

ESTTA Tracking number: **ESTTA962343**

Filing date: **03/25/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Major League Soccer, L.L.C.
Granted to Date of previous extension	03/24/2019
Address	420 Fifth Avenue New York, NY 10018 UNITED STATES

Attorney information	Deborah Shapiro Moses & Singer LLP 405 Lexington Avenue New York, NY 10174 UNITED STATES trademarks@mosessinger.com, dshapiro@mosessinger.com, zshukri@mosessinger.com 212-554-7800
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**Applicant Information**

Application No	86224449	Publication date	09/25/2018
Opposition Filing Date	03/25/2019	Opposition Period Ends	03/24/2019
Applicant	F.C. Internazionale Milano S.p.A. Corso Vittorio Emanuele II, 9 Milano, 20122 ITALY		

**Goods/Services Affected by Opposition**

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: cellular phone covers; protective covers and cases for tablet computers
Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: dog collars; dog leashes
Class 021. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: pet feeding and drinking bowls; coffee cups, tea cups, toothbrush
Class 024. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bed sheets; place mats, not of paper; towels, blanket throws, oven mitts
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Shirts, jackets, pants, pajamas,

sportsshirts, shorts, bathrobes, underwear, slippers, flip flops, swim suits, sweaters, socks, hats, scarves, cloth bibs, boots, gloves, aprons

Class 028. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: soccer balls; plush toy animals; flyingdiscs; yo-yos; pet toys


Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: entertainment services, namely, organizing, conducting, and staging professional soccer games and exhibitions and production of radio and television programs in the nature of professional soccer games and exhibitions

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)

## Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	88129638	Application Date	09/24/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CLUB INTERNACIONAL DE FUTBOL MIAMI MMXX		
Design Mark			
Description of Mark	The mark consists of a shield with two crane bird images back to back with a leg from each entwined and a stylized sun resting above the crane backs, the word MIAMI above the stylized sun, the shield encircled with the words CLUB INTERNACIONAL DE FUTBOL and a stylized star design on either side of MMXX.		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, MP3 players, mobile telephones, smart telephones, tablets, laptop, and wireless speakers; computer and video game software and programs; magnets; sunglasses, pre-recorded DVDs in the field of soccer; downloadable image files containing artwork, text, audio, video, games, internet weblinks in the field of soccer; downloadable video clips from soccer games via mobile communication devices; computer keyboards;		

	<p>mouse pads; computer memory devices; blank USB flash drives</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0</p> <p>posters; decals; sports trading cards; stickers; bumper stickers; printed paper-signs; printed media guides relating to a professional soccer team; souvenir soccer programs; yearbooks in the field of soccer; printed event admission tickets; calendars; paper place mats for beer glasses; photo prints; magazines featuring information in the field of soccer; paper hang tags; pencils; notebooks; binders</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0</p> <p>t-shirts; fleece tops; jerseys; hats; caps being headwear; visors being headwear; beanies; shorts; pants; sweat suits; jackets; hooded sweatshirts; scarves; gloves; socks; headbands; wristbands as clothing; ponchos; baby bibs not made of paper; infant and toddler clothing, namely, one-piece clothing, overalls, socks, and dresses; sleepwear; loungewear; slippers</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0</p> <p>toy figurines; soccer ball bags; soccerballs; plush toys; puzzles; toy foam novelty items, namely, foam heads and fingers; foosball tables and molded plastic toy figurines; golf accessories, namely, golf balls, divot repair tools, bag tags, ball markers, tees, gloves; Christmas tree ornaments; building blocks toys; game tables; tailgating games, namely, bag toss games, washer game in the nature of a target game, tumbler towers in the nature of a stackable tumbling game, and game tables for tailgates; fitted plastic films known as skins for covering and providing a scratch proof barrier and protection for electronic gaming devices, namely, hand-held video gaming devices and video game consoles</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0</p> <p>Entertainment services, namely, soccer exhibitions rendered live in a stadium, and through the media of television and radio and via the internet; provision of entertainment in the nature of non-downloadable pre-recorded film clips from soccer games, presented via mobile communication devices; provision of information in the field of soccer via the internet and mobile devices</p>
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	INTER MIAMI CF		
Goods/Services	including but not limited to scarves in Class 25		

Attachments	88129638#TMSN.png( bytes ) Notice of Opposition INTER Serial No 86224449.pdf(36943 bytes )
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Signature	/Deborah L. Shapiro/
Name	Deborah Shapiro
Date	03/25/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 86/224,449  
For the mark: INTER  
Published in the Official Gazette on September 25, 2018

MAJOR LEAGUE SOCCER, L.L.C.,

Opposer,

-against-

F.C. INTERNAZIONALE MILANO S.P.A.,

Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, Major League Soccer, L.L.C., a limited liability company organized and existing under the laws of Delaware, having its principal place of business at 420 Fifth Avenue, New York, New York, believes that it will be damaged by the registration of the designation INTER that is the subject of Application Serial No. 86/224,449, and hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1063(a).

As grounds for its opposition, Opposer, by its attorneys Moses & Singer, LLP, alleges that:

1. Opposer, Major League Soccer, L.L.C. (“MLS” or “Opposer”), is a professional soccer league representing the sport’s highest level in the United States and Canada. MLS was founded after the United States hosted the 1994 FIFA World Cup. MLS began with ten teams in its first

season in 1996. MLS has expanded tremendously since its inception; twenty-four teams will play in the 2019 season.

