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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

New York Yankees Partnership
v.
Evil Enterprises, Inc.

Opposition No. 91192764

Maryann E. Licciardi of Cowan, Liebowitz & Latman, P.C. for
the New York Yankees Partnership.

Gerard F. Dunne of the Law Offices of Gerard F. Dunne, P.C.
for Evil Enterprises, Inc.

Before Cataldo, Wolfson, and Shaw, Administrative Trademark
Judges.

Opinion by Shaw, Administrative Trademark Judge:

Evil Enterprises, Inc. ("applicant") has filed an
application to register on the Principal Register the mark
BASEBALLS EVIL EMPIRE, in standard character format, for
"clothing, namely, shirts, t-shirts, sweatshirts, jackets,
pants, shorts and hats" in International Class 25.¹

¹ Serial No. 76691096, filed July 7, 2008, based on an allegation
of applicant's bona fide intention to use the mark in commerce.

Registration has been opposed by the New York Yankees Partnership ("opposer"). Opposer alleges that prior to applicant's constructive first use date, the term EVIL EMPIRE has come to identify opposer's baseball entertainment services, and by extension, the source of opposer's wide variety of merchandise, including shirts, T-shirts, sweatshirts, jackets, pants, shorts, hats and other apparel.

As grounds for opposition, opposer alleges the grounds of (1) priority and likelihood of confusion under Section 2(d) of the Trademark Act, (2) a false suggestion of a connection with opposer under Section 2(a) of the Act, and (3) disparagement of opposer and/or that applicant's mark brings opposer into contempt or disrepute, also under Section 2(a) of the Act. In its answer to the notice of opposition, applicant denied the salient allegations.

The Record

By rule, the record includes the application file and the pleadings. Trademark Rule 2.122(b), 37 CFR § 2.122(b). In addition, the parties introduced the following testimony and evidence.

A. Opposer's evidence.

Opposer, by stipulation, submitted the Declaration of Howard Smith, Senior Vice President of Licensing for Major

League Baseball Properties, Inc. (the licensing agent for opposer) with seventeen attached exhibits including news stories using the term EVIL EMPIRE to refer to the Yankees, Internet blogs and message boards where the term EVIL EMPIRE is used to refer to the Yankees, a Wikipedia baseball glossary, printouts of applicant's web pages showing use of the phrase BASEBALLS EVIL EMPIRE to refer to the Yankees, and a dictionary definition of "evil." By Notice of Reliance, opposer submitted applicant's responses to certain interrogatories and admission requests; printed publications; excerpts from internet blogs and message boards; dictionary definitions; and status and title copies of opposer's pleaded registrations for its Yankees marks, i.e., its "interlocking NY" mark and its "Yankees top hat" mark.

B. Applicant's evidence.

Applicant, by stipulation, submitted the declaration of Tracy Carey, the president of applicant, Evil Enterprises, Inc., with two attached exhibits consisting of a copy of applicant's Facebook page and copies of emails from fans; the declaration of Joseph A. Dunne, Esq., attorney for applicant, with five attached exhibits consisting of news articles about baseball; and the declaration of Gerard F. Dunne, Esq., attorney for

applicant, with two attached exhibits consisting of a blog article and a news story. By Notice of Reliance, applicant submitted internet material in the nature of news stories, articles, and advertisements, as well as opposer's responses to applicant's interrogatories.²

Findings of Fact

Opposer is the owner of the well-known New York Yankees baseball club (the "Yankees" or the "Club"), founded in 1903. The Club is the owner of a number of marks, including the two shown below, which are used on player's uniforms as well as on or in connection with a wide variety of licensed goods and services, including the same clothing articles that applicant has listed in its application.³



The Club, through its licensing agent Major League Baseball Properties ("MLBP"), has extensively licensed various Yankees marks for a wide variety of goods and

² The Board notes with approval the parties' stipulation to utilize testimony by declaration and the efficiencies realized thereby. See TBMP §§ 528.05(a)(2) and 702.04 (October 2012) and authorities cited therein.

