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PERSPECTIVE

## YANKEES: BASEBALL'S ONLY "EVIL EMPIRE"

By Jeffrey Kobulnick

**Y**ou can almost hear George Steinbrenner yelling from his grave. In a 1-0 shutout, the New York Yankees have prevailed in their trademark opposition proceeding with the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board against registration of the mark "Baseballs Evil Empire" (yes, without an apostrophe). According to the board, "In short, the record shows that there is only one Evil Empire in baseball and it is the New York Yankees."

In 2008, Evil Enterprises, Inc., filed an application with the U.S. Patent and Trademark Office to register the trademark "Baseballs Evil Empire." According to the board, "In short, the record shows that there is only one Evil Empire in baseball and it is the New York Yankees."

"Baseballs Evil Empire" on an intent-to-use basis in connection with clothing. The New York Yankees Partnership opposed registration of the mark when it was published in 2009. The Yankees' opposition claimed that the "Baseballs Evil Empire" mark was disparaging, suggested a false connection, and was likely to cause confusion with the New York Yankees. While the Yankees never registered or used the term "Evil Empire" as its own mark, the partnership claimed the team had become well known as the "Evil Empire" in major league baseball. In a decision issued just Feb. 8, the board agreed.

Evil Enterprises conceded that the Yankees had been well known to the public as the "Evil Empire" prior to the filing date of its own trademark application. That, plus hundreds of articles put into evidence by the Yankees showing that the team was common-

ly referred to by that term, led the board to conclude that the Yankees had prior rights to that mark even though it had not actually used the mark itself. The Yankees also submitted that they took steps to embrace the "Evil Empire" term by adopting music and other recognizable indicia from the "Star Wars" movies (the origin of another evil empire).

Applying its usual du Pont factor analysis to determine whether the two marks are likely to be confused with one another, the board found that the marks bore a strong resemblance to one another in sight, sound and meaning, and were used with the same products. The board further found that the addition of the word "Baseballs" to "Evil Empire" did not alleviate, but rather exasperated, likelihood of confusion.

Moreover, Evil Enterprises adopted use of the "Baseballs Evil Empire" mark in certain stylized forms, which notably bear similarity to the Yankees' own official marks. A comparison of the respective marks is below:

Not surprisingly, the board found likelihood of confusion. Evil Enterprises also tried to argue its marks were a parody, but that argument was rejected.

The board also found that the "Baseballs Evil Empire" mark was a close approximation of the Yankee's own name or identity. According to the board, the mark was meant to refer to the Yankees, and given that Evil Enterprises has no connection with the baseball team, use of the mark would falsely suggest an association with the parties.

Accordingly, the board sustained the Yankees' opposition and refused to allow registration of the "Baseballs Evil Empire" mark.

This case is an interesting one for several reasons. First, typically an opposer needs to show that it has actually used its own mark in commerce before the priority date claimed



Associated Press

"Darth Vader" throws the ceremonial first pitch on Star Wars Night before the New York Yankees and the Detroit Tigers baseball game in Detroit, June 2, 2012.

by an applicant (in this case, Evil Enterprises' 2008 application filing date since it was filed on an intent-to-use basis under Section 1(b) of the Lanham Act). Here, the Yankees had not actually used "Evil Empire" as its own mark, but had become accustomed to large public reference to the baseball team by that name, and embraced it to some degree. The result was clearly to the Yankees' benefit in this case.

Second, now that there has been a legal determination (albeit, not citable board precedent) and agreement reached between both the Yankees and those who resent them that there is only one Evil Empire in baseball, more interfaith marriages between Yankee and Red Sox fans are expected in the future.



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