2. On March 18, 2014, the applicant, F.C. Internazionale Milano S.p.A. (“Milan”) filed a trademark application with the U.S. Patent and Trademark Office (USPTO) for the mark INTER, Serial No. 86/224,449, in International Classes 9, 18, 21, 24, 25, 28 and 41 (the “INTER Application”).

3. Milan is the owner of Football Club Internazionale Milano, the Serie A professional soccer club based in Milan, Italy.

4. On September 5, 2018, MLS announced its twenty-fifth expansion club would be named Club Internacional de Fútbol Miami, with the nickname “Inter Miami CF” (“Inter” as the short form of “Internacional”).

5. On September 24, 2018, MLS filed a trademark application with the USPTO for the mark CLUB INTERNATIONAL DE FÚTBOL MIAMI MMXX and Design, Serial No. 88/129,638, in International Classes 9, 16, 25, 28 and 41.

6. On September 25, 2018, the INTER Application was published in the *Official Gazette*.

7. MLS intends to file a U.S. trademark application for INTER MIAMI CF in International Classes 9, 16, 25, 28 and 41. Based on the recent examination of other INTER-formative applications, MLS expects the INTER Application to be cited against such an application.

8. The Examining Attorney for Serial Nos. 88/078,179, 88/078,184, and 88/078,190, for MIAMI INTER, MIAMI INTER FC, and FC MIAMI INTER, respectively, for goods in International Classes 9, 16, 21, 25, 28 and services in International Class 41, found in Office Actions dated November 6, 2018 (the “November 6 Office Actions”), that the wording “INTER” is “merely descriptive of applicant and its goods and services.” For each of these applications,

the Examining Attorney found that “the term ‘INTER’ in applicant’s mark is short for ‘internacional’ (which translates to ‘international’) and ‘INTER’ is commonly used to describe soccer teams.”

9. In the November 6 Office Actions, the Examining Attorney attached evidence that the term “INTER” is used widely in soccer, including as some of the examples the web sites of Chicago Inter Soccer Club, Suola Calcio Inter USA, and Inter Soccer Association.

10. In an earlier Office Action, dated January 30, 2018, regarding Serial No. 87/647,061, for INTER SOCCER CLUB and Design covering “soccer club” services in Class 41, the Examining Attorney required a disclaimer of all the wording in the mark, including “INTER,” finding all the wording was descriptive of the services. The Examining Attorney attached evidence of “third-party soccer teams and clubs using the abbreviation ‘inter’ to mean ‘international.’”

11. There are many additional examples of the use of “INTER” by soccer clubs in the United States and abroad, both current and historic, at all levels, including, but not limited to, Inter Nashville F.C., Inter Atlanta FC, FC Inter Turku (Finland), S.C. Internacional, which is known by the nickname “Inter” (Brazil), NK Inter Zaprešić (Croatia), Inter Leipzig (Germany), Inter Club d’Escaldes (Andorra), Inter de Luanda (Angola), Inter de Grand-Goâve (Haiti), Inter Moengotapoe (Surinam).

12. The crowded field of use of the term “INTER” in soccer follows international naming customs in the sport.

13. Because of the widespread use of the term “INTER” in soccer, the relevant consumers do not associate the term “INTER” with one soccer team; “INTER” by itself is not a source indicator in connection with goods and services associated with soccer.

14. “INTER” has not become distinctive as used on or in connection with the applicant’s goods and services in the United States.
15. No one soccer team can claim exclusive rights to the term INTER, therefore Milan has no exclusive rights to the term INTER.
16. As a result, Milan is not entitled to register the designation INTER for the goods and services set forth in the INTER Application.
17. In other applications filed for INTER MIAMI, Serial No. 88/018,919, and INTER MIAMI FC, Serial No. 88/018,925, in International Classes 9, 16, 21, 25, 28, and 41, the Examining Attorney cited the INTER Application as a potential bar to registration because of a likelihood of confusion.
18. In fact, MLS’s use of INTER MIAMI CF does and will co-exist peacefully with other INTER-formative team names, as consumers readily distinguish between the various soccer clubs whose names use the term “INTER.”
19. MLS will be damaged by the registration sought by Applicant because such a registration would prevent registration of the term “INTER” with other wording upon a showing of acquired distinctiveness in connection with a soccer team.
20. Registration should be refused pursuant to Section 2(e) of the Lanham Act, 15 U.S.C. § 1052(e), on the grounds that Applicant’s designation INTER is descriptive.
21. Registration should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Applicant’s use of the INTER designation with the goods and services identified in the application, is likely to cause confusion, or to cause mistake, or to deceive, with consequent injury to MLS and to the public.

WHEREFORE, MLS believes it will be damaged by the registration by Applicant of the designation INTER for the goods and services identified in Application Serial No. 86/224,449 and respectfully requests that this Opposition be sustained in favor of MLS and registration of Applicant's designation be denied.

Pursuant to 37 C.F.R. § 2.6(a)(17), please charge Deposit Account Number 50-3326 the requisite amount of \$400 per class and any additional amounts to cover the statutory filing fee.

Dated: New York, New York  
March 25, 2019

Respectfully submitted,

MOSES & SINGER LLP

\_\_\_\_\_/Deborah L. Shapiro/\_\_\_\_\_  
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Attorneys for Opposer  
Major League Soccer, L.L.C.