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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

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

Opposition No. 102,722

Los Angeles Rams Football Company, St. Louis Rams Football Company, and National Football League Properties, Inc.

v.

Johnny Blastoff, Inc.

Opposition No. 108,292

St. Louis Rams Partnership and National Football League Properties, Inc.

v.

Johnny Blastoff, Inc.

Before Simms, Quinn and Rogers, Administrative Trademark Judges.

By the Board:

Applications have been filed by Johnny Blastoff, Inc. to register the mark shown below

for a variety of products in International Classes 16 and 25.[1]

Registrations have been opposed by the above-named opposers on the grounds of priority and likelihood of confusion with opposer's ST. LOUIS RAMS and RAMS marks used in connection with a wide variety of goods and services.

Applicant, in its answers, denied the salient allegations of the notices of opposition.

In view of the common issues of law and fact involved in these proceedings, and inasmuch as opposers have moved for summary judgment in both cases, the two oppositions are hereby consolidated. The Board will issue a single opinion in this consolidated matter.

This case now comes up on opposers' motion for summary judgment based on a final determination in a civil action between the parties. Opposers assert that in the civil action, it was determined that opposers have prior rights in the mark ST. LOUIS RAMS and that applicant's mark is likely to cause confusion with opposers' mark. Opposers maintain that these issues were decided by the United States District Court for the Western District of Wisconsin, the United States Court of Appeals for the Seventh Circuit and the Supreme Court of the United States (by denial of applicant's

[1] Application Serial Nos. 74/659,944 and 74/644,300, respectively, filed March 10, 1995, each alleging a bona fide intention to use the mark in commerce.

petition for a writ of certiorari). Thus, according to opposers, applicant is estopped from asserting any rights to use the term ST. LOUIS RAMS and owning registrations therefor. Opposers' motion is accompanied by copies of the appropriate decisions of the involved courts.

Applicant has objected to opposers' motion, essentially contending that the underlying civil action does not dispose of the opposition proceedings. Applicant advances a variety of arguments, none of which merit specific mention given the clear import of the final decision in the civil action.[2]

Opposers filed a reply brief.

In the case of Johnny Blastoff, Inc. v. Los Angeles Rams Football Co., St. Louis Rams Partnership, National Football League Properties, Inc., et al., 188 F.3d 427, 51 USPQ2d 1920 (7th Cir. 1999), *aff'g*, 48 USPQ2d 1385 (W.D.WI. 1998), the Seventh Circuit affirmed the district court's holdings in opposers' favor on the issues of priority and likelihood of confusion.

Insofar as priority is concerned, the Seventh Circuit stated that "we agree with the district court's determination that the [opposers] had acquired protectable rights in the 'St. Louis Rams' mark prior to [applicant]."

[2] In this connection, we note, parenthetically, the district court judge's observation that "[t]hroughout this litigation, [applicant's] filings with this court have shifted from the frustratingly vague to the utterly cryptic to the inexplicably absent."

Id. at 1925. The Seventh Circuit went on to state that in view of opposers' superior rights, "[applicant], which has never been part of the NFL in any manner, shape, or form, is precluded from using the 'St. Louis Rams' mark." Id. at 1928.

With respect to likelihood of confusion, the Seventh Circuit noted that applicant did not contest that a likelihood of confusion existed in view of applicant's belief that the public associated applicant's apparel and sundries with opposers' football club. On appeal, according to the Seventh Circuit, applicant appeared to blame opposers for having caused a likelihood of confusion to exist, now framing the issue as one of reverse confusion. The Seventh Circuit found this argument lacking because "[applicant] is not the senior user and furthermore has no protectable rights to the 'St. Louis Rams' mark." Id. at 1926. The Seventh Circuit found that applicant's own statement that the public associated applicant's products with opposers' football club compelled a holding of likelihood of confusion. Accordingly, the Seventh Circuit concluded that the district court did not err in finding that a likelihood of confusion between the parties' marks exists.

Applicant's petition for rehearing was denied by the Seventh Circuit on August 31, 1999. The Supreme Court of

the United States, on February 28, 2000, denied applicant's writ of certiorari.

Contrary to applicant's arguments, the Seventh Circuit's clear and unambiguous holdings that applicant has no rights to the involved mark and that, therefore, applicant is precluded from using the mark, mandate that registration be refused to applicant.[3] In the words of a noted commentator and professor, "[i]f a court decides that a person either has or does not have the exclusive right to use of a mark, it is difficult to see how this determination can be anything less than conclusive of the right to federal registration." 5 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §32:94 (4th ed. 1999). Attention is directed to the case of Tuvache, Inc. v. Emilio Pucci Perfumes International, Inc., 263 F.Supp. 104, 152 USPQ2d 574, 576 (SDNY 1967), wherein the district court cited with approval the following language in the case of Squirrel

[3] In the civil action, each party requested that the district court order the Office to reject the other party's applications to register the ST. LOUIS RAMS mark. The district court indicated in its decision that it lacked authority over the registrability issues raised herein. On appeal, the Seventh Circuit viewed applicant's contentions on this point as "unsupported or cursory," stating that "[b]ecause the [applicant] has failed to adequately challenge this issue on appeal, we need not reach a conclusion concerning the trial court's authority to order the PTO to reject trademark applications." Id. at 1928. In their papers herein, the parties have referred to their other applications, none of which are involved in these proceedings. Opposers should take appropriate action relative thereto on the basis of this decision.

Brand Co. v. Barnard Nut Co., 101 USPQ 340 (Comm'r Pat. 1954):

> Rights in trade marks grow out of their use. Use is a prerequisite to ownership, and use in commerce by the owner is a prerequisite to registration. Although the ultimate finding of the tribunals of the Patent Office in proceedings such as these is the right of an applicant to register, nevertheless there must be a finding of the right to use in commerce before that ultimate finding can be made. The Court, in the civil action, will necessarily determine this preliminary question of the right to use, and that determination will form the basis of the ultimate finding of the Office.
>
> Simply stated, if the Court concludes that this defendant (applicant) has the right to use its mark in commerce, it has a right to register; **if the Court concludes that the defendant (applicant) has no right to use its mark, it has no right to register**;...[emphasis added]

In view of the final determination in the civil action, wherein the Seventh Circuit found that applicant has no rights to the involved mark and is precluded from using the mark, opposers' motion for summary judgment is granted. The oppositions are sustained, judgment is entered against applicant, and registrations to applicant are refused.