms. The record consists of:

- The pleadings.
- The files of opposed Application Serial Nos. 85919900 and 85888764.²⁶

²⁵ 74 TTABVUE 48-49 (Applicant’s Brief, Appendix A).

²⁶ See 37 C.F.R. § 2.122(b). Because the opposed application files are automatically of record under the applicable rule, it was unnecessary for Opposer and Applicant to submit copies by Notices of Reliance.

Opposer's Evidence:

- Excerpts from the file of Opposer's Application Serial No. 86052371, by Opposer's Notice of Reliance.²⁷
- Applicant's Discovery Responses under Opposer's Notice of Reliance.²⁸
- Excerpts from the discovery deposition of William Hancock submitted under Opposer's Notice of Reliance.²⁹
- The testimony declaration of Edward Deeb.³⁰
- Excerpts from the files of Applicant's Application Serial No. 85888738 (abandoned) and Registration Nos. 4748471, 5287201, 5312456, 5335642, and 5335688.³¹
- Internet materials submitted under Opposer's Notice of Reliance.³²
- H.R. 390 – College Football Playoff Act of 2009.³³

Applicant's Evidence

- A copy of Applicant's Application Serial No. 85888738 (abandoned) and status-and-title copies of Registration Nos. 4748471, 5287201, 5312456, 5335642, and 5335688 and excerpts from the files.³⁴
- Opposer's Discovery Responses under Applicant's Notice of Reliance.³⁵
- Excerpts from the file of Opposer's Application Serial No. 86052371.³⁶

²⁷ 46 TTABVUE 17-24.

²⁸ 47 TTABVUE (confidential).

²⁹ 47 TTABVUE 759-877 (confidential); *see also* 71 TTABVUE 78-96.

³⁰ 70 TTABVUE 1-238; 48 TTABVUE (confidential).

³¹ 46 TTABVUE 213-44; *see also* 71 TTABVUE 6-74 ('738 excerpts).

³² 46 TTABVUE 245-635; 71 TTABVUE 99-100.

³³ 71 TTABVUE 74-76.

³⁴ 63 TTABVUE 20-222

³⁵ 63 TTABVUE 223-; 61 TTABVUE (confidential).

³⁶ 64 TTABVUE 20-27.

- Internet materials submitted under Applicant’s Notice of Reliance.³⁷
- The testimony declaration of William Hancock under Applicant’s Notice of Reliance.³⁸
- The discovery deposition of Edward Deeb under Applicant’s Notice of Reliance.³⁹

III. Standing

Opposer must show a real interest in the proceeding and a reasonable basis for its belief of damage. *See* 15 U.S.C. §§ 1063, 1064; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). In support of its allegations of standing and asserted claims of mere descriptiveness and lack of bona fide intent to use the marks, Opposer pleads ownership of pending application Serial Number 86052371 for the mark CFBPLAYOFF.COM, in standard characters, for “Providing a website featuring information relating to the sport of football; Providing a web-based system and on-line portal for customers to participate in on-line gaming, operation and coordination of game tournaments, leagues and tours” in International Class 41. This application is suspended based on a potential likelihood of confusion under Section 2(d) of the Trademark Act with the marks opposed in this proceeding.⁴⁰ Opposer also pleads common law use of the mark CFBPLAYOFF.COM since at least as early as July 2008. Additionally, Opposer introduced evidence of a letter from

³⁷ 64 TTABVUE 28-1047; 62 TTABVUE 111-1130 (confidential); 71 TTABVUE 80-98.

³⁸ 61 TTABVUE 857-1551.

³⁹ 63 TTABVUE 405-852; 61 TTABVUE 407-855 (confidential).

⁴⁰ 46 TTABVUE 23.

