

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: January 27, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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United States Soccer Federation, Inc.

v.

Aztec Shops, Ltd.
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Opposition No. 91220225
to Application Serial No. 85458395
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Marie A. Lavalleye of Covington & Burling LLP for United States Soccer
Federation, Inc.

Katie Heilman of the Arent Fox LLP for Aztec Shops, Ltd.

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Before Shaw, Adlin, and Pologeorgis, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Aztec Shops, Ltd., seeks registration of the mark I BELIEVE THAT
WE WILL WIN!, in standard characters, for “Bottoms; Caps; Hats; Jackets; Shirts;
Sweatshirts; T-shirts; Tops,” in International Class 25:¹

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¹ Application Serial No. 85458395, filed on October 27, 2011, under Section 1(a) of the
Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce
of October 19, 2011.

Opposer, United States Soccer Federation, Inc., has opposed registration of Applicant's mark on the ground that it fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1151, 1052, and 1127. Applicant denied the salient allegations of the notice of opposition.

The parties stipulated to resolution of this case through the Board's Accelerated Case Resolution procedure ("ACR"). Following the Board's order approving the use of ACR, the parties submitted their Joint Stipulation of Facts incorporating evidence previously submitted with the parties' respective motions for summary judgment. In addition, pursuant to their agreement, the parties submitted supplemental evidence.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application. Opposer submitted the following evidence:

1. The first declaration of Grant D. Johnson, counsel for Opposer, with exhibits comprising internet excerpts and videos purporting to show use of the applied-for mark by Applicant, Opposer, and third parties, as well as Opposer's Initial Disclosures;²
2. Mr. Johnson's second declaration with exhibits comprising internet excerpts about Applicant, as well as web page excerpts purporting to show Opposer's attempts to sell products bearing the proposed mark or variations thereof;³ and
3. The declaration of Michael Gressle, Director of Marketing for Opposer, with exhibits relating to apparel sold by Opposer.⁴

² 5 and 6 TTABVUE.

³ 14 TTABVUE.

⁴ 22 TTABVUE.

Applicant submitted the following evidence:

1. The declaration of Todd Summer, Director of Campus Stores Division & San Diego State University (“SDSU”) Licensing, with exhibits relating to Applicant’s use of the proposed mark and apparel sold by Applicant;⁵ and
2. A Notice of Reliance introducing third-party registrations of marks comprising slogans and three of Opposer’s trademark application file wrappers for slogans.⁶

In addition, the parties filed a joint stipulation of facts.⁷

I. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco* at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026. Moreover, allegations in support of standing which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

⁵ 23 and 34 TTABVUE.

⁶ 24-33 and 40 TTABVUE.

⁷ 35 TTABVUE.

In its pleading Opposer alleges that as soccer's national governing body in the United States, it is responsible for the U.S. Men's National Team and U.S. Women's National Team which compete against other countries, including in qualification rounds for the World Cup, and if they qualify in the World Cup finals themselves. Opposer further alleges that during the 2014 FIFA World Cup, fans of the U.S. Men's National Team adopted the applied-for mark as the rallying cry for the team. Finally, Opposer alleges that registration of the applied-for mark will deprive Opposer and others of the ability to use the mark as an "informational and aspirational slogan." We find Opposer properly pleaded standing.

To prove its standing, Opposer made of record video advertisements from 2014 for the United States' Men's National Soccer Team showing use of the applied-for mark by fans, professional athletes, and celebrities supporting the U.S. team.⁸ In addition, Mr. Gresssle testified that Opposer has sold apparel, including apparel bearing the applied-for mark, or marks derived from the applied-for mark.⁹ This establishes Opposer's interest in and use of the mark. *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding."); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's

⁸ 5 TTABVUE, exhibits 17 and 18.

⁹ Gresssle Declaration, 22 TTABVUE.

allegations of a reasonable belief that it would be damaged. . . .” where opposer alleged likelihood of confusion).

