ESTTA Tracking number: **ESTTA1313318**
Filing date: **10/02/2023**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following parties has filed a petition to cancel the registration indicated below.

Petitioner information

Name	Tennessee Football, LLC		
Entity	Limited Liability Company	Incorporated or registered in	Delaware
Address	460 GREAT CIRCLE ROAD NASHVILLE, TN 37228 UNITED STATES		

Name	Houston Oilers, LLC		
Entity	Limited Liability Company	Incorporated or registered in	Delaware
Address	460 GREAT CIRCLE ROAD NASHVILLE, TN 37228 UNITED STATES		

Name	NFL Properties LLC		
Entity	Limited Liability Company	Incorporated or registered in	Delaware
Address	345 PARK AVENUE NEW YORK, NY 10154 UNITED STATES		

Attorney information	KRISTIN H ALTOFF MORGAN, LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVE NW WASHINGTON, DC 20004 UNITED STATES Primary email: trademarks@morganlewis.com Secondary email(s): kristin.altoff@morganlewis.com, tara.bhupathi@morganlewis.com 2027395093
Docket no.	049643-0173

Registration subject to cancellation

Registration no.	5382753	Registration date	01/16/2018
Register	Supplemental		
Registrant	JOHNSON, M.B. 3606 HOLMAN ST 3636 OLD SPANISH TRAIL UNIT 115 HOUSTON, TX 77021 UNITED STATES		

Goods/services subject to cancellation

Class 025. First Use: Sep 20, 2015 First Use In Commerce: Sep 20, 2015 All goods and services in the class are subject to cancellation, namely: T-shirts; Graphic T-shirts

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 23(a) and 2(d)
Dilution by blurring	Trademark Act Sections 24 and 43(c)

Registration subject to cancellation

Registration no.	5970125	Registration date	01/28/2020
Register	Principal		
Registrant	JOHNSON, M.B. 3606 HOLMAN ST 3636 OLD SPANISH TRAIL UNIT 115 HOUSTON, TX 77021 UNITED STATES		

Goods/services subject to cancellation

Class 025. First Use: Sep 16, 2012 First Use In Commerce: Dec 20, 2017 All goods and services in the class are subject to cancellation, namely: T-shirts

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)

Marks cited by petitioner as basis for cancellation

U.S. registration no.	1066431	Application date	10/22/1976
Register	Principal		
Registration date	05/24/1977	Foreign priority date	NONE
Word mark	OILERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Jan 1, 1960 First Use In Commerce: Jan 1, 1960 EDUCATIONAL AND ENTERTAINMENT SERVICES IN THE FORM OF PRO-FESSIONAL FOOTBALL GAMES AND EXHIBITIONS		

U.S. registration no.	1066433	Application date	10/22/1976
Register	Principal		
Registration date	05/24/1977	Foreign priority	NONE

		date	
Word mark	OILERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Jan 1, 1960 First Use In Commerce: Jan 1, 1960 EDUCATIONAL AND ENTERTAINMENT SERVICES IN THE FORM OF PROFESSIONAL FOOTBALL GAMES AND EXHIBITIONS		

U.S. registration no.	1069143	Application date	10/22/1976
Register	Principal		
Registration date	07/05/1977	Foreign priority date	NONE
Word mark	HOUSTON OILERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Jan 1, 1960 First Use In Commerce: Jan 1, 1960 EDUCATIONAL AND ENTERTAINMENT SERVICES IN THE FORM OF PROFESSIONAL FOOTBALL GAMES AND EXHIBITIONS		

U.S. registration no.	1810712	Application date	08/31/1992
Register	Principal		
Registration date	12/14/1993	Foreign priority date	NONE
Word mark	HOUSTON OILERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 016. First use: First Use: Sep 1970 First Use In Commerce: Sep 1970 trading cards, [posters,] [magazines relating to football,] [postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper towels,] books relating to football, [posterbooks,] notepads [, paper party hats and greeting cards] Class 025. First use: First Use: Feb 1970 First Use In Commerce: Feb 1970 men's, women's and children's clothing and footwear; namely, [coaches caps, wool hats, painters caps,] baseball caps, [visors, headbands, ear muffs, knit face maskks, belts, wristbands, T-shirts, tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, suspenders, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweatpants, jeans, pants, knickers, socks, underwear, bathing suits and leg warmers]		

U.S. registration no.	1809126	Application date	08/31/1992
Register	Principal		
Registration date	12/07/1993	Foreign priority date	NONE

