

What's in a name? Everything if it is a registered Trade-mark!

Copyright | Hockey | Intellectual Property | Litigation | Sports | Trademarks

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At the end of November, the new National Hockey League franchise awarded to Las Vegas unveiled, along with a logo, that the team would be named the "Vegas Golden Knights". This is a clever name since gold mining is a major industry in Nevada, and Las Vegas is a gambling mecca and is known for its "(k)night life".

However, all that glitters is not golden for the name because the "Golden Knights" is a registered trademark of another sports team, the NCAA's College of St. Rose Golden Knights, located in Albany, New York, and the logo's feature a knight or knight's helmet.

Thus, this week, the U.S. Patent and Trademarks Office (the "**USPTO**") rejected the NHL's team application because there were too many similarities in the name and logo.

More specifically, the USPTO stated as follows"

In this case, the marks are identical in part, sharing the same dominant wording and overall commercial impression. The nature of the applicant's and registrant's services is similar, both offer sports entertainment of a kind available in the same venues, broadcast on television, and are generally available to the same class of consumers. Accordingly, the examining attorney concludes that there is a likelihood of confusion between the applicant's and registrant's marks."

In sports, teams in different leagues often share the same team name. Professional hockey has the New York Rangers, while professional baseball has the Texas Rangers. The National Football League has the Arizona Cardinals, while professional baseball has the St. Louis Cardinals. At one time, the Canadian Football League had both the Ottawa Rough Riders and the Saskatchewan Roughriders. But this has not currently helped the Vegas Golden Knights and demonstrates the importance of registering a trademark to protect a name, logo and brand.

In Canada, a trade-mark is not registrable if it is confusing with a registered trade-mark. As explained in the Canadian Encyclopedic Digest:

Confusion will be caused if the use of both (the applicant's trademark and the registrant's trademark) in the same area would likely lead to the inference that the goods or services associated with such trade-marks and those associated with a business carried on under the trade name are manufactured, sold, leased, hired or performed by the same person whether or not such goods or services are of the same general class.

In assessing where there is "confusion", surrounding circumstances must be considered, including:

- (a) the inherent distinctiveness of the trade-marks or the trade names and the extent to which they have become known;
- (b) the length of time the trade-marks or trade names have been in use;
- (c) the nature of the goods, services or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them.

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Registering a trade-mark in Canada gives an owner the exclusive right to use the mark throughout the country in relation to the owner's goods or services. The registration is evidence of title and will give the owner the right to bring an action for infringement under the *Trade-Marks Act*.

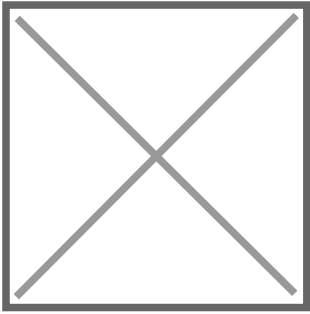
Currently, the NHL is unwilling to change the name of the Vegas Golden Knights. Instead, the NHL is prepared to rely on common law trademark rights and Nevada trademark registrations, while at the same time challenging the USPTO's rejection.

As an aside, in Canada, no process exists for registering a trademark at the provincial level. Trademarks here can only be registered under the federal *Trade-Marks Act*.

The NHL and the Vegas Golden Knights have until 7 June 2017 to respond to the USPTO's rejection. Before this deadline arrives, we speculate that the Vegas Golden Knights will make efforts to secure the permission of the St. Rose Golden Knights to reverse the rejection.

(This blog is provided for educational purposes only, and does not necessarily reflect the views of Gardiner Roberts LLP).

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