UNITED STATES: Trademark Applicant Runs Into False Association Claim

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In a precedential decision, the Trademark Trial and Appeal Board (TTAB) dismissed an opposition brought under Section 2(a) of the Trademark Act alleging a false suggestion of a connection between the opponent and the applied-for mark. Boston Athletic Association v. Velocity, LLC, Opposition No. 91202562 (Oct. 26, 2015) [precedential]. Velocity, LLC, (applicant) applied to register MARATHON MONDAY for various items of clothing. The Boston Athletic Association (opponent), owner of the mark BOSTON MARATHON, opposed the application under Section 2(a), alleging that the applied-for mark created a false suggestion of an association with the opponent. Although the opponent did not own a registration for MARATHON MONDAY, it alleged that it had used the name in association with the BOSTON MARATHON race which has been held on the third Monday in April for 117 years.

To prove false suggestion of a connection under Section 2(a), the opponent was required to prove that:

1. MARATHON MONDAY was a close approximation of the opponent’s name or identity;
2. The opposed mark would be recognized as pointing uniquely and unmistakably to the opponent;
3. The opponent was not connected with the goods sold by the applicant; and
4. The opponent’s name or identity is of sufficient fame or reputation that, when used by the applicant, a connection with the opponent is presumed.

In addressing the first element, the TTAB found that the opponent failed to prove that MARATHON MONDAY was the name or identity of the opponent, or a close approximation of its name or identity. The TTAB found no dispute that the name BOSTON MARATHON is well known for the annual race, is associated with the opponent and would be perceived as a name or identity of the opponent. The TTAB, however, found little evidence that the name MARATHON MONDAY had become known as the opponent’s persona or as a synonym of BOSTON MARATHON. The TTAB found nothing in the record that proved that consumers associate MARATHON MONDAY so closely with the opponent that they recognize it as the opponent’s name (or nickname), identity or persona.

With respect to the second element, the TTAB found that the opponent failed to show that the mark MARATHON MONDAY points uniquely and unmistakably to the opponent. The applicant provided evidence that other entities have used “Marathon Monday” to refer to marathons and marathon activities not associated with the opponent. The TTAB concluded that the opponent failed to prove the first and second elements of a false association claim under Section 2(a) and thus found it unnecessary to evaluate the third and fourth elements. As a result, the TTAB dismissed the opposition.

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