Word mark	NONE
Design mark	
Description of mark	NONE
Goods/services	Class 016. First use: First Use: Sep 1970 First Use In Commerce: Sep 1970 trading cards, [posters,] [magazines relating to football,] [postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper towels,] [books relating to football,] [posterbooks,] notepads, [paper party hats and greeting cards] Class 025. First use: First Use: Feb 1970 First Use In Commerce: Feb 1970 men's, women's and children's clothing [and footwear;] namely, [coaches caps, wool hats, painters caps,] baseball caps, [visors, headbands, ear muffs, knit face masks, belts, wristbands,] T-shirts, [tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, suspenders, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweatpants, jeans, pants, knickers, socks, underwear, bathing suits and leg warmers]

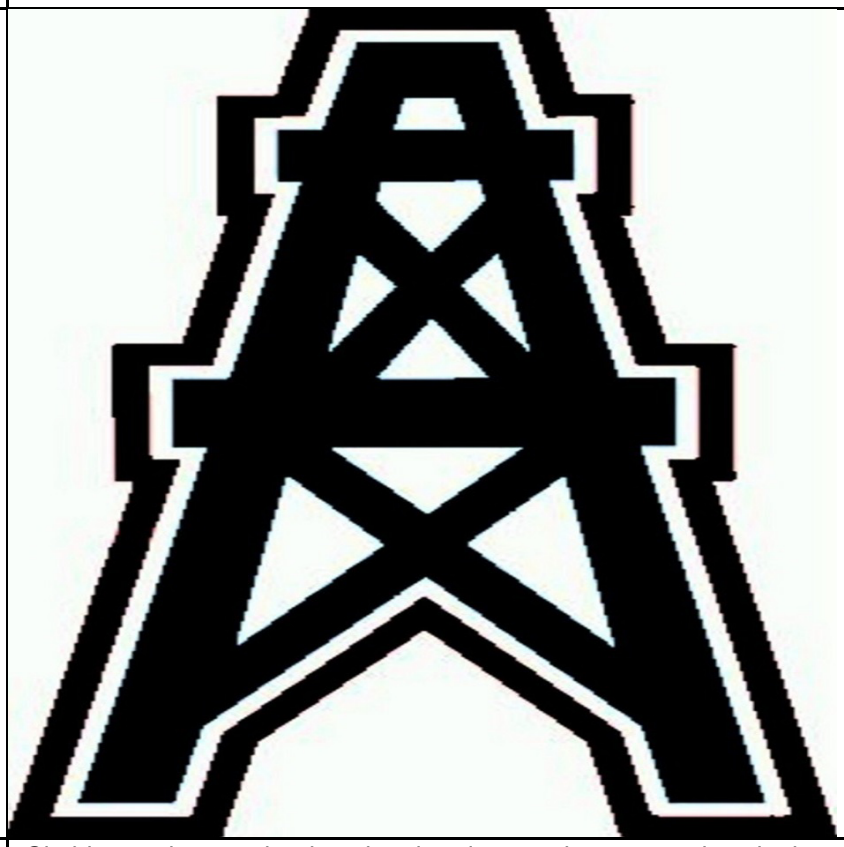
U.S. registration no.	2573988	Application date	12/27/1996
Register	Principal		
Registration date	05/28/2002	Foreign priority date	NONE
Word mark	TENNESSEE OILERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Aug 1, 1997 First Use In Commerce: Aug 1, 1997 men's, women's and children's clothing, namely, T-shirts [, tank tops,] and caps		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark	OILERS		
Goods/services	Clothing and apparel; educational and entertainment services in the form of professional football games and exhibitions		