Applicant asserting rights in COLLEGE FOOTBALL PLAYOFF marks. The letter demanded proof of prior use by Opposer, or assurances that Opposer would expressly abandon its pending application and cease plans to oppose any of Applicant's applications, and "reserve[d] all rights and remedies available at law and equity" to Applicant.⁴¹

The Board previously denied Applicant's motion for summary judgment that Opposer lacked standing and sua sponte entered summary judgment in Opposer's favor with respect to standing.⁴² As noted in the Board's order, the provisional refusal of Opposer's pending Application Serial Number 86052371 establishes its standing. *Lipton Ind.*, 213 USPQ at 189 ("Thus, to have standing in this case, it would be sufficient that [plaintiff] prove that it filed an application and that a rejection was made because of [defendant's] registration"); *Tri-Star Marketing, LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007). The Board order noted "that Opposer must maintain its standing throughout these proceedings,"⁴³ and Applicant continues to challenge Opposer's standing because Opposer withdrew its previously-asserted likelihood of confusion claim. However, based on the evidence, including that Opposer's pending application remains suspended in view of Applicant's opposed prior applications, we find no change in circumstances that would eliminate Opposer's previously determined standing.

⁴¹ 70 TTABVUE 8-9, 236-38 (Deeb Declaration, Exhibit E).

⁴² 44 TTABVUE.

⁴³ *Id.* at 9.

IV. Descriptiveness

Opposer claims that Applicant's marks immediately convey knowledge of a quality, characteristic, function, feature, purpose or use of the goods with which they are used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). “[M]arks that are merely descriptive cannot be registered unless they acquire secondary meaning under § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017). We must determine descriptiveness not in the abstract, but in relation to the goods for which registration is sought, the context in which the term is used, and the possible significance that the term is likely to have to the average prospective purchaser encountering the goods in the marketplace. *See In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

For marks with multiple components such as these, we “may not ‘dissect’ the mark into isolated elements, without ever consider[ing] . . . the entire mark, [but we] may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *See Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (internal quotations and citations omitted).

Opposer bears the burden of showing, by a preponderance of the evidence, that the designations sought to be registered are merely descriptive. *Id.*; *StonCor Grp.*,

Inc. v. Specialty Coatings, Inc., 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014). Opposer argues, citing *In re Chamber of Commerce* and *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005), that the oppositions should be sustained as to all the goods in the opposed multi-class applications if the marks are descriptive of any single good. We do not agree with Opposer's contention. Opposer must demonstrate the descriptiveness of the marks as to at least one good in each International Class to sustain the oppositions as to that class. Both *In re Chamber of Commerce* and *In re Stereotaxis* involved applications for marks for goods or services in a single International Class,⁴⁴ so the broad quoted language, "if the mark is descriptive of any of the goods for which registration is sought," is consistent with requiring a showing for at least one good per class. *Cf. In re Aquamar, Inc.*, 115 USPQ2d 1122 (TTAB 2015) (citing cases for the proposition that likelihood of confusion may be established "for any item encompassed by the identification of goods **within a particular class** in the application") (emphasis added).

A. Introductory Background on Opposer's Descriptiveness Argument

Much of Opposer's argument and evidence in this case centers on the descriptiveness of COLLEGE FOOTBALL PLAYOFF in relation to sporting events. Opposer points to the following evidence of the descriptiveness of COLLEGE FOOTBALL PLAYOFF in its Brief:⁴⁵

⁴⁴ In *In re Chamber of Commerce*, all the services in Serial Nos. 77975745 and 77147075 were in International Class 35. In *In re Stereotaxis*, all the goods in Serial No. 78108674 were in International Class 10.

⁴⁵ 72 TTABVUE 29-30.

- Evidence in the files of the opposed applications, which mainly focused on descriptiveness or genericness of the marks as to the software and digital media in International Class 9 and the printed publications in International Class 16, prior to Applicant disclaiming the wording in the mark as to those classes in Serial No. 85919900 and deleting those classes of goods from Serial No. 85888764. The application file record includes, for example, a 2012 article from the Times-Picayune (New Orleans) notice that “[t]he promised four-team college football playoff format goes into effect after the 2014 season” but “hasn’t been given a name.”⁴⁶
- Dictionary definitions of the component words.⁴⁷
- Third-party uses of what Opposer deems “college football playoff” and its derivatives ... to describe their college football playoff contests.”⁴⁸
- The statements by Mr. Hancock that “we did want a simple and descriptive name rather than a cutesy name,” and “[w]e decided to call the playoff what it is – the College Football Playoff.”⁴⁹

The record also contains evidence of descriptive use by third parties of the terms in the marks in connection with college football contests and other sporting events. Various articles from the NCAA.com website⁵⁰ have titles and references such as

⁴⁶ TSDR Serial No. 85919900, July 16, 2013 Office Action at 31-32.

⁴⁷ 46 TTABVUE 576-85.

