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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

12/12/00

KSK

Opposition No. 113,802

National Hockey League

v.

Yisreal Jakobovits

Before Chapman, Bucher and Bottorff, Administrative  
Trademark Judges.

Opinion by **the Board**:

This case now comes before the Board for  
consideration of opposer's motion (filed November 24,  
1999) for summary judgment on the issues of likelihood of  
confusion under Section 2(d) of the Trademark Act and  
dilution under Section 43(c) of the Trademark Act as  
amended by the Trademark Amendments Act of 1999. The  
motion has been fully briefed.

**BACKGROUND/PLEADINGS**

Applicant has filed an application for registration  
of the mark WNHL (in typed form) for "entertainment

**Opposition No. 113,802**

services, namely, providing professional female hockey exhibitions" in Class 41.<sup>1</sup>

In its amended notice of opposition,<sup>2</sup> opposer (NHL) alleges, inter alia, that "[a]pplicant's mark consists of and comprises a mark that so resembles the NHL marks registered in the Patent and Trademark Office previously and currently used by NHL as to be likely, when used on or in connection with the services of the applicant, to cause confusion, or to cause mistake or to deceive as to the affiliation, connection or association of applicant and its services with NHL and as to NHL's sponsorship or approval of applicant's services" and that "[a]pplicant's mark consists of and comprises a mark that so resembles the NHL marks registered in the Patent and Trademark Office previously and currently used by NHL as to dilute the NHL marks when used on or in connection with the services of the Applicant."

Opposer asserted several of its registrations, including the following: (1) NHL for "indicating

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<sup>1</sup> Application Serial No. 75/438,648 filed on February 23, 1998 and claiming a bona fide intent to use the mark in commerce.

<sup>2</sup> Opposer's amended notice of opposition (adding a claim of dilution) was allowed by Board order dated December 7, 1999. The Board also allowed applicant time to file an answer to the amended pleading. No answer was filed, but a default notice under Fed. R. Civ. P. 55(a) has not been issued by the Board.

**Opposition No. 113,802**

membership in applicant" in Class 200;<sup>3</sup> and (2) NHL for  
"entertainment

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<sup>3</sup> Registration No. 883,569 issued on December 30, 1969 filed on January 2, 1969 and claiming first use in 1917 and first use in commerce in 1924.

**Opposition No. 113,802**

services, namely providing professional hockey games" in Class 41.<sup>4</sup>

Although applicant denied the salient allegations of the original notice of opposition, the Board has not received an answer from applicant to the amended notice of opposition which adds the claim of dilution. Inasmuch as applicant has responded on the merits to the summary judgment motion, rather than approach the added dilution claim now as one of default the Board in its discretion takes up for consideration the motion for summary judgment on both issues.

**SUMMARY JUDGMENT STANDARD**

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). However, a

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<sup>4</sup> Registration No. 1,960,563 issued on March 5, 1996 filed on July 13, 1995 and claiming first use and first use in commerce in October, 1926. Opposer's various other pleaded registrations for the mark NHL and NHL with design are for use in connection with a wide variety of goods and services, including clothing, video game cartridges, television programs, and providing information on a website.

**Opposition No. 113,802**

dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

**THE PARTIES' EVIDENCE AND ARGUMENTS**

Opposer has moved for summary judgment in its favor as to its Section 2(d) and Section 43(c) grounds of opposition.

**Opposition No. 113,802**

In support of its motion, opposer has presented evidence showing that: (1) opposer's "annual revenues are approximately \$1.4 billion" (Declaration of Mary Sotis (hereinafter "Sotis") at paragraph 7); (2) "total retail sales of merchandise in North America bearing the NHL trademark and/or the teams' trademarks are in excess of \$1 billion" (Sotis at paragraph 13); (3) total attendance at opposer's regular season games in the 1998-1999 season was 18,001,741 (Sotis at paragraph 6); (4) opposer's mark has been featured "for over eighty years in nearly every possible setting" including television and radio broadcasts, books, newspapers and magazines, in advertising, marketing and promotional material, in connection with corporate sponsorships and special events, and, on or in connection with, numerous consumer goods and services through commercial licensing efforts (Sotis at paragraph 10); (5) television broadcasts of NHL games reach over 200 million homes in 181 countries and NHL currently is signed to a five-year contract with ABC and ESPN ("worth hundreds of millions of dollars") for broadcast coverage of NHL games (Sotis at paragraph 14); (6) NHL maintains a website "accessed by millions of Internet users every month around the world" (Sotis at paragraph 15); (7) major newspapers in the United States

**Opposition No. 113,802**

devote a portion of their sports sections to coverage of the NHL (Sotis at paragraph 18); and (8) several magazines are devoted to coverage of NHL hockey (Sotis at paragraph 19).