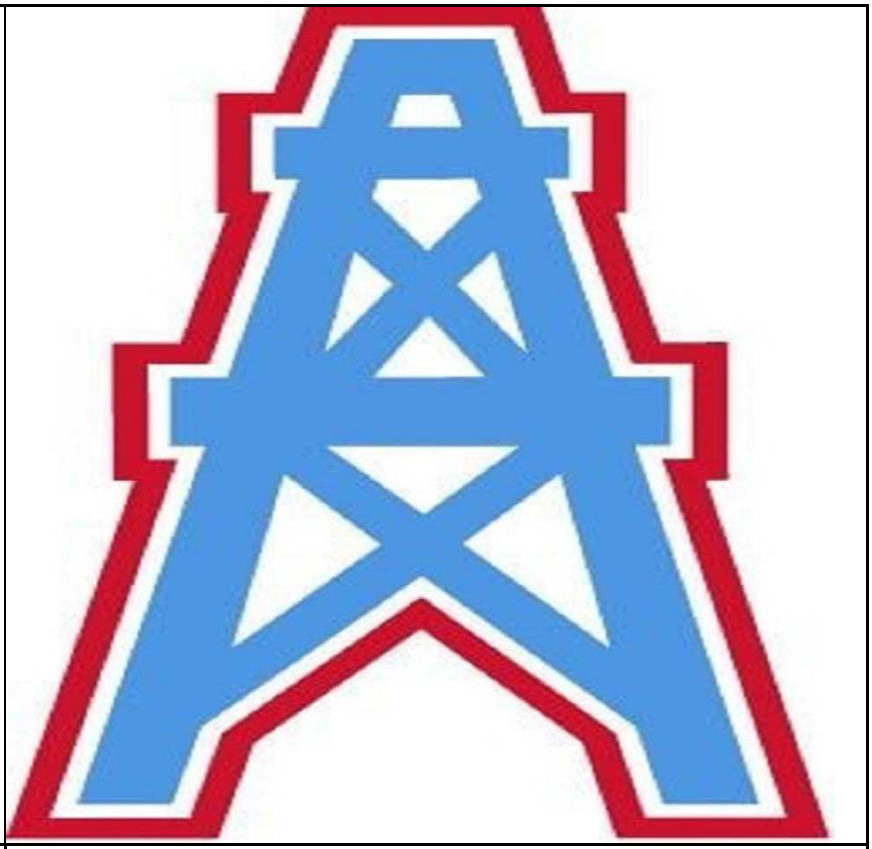
U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark	HOUSTON OILERS		
Goods/services	Clothing and apparel; educational and entertainment services in the form of professional football games and exhibitions		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		

Registration date	NONE
Mark	TENNESSEE OILERS
Goods/services	Clothing and apparel; educational and entertainment services in the form of professional football games and exhibitions

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark			
Goods/services	Clothing and apparel; educational and entertainment services in the form of professional football games and exhibitions		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		

Mark	
Goods/services	Clothing and apparel; educational and entertainment services in the form of professional football games and exhibitions

Attachments	oilers bw.jpg Oilers Color Image.jpg RIG EM Petition to Cancel - Final.pdf(2689233 bytes)

Signature	/Kristin H. Altoff/
Name	Kristin H. Altoff
Date	10/02/2023

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TENNESSEE FOOTBALL, LLC, HOUSTON OILERS, LLC and NFL PROPERTIES LLC, Petitioners, v. M.B. JOHNSON, Respondent.	In re Registration Nos. 5382753 and 5970125 Mark: RIG 'EM OILERS and Registered: January 16, 2018 and January 28, 2020 Cancellation No. _____

CONSOLIDATED PETITION FOR CANCELLATION

Petitioners NFL Properties LLC ("NFLP"), Tennessee Football, LLC and Houston Oilers, LLC (collectively, "Petitioners") believe they are being damaged by the registrations for the following designations registered in the name of M.B. Johnson ("Respondent"): (1) RIG 'EM OILERS (Reg. 5382753) covering "T-shirts; Graphic T-shirts" in Class 25; and (2) RIG 'EM and Design (Reg. 5970125) covering "T-shirts" in Class 25 (collectively, the "RIG 'EM Registrations"). Petitioners' efforts to discuss this matter with Respondent have been unsuccessful. In particular, Respondent did not return Petitioners' most recent phone call and as of September 25, 2023, Respondent's voice mailbox was not accepting messages. Accordingly, Petitioners hereby petition to cancel the RIG 'EM Registrations under Sections 2(d), and 43(c) of the Trademark Act of July 5, 1946 (the "Lanham Act"), 15 U.S.C. §§ 1052(d) and 1125(c).

As grounds for the petition to cancel, Petitioners allege:

Petitioners' Rights

1. Petitioner Tennessee Football, LLC (the "Titans" or "Titans Club") is a Delaware limited liability company with a principal place of business at 460 Great Circle Road, Nashville, Tennessee 37228.

2. Petitioner Houston Oilers, LLC ("Houston Oilers") is a Delaware limited liability company with a principal place of business at 460 Great Circle Road, Nashville, Tennessee 37228.

3. The Titans Club owns and operates a professional football team and provides entertainment services to the public in the form of competitive professional football games. The Titans Club is one of the thirty-two member clubs (the "Member Clubs") of the National Football League ("NFL").