⁴⁸ 72 TTABVUE 29.

⁴⁹ 72 TTABVUE 29-30.

⁵⁰ 46 TTABVUE 252-360.

“College football: History, mayhem and more reasons to love the FCS playoff,”⁵¹ “2017 FCS playoff bracket reactions” including references in the article to “college football,”⁵² “FCS playoffs,” reporting on the college football teams that played in the first round,⁵³ “2017 FCS playoff bracket released: JMU lands top seed,”⁵⁴ and “DII Football Championship quarterfinals,” referring to a college football team having “two playoff wins.”⁵⁵ As another example, the University Interscholastic League website shows “Football Playoff Brackets” for Divisions 1 and 2.⁵⁶ An article on the Great Northwest Athletic Conference titled “Playoff Football Returns to Ellensburg for Wildcats” details the NCAA Division II college football playoffs.⁵⁷ An article on the website of Northland Community & Technical College bears the headline “Northland one of four teams to advance in MCAC [Minnesota College Athletic Conference] football playoffs.”⁵⁸ An article from The Orange County Register refers to two colleges being “left out of football playoffs,” describing berths in the “CIF [California Interscholastic Federation] football playoffs.”⁵⁹ The record also includes screenshots from the MaxPreps website with the headings “High School Football

⁵¹ 46 TTABVUE 283-84.

⁵² 46 TTABVUE 286-89.

⁵³ 46 TTABVUE 291-93.

⁵⁴ 46 TTABVUE 295-98.

⁵⁵ 46 TTABVUE 314-18.

⁵⁶ 46 TTABVUE 587.

⁵⁷ 46 TTABVUE 588-89.

⁵⁸ 46 TTABVUE 591.

⁵⁹ 46 TTABVUE 593-95.

Playoffs,” “Maryland High School Football Playoffs,” “Virginia High School Football Playoffs,” and “Washington, DC High School Football Playoffs.”⁶⁰ A Wikipedia article describes the “NFL [National Football League] playoffs.”⁶¹ And outside of football, other articles use “playoffs” in reference to sports and leagues such as the National Hockey League, the National Basketball Association, and Major League Baseball.⁶²

However, while the evidence discussed above relates to the descriptiveness of the wording in the marks in connection with entertainment- or sports-related services, the opposed applications in this proceeding do not include services, and our descriptiveness analysis instead must rest on the identified goods.

B. Descriptiveness Analysis of COLLEGE FOOTBALL PLAYOFF in Standard Characters (Serial No. 85888764)

We first consider the application for the standard-character mark COLLEGE FOOTBALL PLAYOFF, which includes a disclaimer of FOOTBALL as to all classes of goods.

1. International Class 28

First, Opposer emphasizes the footballs and kicking tees in International Class 28, arguing that if the marks are descriptive of these goods, under *In re Chamber of Commerce*, they must be considered descriptive “of all of Applicant’s licensed promotional merchandise.”⁶³ Without pointing to any evidence or specifying exactly

⁶⁰ 46 TTABVUE 596-604.

⁶¹ 46 TTABVUE 605-10.

⁶² 46 TTABVUE 621-28.

⁶³ 72 TTABVUE 25-26 (Opposer’s Brief). As explained above, *In re Chamber of Commerce* does not stand for the proposition that descriptiveness as to one item results in a

why, Opposer contends that “[t]here can be no doubt” that the marks are descriptive of the footballs and kicking tees that, according to Opposer, “are used in and/or to promote Applicant’s college football playoff contests under its COLLEGE FOOTBALL PLAYOFF mark.”⁶⁴ Clearly, the goods include footballs, but the application includes a disclaimer of FOOTBALL.⁶⁵ Opposer has failed to make a showing that COLLEGE FOOTBALL PLAYOFF as a whole, or even COLLEGE FOOTBALL, describes these goods. For example, the record lacks evidence that third parties offer footballs that are described as for or from “college football” games or practices or “college football playoffs,” or even that conform to “college football” regulations. We simply cannot find the mark, as a whole, is descriptive of any of the goods in Class 28, including footballs, without relevant evidence of consumer understanding of the mark *in relation to the identified goods*.

