

representative. Despite the language used in the Athletics Clause failing to mention specifically the role of a representative of a decedent's estate, the Plaintiff's claim while serving as administratrix of Frederick's estate is considered the same as a claim being established by Frederick himself. Based on this reasoning and justification, the Plaintiff's claim is found to be excluded from the Board of Education's liability coverage and the Board of Education did not waive its sovereign immunity. In summation, the Plaintiff's claim is barred from recovery by the court. The official ruling presented by the court states "The Board is immune from Plaintiff's wrongful death suit where the personal representative of the deceased's estate's suit is equivalent to a claim brought by the athletics participant."

Application

One such area warranting additional and future consideration from a practitioner perspective is the potential repercussions resulting in multiple insurance policies and how they may affect one another. Not witnessed within this specific case, but something to consider in future adoptions of additional insurance, are the loopholes that may come into existence that schools and various board of education entities need to consider

from both a liability and negligence perspective and the potential outcomes that may ensue. Another key point highlighted within this case is the importance placed on the language, terminology, construction, intent, and purpose in which an insurance policy, its clauses and exclusions provide to those directly affected through their implementation. Although the final result did not specifically harm the board of education and the other defendants, it does shed light on potential gaps in protection that various insurance policies may have. With this in mind, parties similar to those witnessed throughout this case should take as many proactive measures as possible while implementing a sound and thorough risk management plan for all stakeholders involved.

References

Estate of Seymour v. Orange Cty. Bd. of Educ., No. COA19-334-2, 2021-NCCOA-10; 2021 WL 347630

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Articles

Two Soccer Clubs Fight It Out in Trademark Dispute

By Deborah Greaves, Michael Rueda, and Paolo Macchi, of Withersworldwide

Major League Soccer, LLC ("MLS") has met a formidable foe on an unexpected playing field, that of the U.S. Trademark Trial and Appeal Board ("TTAB"). This match arises out of a trademark dispute between Italian Serie A football club Inter Milano and an MLS club, Inter Miami (co-founded by world famous soccer player David Beckham), over registration of the trademark "INTER."

In 2014, F.C. Internazionale Milano S.p.A. ("FCIM") filed applications for registration of the trademarks INTER and INTER MILANO with the U.S. Patent and Trademark Office ("USPTO"). FCIM

is the owner of the historic football club Inter Milano, which was established in 1908. The applications were filed under 15 U.S.C. § 1051(b) of the Trademark Act, claiming a *bona fide* intent to use the mark in commerce in the U.S. The dispute relates only to the trademark application for INTER.

The application for INTER was published for opposition on September 25, 2018 and MLS filed an opposition on March 25, 2019. In its Opposition, MLS argued that (i) the INTER mark is not registrable under 15 U.S.C. 1052(e) because the mark is merely descriptive of the various goods and services identified in the application (which encompassed seven international classes); and (ii) based on priority and a likelihood of confusion under 15 U.S.C. § 1052(d)). MLS filed the Notice of Opposition on behalf of Inter Miami, one of the MLS member

clubs. MLS operates under a single-entity structure and not with independent club franchises.

In its Opposition, MLS argued that MLS had priority common law rights in connection with a new professional Miami-based club, namely, Inter Miami. Concurrent with the filing of its Opposition, MLS filed applications to register the INTER MIAMI mark; however, those applications were filed under 15. U.S.C. §1051(b), based on a *bona fide* intent to use the mark in commerce. FCIM moved to dismiss the Opposition arguing that MLS failed to properly plead prior rights in that its application was filed subsequent to FCIM's, and the applications of both parties were based on an intent to use.

MLS amended its Opposition, arguing that its senior rights were derived from use of the INTER mark in the U.S. by third-party soccer clubs or organizations, and not on the proposed use by Inter Miami, a club in MLS. FCIM then filed another motion to dismiss, arguing that MLS' reliance on prior use of the mark by third-party soccer clubs in order to demonstrate priority was insufficient because MLS failed to establish any connection with the third-party soccer clubs or their use of the INTER mark.

On January 3, 2020, the TTAB issued an order granting FCIM's second motion to dismiss the Section 2(d) claim, agreeing with FCIM that MLS failed to allege any particular relationship with the third-party users or to demonstrate that its duties as a professional soccer league encompassed the interests of those third-party users. However, MLS was given another opportunity to amend its Opposition, following which FCIM filed yet a third motion to dismiss.