4. Houston Oilers is a company affiliated with and related to the Titans Club.

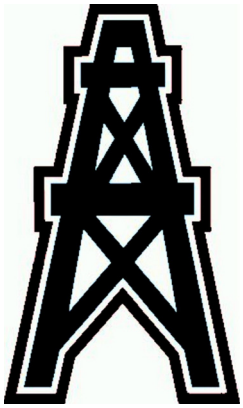
5. In 1997, after playing in Houston since 1960, the Oilers football club relocated to Nashville, Tennessee. For two seasons, the NFL team was known as the Tennessee Oilers, but it changed its name to the Tennessee Titans for the 1999 season.

6. Petitioners continued to and currently use the marks that were associated with its long history in Houston. In particular, the Titans Club has continued to use in commerce various marks consisting of and containing OILERS, such as OILERS, HOUSTON OILERS, TENNESSEE OILERS, and the Oil Derrick Design, *i.e.*, (collectively, "Petitioners' OILERS Marks").

7. Petitioner NFLP is a limited liability company organized and existing under the laws of Delaware with its principal place of business at 345 Park Avenue, New York, New York, 10154.

8. NFLP represents the NFL and its thirty-two Member Clubs for the licensing and protection of their names, logos, symbols, and other identifying marks and is charged with protecting these marks and the rights of the NFL and the Member Clubs with respect thereto.

9. For many years, and long before the May 20, 2017, filing date or the September 20, 2015, alleged first use in commerce date of the application for Respondent's registration for RIG 'EM OILERS (Reg. 5382753) and long before the April 20, 2018, filing date or the December 20, 2017, alleged first use in commerce date (or alleged September 16, 2012, first use date) of the application for Respondent's registration for RIG 'EM and Design (Reg. 5970125), Petitioners and their predecessors-in-interest have used Petitioners' OILERS Marks in connection with their business of organizing, conducting, and promoting the Houston Oilers, Tennessee Oilers and Tennessee Titans football franchise (the "Oilers/Titans Franchise").



10. For many years, and long before the filing dates or alleged first use dates of the marks covered by the RIG 'EM Registrations, Petitioners, their predecessors-in-interest, and their authorized business partners, sponsors, and/or licensees have used Petitioners' OILERS

Marks on or in connection with the sale of a wide variety of goods and services related to the business of organizing, conducting, and promoting the Oilers/Titans Franchise, including clothing and apparel.

11. Depicted below are examples of Petitioners' current use of Petitioners' OILERS Marks in connection with clothing and apparel.

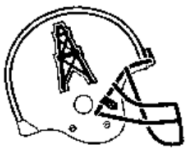
OILERS

OILERS

'47

OILERS

12. In addition to the common law rights in Petitioners' OILERS Marks, the Titans Club and Houston Oilers own registrations and applications for some of Petitioners' OILERS Marks used in connection with entertainment services in the form of football games and exhibitions and promotional and merchandising products and services, including clothing and apparel, including among others, the following registrations issued by the United States Patent and Trademark Office ("PTO"):

Registration Number	Mark	International Class	Date of First Use in Commerce
1,066,431	OILERS	41	01/01/1960
1,066,433	OILERS	41	01/01/1960
1,069,143	HOUSTON OILERS	41	01/01/1960
1,810,712	HOUSTON OILERS	16, 25	09/1970 (Cl. 16) 02/1970 (Cl. 25)
1,809,126		16, 25	09/1970 (Cl. 16) 02/1970 (Cl. 25)
2,573,988	TENNESSEE OILERS	25	08/01/1997

13. The registrations referenced above are valid and subsisting, in full force and effect, and constitute *prima facie* and/or conclusive evidence of the registrant's exclusive right to use the marks in commerce in connection with the goods and services specified in the registrations.

14. The following registrations referenced above are incontestable pursuant to the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065, and constitute conclusive evidence of the registrant's exclusive right to use the marks in commerce in connection with the goods and services specified in the registrations: 1,066,431; 1,066,433; 1,069,143; and 2,573,988.

15. During the longstanding, widespread and continuous use of Petitioners' OILERS Marks, Petitioners, their predecessors-in-interest, and their authorized business partners, sponsors, and licensees have expended considerable time, effort, and money in advertising and publicizing the sale of goods and services bearing the Petitioners' OILERS Marks.

16. Petitioners, their predecessors-in-interest, and their licensees and sponsors have sold and offered for sale goods and services bearing Petitioners' OILERS Marks in a trading area of broad geographical scope encompassing the United States, including its territories.

17. Petitioners, their predecessors-in-interest, and their licensees and sponsors have sold and offered for sale goods and services bearing Petitioners' OILERS Marks in numerous channels of trade.