2. International Classes 6, 14, 18, 20, 21, 25 and 27

We turn to the remaining classes, again bearing in mind that this application includes a disclaimer of FOOTBALL as to all the classes of goods. Opposer does not identify any evidence that specifically relates to the goods in these classes, but characterizes them as “collateral” goods. Opposer then concludes that the mark must

descriptiveness determination as to all the goods in a multiple class application or registration.

⁶⁴ 72 TTABVUE 25-26.

⁶⁵ The disclaimer of FOOTBALL as to the Class 28 goods is consistent with Applicant’s



Registration No. 5335688 for the mark **COLLEGE FOOTBALL PLAYOFF** for replica footballs, which issued with a disclaimer only of FOOTBALL.

be considered merely descriptive, presumably because of its use in connection with sporting events and how that relates to these goods, which include clothing and items such as key chains, jewelry, wallets, vinyl flags, and rugs. As discussed above, Opposer's evidentiary record focuses on descriptiveness of the wording in the mark for entertainment- or sports-related services. Opposer implicitly advocates that the third parties who may use some or all of the wording for sporting events must also use or need to use the terms in the opposed marks to describe the same types of goods in the opposed applications. In Opposer's Reply Brief, for example, it argues that the existence of other football playoffs mean that "*high schools* are the source of goods and services for high school football playoffs. And here, *colleges* are the source of goods and services for college football playoffs."⁶⁶ Tellingly, however, there is no citation to the record. We consider the evidence in relation to the identified goods, and do not find the record persuasive to show that these terms merely describe a feature of the goods.

Opposer also contends that because the opposed application received a descriptiveness refusal as to International Classes 9 and 16 (which Applicant deleted from this application), for consistency, the mark also must be considered merely descriptive of "*all* collateral, licensed merchandise contained in Applicant's identification of goods."⁶⁷ Opposer relies on a prior likelihood of confusion case, *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986), in which the Board

⁶⁶ 75 TTABVUE 5.

⁶⁷ 72 TTABVUE 27 (Opposer's Brief).

referred to the “common practice” of licensing marks for use on collateral goods “that are unrelated in nature to those goods or services on which the marks are normally used.” This discussion arose in the analysis of the relatedness of the goods for likelihood of confusion purposes – i.e., whether a consumer would believe that different types of goods or services tend to emanate from the same source.⁶⁸ Opposer then cites to the declaration and deposition testimony of Mr. Hancock for the proposition that all of the applied-for goods constitute “collateral, promotional items to be licensed for sale to promote its college football playoff events.”⁶⁹

In re Phillips-Van Heusen, which did not involve descriptiveness, does not stand for the proposition that a descriptiveness refusal must be applied across multiple classes if the goods are characterized as “collateral” goods. During prosecution of the opposed application at issue, the limitation of the descriptiveness refusal to particular goods almost certainly reflects the Examining Attorney’s determination that the mark does not merely describe the other goods. We are not willing to extrapolate from evidence or a refusal relating to goods in International Classes 9 and 16 that the mark merely describes a feature of the diverse goods in the remaining classes. Opposer

⁶⁸ Similar statements have been made in other likelihood of confusion cases, such as *DC Comics v. Pan American Grain Mfg. Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005) (“[T]he licensing of commercial trademarks on ‘collateral’ goods has become a part of everyday life.”) and *Turner Entertainment v. Nelson*, 38 USPQ2d 1942, 1945 (TTAB 1996).

⁶⁹ 72 TTABVUE 26 (citing “Hancock Decl. ¶¶ 25-30; Hancock Depo. At 136”); see 61 TTABVUE 862 (Hancock Declaration) (confidential) and 47 TTABVUE 832 (Hancock Deposition). In fact, the cited portions of testimony do not explicitly so state. While the testimony discusses licenses and potential licenses for goods bearing the marks, there is no representation of the goods as “collateral” or “promotional,” and there is no characterization of the nature of the use of the marks on the goods.

cannot avoid its burden to show descriptiveness by a preponderance of the evidence as to at least one of the goods in each class simply by a sweeping characterization of the goods as “collateral.” In the descriptiveness context, Applicant’s proposed blanket rule about “collateral” goods is not supported by the case law or the record in this case.