³ Registration Nos. 1076665, 3320067, 1032767, and 3320070.

services. The goods include apparel such as shirts, t-shirts, sweatshirts, jackets, pants, shorts and hats, as well as posters, toys, and a wide variety of other goods sought by sports fans. The licensed merchandise is sold over the Internet through opposer's website and the website of Major League Baseball, among others, as well as in official team stores and through numerous national retail store and sporting goods chains. Opposer's retail sales in the United States of licensed products bearing Yankees' marks or otherwise promoting the Yankees have exceeded \$1.1 billion since the year 2000.

Applicant, Evil Enterprises, Inc., filed its application for the mark BASEBALLS EVIL EMPIRE, for use on clothing, on July 7, 2008, based on an assertion of its intent to use the mark in commerce. Applicant has not yet filed an allegation of use of the mark. Applicant's website indicates that the goods are or will be directed to consumers seeking merchandise relating to the New York Yankees Baseball Club, proclaiming: "If you are passionate about the New York Yankees then you have come to the right place."⁴

⁴ Applicant's Responses to Opposer's First Set of Requests for Admission, Request No. 12.

Both applicant and opposer agree that the term EVIL EMPIRE, as it relates to baseball and these proceedings, was coined in 2002 by the president of the rival Boston Red Sox baseball club upon learning that a sought-after Cuban pitcher, Jose Contreras, had signed a contract to play for the Yankees and not the Red Sox. Upon hearing the news of Contreras' signing, Red Sox club president, Larry Lucchino, is reported to have said: "The evil empire extends its tentacles even into Latin America."⁵ The term EVIL EMPIRE has since been taken up by the media, Yankees' fans, and detractors as a reference to the Yankees. The Yankees have "implicitly embraced" the nickname EVIL EMPIRE, including playing ominous music from the soundtrack of the STAR WARS movies at baseball games.⁶ Opposer, however, does not own an application or registration for the term EVIL EMPIRE. Nor has opposer used the mark itself in connection with any goods or services.

Standing

Any person "who believes that he would be damaged by the registration of a mark upon the principal register" may oppose registration of the mark under Trademark Act § 13, 15 U.S.C. § 1063. To oppose registration, the opposing

⁵ Smith Declaration at 7.

⁶ *Id.* at 20.

party must show both standing and valid grounds for opposition. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Standing requires only that the petitioner have a "real interest" in the opposition proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). In most instances, a direct commercial interest satisfies the "real interest" test. *Cunningham*, 55 USPQ2d at 1844. Opposer has made its pleaded registrations of record and has shown that the registrations are valid and subsisting. Further, opposer has demonstrated that applicant "was aware that the NEW YORK YANKEES baseball team has been referred to and known as the 'Evil Empire' by the press, fans, media and/or public prior to filing Application Serial No. 76/691,096 on July 7, 2008."⁷ Accordingly, Opposer has established its real interest in opposing the registration of applicant's mark for the identified goods. Inasmuch as opposer has established its standing, opposer may raise any statutory ground for opposition to registration of the mark under the Trademark Act. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982).

⁷ Applicant's Responses to Opposer's First Set of Requests for Admissions, Request No. 3.

Likelihood of Confusion

Priority

Opposer has established its priority through applicant's response to Opposer's First Set of Requests for Admissions indicating that applicant was aware "that the NEW YORK YANKEES baseball team has been referred to and known as the 'Evil Empire'" prior to applicant's filing date of July 7, 2008.⁸ See *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002).

