

THIS ORDER IS NOT A  
PRECEDENT OF THE  
TTAB

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

mbm

Mailed: September 28, 2017

Opposition No. 91220066 (**Parent**)  
Opposition No. 91221745

*Lile Inc*

*v.*

*BCS Properties, LLC*

Before Taylor, Wellington, and Gorowitz,  
Administrative Trademark Judges.

**By the Board:**

This proceeding comes before the Board for consideration of the motion (filed May 5, 2017) of BCS Properties, LLC (“Applicant”) for summary judgment based on the alleged lack of standing of Lile Inc. (“Opposer”). Opposer filed a timely response on June 5, 2017.<sup>1</sup>

**I. Background**

Applicant seeks to register the mark COLLEGE FOOTBALL PLAYOFF, in standard characters, for the following goods: “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

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<sup>1</sup> Applicant’s reply brief, filed June 30, 2017, is untimely and will be given no consideration. See Trademark Rule 2.127(e)(1).

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.<sup>2</sup>

Applicant also seeks to register the mark COLLEGE FOOTBALL PLAYOFF and Design, as shown below, 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 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

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<sup>2</sup> Application Serial No. 85888764, filed March 28, 2013, based on an allegation of a bona fide intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). “FOOTBALL” is disclaimed.

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 teas; collectible toys, namely, full-sized replica football helmets and mini collector football helmets, collectible full-sized replica footballs” in International Class 28.<sup>3</sup>



On January 7, 2015, Opposer filed a notice of opposition opposing registration of the mark in application Serial No. 85919900 on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and that the mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). On April 29, 2015, Opposer filed a notice of opposition opposing registration of the mark in application Serial No. 8588764 on the same grounds. On August 31, 2015, these proceedings were consolidated. On March 21, 2017, the Board

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<sup>3</sup> Application Serial No. 85919900, filed May 1, 2013, based on an allegation of a bona fide intent to use in commerce pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). “COLLEGE FOOTBALL PLAYOFF” is disclaimed for International Classes 9 and 16. “FOOTBALL” is disclaimed for International Class 28.

granted Opposer's motion for leave to amend its notice of opposition in each of these proceedings to assert a claim that Applicant lacked a bona fide intent to use the marks as of the filing dates of the respective applications.

In support of its allegations of standing and asserted claims, Opposer pleads, *inter alia*, ownership of pending application Serial No. 86052371 for the mark CFBPLAYOFF.COM, in standard characters, for the following services in International Class 41: "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.<sup>4</sup> Opposer also pleads common law use of the mark CFBPLAYOFF.COM since at least as early as July 2008. With regard to its pleaded pending application, Opposer further pleads that its application has been preliminarily refused registration under Section 2(d) of the Trademark Act on the ground that Opposer's pleaded mark is likely to cause confusion with Applicant's involved marks.

In its answers, Applicant denies the salient allegations in the consolidated amended notices of opposition.

## **II. Applicant's Motion for Summary Judgment**

Applicant has moved for summary judgment on the ground that Opposer lacks standing. In support of its motion for summary judgment, Applicant submitted the

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<sup>4</sup> Application Serial No. 86052371, filed August 30, 2013, for registration on the Supplemental Register, alleging July 1, 2008 as both the date of first use and the date of first use in commerce.

declaration of Steven Hollman, counsel for Applicant, who introduces, *inter alia*, the following exhibits: (1) selected portions of the deposition transcript of Bill Hancock; (2) selected portions of the deposition transcript of Edward Deeb; (3) copies of TSDR printouts for Opposer's Serial No. 86052371; (4) selected portions of the deposition transcript of Tanya Falleiro; (5) a copy of the Office Action issued by the USPTO with respect to Opposer's Application Serial No. 86052371; (6) a copy of Opposer's response to the USPTO Office Action for Serial No. 86052371; (7) Opposer's responses to Applicant's First Set of Interrogatories; (8) copies of portions of the file history for Serial No. 85919900; (8) copies of portions of the file history for Serial No. 85888764; (9) copies of portions of the file history for Serial No. 85888738; and (10) copies of the file history for Serial No. 86052371.