Next, Opposer argues that Applicant’s mark must be deemed merely descriptive because it “describes the provider of goods or services [and therefore is] also merely descriptive of those goods and services,” quoting *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001).⁷⁰ Opposer alleges that, “[h]ere, the source of the licensed promotional goods under the Mark COLLEGE FOOTBALL PLAYOFF merely describes various college football playoff divisions, including Applicant’s college football playoff games.”⁷¹ In *In re Major League Umpires*, involving the mark MAJOR LEAGUE UMPIRE, “the officers and partners of Applicant [were] employed as major league baseball umpires,” *id.*, and the goods were baseball clothing and protective gear, including gear designed by and used by Major League umpires. Thus, the mark clearly described features of the goods. Here, Opposer has not convincingly explained how COLLEGE FOOTBALL PLAYOFF is analogous, and we do not find the analysis in *Major League Umpires* applicable. Opposer has not shown how the wording in the mark describes a feature of the goods in these classes.

⁷⁰ 72 TTABVUE 28-29.

⁷¹ 72 TTABVUE 29.



C. Serial No. 85919900

Turning next to Applicant's other mark, it contains the same wording as the standard-character mark, along with a stylized football design, and includes a disclaimer of COLLEGE FOOTBALL PLAYOFF for International Classes 9 and 16, and a disclaimer of FOOTBALL for International Class 28.

1. International Classes 9 and 16

For the Class 9 software and digital media "all in the field of the sport of football" and the Class 16 printed publications including those "in the field of sports and entertainment," Applicant has disclaimed all the wording in the mark, leaving only the question whether the stylized football design renders the mark as a whole merely descriptive as to these goods. Opposer contends that the stylized football design in Applicant's word-and-design mark "reinforces the descriptive meaning of the wording" and therefore should render the entire mark merely descriptive.⁷² The outline of the ball uses lines that do not connect at either end, making the depiction appear more fanciful. With the exception of the four vertical lines inside the outline, the drawing does not include any other lines or markings, such as the seams of the football. The only detail on the drawing are the vertical lines that suggest – but do not realistically depict – the lacing on the ball, which actually would run both horizontally and vertically. Overall, we find that the football design appears "stylized, rather than realistic, in nature" so as to make it "sufficiently arbitrary and fanciful

⁷² 72 TTABVUE 28 (Opposer's Brief).

as to remove it from the category of merely descriptive.” *In re LRC Products Ltd.*, 223 USPQ 1250, 1253 (TTAB 1984).

2. International Class 28

Applicant disclaimed FOOTBALL as to the toys in this class that include footballs and football helmets. For the same reasons set out above in connection with the Class 28 goods in the standard-character mark application, Opposer fails to meet its burden of proof due to the lack of evidence of descriptiveness of the remaining wording in relation to the Class 28 goods. And based on the same rationale set out above as to the stylized nature of the design element in this mark, we do not find it merely descriptive in relation even to these goods because it is not a sufficiently realistic depiction of a football.

3. International Classes 6, 14, 18, 20, 21, 25 and 27

While this application includes no disclaimer applicable to the goods in International Classes 6, 14, 18, 20, 21, 25 and 27, for the same reasons set out above in addressing the standard-character mark, the mere characterization of these goods as “collateral” does not suffice to establish their descriptiveness. Nor has Opposer shown why the design element in this mark – even putting aside its stylization – should be deemed descriptive of the goods in these classes, except again by arguing that the goods are “collateral.” Opposer has failed to meet its burden of proof.

We note as an aside that in *In re WNBA Enterprises, LLC*, 70 USPQ2d 1153, 1156 (TTAB 2003), the Board held that where an owner of a mark for entertainment services also uses the mark for Class 16 publications featuring “news about applicant’s entertainment services,” the mark “is not merely descriptive of [the mark

owner's] publications because it does not name the subject matter of them," but rather "is the mark by which [the mark owner] identifies the source of the publications, in the same manner that it is the mark under which applicant renders its services." The Board in *In re WNBA Enterprises* held that just because the applicant's inherently distinctive mark, which included the wording ORLANDO MIRACLE, referred to the WNBA sports team that was the subject matter of the applied-for publications, it was not descriptive of the publications. *Id.* While we recognize the distinction between the inherently distinctive mark in *In re WNBA Enterprises* and the word-and-design mark in Applicant's prior registration for entertainment services, in which Applicant disclaimed the wording,⁷³ nonetheless, the case demonstrates that *Major League Umpires* cannot be inconsiderately overextended. In this case, we must consider whether the marks merely describe a feature of the identified goods in these applications, and Applicant fails to make the requisite evidentiary showing.