18. Petitioners' OILERS Marks are symbolic of the extensive goodwill and consumer recognition that Petitioners have established through substantial expenditures of time, effort and other resources in the advertising and promotion of the goods and services Petitioners sell and offer for sale under Petitioners' OILERS Marks.

19. As a result of Petitioners' regular, extensive, and well-publicized use, one or more of Petitioners' OILERS Marks are famous in the United States and are associated exclusively with Petitioners and their high-quality goods and services.

Respondent's RIG 'EM Marks and Registrations

20. The application for Respondent's RIG 'EM OILERS mark (App. 87457960) was filed on May 20, 2017, and registered on the Supplemental Register on January 16, 2018, under Reg. 5382753 for "T-shirts; Graphic T-shirts" in Class 25.

21. Respondent's registration for RIG 'EM OILERS (Reg. 5382753) is on the Supplemental Register and therefore not incontestable.

22. The application for Respondent's RIG 'EM and Design mark (App. 87886264) was filed on April 20, 2018, and registered on January 28, 2020, under Reg. 5970125 for "T-shirts" in Class 25.

23. Petitioners have contacted Respondent to discuss this matter, but Respondent has not returned Petitioners' most recent phone call and as of September 25, 2023, Respondent's voice mailbox was not accepting messages.

FIRST GROUND FOR OPPOSITION
(Likelihood of Confusion)

24. Petitioners incorporate and reallege as if fully set forth herein the allegations contained in paragraphs 1 through 23 of this Petition for Cancellation.

25. Petitioners' rights in and to Petitioners' OILERS Marks are superior to those of Respondent.

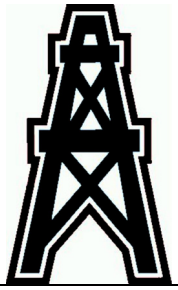
26. Respondent's RIG 'EM Registration and any use of the designations covered by the RIG 'EM Registrations are without the consent, authorization, or license of Petitioners.

27. Upon information and belief, Respondent has used the designations covered by the RIG ‘EM Registrations in bad faith to trade off of the substantial goodwill associated with Petitioners’ OILERS Marks.

28. The designations covered by Respondent’s RIG ‘EM Registrations are similar in sight, sound, and commercial impression to Petitioners’ OILERS Marks.

29. The OILERS element in Respondent’s RIG ‘EM OILERS designation is identical to the OILERS mark used by Petitioners and registered by the Titans Club.

30. The oil derrick design in Respondent’s RIG ‘EM and Design designation is identical to the oil derrick design used by Petitioners and registered by the Titans Club as a part of Reg. No. 1,809,126, as shown below.

Petitioners’ Oil Derrick Design	Respondent’s Oil Derrick Designation
	

31. The colors primarily associated with the Oilers/Titans Franchise and the OILERS Marks are light blue and red.

32. Upon information and belief, Respondent uses the designations covered by the RIG ‘EM Registrations in the same or similar light blue and red colors, including as depicted below.

Petitioners' Oil Derrick Design	Respondent's Oil Derrick Designation

33. Petitioners believe they are being and will continue to be damaged by Respondent's RIG 'EM Registrations and the designations covered by Respondent's RIG 'EM Registrations under Section 14(1) of the Lanham Act, 15 U.S.C. § 1064(1), on the ground that the subject designations so resemble Petitioners' OILERS Marks used by Petitioners in the United States as to be likely, when used on or in connection with the goods identified in the RIG 'EM Registrations, to cause confusion, mistake or to deceive consumers, with consequent injury to Petitioners and to the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

SECOND GROUND FOR CANCELLATION
(Dilution)

34. Petitioners incorporate and reallege as if fully set forth herein the allegations contained in paragraphs 1 through 33 of this Petition for Cancellation.

35. Petitioners' OILERS Marks are strong and famous and became strong and famous before the filing date of the applications for the RIG 'EM Registrations or any use dates upon which the Respondent can rely.

36. Petitioners believe they are being and will continue to be damaged by Respondent's RIG 'EM Registrations and the designations covered by Respondent's RIG 'EM Registrations under Section 14(1) of the Lanham Act, 15 U.S.C. § 1064(1), because the use and

registration of the designations covered by the RIG 'EM Registrations are likely to dilute the distinctive quality of Petitioners' famous OILERS Marks, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, for each of these grounds, separately and combined, Petitioners respectfully request that the RIG 'EM Registration be cancelled and that any other appropriate relief be entered.

Dated: October 2, 2023

Respectfully submitted,

By: */Kristin H. Altoff/*

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Attorneys for Petitioners Tennessee Football, LLC, Houston Oilers, LLC And NFL Properties LLC