In opposition to Applicant's motion for summary judgment, Opposer submitted the declarations of James R. Hastings, counsel for Opposer, and Edward Deeb, Vice President of Opposer, who introduce, *inter alia*, the following exhibits: (1) Applicant's Responses to Opposer's First Set of Requests for Admission; (2) copies of TSDR printouts for Applicant's Serial No. 85888764; (3) copies of TSDR printouts for Applicant's Serial Nos. 85919900, 85888738, 85919919, 86191300, and 86275222; (4) copies of TSDR printouts of the file history for Opposer's Serial No. 86052371; (5) a screenshot of the Wayback Machine purporting to show the website [www.cfbplayoff.com](http://www.cfbplayoff.com) as of May 30, 2013; (6) a document listing Opposer's ownership of the domain name [cfbplayoff.com](http://cfbplayoff.com); (7) screenshots of websites showing use of Opposer's CFBPLAYOFF.COM mark; (8) screenshots of Applicant's social media

accounts; and (9) a copy of a letter sent from Applicant to Opposer dated November 19, 2014.

### **A. Summary Judgment Standard**

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c).

A movant for summary judgment carries the burden of proof in regard to its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the function of the Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. *See* TBMP § 529.01 and cases cited therein (June 2017). When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact and that the moving party is entitled to judgment as a matter of law, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist, and the evidentiary record on

summary judgment, and all reasonable inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

## **B. Decision**

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015) and *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Our primary reviewing court has enunciated a liberal threshold for determining standing, namely, that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062. A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1025. This threshold determination is made prior to consideration of the pleaded grounds and defenses.

Here, there is no genuine dispute as to the fact that Opposer is the owner of application Serial No. 86052371, which has been preliminarily refused registration based on a potential likelihood of confusion with the applications at issue in these consolidated proceedings. *See* 40 TTABVUE 8. Both Applicant and Opposer made the Office Action preliminarily refusing Opposer’s application of record for this motion.

It is clear that ownership of an application that has been refused registration based on a defendant's prior registration or application is sufficient to confer standing. *See Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062; *Saddlesprings Inc. v. Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012); *Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) ("Inasmuch as Petitioner has made of record the USPTO Office action suspending its pleaded application pending the possible refusal to registration under Section 2(d) of the Lanham Act based on an alleged likelihood of confusion with Respondent's registration, there is no question that Petitioner has standing to bring this petition to cancel."); *Fiat Group Automobiles S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1237 (TTAB 2007); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1299-1300 (TTAB 2000). Moreover, Opposer has made of record a letter from counsel for Applicant addressed to Opposer asserting Applicant's rights in its marks and requesting that Opposer abandon its application. 42 TTABVUE 223-224; *See Mitchell Miller, A Professional Corp. v. Michele Ballard Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013).

Applicant argues that Opposer cannot have a reasonable basis for its belief of damage based on Applicant's ownership of a registration (Registration No. 4748471) that was also cited as a basis for refusing registration to Opposer's application based on a likelihood of confusion. Applicant further notes that Opposer has not sought to cancel this registration. Opposer's actions, or lack thereof, with respect to this



registration has no bearing on Opposer's standing to bring these consolidated proceedings. The validity of this registration is not at issue in this proceeding. Opposer's standing is established by the fact that it has made of record the preliminary refusal of its pleaded pending application based on a potential likelihood of confusion with each of Applicant's involved marks.<sup>5</sup>

Based on the foregoing, we *sua sponte* find that entry of summary judgment in favor of Opposer with respect to standing is appropriate. In view thereof, Applicant's motion for summary judgment based on Opposer's alleged lack of standing is **DENIED** and we hereby enter partial summary judgment in Opposer's favor with regard to the issue of Opposer's standing to maintain this proceeding.<sup>6</sup> We note, however, that Opposer must maintain its standing throughout these proceedings.