Opposer asserts likelihood of confusion under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). Opposer alleges that applicant's mark, BASEBALLS EVIL EMPIRE, when used in connection with applicant's clothing so resembles the mark EVIL EMPIRE which has become associated with opposer, as to be likely to cause confusion.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531,

⁸ *Id.*

1533 (Fed. Cir. 1997). In appropriate cases, a single *du Pont* factor may be dispositive of the likelihood of confusion analysis. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998); and *Kellogg Co. v. Pack 'Em Enter. Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Moreover, it is the opposer's burden to establish facts sufficient to support the conclusion that confusion, mistake, or deception is likely. *Bridgestone Americas Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012).

A. Opposer's rights in EVIL EMPIRE

It is well-settled that in order to establish rights in a mark, a party need not have actually used a mark if the public nevertheless associates the mark with the goods or services of that party: "even if a company itself has not made use of a term, it may have 'a protectable property right in the term' if the public has come to associate the term with the company or its goods or services." *Big Blue Prods. Inc. v. Int'l Bus. Machines Corp.*, 19 USPQ2d 1072, 1074 (TTAB 1991). See *Martahus v. Video Duplication Servs. Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1853 n.9 (Fed. Cir. 1993) ("[T]he public's adoption of [the mark] to refer to [opposer] is enough to establish trade name and service

mark use."); *Nat'l Cable Television Ass'n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) ("public use by others inures to the claimant's benefit and, where this occurs, public use can reasonably be deemed use 'by' that party in the sense of a use on its behalf."); *George & Co. LLC v. Imagination Entertainment Ltd.*, 575 F.3d 383, 403, 91 USPQ2d 1786, 1798 (4th Cir. 2009) ("The Public Use doctrine . . . states that abbreviations or nicknames used only by the public can give rise to protectable trademark rights to the owner of a mark which the public has modified."); *American Stock Exch., Inc. v. American Express Co.*, 207 USPQ 356, 363 (TTAB 1980) ("[W]here the public has come to associate a term with a particular company and/or its goods or services as a result, for example, of use of the term in the trade and by the news media, that company has a protectable property right in the term even if the company itself has made no use of the term."); *Coca Cola Co. v. Busch*, 44 F.Supp. 405, 52 USPQ 377, 382 (D.Pa. 1942) (holding the public's use of "COKE" to refer to Coca-Cola sufficient to enjoin defendant's use of KOKE-UP for soft drinks). *See also*, 1 *J. Thomas McCarthy, Trademarks and Unfair Competition* § 7:18 (4th ed. 2012), and additional cases cited therein.

Opposer has made of record hundreds of news articles, stories, and blog entries, as well as admissions by applicant, demonstrating that the term EVIL EMPIRE is widely used as a shorthand reference or nickname for the New York Yankees baseball club. The following is a representative sample of newspaper articles and other sources attached to the Smith declaration referring to the Yankees as the EVIL EMPIRE:⁹

- *The Denver Post*, February 9, 2003, "There is so much to love about baseball. . . . We love it that baseball has an Evil Empire, a team to beat, the perpetual villain in the New York Yankees."
- *The New York Post*, October 17, 2003, "Yankees 6 Red Sox 5 The Evil Empire lives!"
- *Dallas Morning News*, May 22, 2004, "[Rangers] traded Rodriguez to the 'Evil Empire,' for second baseman Alfonso Soriano and minor-leaguer Joaquin Arias."
- *Bangor Daily News*, Oct. 16, 2004, "Onetime Red Sox pitching ace Pedro Martinez . . . served up a two-run homer to Yankee first baseman John Olerud that put the Evil Empire up 3-0 in the sixth inning."
- *Ventura County Star*, March 3, 2005, "The only thing that is even more exciting to Perry is the end of The Curse as the Red Sox finally defeated the Evil Empire (the Yankees) en route to their first World Series win in ages."
- *Daily News*, July 23, 2008, "But these are the Yanks, after all, and everything is breaking right again for the Evil Empire since the All-Star break."
- *The Baltimore Sun*, Nov. 3, 2009, "The Evil Empire still stands poised to conquer all of baseball."
- A Wikipedia glossary of baseball terms including a definition of EVIL EMPIRE as a "common name for the

⁹ Smith declaration, Exhs. 4, 5, and 8.