Applicant argues that Opposer has not established standing because it does not show that it has a real interest in using the mark in connection with Applicant’s goods, or goods commercially related to them, or that Opposer is a competitor of Applicant in the field of apparel.¹⁰ This argument is unpersuasive.

The Gresssle declaration establishes that Opposer produces clothing products in connection with U.S. national soccer teams and that Opposer would like to use the applied-for mark on clothing articles such as scarves. Accordingly, the Gresssle declaration establishes that Opposer is indeed a competitor of Applicant in that Opposer sells or licenses clothing supporting sports teams and that it would like to continue using the applied-for mark.

Applicant also argues that Opposer does not itself make any goods and that “Opposer’s standing cannot be premised on a third party’s activities or interest in using the Applicant’s mark in connection with the same or commercially-related goods.”¹¹ This argument too is unpersuasive because Applicant is conflating “third parties” with related parties, as that term is used in the Lanham Act, specifically Opposer’s licensees. The fact that licensees may produce and sell goods for Opposer does not negate Opposer’s real interest in this proceeding inasmuch as a licensee’s use of a mark inures to the benefit of the trademark owner. *See Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 USPQ2d 1389 (TTAB

¹⁰ Applicant’s Br., p. 18, 37 TTABVUE 19.

¹¹ *Id.* at 20.

2007) (“[Y]ears of precedent make it very clear that proper use of a mark by a trademark owner’s licensee or related company constitutes ‘use’ of that mark attributable to the trademark owner.”); Section 5 of the Trademark Act, 15 USC § 1055.

Lastly, Applicant argues that Opposer has not proven that it has a real interest in use of the applied-for mark as of the filing date of the opposition, January 20, 2015. Applicant’s argument is unavailing. Opposer’s evidence establishes that the chant I BELIEVE THAT WE WILL WIN! was used in advertising for the U.S. men’s soccer team in mid-2014. In any event, it is not necessary that an opposer be using that term as a trademark in order to find standing. *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (1966). Rather, an Opposer may prove its standing by establishing merely that it has an interest in using the term in its business. *See De Walt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 USPQ 275, 280 (CCPA 1961) (Standing “will be presumed or inferred when . . . the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business.”).

II. Failure to function as a mark

Section 45 of the Trademark Act defines a “trademark” as “any word, name, symbol, or device, or any combination thereof – (1) used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. It is well settled that not every designation that is placed or used on a product necessarily functions as a trademark and not every designation adopted with the

intention that it perform a trademark function necessarily does so. *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013).

Slogans and other terms that are considered to be merely informational in nature, or that express support, admiration or affiliation, are generally not registrable. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1232 (TTAB 2010) (“ONCE A MARINE, ALWAYS A MARINE is an old and familiar Marine expression, and as such it is the type of expression that should remain free for all to use.”); *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993) (BLACKER THE COLLEGE SWEETER THE KNOWLEDGE appearing on t-shirts “would be viewed merely as an informational message or slogan devoid of trademark significance.”). The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark. *See Reed v. Amoco Oil Co.*, 611 F. Supp. 9, 225 USPQ 876, 877 (M.D. Tenn. 1984).

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to specimens and other evidence of record showing how the designation is actually used in the marketplace. *In re Eagle Crest Inc.*, 96 USPQ2d at 1229. Thus, the determinative factor as far as registrability is concerned is the manner in which the mark is actually used. *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1135 (TTAB 2000).

Opposer argues that the applied-for mark fails to function as a trademark identifying the source of Applicant’s goods:

Applicant’s alleged mark—I BELIEVE THAT WE WILL WIN!—is an enormously popular inspirational chant that has been uttered by thousands (if not millions) and viewed and heard by hundreds of millions of fans and devotees of a multitude of causes over the past twenty years. . . . This includes the chant’s long standing and wide-spread use at sporting events and other social gatherings that have absolutely no association with Applicant. . . . Many of these documented uses predate Applicant’s own claimed first use.¹²

In fact, Opposer made of record a number of news articles, blog excerpts, videos, and other material showing that the chant I BELIEVE THAT WE WILL WIN has been widely publicized to have been used by others both before and after Applicant’s adoption of the slogan in October of 2011. The following examples are representative:

- A U.S. Naval Academy blog excerpt dated October 30, 2003 from “Eric the Jarl” describes the arrival of T-shirts featuring the chant I BELIEVE THAT WE WILL WIN.¹³
- An Internet story dated May 25, 2009 describes the Northern Lebanon Pennsylvania High School football team’s use of the chant I BELIEVE THAT WE WILL WIN before a game.¹⁴
- A 2008 “Fan Manual” from Embry-Riddle University encourages students to use the I BELIEVE THAT WE WILL WIN cheer.¹⁵
- A YouTube video dated May 16, 2009 depicts Ithaca college football fans chanting I BELIEVE THAT WE WILL WIN.¹⁶

¹² Opposer’s Br at 17, 36 TTABVUE 18.

¹³ 5 TTABVUE 19.

¹⁴ *Id.* at 31.

¹⁵ *Id.* at 54.

¹⁶ *Id.* at exh. 7 (video).

- A 2010 article in *The Harvard Crimson* describes fans' use of the I BELIEVE THAT WE WILL WIN chant to support Harvard's basketball team.¹⁷
- A 2010 article from phillynews.com describes a high school quarterback who "helped change the final line of the famous sports chant from 'I believe that we will win' to 'I believe that we have won. . . .'"¹⁸
- A February 2011 blog article from yahoo.com/ncaa/basketball/the_dagger discusses a basketball game between Temple University and St. Joseph's University. The article claims that Temple students "adapted the ubiquitous 'I believe that we will win' cheer, chanting 'I believe the [St. Joseph's] Hawk is dead' instead."¹⁹
- A June 2011 blog article about cheering for a high school robotics team at a competition states:

[T]his year we began to do a cheer known simply as "I Believe." This is a simple, yet effective chant that psychs up the drive team when they hear it. It starts off with [team members] screaming "I" at the top of our lungs. Then, everybody else repeats after us. We then shout "I Believe," and everybody follows. Then "I Believe That," and "I Believe That We," which everybody keeps following, getting progressively louder. Then with one final scream, the three of us scream "I Believe That We Will Win!" Everybody then goes crazy chanting "I BELIEVE THAT WE WILL WIN" repeatedly at the top of their lungs for around 30 to 45 seconds.²⁰

¹⁷ *Id.* at 64.

¹⁸ *Id.* at 71.

¹⁹ *Id.* at 75.

²⁰ *Id.* at 78.

- A June 2014 article purports to trace the origins of the I BELIEVE THAT WE WILL WIN chant used in connection with the U.S. men’s national soccer team to a New York high school in “the late 1990’s.”²¹
- A June 2014 article purports to trace the origins of the I BELIEVE THAT WE WILL WIN chant “used by enthusiastic college basketball student sections or hopeful U.S. soccer fans” to a “Naval Academy Prep School student” in 1998.²²
- A November 2011 article from ESPN.com discusses use of the I BELIEVE THAT WE WILL WIN chant by Utah State basketball fans, and cites to a 2003 Washington Post article which alleged that the chant began at the U.S. Naval Academy. The article also alleges that T-shirts bearing the mark appeared in 2003.²³
- An ESPN video from YouTube dated April 2014 depicts U.S. soccer fans chanting I BELIEVE THAT WE WILL WIN.²⁴
- A YouTube video dated April 2015 depicts union members advocating for higher wages chanting I BELIEVE THAT WE WILL WIN.²⁵

For its part, Applicant argues that “[b]ecause the relevant purchasing public has come to associate the I BELIEVE THAT WE WILL WIN! Mark with SDSU, the Mark serves a source-identifying function and is entitled to registration.”²⁶ In support,

²¹ *Id.* at 8.

²² *Id.* at 10.

²³ *Id.* at 17-18.

²⁴ *Id.* at exh. 17 (video).

²⁵ *Id.* at exh. 20 (video).

²⁶ Applicant’s Br., p. 14, 37 TTABVUE 15.