Opposer's evidence on summary judgment includes the declaration of Mary Sotis, Vice President Legal and Associate General Counsel of NHL Enterprises L.P., the marketing and licensing arm of the National Hockey League, together with the exhibits identified therein; and the declaration of Bruce P. Keller, opposer's outside counsel with the law firm of Debevoise & Plimpton, together with the exhibits identified therein.

In response, applicant has submitted the declaration of the applicant, Yisreal Jakobovits; and the declaration of applicant's counsel, Jeffrey E. Jacobson, with exhibits.

Opposer argues that its mark NHL "is famous to, and instantly recognizable by, millions of consumers as a result of the NHL's continuous marketing, advertising, and promotional efforts" and that "both sports fans and the general public 'have been educated to recognize and accept' the NHL mark as the 'hallmark' for a renowned league of professional ice hockey teams." Further, opposer argues that the applicant's proposed mark WNHL is

**Opposition No. 113,802**

"but for the letter 'W' ... identical to the NHL mark in sound, appearance and commercial impression."

As to the services, opposer argues that applicant's "description of services is virtually identical to those currently being offered by the NHL." Further, opposer contends that opposer's registration is not restricted by gender and, moreover, "as the senior user of the NHL mark for professional hockey exhibitions...opposer has the right to expand the scope of such services, by for example, creating Women's National Hockey League or WNHL."

Opposer argues that sports consumers consist of both discriminating and ordinary consumers. Moreover, opposer states that due to the "widely reported marketplace event" of the "successful expansion in 1997 of the National Basketball Association (NBA) into women's professional basketball under the mark WNBA" it is "even more likely that consumers will assume that a new hockey league for women, operating under the mark WNHL, is the product of the NHL's expansion into women's hockey."

Finally, opposer argues that applicant acted in bad faith in his adoption of the mark WNHL, specifically, that the fact that "[applicant] and his brother ... have filed other trademark applications for the marks that

**Opposition No. 113,802**

were likely to be confused with other famous trademarks, reflects poorly on Jakobovits' intentions with regard to his application to register the WHNL ... mark[]."

In response, applicant argues that "WNHL, used in connection with an internet based fantasy women's hockey league is not likely to cause confusion with the NHL ice hockey league mark"; that "the fact that two marks share specific common elements is not enough, by itself, to prove that consumers will be confused as to the source of the goods"; that "[s]ports fans typically exercise a high degree of care regarding the events that they choose to view"; and that there is no evidence of actual confusion.

In connection with opposer's assertion of fame, applicant argues that opposer's mark is not famous because: (1) "the letters 'N' and 'L' are common among almost all sports leagues...[t]herefore, it is not a distinctive mark"; (2) "[m]ost of the states in this country do not have an NHL hockey team" and "this point is especially important since the NHL does not even have a major network television deal as all 'popular' sports in this country do"; and (3) "many third parties use similar marks." In support of this last argument, applicant submitted print-outs of registrations from the U. S. Patent and Trademark Office Trademark Text and

**Opposition No. 113,802**

Image Database. Applicant has not provided any evidence showing use of the marks depicted in these third-party registrations.

Applicant also argues that opposer has "unclean hands" because opposer has applied for a trademark registration of WNHL in Canada in an attempt to "pre-empt [applicant's] possible use in other areas."

Finally, applicant argues that opposer "should be barred from bringing this action" because opposer did not take action against third parties' use of a "similar mark on similar goods." Applicant lists the examples of the marks WPHL, WNL, ECHL, and PHL 3 all for use in connection with hockey related services and NHLA for a lumber association. As noted above, applicant submitted only print-outs of the registrations but no evidence of use.

**DECISION**

We turn first to the issue of likelihood of confusion under Section 2(d).

In determining whether there is any genuine issue of material fact relating to the legal question of likelihood of confusion, the Board must consider all of the probative facts in evidence which are relevant to the factors bearing on likelihood of confusion, as identified

**Opposition No. 113,802**

in *In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, various factors, from case to case, may play a dominant role. *Id.*, 476 F.2d at 1361, 177 USPQ at 567. Those factors as to which we have probative evidence are discussed below. After a careful review of the record in this case, we find that there are no genuine issues of material fact relating to those factors.

As a preliminary matter, priority is not an issue in this case in view of opposer's submission of uncontroverted evidence showing that the pleaded registrations are subsisting and owned by opposer. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Likewise we find that the evidence of these registrations is sufficient to establish opposer's standing in this case. No genuine issue of material fact exists on these issues.

While the key likelihood of confusion factors in this case are the degree of similarity between opposer's and applicant's marks, NHL and WNHL, and the degree of similarity between the parties' services as recited in their respective registrations and application, we have also considered other *du Pont* factors in making our determination.