New York Yankees due to its wealth and winning by far the most championships. This nickname is used especially by fans of the Boston Red Sox and by fans of other teams to a lesser extent. Even some Yankees fans have been known to call themselves and their team the 'Evil Empire' as a badge of honor."

By notices of reliance, opposer submitted hundreds more similar news stories, internet articles, blog entries, and message board postings since 2002 showing that the Yankees are known as the EVIL EMPIRE. Opposer also has stated that it "implicitly embraced" the EVIL EMPIRE theme by adopting music and other indicia from the STAR WARS movies in connection with games played at Yankee Stadium.¹⁰

Applicant, in its response to Opposer's First Set of Requests for Admissions, has admitted that "the New York Yankees baseball team has been referred to and known as the 'Evil Empire' by the press, fans, media, other Major League baseball teams and/or public."¹¹ Moreover, applicant's web page proclaims that "Baseballs Evil Empire takes pride in our merchandise and our great task of alerting all baseball fans and the like to send the message out loud that the NY Yankees are Baseballs Evil Empire"¹²

¹⁰ Smith Declaration at 20.

¹¹ Opposer's First Notice of Reliance, Exh. A, Applicant's Responses to Opposer's First Set of Requests for Admissions, Request No. 2.

¹² Smith Declaration, Exh. 13.

In view of the evidence submitted by opposer, we find that the term EVIL EMPIRE, when used in connection with baseball, refers to opposer, the Yankees.

Applicant nevertheless argues that opposer cannot claim a protectable right in the term EVIL EMPIRE because "[t]oo many baseball teams are now referred to by the media as an 'Evil Empire'" for the term to point exclusively to opposer.¹³ We disagree.

Applicant's evidence showing a small number of stories discussing other sports teams as "evil empires" does not counter the weight of opposer's evidence. Rather, applicant's evidence shows only that these other teams aspire to be in the position of the Yankees, i.e., spending more on salaries and winning more championships. In short, the record shows that there is only one EVIL EMPIRE in baseball and it is the New York Yankees. Accordingly, we find that opposer has a protectable trademark right in the term EVIL EMPIRE as used in connection with baseball.

B. The fame of opposer's marks.

Having found that opposer has a protectable interest in the term EVIL EMPIRE, we turn first to the factor of fame, because the fame of the prior mark, if it exists, plays a "dominant role in the process of balancing the

¹³ Applicant's Br. at 7.

DuPont factors." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). A famous mark has extensive public recognition and renown and enjoys a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Regarding fame, the Court of Appeals for the Federal Circuit has stated the following: [T]here is "no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

Fame may be measured indirectly in a number of ways: by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by

the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-1306 and 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer has submitted hundreds of news articles from major metropolitan newspapers, such as The Boston Globe, The New York Times, The Washington Post, The Los Angeles Times, and The Atlanta Journal-Constitution, among others, referring to the Yankees as the EVIL EMPIRE. These articles, dating back to 2002, show that a broad segment of the population has been exposed to the use of the term EVIL EMPIRE to refer to the Yankees.

Based on the evidence, the term EVIL EMPIRE certainly has achieved a level of fame such that most baseball fans would recognize the term as a nickname for the Yankees. We have no doubt that EVIL EMPIRE, in the world of baseball at a minimum, has become famous in identifying the Yankees for purposes of likelihood of confusion. EVIL EMPIRE, thus, is

entitled to a broad scope of protection, especially since applicant markets its goods to opposer's baseball fans.

C. Similarity or dissimilarity of the goods, the channels of trade, and classes of consumers.

The goods identified in the application, which include shirts, t-shirts, sweatshirts, jackets, pants, shorts and hats, are identical to the items of clothing sold by opposer to promote its baseball team under its Yankees marks.