### **III. Pleadings**

As a final matter, in reviewing the pleadings for purposes of the motion for summary judgment, we find that Opposer has not properly pleaded a claim of likelihood of confusion. In order to state a claim for likelihood of confusion pursuant to Section 2(d) of the Trademark Act, a plaintiff must allege that it has valid

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<sup>5</sup> Applicant also argues that Opposer's actions (e.g., Opposer's refusal to consent to Applicant's proposed amendments to its application and Opposer's failure to oppose Applicant's now issued Registration No. 4748471) demonstrate Opposer's lack of a real interest in its mark and a lack of a reasonable belief of damage. 40 TTABUVE 18-19. To the extent Applicant is attempting to argue that Opposer's actions or inactions bar Opposer's claims in these consolidated proceedings, these arguments are not persuasive because such allegations do not deprive Opposer of standing.

<sup>6</sup> The parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 (TTAB 1983).

proprietary rights that are prior to those of Applicant's, or that it owns a registration that Applicant has not counterclaimed to cancel, and that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion. *See* 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

Here, Opposer has pleaded that its pending application Serial No. 86052371 has been preliminarily refused registration by the USPTO based upon a finding of likelihood of confusion with respect to Opposer's mark and Applicant's involved marks. Amended notices of opposition ¶ 4. It appears that Opposer is seeking to assert a hypothetical claim of likelihood of confusion based on the Examining Attorney's preliminary refusal. A plaintiff may plead likelihood of confusion hypothetically; however, here, Opposer has not affirmatively pleaded that if, as the examining attorney contends, Opposer's mark so resembles Applicant's cited marks as to be likely, when applied to the goods or services of Opposer, to cause confusion, that registration should be refused based on Opposer's alleged priority. *See* TBMP § 309.03(c)(B). Moreover, although Opposer has pleaded common law use of its CFBPLAYOFF.COM mark since 2008, Opposer must specifically allege the goods or services used in connection with its pleaded mark since 2008.

Accordingly, Opposer is allowed until **twenty days** from the mailing date of this order to file and serve an amended notice of opposition for each of these consolidated proceedings that properly sets forth a claim of likelihood of confusion, failing which Opposer's claim of likelihood of confusion will be dismissed with prejudice and given no further consideration by the Board.

In turn, Applicant is allowed until **twenty days** from the date of service of the amended notices of opposition, if any, in which to file and serve answers to the amended pleadings. Although proceedings are consolidated, Applicant should file its answers separately in each proceeding, as an exception to the rule that filings be made only in the parent case.

#### **IV. Trial Schedule**

These consolidated proceedings are resumed. Remaining dates for this consolidated case are reset as follows:

Discovery Closes	<b>October 19, 2017</b>
Plaintiff's Pretrial Disclosures Due	<b>December 3, 2017</b>
Plaintiff's 30-day Trial Period Ends	<b>January 17, 2018</b>
Defendant's Pretrial Disclosures Due	<b>February 1, 2018</b>
Defendant's 30-day Trial Period Ends	<b>March 18, 2018</b>
Plaintiff's Rebuttal Disclosures Due	<b>April 2, 2018</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>May 2, 2018</b>
<b>BRIEFS SHALL BE DUE AS FOLLOWS:</b>	
Plaintiff's Main Brief Due	<b>July 1, 2018</b>
Defendant's Main Brief Due	<b>July 31, 2018</b>
Plaintiff's Reply Brief Due	<b>August 15, 2018</b>

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits,

declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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**NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE EFFECTIVE JANUARY 14, 2017**

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board’s home page on the uspto.gov website:  
<https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board>
- The final rule:  
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule:  
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>
- The clarification to the final rule:  
<https://www.uspto.gov/sites/default/files/documents/82%20FR%2033804%20%28Final%20rule%29.pdf>
- A chart summarizing the affected rules and changes:  
[http://www.uspto.gov/sites/default/files/documents/RulesChart\\_12\\_9\\_16.pdf](http://www.uspto.gov/sites/default/files/documents/RulesChart_12_9_16.pdf)

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.