**Opposition No. 113,802**

The evidence of record clearly establishes the lack of a genuine issue of material fact as to the fame of opposer's mark NHL for, at a minimum, the entertainment services of providing professional hockey games.

Applicant's argument that opposer's mark is weak because of the pervasive use of the letters N and L is not supported by competent evidence. Applicant's submission of third-party registrations does not establish third-party use. Finally, applicant's unsupported allegation that opposer does not have a "major network television deal" is in direct contradiction to opposer's sworn statement that opposer has a contract with ABC.

(Applicant's attorney's attention is directed to Fed. R. Civ. P. 11 and Patent and Trademark Office Rules 10.18 and 10.23(c)(15).)

Turning now to the marks, NHL and WNHL, the only difference between the marks is the letter W placed at the beginning of applicant's mark. When these marks are considered in their entirety, they are substantially similar in sound, appearance, and commercial impression.

The marks only differ by the first letter. Marks may be confusingly similar in appearance notwithstanding the addition, deletion or substitution of letters. See *Weiss Associates, Inc. v. HRL Associates*, 902 F.2d 1546,

**Opposition No. 113,802**

14 USPQ2d 1840 (Fed. Cir. 1990). This situation is heightened by the "marketplace event" where the consuming public has witnessed the creation of the WNBA. In the context of the services, the purchasing public would understand NHL refers to National Hockey League and WNHL refers to Women's National Hockey League.

As to the services offered by each party, opposer's identified services, "entertainment services, namely providing hockey games," and applicant's identified services, "entertainment services namely, providing professional female hockey exhibitions" are virtually identical.

Applicant's arguments relating to the possible dissimilarity of the services, based on his alleged intended use of the mark in connection with a "female fantasy hockey league on the internet," as opposed to the services identified in his application, are wholly irrelevant. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the

**Opposition No. 113,802**

particular channels of trade or the class of purchasers to which sales of the goods are directed. Because OSI seeks an unrestricted registration, such evidence as there is of a specific class of customers did not relate to a material fact." *Id.* at 1787).<sup>5</sup>

Regarding the channels of trade, both the involved application and opposer's pleaded registrations are unrestricted. Thus, the Board must presume that the services are marketed or will be marketed in all the normal channels of trade for the identified services and to all the usual classes of purchasers of such services. See *Kangol Ltd. v. Kangaroo U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed Cir. 1992). Applicant's argument that a high degree of care is exercised by sports consumers in choosing what sports event(s) they view is unsupported and is not persuasive.

Inasmuch as applicant has not yet begun use of his mark, the fact that there has been no actual confusion is not a basis to find this factor in his favor. There has

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<sup>5</sup> In the *Octocom* case, the court sanctioned the appellant for bringing a frivolous appeal. "Where a party blindly disregards long established authority and raises arguments with no factual foundation, as OSI has in this case, the judicial process has not been used, but abused, and sanctions under Rule 38 are warranted." *Octocom, supra*, at 1789.

**Opposition No. 113,802**

been no opportunity for actual confusion. Hence, this factor is neutral. Moreover, it is unnecessary to show actual confusion in establishing likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983).

Finally, applicant's argument that opposer has not "policed" its mark and is therefore "barred" from opposing applicant's mark is not well taken. The marks in the third-party registration print-outs proffered by applicant that pertain to hockey-related services only contain the letters HL unlike applicant's mark which includes the entirety of opposer's mark. The only third-party registration offered by applicant that contains the letters NHL is the lumber industry's mark NHLA for wholly unrelated services.<sup>6</sup>

In summary, considering the fame of opposer's mark, the substantial similarity of the marks, the legally identical services, and the similar trade channels and purchasers, as identified, we find that there are no

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<sup>6</sup> We have given little weight to the parties' arguments on "bad faith." While this factor may fit within the catch-all 13th *du Pont* factor, there is not sufficient evidence to find in either party's favor on this factor. While it may remain an issue of fact in this case, it is not a genuine issue of material fact. Even if we draw this inference in favor of applicant, (no bad faith), our finding on the ultimate issue of likelihood of confusion remains the same.

**Opposition No. 113,802**

genuine issues of material fact that confusion is likely to result.

In view of the above, opposer's motion for summary judgment on the issue of likelihood of confusion under Section 2(d) of the Trademark Act is granted. Accordingly, judgment is hereby entered against applicant, the opposition is sustained, and registration to applicant is refused.<sup>7</sup>

B. A. Chapman

D. E. Bucher

C. M. Bottorff  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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<sup>7</sup> In view of our decision sustaining opposer's Section 2(d) ground of opposition, we need not reach the issue of dilution.