Furthermore, because there are no restrictions in the application, we must presume that applicant's clothing will be sold, not just over the Internet, but in all the normal channels of trade for such goods, including the department stores and sporting goods stores where opposer's clothing is sold; and that applicant's clothing will reach all the usual purchasers, including ordinary consumers who are also among the purchasers for opposer's clothing. *See Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

It is also important to consider that t-shirts and many of the other casual, everyday items of wearing apparel identified in applicant's application are relatively inexpensive and are therefore likely to be purchased by consumers on impulse, and without a great deal of care.

This is a factor that increases the likelihood of confusion. See *Recot v. Becton*, 54 USPQ2d at 1899 ("When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care."). This *du Pont* factor favors opposer.

D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We next consider the similarity of the marks as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The test, under this *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). While we must consider the marks in their entirety, in articulating

reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Opposer claims proprietary rights in the term EVIL EMPIRE as a mark. Applicant's mark consists of the words BASEBALLS EVIL EMPIRE in standard characters and incorporates opposer's EVIL EMPIRE mark in its entirety. EVIL EMPIRE is the dominant feature of both marks. The presence of the term BASEBALLS in applicant's mark merely defines the reach of opposer's "empire" and does little to create a commercial impression different from opposer's mark, EVIL EMPIRE. Instead, the addition of the term BASEBALLS to EVIL EMPIRE increases the likelihood of confusion by defining opposer's field of use and pointing even more directly to opposer's baseball team.

In comparing the marks in their entireties, we find that on the whole they are similar in appearance, sound, connotation and commercial impression and that the additional wording in applicant's mark is not sufficient to distinguish the marks when used in connection with related goods. This *du Pont* factor favors opposer.

E. Remaining du Pont factors

We have considered any remaining arguments and evidence put forth by applicant but in light of the fame of the designation EVIL EMPIRE as applied to opposer, the similarity of the goods, the similarity of the marks, and the overlapping channels of trade, we find these arguments unpersuasive. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) ("The likelihood of confusion analysis considers all *du Pont* factors for which there is evidence of record but 'may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.'").

F. Balancing the factors.

On balance, the relevant *du Pont* factors weigh heavily in favor of a finding of likelihood of confusion. We conclude that consumers familiar with usage of the term EVIL EMPIRE to refer to opposer, upon encountering applicant's mark BASEBALLS EVIL EMPIRE for clothing, would be likely to believe that the goods originate from or are associated with or sponsored by the same entity.

Notwithstanding the similarity of the marks and the similarity of the goods, applicant argues that its use of BASEBALLS EVIL EMPIRE is a "spoof and parody of the New

York Yankees baseball club, and thus no likelihood of confusion can be established by opposer."¹⁴

Parody, however, is not a defense to opposition if the marks are otherwise confusingly similar, as they are here. *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1592 (TTAB 2008); *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011); *Columbia Pictures Indus., Inc. v. Miller*, 211 USPQ 816, 820 (TTAB 1981) ("The right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of the substantially same mark by another.").

Section 2(a) - False Suggestion of a Connection

Section 2(a) prohibits registration of "matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols." 15 U.S.C. § 1052(a). To establish this claim, opposer must prove (1) that applicant's mark is the same or a close approximation of opposer's previously used name or identity; (2) that applicant's mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to opposer; (3) that opposer is not connected with the goods that are sold or will be sold by applicant

¹⁴ Applicant's Br. at 1.

under its mark; and (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods, a connection with opposer would be presumed. See *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d at 1593; *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Beginning with the first element, we find that applicant's mark is the same as or a close approximation of opposer's previously used name or identity. That is, applicant's BASEBALLS EVIL EMPIRE differs only slightly from opposer's EVIL EMPIRE by the addition of the term BASEBALLS. Given that opposer has shown that it is identified by the designation "Evil Empire" within the context of a baseball club, i.e., the well-known New York Yankees baseball club, this is a distinction without a difference.

