

This Opinion Is a
Precedent of the TTAB

Mailed: May 8, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
—————

New York Yankees Partnership

v.

IET Products and Services, Inc.

—————
Opposition No. 91189692
—————

Mary L. Kevlin, Richard S. Mandel, and Maryann E. Licciardi of Cowan, Liebowitz & Latman, P.C., for Opposer New York Yankees Partnership.

G. Mathew Lombard and Darren M. Geliebter of Lombard & Geliebter LLP,
for Applicant IET Products and Services, Inc.

—————

Before Rogers, Chief Administrative Trademark Judge, Richey, Deputy Chief Administrative Trademark Judge, and Bucher, Zervas, Cataldo, Ritchie, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

IET Products and Services, Inc. (“Applicant”) seeks to register three marks on the Principal Register:

- “THE HOUSE THAT JUICE BUILT” (in standard characters) for T-shirts, baseball caps, hats, jackets and sweatshirts (as amended), in International Class 25;¹

¹ Application Serial No. 77404369, filed February 22, 2008 for registration on the Supplemental Register based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act; amended to seek registration

- The designation shown at right for T-shirts, baseball caps, hats, jackets and sweatshirts, in International Class 25;² and
- THE HOUSE THAT JUICE BUILT (in standard characters) for mugs, in International Class 21.³



New York Yankees Partnership (“Opposer”), which the record shows is owner of the New York Yankees Major League Baseball club, opposes registration of the marks on the grounds that they are likely to cause confusion with certain of its marks, including its top hat logo design (shown at right) and THE HOUSE THAT RUTH



BUILT, pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); are likely to cause dilution of its marks by blurring pursuant to Trademark Act Section 43(c), 15 U.S.C. § 1125(c); and falsely suggest an association with its New York

on the Principal Register. The quotation marks are part of the mark. Assignment of the application from Steven Lore to Applicant was recorded with the PTO’s Assignment Branch on March 10, 2009 at Reel/Frame 3949/0441. The assignments of the three intent-to-use applications at issue include no reference to Applicant as a successor to Mr. Lore’s business pursuant to Trademark Act Section 10(a)(1), 15 USC § 1060(a)(1). However, in view of the Board’s decision, further inquiry into the validity of the assignments is not necessary.

² Application Serial No. 76691994, filed August 12, 2008 based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The description of the mark states: “The mark consists of a hat with white stars against a blue hat band, red and white stripes and a white rim, all bordered in black and a tuft of blue, all above a white syringe with a black dot within it and bordered in black, which is circled with a red universal prohibition symbol.” Assignment of the application from Steven Lore to Applicant was recorded with the PTO’s Assignment Branch on March 20, 2009 at Reel/Frame 3969/0777.

³ Application Serial No. 77576227, filed September 23, 2008 based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. Assignment of the application from Steven Lore to Applicant was recorded with the PTO’s Assignment Branch on March 10, 2009 at Reel/Frame 3949/0441.

Yankees Major League Baseball club pursuant to Trademark Act Section 2(a), 15 U.S.C. § 1052(a). We sustain the opposition on the ground of dilution.

I. Record

Pursuant to Trademark Rule 2.123(b), the parties stipulated that witness testimony would be submitted solely by declaration and without cross-examination. The parties otherwise reserved the right to assert any evidentiary objections to the testimony contained in any witness declaration on any basis other than the manner of its submission.⁴

Opposer made the following evidence of record:

- Declaration of Ethan Orlinsky, with Exhibits A-S.⁵
- Applicant's admissions in response to Opposer's requests for admissions and responses to Opposer's interrogatories.⁶
- Numerous printed publications and Internet printouts, many of them newspaper articles, relating to use of Opposer's asserted top hat logo design and HOUSE THAT RUTH BUILT marks; Opposer's participation in charitable, community, and anti-drug initiatives; and its sponsorship of beverages, including juice products.⁷
- Dictionary definitions of the term "juice."⁸
- Printouts from the electronic records of the U.S. Patent and Trademark Office ("PTO") of the registrations for Opposer's top hat logo design and THE HOUSE THAT RUTH BUILT marks, as well as the files of

⁴ 43 TTABVUE. Record citations are to the Trademark Trial and Appeal Board docket history system. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

⁵ 57-58 and 61-63 TTABVUE. Applicant has moved to strike ¶¶ 32-41 and exhibits J-R from the declaration. We have not relied on the material Applicant moves to strike and therefore do not address Applicant's motion.