On December 9, 2020, in a precedential order, the TTAB granted FCIM's third motion to dismiss MLS' Section 2(d) claims (2020 WL 7260794 (Trademark Tr. & App. Bd.)). MLS asserted that its relationship to the soccer industry in the United States in general, and in particular to the third-party owners of the other INTER marks, predated the filing of FCIM's application to register INTER. Moreover, MLS had an interest in preventing confusion or mistake between the INTER mark and the prior use of the same mark in the U.S. by other INTER users, which would create confusion and adversely affect MLS and its member clubs. MLS further argued that it had standing and legally binding partnerships with all official U.S. Soccer-sanctioned

Youth and Adult recreation membership organizations, and that it was involved in all levels of soccer in the United States and all ancillary programs related to soccer, stating that MLS had a legitimate interest in protecting the interest of all soccer clubs using INTER in their names prior to FCIM's filing to prevent the public from mistakenly believing that there is a connection between any of the prior U.S. INTER users and FCIM, or that FCIM has the exclusive right to use the term INTER as a mark.

In its analysis, the TTAB viewed as most relevant to the instant motion other cases that concerned claimants seeking to assert trademark rights via third parties. Prior decisions had different outcomes. For example, in the Federal court decision of *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490 (Fed. Cir. 1987), as well the decision in the appeal on the merits of that decision (853 F.2d 888 (Fed. Cir. 1988)), the court held that *Jeweler's Vigilance*, the opposer, had a legitimate interest in a mark used by third parties because it was a trade organization that had thousands of members using the term DEBEERS.

In contrast, a later decision by the Board in *Holmes Prods. Corp. v. Duracraft Corp.*, 30 USPQ2d 1549 (TTAB 1994) found that the opposer's arguments were insufficient to establish a legitimate interest in preventing registration of the mark TURBO.

“Opposer has not alleged that it has used the third-party TURBO marks. Nor has it alleged any connection with these marks or with those who registered them that would establish its legitimate interest in preventing likelihood of confusion; and we hold that such a legitimate interest is a necessary element of a ground of likelihood of confusion predicated on the third-party registrations.”

Id.

In this case the Board ruled that MLS had failed to establish a “legitimate interest” in avoiding a likelihood of confusion between FCIM's application for INTER and the pleaded third-party marks. The Board specifically noted that MLS was not seeking to protect any prior trademark rights of its member clubs. Although MLS had filed several applications for registration of marks for its member clubs containing the term INTER, these

applications were all filed after FCIM's application was filed and none of the clubs had used the INTER mark prior to FCIM's filing date. The Board held that the alleged relationship between MLS and the prior U.S. users of INTER was, at best, "tangential."

After two amended oppositions and three motions to dismiss, one might believe that the clock has run on this matter. However, MLS' Section 2(e) claim has yet to be adjudicated. That claim asserts that FCIM's application for INTER should be denied as the goods and services are "descriptive," namely, that the mark merely describes a product or identifies the characteristics of such a product. A decision on the remaining claim is expected in early 2022.

Here MLS argues, among other things, that the term INTER is short for "International" and that (i) the use of the term INTER is crowded in the soccer industry because it is commonly used in club names, (ii) because of the widespread use of the term INTER in the soccer industry consumers do not associate it, by itself, as a source indicator, and (iii) INTER is not distinctive as used in connection with FCIM's goods and services in the U.S.

MLS' descriptiveness argument certainly has merit; however, at this time neither party has fully briefed its arguments. What is uncertain is whether there will be much fallout from the Board's final determination, regardless of what that may be. For example, if the Board grants the opposition and refuses registration of INTER, this may facilitate the registration by numerous clubs of marks containing the term, i.e., INTER MIAMI. On the other hand, the outcome may be the same if the USPTO rejects the opposition. Based upon the large number of existing registrations and applications with the USPTO containing the term INTER, and also recognizing that many soccer clubs use the term INTER along with their club or city name, it seems that an application for INTER MIAMI (or any other city) would not be likely to cause confusion with the INTER mark if it is registered.

The outcome that could be the most problematic is if the USPTO determines that the term INTER is descriptive as used in connection with sports teams, including soccer clubs. An applicant might then be required to disclaim exclusive use of the term INTER, in which case the substantive examination would be based only on the city name, which could give rise to refusal on grounds that the mark is primarily geographically

descriptive (15 U.S.C. §1052(e)(2)). The Trademark Manual of Examining Procedure states that "the addition of a highly descriptive or generic term to the name of a geographic place does not alter its primarily geographic significance." (TMEP 1210.02(c)(ii).)

There are significant rights at stake on this battlefield which suggests that appeals to the Federal Circuit are also probable. Hopefully the parties will find a way to work through their issues and can find a mutually beneficial resolution.

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