Regarding the Class 25 clothing, we take special note that unlike in the standard-character mark application, this application does not include a disclaimer of FOOTBALL, and the identification includes some clothing that arguably could encompass "football clothing." However, the parties did not address this issue specifically, and we have no evidentiary showing on this point. The evidence of Applicant's use of the mark on clothing is along the lines of the following:

⁷³ Registration No. 4748471.



.⁷⁴ Based on this record, Opposer failed to meet its burden of proof as to the Class 25 goods also.

Overall, Opposer's evidence falls short of showing that the applied-for marks merely describe a feature of the goods.

V. Lack of Bona Fide Intent

The Trademark Act provides in pertinent part that “[a] person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register...” Trademark Act Section 1(b)(1), 15 U.S.C. § 1051(b)(1). The bona fide intent requirement “must be read in conjunction with the revised definition of ‘use in commerce’ in Section 45 of the Trademark Act, which the Trademark Law Revision Act of 1988 amended to require that such use be ‘in the ordinary course of trade, and not made merely to reserve a right in a mark.’” *Commodore Elec. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). If a lack of bona fide intent is found as to some but not all of the goods, such goods would be subject to deletion from the applications, but absent proof of fraud, the applications would not be considered void in their entireties. *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930 (TTAB 2013) (where

⁷⁴ 46 TTABVUE 633.

the applicant lacked a bona fide intent as to some but not all of the goods, “application [to] be amended to reflect those goods with which it has a bona fide intent to use the mark ... and a Notice of Allowance will issue in due course”); *see also Kelly Servs. v. Creative Harbor, LLC*, 846 F.3d 857, 121 USPQ2d 1357, 1366 (6th Cir. 2017).

The “determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances.” *Lane Ltd. v. Jackson Int’l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). “Opposer has the initial burden of demonstrating by a preponderance of the evidence that [A]pplicant lacked a bona fide intent to use the mark on the identified goods.” *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008).

Opposer can establish its prima facie case of no bona fide intent “by proving that [A]pplicant has no documentary evidence to support its allegation in the application of its claimed bona fide intent to use the mark in commerce as of the application filing date.” *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1727 (TTAB 2010). If Opposer satisfies this burden, the burden of production shifts to Applicant to offer additional evidence showing its bona fide intent to use its mark in commerce. *Id.*; *see also Commodore Elec.*, 26 USPQ2d at 1507 n.11.

Opposer contends that Applicant lacks documentary evidence to support its bona fide intent, thereby establishing Opposer’s prima facie case. Applicant concedes that no contemporaneous written business plan for the opposed marks existed,⁷⁵ but

⁷⁵ 47 TTABVUE 806-07 (Hancock Deposition) (confidential).

maintains that certain other documents – mostly designated as confidential in this proceeding – serve as the requisite documentary evidence. Applicant points as an example to a confidential January 2013 trademark search report.⁷⁶ *Swatch AG v. M. Z. Berger & Co., Inc.*, 108 USPQ2d 1463, 1477 (TTAB 2013) (“a trademark clearance search may be probative evidence of a bona fide intent to use”). Applicant relies on other confidential documentary evidence as well as its registrations for BCS Marks to show its intent at the time the applications were filed, but the documents do not directly refer to the opposed marks.⁷⁷ The essence of Applicant’s argument and explanation on this point is that it merely intended to transition the type of use it already had in place for its BCS Marks to its new marks, such that a written business plan and similar documentation were unnecessary.

Even if we assume that the documentary evidence provided by Applicant does not suffice to show its bona fide intent at the time the applications were filed, we find that the totality of the evidence shows the requisite intent. In his confidential declaration, which we can only discuss in limited terms, Mr. Hancock detailed the history of the selection and adoption of the applied-for marks, as well as the decision about which goods and services to include in the opposed applications. Applicant relied in part on the classes of goods and services for which Applicant already had registrations based on actual use, for Applicant’s BCS Marks.⁷⁸ The record also

⁷⁶ 61 TTABVUE 1472-79.

⁷⁷ 47 TTABVUE 58-100.