Applicant points to over \$74,000 in sales of products bearing the applied-for mark since 2011 and advertising expenditures of approximately \$400,000 annually for the entire SDSU brand.²⁷ Applicant submitted evidence showing use of the applied-for mark on clothing, in retail store displays, and as an athletic facility wall decoration.

The following examples are representative:



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Applicant also submitted examples of I BELIEVE THAT WE WILL WIN! used as a cheer in video promotions for the school.³¹

²⁷ Summer dec., p. 4, 23 TTABVUE 5.

²⁸ 11 TTABVUE 35.

²⁹ *Id.* at 42.

³⁰ *Id.* at 37.

³¹ 34 TTABVUE, exh. C (video).

The function of a trademark is to identify a *single* commercial source. The record before us establishes that the slogan I BELIEVE THAT WE WILL WIN! has been widely used over a long period of time by various groups and organizations as an expression of enthusiasm and support for their particular sports team or cause. For example, the videos, news articles, and blog excerpts establish that since at least the late 1990's the public has been exposed to numerous stories discussing how the slogan has been chanted at games at all levels and types of competition—from high schools, to colleges, to international-level events, and from basketball, to soccer, to football, to union activities to robotics competitions. The evidence also establishes that the public has been exposed to stories discussing how the slogan has been chanted at political events and placed on T-shirts. The record establishes that I BELIEVE THAT WE WILL WIN! has been described as “famous” and “ubiquitous.”

Because consumers are accustomed to seeing I BELIEVE THAT WE WILL WIN! used by many different groups, they would not view the slogan as a trademark indicating that Applicant is the sole source of the clothing bearing the mark. Moreover, some consumers will purchase clothing and other goods bearing the slogan for the message it conveys. Applicant is not entitled to appropriate the slogan to itself and thereby attempt to prevent competitors from using it to promote the sale of their own clothing. It has been noted that “as a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights” in common phrases or slogans. 1 McCarthy on Trademarks and Unfair Competition § 7:23 (4th ed. Dec. 2016).

Applicant argues that the applied-for mark is registrable because it is “an arbitrary phrase when used in connection with the goods at issue, *i.e.*, shirts and other clothing items. . . .”³² And further, that “the USPTO has routinely registered sport-related slogans as inherently distinctive, many for use on clothing.”³³ Applicant is correct that I BELIEVE THAT WE WILL WIN! as applied to clothing does not impart any information about the goods themselves. However, that is beside the point. The issue before us is not whether the mark is merely descriptive of the goods, but whether it functions as a trademark, *i.e.* to distinguish Applicant’s goods from those of others. Thus, the numerous third party registrations submitted by Applicant establish only that some slogans are registrable, not that *this* slogan is registrable. Here, the primary purpose of I BELIEVE THAT WE WILL WIN!, as shown by the evidence of use by the public, is to convey information, that is, to convey enthusiasm and support for particular sports teams or causes.

Applicant argues that “the fact that the I BELIEVE THAT WE WILL WIN! Mark is used in a non-trademark manner as a chant in sports and political arenas is not a bar to registration, where it serves as an indicator of source of Applicant’s apparel goods.”³⁴ We disagree. It is well established that slogans such as the proposed mark cannot serve as source indicators and they must remain available for others to use. Indeed, the fact that I BELIEVE THAT WE WILL WIN! is used by others in a “non-trademark manner” as a chant in sports and political arenas (and on clothing)

³² Applicant’s Br., p. 10, 37 TTABVUE 11.

³³ *Id.* at 11.

³⁴ *Id.* at 16.

establishes that the slogan cannot serve as an indicator of the source of Applicant's apparel. *See In re Eagle Crest Inc.*, 96 USPQ2d at 1232 (holding the primary function of slogan ONCE A MARINE, ALWAYS A MARINE is to express support, admiration or affiliation with the U.S. Marines).

We find that I BELIEVE THAT WE WILL WIN! would not be perceived as a trademark to identify and distinguish Applicant's goods from the like goods of others.

Decision: The opposition is sustained and registration of the mark is refused.