NFL TEAMS 0-2 IN THE TTAB

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This past summer yielded two interesting decisions from the Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office (USPTO) involving NFL teams. In the Washington Redskins case, the TTAB cancelled several registrations owned by the Washington Redskins that included the word "Redskins" on the ground that the term was disparaging. Although for different reasons than the Washington Redskins case, the New York Giants likewise found an unsympathetic ear in the TTAB when it attempted to register the term "G-MEN."

Marketplace Fame & Use Evidence Isn't Enough to Avoid Likelihood of Confusion: *In re New York Football Giants, Inc.,* (TTAB July 3, 2014) (unpublished)

The New York Football Giants sought to register "G-MEN" for "shirts; t-shirts; tops" in Class 25 (SN 85599795). The USPTO refused registration on the basis of likelihood of confusion with a prior registration for GMAN Sport for "boxer shorts; socks; t-shirts; tank tops," also in Class 25.

GMAN Sport

The Giants tried mightily to convince the TTAB that even though there was overlap in the description of the goods in their application and the cited registration, and no restrictions on the intended uses or channels of trade, the mark "G-MEN" in its application is so famous that there was no likelihood of confusion. As the TTAB noted at the outset of its opinion, "The essence of Applicant's argument as to why there is no likelihood of confusion is that its G-MEN mark is (1) so famous that (2) when used in the context of football related merchandise, it has a unique and singular meaning for a distinct set of products."

Per the Giants, "[t]here is no more fundamental and grievous error than to conclude that confusion is likely by comparing two marks in the abstract, divorced from marketplace circumstances…" The TTAB boiled down the Giants' argument to the proposition that if the Applicant produces evidence of record relating to the fame of its mark, and the nature of the goods/channels of trade for the goods, then "… the lack of express restrictions or limitations in the respective descriptions of the goods is no longer relevant." The problem for the Giants, according to the TTAB, is that this interpretation is expressly contrary to longstanding TTAB and Federal Circuit law.

The TTAB, which seemed to be somewhat frustrated by the position taken by the Applicant, notes that usually, when this type of argument is made, it is because the Applicant fails to recognize that Board precedent requires it to take into account the specific identification of the goods in the application. Here, the TTAB noted, "… Applicant's counsel appears not to have ignored such precedent, but to have made a direct argument that application of such precedent, over the course of many years, has been improper and the Board's focus, in likelihood of confusion cases, on broadly construed identifications, has been in error."

The TTAB then proceeded to provide a primer on its longstanding precedent that requires it to focus on the

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similarity or dissimilarity of the goods *as described in an application or registration*. Having concluded that, under its precedent, the goods as described in the application are overlapping, the TTAB also found the Giants arguments relating to the other factors considered in determining likelihood of confusion were not persuasive, and it affirmed the refusal to register the mark.

This case provides a good example of the differences between the analysis of likelihood of confusion in a registrability proceeding, which is constricted significantly by the boundaries of the description in the application or registration, and the type of marketplace analysis that courts typically make in assessing likelihood of confusion in an infringement context. The Supreme Court presently has before it the case of *B&B v. Hargis*, where it will weigh how much deference, if any, courts should give to a TTAB decision on likelihood of confusion. The Giants case is a reminder that even though some aspects of the analysis may be similar, there are fundamental differences between how the TTAB looks at likelihood of confusion and how a court analyzes the issue. ■

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