⁷⁸ 61 TTABVUE 862, 1465-71, 1537-51. Most of the registrations are for more limited goods/services than in the opposed applications. However, except for the goods in International Classes 9 (which appears in Registration No. 2719550, issued in 2003) and 20,

includes confidential evidence regarding licensing arrangements for the BCS Marks that were in place at the time of the opposed applications.⁷⁹ As with the BCS Marks, Applicant now licenses the opposed marks for use by others, and Applicant has provided information about successful licensing arrangements as of 2015 for many, but not all, of the goods in the opposed applications.⁸⁰

Applicant's testimony and evidence of its prior use through an active licensing program and registration of its BCS Marks for most of the same types of goods support its bona fide intent to use the applied-for marks on such goods as part of the transition from the "Bowl Championship Series" to the "College Football Playoffs." "[A]n applicant's capacity to market and/or manufacture the identified goods is evidence that weighs against a finding that an applicant lacked bona fide intent to use. *See Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007)." In *Wet Seal*, the Board held that "the evidence falls far short of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intention to use the mark in connection with any of the identified products" where:

it is clear from Mr. Rolleston's testimony that applicant had the capacity to market and/or manufacture shampoos and color products, having produced them in the past under different marks, which would tend to affirmatively rebut any claim by opposer regarding applicant's intent.

82 USPQ2d at 1643.

Registration Number 3682157 for the mark BCS NATIONAL CHAMPIONSHIP, issued in 2009, contains the full range of goods in the opposed applications.

⁷⁹ *E.g.*, 61 TTABVUE 950-966; *see also* 47 TTABVUE 58-100.

⁸⁰ 61 TTABVUE 863, 901-10.

While Opposer points to Mr. Hancock's confidential deposition testimony as indicative of a lack of bona fide intent, we do not agree. Mr. Hancock is a non-attorney who, as he described it at the time he was deposed (before the lack of bona fide intent ground was added to this proceeding) "know[s] what intent to use means colloquially" but not "exactly what it means in terms of in the trademark world."⁸¹ When asked about intent to use the mark during the deposition, he repeatedly used terminology such as Applicant's intent to "test the market" for the identified goods, and answered affirmatively when asked if Applicant applied as to particular goods "in order to reserve rights in the mark."⁸² However, his confidential testimony as a whole makes clear that such terminology is not indicative of vague possibilities, but more of working through and with third parties to pursue license arrangements for the goods. His references to "testing the market" referred to ongoing negotiations with licensees to determine whether they would produce the particular goods.⁸³ Moreover, corroborating evidence of Applicant's activity supports steps toward use of the marks.

Overall, we find that the evidence generally reflects "an intention that is firm, [al]though ... contingent on the outcome of an event (that is, market research or product testing)." *Swatch AG*, 108 USPQ2d at 1477 (quoting Lanham Act legislative history). The preponderance of the evidence supports Applicant's bona fide intent to use the marks at the time the applications were filed.

⁸¹ 47 TTABVUE 803 (Hancock Deposition).

⁸² E.g., 47 TTABVUE 810-11.

⁸³ 61 TTABVUE 863.

VI. Amending the Identifications

We note that while these proceedings were pending, Applicant filed, without Opposer's consent, a motion to amend both opposed applications to delete the goods in International Classes 6, 14, 18, and 27, and also to delete only from Serial Number 85919900 the goods in International Class 20.⁸⁴ After Opposer opposed the proposed deletions,⁸⁵ Applicant withdrew the motion "without prejudice to its renewal at a later date."⁸⁶ In its Brief, Applicant states that it moved to delete the goods because "it had at that point found the market to be lacking for particular goods it intended to license at the time it filed its applications."⁸⁷ We have not found a lack of bona fide intent to use the marks as to any of the goods in the opposed applications at the time the applications were filed. However, if Applicant no longer wishes to retain these goods in the applications, Applicant should submit amendments to the applications to delete these goods. *See* TMEP § 1107 (Oct. 2018) (allowing entry of an amendment to delete goods between the issuance of the notice of allowance and the submission of a statement of use).

Decision

The consolidated oppositions are dismissed on both grounds, and the applications will be forwarded for issuance of notices of allowance in due course.

⁸⁴ 19 TTABVUE.

⁸⁵ 21 TTABVUE.

⁸⁶ 24 TTABVUE.

⁸⁷ 73 TTABVUE 44 (Applicant's Brief).