Similarly, we find that applicant's mark would be recognized by prospective purchasers as pointing uniquely and unmistakably to opposer. The weight of evidence submitted by opposer clearly demonstrates that the mark BASEBALLS EVIL EMPIRE would be understood by consumers to refer to the New York Yankees. Television, radio,

newspapers, and the Internet are full of stories recounting the exploits of baseball's "EVIL EMPIRE." Moreover, applicant's own web page is directed to selling clothing to Yankees' fans:

The official home of Baseballs Evil Empire. The one source for all the latest tee-shirts and hats for all the Yankee Fans around the world. Be seen in our Yankee apparel and help us in our message that the Yankees are truly "Baseballs Evil Empire" . . . "Thank you, for being a Yankee Fan"¹⁵

Simply put, we have no doubt that BASEBALLS EVIL EMPIRE would be understood by consumers to point uniquely and unmistakably to the New York Yankees because that is precisely applicant's demonstrated intent: to associate its products with the New York Yankees baseball club.

Regarding the third element, opposer states that applicant does not have any association with the Yankees and applicant has not submitted any evidence to the contrary, thus, we must presume that there is no connection between the parties.

Finally, the evidence regarding "fame or reputation" is sufficient to show that the term EVIL EMPIRE has such fame or renown that the use of BASEBALLS EVIL EMPIRE as a trademark by an unauthorized user will falsely suggest a connection with the Yankees. Simply put, consumers, upon

¹⁵ Smith Declaration, Exh. 13.

seeing applicant's mark, BASEBALL EVIL EMPIRE, on clothing, would be likely to assume that these goods are connected with the Yankees baseball club when there is no such connection.

After considering all of the testimony and evidence of record in regard to the Section 2(a) false suggestion of a connection factors, as well as the argument of counsel, we find that applicant's mark BASEBALLS EVIL EMPIRE falsely suggests a connection with opposer.

Section 2(a) - Disparagement

Section 2(a) of the Trademark Act also prohibits registration of a mark that "consists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). See *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988) ("Disparagement is essentially a violation of one's right of privacy -- the right to be 'let alone' from contempt or ridicule.").

The Board in *Greyhound* set forth the two elements of a claim of disparagement: 1) that the communication reasonably would be understood as referring to the plaintiff; and 2) that the communication is disparaging,

that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.

As discussed above, given opposer's evidence and the references to opposer in applicant's web page, we have no doubt that the term BASEBALLS EVIL EMPIRE would be understood as referring to opposer's identity.

Whether use of the term BASEBALLS EVIL EMPIRE would be considered offensive or objectionable by a reasonable person is much less clear. Applicant argues that the definitions of the term EVIL "speak for themselves in outlining a host of offensive meanings."¹⁶ But the offensiveness of "evil" isn't as obvious as a dictionary definition would suggest, especially in matters of popular culture.

Opposer's evidence demonstrates that a number of its fans have adopted the EVIL EMPIRE moniker as a "badge of honor" so that it now has a "positive connotation" among Yankees' fans.¹⁷ The Smith declaration admits that opposer has "implicitly embraced" the EVIL EMPIRE designation.¹⁸ For example, opposer has played the ominous theme from the STAR WARS movies at baseball games. Opposer's embracing the EVIL EMPIRE characterization, whether explicitly or

¹⁶ Opposer's Br. at 44.

¹⁷ Smith Declaration, pp. 8, 11.

¹⁸ Smith Declaration, p. 20.

implicitly, undermines its argument that use of BASEBALLS EVIL EMPIRE disparages the Yankees. In other words, having succumbed to the lure of the dark side, opposer will not now be heard to complain about the judgment of those who prefer the comfort of the light. We find that use of the term BASEBALLS EVIL EMPIRE is not disparaging to opposer.

Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act and on the ground that the mark falsely suggests a connection with opposer under Section 2(a) of the Act. The opposition is dismissed on the ground that the mark is disparaging under Section 2(a) of the Trademark Act.