⁶ Opposer's First Notice of Reliance, Exhibits A and B, 49 TTABVUE at 5-85.

⁷ Opposer's Second and Third Notices of Reliance, Exhibits A-D, 49 TTABVUE at 86 through 55 TTABVUE at 113, 56 TTABVUE, 59 TTABVUE through 60 TTABVUE at 55.

⁸ Opposer's Second and Third Notices of Reliance, Exhibit E, 55 TTABVUE at 114-38, 60 TTABVUE at 56-72.

registrations of the marks THE HOUSE THAT GEORGE BUILT and THE HOUSE THAT JETER BUILT.⁹

Applicant introduced the following evidence:

- Declaration of Steven Lore, with Exhibits A-M.¹⁰
- Opposer's responses to Applicant's interrogatories and admissions in response to Applicant's requests for admission.¹¹
- Printed publications and Internet printouts, including the 2007 Mitchell Report of an investigation into the illegal use of steroids and other performance enhancing substances by Major League Baseball players; and news articles mentioning the illegal use of steroids and other performance enhancing substances by Major League Baseball players, including players for Opposer's club.¹²
- Printouts from the electronic records of the PTO and Internet printouts relating to the third-party marks THE HOUSE THAT ROCK BUILT and THE HOUSE THAT FEAR BUILT, and records of the Secretary of the Commonwealth of Massachusetts relating to registration of the mark FENWAY THE HOUSE THAT PAPI BUILT.¹³
- Printouts from electronic PTO records and Internet printouts relating to other third-party HOUSE THAT _____ BUILT formative marks.¹⁴
- An Internet printout announcing that Alex Rodriguez of the New York Yankees would join the Taylor Hooton Foundation "to help fight youth steroid and other performance enhancing drug use," as well as news

⁹ Opposer's Fourth and Rebuttal Notices of Reliance, Exhibits A-B, 60 TTABVUE at 74-112; 77 TTABVUE.

¹⁰ 66-68 TTABVUE.

¹¹ Applicant's First Notice of Reliance, Exhibits 1-B through 1-D, 69 TTABVUE at 23-100. Applicant also submitted Opposer's responses to Applicant's document requests, but such responses generally are inadmissible unless they state that no responsive documents exist. *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1044 (TTAB 2014). Also, we have considered only Opposer's admissions, not denials, in response to Applicant's requests for admission. *See Trademark Rule 2.120(j)(3)(i)*.

¹² Applicant's First Notice of Reliance, Exhibit 1-E, Second and Fourth Notices of Reliance, and Eighth Notice of Reliance, Exhibit 8-B, 69 TTABVUE at 101 through 71 TTABVUE, 72 TTABVUE at 182-220, 74 TTABVUE.

¹³ Applicant's Fifth through Seventh Notices of Reliance, 72 TTABVUE at 2-180.

¹⁴ Applicant's Tenth Notice of Reliance, 73 TTABVUE and 75 TTABVUE at 2-398.

stories relating to the same player's suspension for his role in a performance enhancing drug case.¹⁵

- A 2007 article on trademark parody from the website of Opposer's counsel.¹⁶
- Congressional testimony before the Committee on Government Reform, U.S. House of Representatives, on Senator Mitchell's report on the illegal use of steroids and other performance-enhancing substances by players in Major League Baseball.¹⁷

II. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Although neither party addressed standing, Opposer's standing is established with respect to its likelihood of confusion and dilution claims by its registrations for its pleaded common-law marks, its top hat logo design and THE HOUSE THAT RUTH BUILT, which the record shows to be valid and subsisting, and owned by Opposer.¹⁸ *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). If a plaintiff can show standing on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. *See Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011).



¹⁵ Exhibit 8-A to Applicant's Eighth Notice of Reliance, 72 TTABVUE at 221-23, and Applicant's Eleventh Notice of Reliance, 75 TTABVUE at 400-65.

¹⁶ Applicant's Ninth Notice of Reliance, 72 TTABVUE at 226-59.

¹⁷ Applicant's Third Notice of Reliance, 76 TTABVUE.

¹⁸ Orlinsky Decl. at ¶ 4 & Exhibit A (printouts of Office records showing status and title of Registration Nos. 1032767, 2575644, 3320068, 3320069, 3320070), ¶ 5 & Exhibit B (printouts of Office records for Registration Nos. 2884499, 3363883, 3600235). 57 TTABVUE at 8-9, 28-63.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.