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Pasadena Beats Trademark Lawsuit Over Rose Bowl

By **Bill Donahue**

Law360 (July 13, 2021, 7:59 PM EDT) -- A federal judge on Tuesday dismissed a trademark lawsuit filed by college football's Rose Bowl against the game's California host city of Pasadena, ruling that a single Instagram reference to the game was a so-called nominative fair use.

The decision came in a case filed by the Pasadena Tournament of Roses Association, a nonprofit that produces the game, against the city, which owns the eponymous stadium, over the association's decision to hold the 2021 event in Texas amid the COVID-19 pandemic.

In filing the lawsuit, the Tournament of Roses Association wanted a ruling that the agreements between the city and the association permitted the game to be held elsewhere during future 'force majeure' events, but U.S. District Judge André Birotte Jr. ruled Tuesday that such a decision would be premature.

"The court cannot provide clarity on contractual language based on a potential breach of contract in the future," the judge wrote.

Judge Birotte also rejected infringement accusations against Pasadena over an Instagram post that referenced the term "Rose Bowl." He ruled the post a nominative fair use — a doctrine that allows the use of a trademark if it's necessary to identify a brand owner.

He also called the claim "puzzling," given the long history of cooperation between the two groups.

"The court does not find that defendant is attempting to capitalize on consumer confusion or to appropriate the Rose Bowl Game via this Instagram post," the judge wrote. "Plaintiff and defendant have been business partners for decades. Due to this mutually beneficial relationship, plaintiff has consistently benefited from defendant's promotion of plaintiff's game and its history and likely encourages such promotion."

The legal dispute was sparked by the 2021 Rose Bowl's move from Pasadena to Arlington, Texas, because of the COVID-19 pandemic. Cases of the virus had surged in California in the weeks leading up to the game, and the state set sweeping restrictions on public gatherings.

That location change led to a New York Times article in January, in which Pasadena's mayor, Victor Gordo, claimed that the game "belongs to the city." The article also reported that Pasadena "shares" a trademark with the association on the name of the game.

The Tournament of Roses Association sued shortly after, claiming that Pasadena was engaged in a "public campaign" to falsely claim rights to the game.

But the city later acknowledged that it did not own any trademark rights to the game. That prompted Judge Birotte to wonder during **oral arguments in May** why the two sides were still litigating the case.

"Sometimes these civil cases seem like two millionaires standing outside of a McDonald's fighting over the price of a cheeseburger," Judge Birotte quipped. "You acknowledge that you don't own these rights, why are you fighting?"

In a statement on Tuesday, Pasadena Mayor Victor Gordo praised Judge Birotte for dismissing a case that was "ill-conceived and full of egregious assertions."

"This lawsuit should have never been filed in the first place," Gordo said. "The City of Pasadena has been a tremendous partner to the Tournament, and it is appalling that the Tournament took such a significant step over nothing."

In its own statement, the Tournament of Roses Association said the case had "achieved its most important purposes."

"Our ownership of the Rose Bowl trademarks has been confirmed, and we retain the ability to enforce our rights under the 'force majeure' provision if necessary," said Tournament of Roses CEO David Eads.

The Tournament of Roses Association is represented by John Nadolenco, A. John P. Mancini, Jonathan W. Thomas and C. Mitchell Hendy of Mayer Brown LLP.

The city is represented by Kent R. Raygor, Jonathan D. Moss, Valerie E. Alter and Paul A. Bost of Sheppard Mullin Richter & Hampton LLP, and Michele Beal Bagneris and Theresa E. Fuentes of the Pasadena City Attorney's Office.

The case is Pasadena Tournament of Roses Association v. City of Pasadena, case number 2:21-cv-01051, in the U.S. District Court for the Central District of California.

--Editing by JoVona Taylor.

Update: This story has been updated with statements from both sides.

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