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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

University of Kentucky
v.
40-0, LLC

Opposition No. 91224310

Michael S. Hargis and Trevor T. Graves of King & Schickli, PLLC,
for University of Kentucky.

Brian P. McGraw of Middleton Reutlinger,
for 40-0, LLC.

Before Bergsman, Heasley, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Opposer, the University of Kentucky, opposes Applicant 40-0 LLC's application to register the standard character mark **40-0** on the Principal Register for T-shirts and other sports-related apparel in International Class 25, primarily on the ground that "**40-0**" fails to function as a trademark.

I. Background

A. Factual Background

In mid-October 2013, John Calipari, the head coach for the University of Kentucky's men's basketball team, publicly announced his desire "to coach a team that goes 40-0"—a perfect record in the National Collegiate Athletic Association Division I.[1] His announcement, carried in the media, echoed the desire of University of Kentucky players and fans for an undefeated season.[2]

That same month, David Son, an attorney and a self-proclaimed fan of Opposer's men's basketball team, formed Applicant, a Kentucky limited liability company, of which he is the sole member.[3] Applicant began creating, promoting, and selling T-shirts bearing the legend "**40-0**" in October 2013, initially distributing and selling the T-shirts at University of Kentucky men's basketball viewing parties, and then marketing and promoting them through its website, 40and0.com, its Facebook page, and through in-person promotions.[4] The next month, November 2013, Mr. Son contacted the University of Kentucky athletics director, informed him that he had created the "**40-0**" T-shirts, and said he was interested in working with the University's athletic department in promoting and marketing the T-shirts.[5] This overture did not result in a business relationship, and the parties had no further

[1] Stipulated facts 4, 13, 57 TTABVUE 9, 11; Opposer's brief, 63 TTABVUE 9.

[2] Stipulated fact 11, 57 TTABVUE 10.

[3] Stipulated facts 46-49, 57 TTABVUE 15.

[4] Stipulated facts 45, 52-59, 57 TTABVUE 14-16; Applicant's brief, 67 TTABVUE 7.

[5] Stipulated facts 5-6, 57 TTABVUE 10; Applicant's brief, 67 TTABVUE 8.

discussions until early 2015.[6]

On February 13, 2015, Applicant applied to register the mark **40-0** (in standard characters) on the Principal Register for "clothing, namely, T-shirts, sport shirts, shorts, sweatshirts, mufflers, hats, jackets, athletic jerseys, sweatpants, cloth bibs, shoes, scarves, bandanas, wrist-bands and socks" in International Class 25.[7] About a month later, Opposer's counsel sent Applicant's counsel a cease and desist letter claiming that Applicant's use of the term "**40-0**" in combination with the University's blue and white color scheme violated its rights under the Trademark Act.[8] The letter asked Applicant to abandon the involved application, and stated, in pertinent part:

> Finally, with regard to your client's stated threat to interfere with the University's possible use of the term "40-0," the University and approved entities have every right to reference the record of the University's men's basketball team on merchandise bearing University marks. In the event the University's basketball team completes the 2014-15 season undefeated, which would necessarily result in a ninth national title, sales of merchandise bearing University marks and referencing their 40-0 record would be significant.[9]

Applicant did not abandon the application, and this opposition proceeding followed.

B. Procedural Background

Opposer's Notice of Opposition, as amended, claims in three counts:

(1) **Failure to Function**— The applied-for mark, **40-0**, refers solely to a record

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[6] Applicant's brief, 67 TTABVUE 9.

[7] Application Serial No. 86534269 was filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as October 24, 2013.

[8] Correspondence of March 27, 2015, 66 TTABVUE 64-67.

[9] *Id*. 66 TTABVUE 66.

of an NCAA basketball team that wins each and every game played in a single season. So the term does not function as a trademark to indicate the source of the clothing and to identify and distinguish Applicant's clothing from others. 15 U.S.C. §§ 1051-1052, 1127.[10]

(2) **Fraud**—When Applicant filed the involved application, it had only used the applied-for **40-0** mark in commerce on T-shirts, not on the other goods identified in the use-based application. So Applicant committed fraud on the USPTO by knowingly and falsely asserting that it had used the applied-for mark in commerce on all of the goods identified in the use-based application.[11]

(3) **Nonuse**—Registration should be denied for all goods identified in the involved application on which Applicant failed to use the applied-for mark as of the date it filed the use-based application.[12] 15 U.S.C. § 1051(a).

Applicant's Answer denied the salient claims in the Notice of Opposition, although it admitted that "it sold t-shirts under the applied-for-mark as of the filing of the application and that it did not and does not sell sport shirts, sweatshirts, jackets, socks, shorts, mufflers, athletic jerseys, sweatpants, cloth bibs, shoes, scarves, bandanas, and wrist bands as of the filing date of the '269 Application."[13]

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[10] First amended notice of opposition ¶¶ 36-37, 18 TTABVUE 13-14.

[11] *Id.* at ¶¶ 40-45, 18 TTABVUE 14-15.

[12] *Id.* at ¶¶ 46-48, 18 TTABVUE 15.

[13] Answer to first amended notice of opposition, ¶ 40, 22 TTABVUE 7. Applicant also asserted the affirmative defenses of unclean hands, laches, estoppel and/or acquiescence, 22 TTABVUE 9, but did not pursue them at trial or in its final brief, so they are waived or forfeited. *See TPI Holdings, Inc. v. TrailerTrader.com LLC,* 126 USPQ2d 1409, 1413 n.28 (TTAB 2018) ("Respondent also asserted 'estoppel, acquiescence and waiver,' but does not argue any of these in its brief. They are therefore waived.").

Applicant later moved to amend the application to delete from its identification of goods all clothing items aside from T-shirts. Applicant made its motion without Opposer's consent, and in a concurrently filed motion for summary judgment, stated that if the motion to amend were granted it would accept "judgment against it with respect to only those goods that it has proposed to delete." (emphasis in original).[14]

Opposer then filed a response and a cross-motion for summary judgment as to all three counts in the amended notice of opposition. Applicant disputed Opposer's claims, and averred in particular that "[b]ecause the 40-0 Mark was used in connection with at least one of the goods listed in the application at the time of filing the application, the '269 Application cannot be found void ab initio…. Applicant began selling T-shirts under the mark in October, 2013 and continued to sell and offer for sale those 40-0 marked T-shirts since that time. … As a result, there is no basis for a non-use claim with respect to Applicant's T-shirts."[15]

Opposer responded, in pertinent part:

> Given Applicant's failure to (1) initiate use of the alleged mark on any of the listed goods except T-shirts prior to filing its use-based application or (2) amend the '269 Application prior to commencement of the present proceeding, judgment against Applicant as to those goods would seem appropriate.
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> With regard to Applicant's motion for judgment with regard to T-shirts, Opposer concedes that the evidence of record indicates that Applicant

[14] Applicant's motion for leave to amend application without consent, 32 TTABVUE; Applicant's motion for summary judgment, 33 TTABVUE 14.

[15] Applicant's motion for summary judgment, 33 TTABVUE 15. *See also* Applicant's reply in support of motion for summary judgment, 37 TTABVUE.

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