

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

In re: Application Serial No.: 76/526571
For the Mark: USA FOOTBALL
Filed: July 1, 2003
Published in the Official Gazette: September 21, 2004

USA Football, Inc.

Opposer,

v.

USA Football, Inc.

Applicant.

TO: **BOX TTAB – FEE
COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513**

NOTICE OF OPPOSITION

The above-identified opposer, USA Football, Inc., a Delaware not-for-profit corporation, having a place of business at 8300 Boone Boulevard, Suite 870 Vienna, Virginia 22182, believes that it will be damaged by registration of the mark USA FOOTBALL in Application Serial No. 76/526571 for EDUCATION AND ENTERTAINMENT SERVICES, NAMELY YOUTH FOOTBALL EXHIBITIONS, SEMINARS AND CLINICS FOR YOUTH IN THE FIELD OF FOOTBALL, AND SPORTS EVENTS, NAMELY FOOTBALL; PROVIDING SPORTS AND ENTERTAINMENT

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INFORMATION IN THE NATURE OF NEWS RELEASES, AND PUBLICITY AND PROMOTIONAL PRESENTATIONS VIA A GLOBAL COMPUTER NETWORK OR ON-LINE SERVICE in International Class 41, and hereby opposes same.

USA Football, Inc.
8300 Boone Boulevard, Suite 870
Vienna, Virginia 22182

The grounds for opposition are as follows:

General Allegations of Fact

1. In December 2002, Opposer, USA Football, Inc. was formed as a non-profit association with the goals of promoting the sport of amateur football at the high school and youth level in the United States.

2. Since its creation, Opposer has engaged in promoting the sport of amateur football at the high school and youth level in the United States and offering products and services related thereto.

3. Opposer adopted the mark USA FOOTBALL (the "USA FOOTBALL Mark") and the mark USA FOOTBALL in conjunction with a graphic design (the "USA FOOTBALL Design Mark") (collectively, the "USA Football Marks") in December 2002 and March 2003, respectively, and has used and continues to use the USA Football Marks on or in connection with promoting the sport of amateur football at the high school and youth level in the United States and offering products and services related thereto.

4. Opposer is the owner of the following applications for federal registration, as well as the goodwill attached to the marks subject of those applications. Official information from the U.S. Patent and Trademark Office TARR website accompanies this Notice of Opposition as Exhibit A.

USA FOOTBALL

Serial No. 78/341626

Services: Educational and entertainment services, namely youth sports programs, sports exhibitions, seminars and sports events; providing sports and entertainment information via a global computer network or a commercial on-line service

USA FOOTBALL and Design Serial No. 78/341632

Services: Educational and entertainment services, namely youth sports programs, sports exhibitions, seminars and sports events; providing sports and entertainment information via a global computer network or a commercial on-line service

5. The services described in these applications and other activities furthering the Opposer's missions of promoting the sport of amateur football at the high school and youth level in the United States and offering products and services related thereto ("Services").

6. Opposer has maintained a considerable presence nationwide through significant expenditures to market and promote the USA FOOTBALL Marks in association with the Services and signifying itself as the sole source of those Services including without limitation through its internet website at <http://www.usafootball.com>, sponsorships of nationally advertised amateur football events and education initiatives, and community involvement.

7. Opposer has acquired goodwill in its USA FOOTBALL Marks which have been in continuous use since their adoption.

8. On July 1, 2003, with knowledge of Opposer and its pending trademark applications, Applicant, alleging itself to be an organization existing under Texas law, filed an application alleging continuous and exclusive use in the United States Patent and Trademark Office, Serial No. 76/526571 for registration on the Principal Register of Applicant's purported USA FOOTBALL mark for "education and entertainment services, namely youth football exhibitions, seminars and clinics for youth in the field of football, and sports events, namely football; providing sports and entertainment information in the nature of news releases, and publicity and promotional presentations via a global computer network or on-line service". In prosecution of the application for trademark registration, Applicant has filed an affidavit of use under 15 U.S.C. §1052(f).

9. On October 29, 2003, the National Football League and Opposer, USA Football, Inc., filed a Declaratory Judgment Complaint in the United States District Court for the Southern District of Texas, Houston Division against Timothy B. Robinson, the principal of Applicant, seeking, among other things, a declaration that Opposer's use of the words "USA Football" did not infringe or dilute the rights -- if any -- possessed by Robinson, did not constitute a false designation of origin and did not constitute unfair competition (the "District Court Litigation"). On March 30, 2004, the NFL and Opposer amended their complaint to add Applicant as a named party. On April 14, 2004, Robinson and Applicant filed a Counterclaim for federal and state trademark infringement and unfair competition against the NFL and Opposer under the Lanham Act.

Specification of Grounds for Opposition

10. The NFL and Opposer sought and received summary judgment on all issues relevant to this proceeding in the District Court Litigation. The attached Memorandum and Order and Final Judgment, Exhibit B and Exhibit C hereto, respectively, were issued on September 20, 2004 by the Honorable Nancy F. Atlas, United States District Judge.

11. In this Memorandum and Order, which contains the findings of fact and conclusions of law, the Court held that Applicant's use of the designation, USA FOOTBALL, is "properly classified as descriptive". Memorandum and Order at pp. 16 and 37. This holding is preclusive of Applicant's ability to argue the contrary before the Trademark Trial and Appeal Board (the "Board").

12. In the Memorandum and Order, the Court further held that, as of September 20, 2004, Applicant had created no secondary meaning in the designation USA FOOTBALL. Memorandum and Order at pp. 26-33 and 37-38. This holding is preclusive of Applicant's ability to argue to the contrary before the Board.

13. In the Memorandum and Order, the Court further held that, as of September 20, 2004, Applicant has made no use in commerce of Applicant's USA FOOTBALL mark on or in connection with services capable of trademark significance. Memorandum and Order at pp. 37-38 and Final Judgment. As a consequence, Applicant has made no use of USA FOOTBALL capable of trademark significance prior to Opposer's first use date.

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