

EXH

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

In re Application of:)
)
WNBA Enterprises, LLC)
)
Serial No: 75/235,781)
)
Mark: NEW YORK LIBERTY and Design)
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)
)

03-12-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #77

BRIEF OF APPLICANT

**I.
NATURE OF CASE**

Applicant appeals, under Section 20 of the Trademark Act, 15 U.S.C. §1070, the Examining Attorney's final refusal to register the trademark NEW YORK LIBERTY and Design in the identified application.

**II.
DESCRIPTION OF THE RECORD**

WNBA Enterprises, LLC filed¹ an application to register the mark NEW YORK LIBERTY and Design on the Principal Register² for audio, video, computer and laser discs, pre-recorded audio and video cassettes, pre-recorded audio and video tapes, pre-recorded compact discs, all featuring basketball; computer accessories, namely, screen saving software related to basketball and computer peripheral mouse and wrist pads, compact and computer disc cases; computer programs and computer software in the field

¹ The filing date of the current application is February 3, 1997.

² The current application was filed on the basis of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. §1051(b). Applicant subsequently filed a Statement of Use within the Notice of Allowance period on April 12, 2001.

of basketball; video game cartridges and video game machines for use with televisions in International Class 9. The Examining Attorney issued a final refusal, asserting that the proposed mark does not function as a trademark under Sections 1, 2, and 45 of the Trademark Act.³

Applicant owns prior U.S. registrations for DETROIT SHOCK and Design⁴, SACRAMENTO MONARCHS and Design⁵, and UTAH STARZZ and Design⁶ for International Class 9 goods which are identified similarly to the goods in the current application, for which the U.S. Patent and Trademark Office ("PTO") accepted compact disc packaging inserts identical to the specimens of record in the current application. Applicant owns a prior U.S. registration for a Star and Ball Design⁷ for International Class 9 goods which are identified similarly to the goods in the current application, for which the PTO accepted computer screen printouts of downloadable software displays similar to additional specimens of record in the current application. See Section IV, below, Request for Judicial Notice.

Applicant also owns prior U.S. registrations for NEW YORK LIBERTY and Design, identical to the proposed mark, for various goods and services in International

³ 15 U.S.C. §§ 1051, 1052, and 1127.

⁴ Applicant's prior DETROIT SCHOCK and Design registration no. 2,500,622 issued on October 23, 2001.

⁵ Applicant's prior SACRAMENTO MONARACHS and Design registration no. 2,465,905 issued on July 3, 2001.

⁶ Applicant's prior UTAH STARZZ and Design registration no. 2,465,903 issued on July 3, 2001.

⁷ Applicant's prior Star and Ball Design registration no. 2,659,873 issued on December 10, 2001.

Classes 16⁸, 18⁹, 25¹⁰, 28¹¹, 35¹², 38¹³, and 41¹⁴. See Section IV, below, Request for Judicial Notice.

**III.
BACKGROUND**

Applicant provides basketball entertainment services through the Women's National Basketball Association ("WNBA"). The New York Liberty (the "Liberty") is a WNBA team and the proposed mark is the Liberty team logo. Applicant merchandises for fans a host of products -- including audio and video recordings and computer software and accessories -- associated with the WNBA teams, including the Liberty.

**IV.
JUDICIAL NOTICE**

Pursuant to the Federal Rules of Evidence and related case law, Applicant requests the Trademark Trial and Appeal Board (the "Board") to take judicial notice of its prior International Class 9 DETROIT SCHOCK and Design, SACRAMENTO

⁸ Applicant's prior NEW YORK LIBERTY and Design assorted publications and printed matter registration no. 2,500,586 issued on October 23, 2001.

⁹ Applicant's prior NEW YORK LIBERTY and Design assorted bags and carrying cases registration no. 2,645,973 issued on November 5, 2002.

¹⁰ Applicant's prior NEW YORK LIBERTY and Design assorted clothing registration no. 2,522,893 issued on December 25, 2001.

¹¹ Applicant's prior NEW YORK LIBERTY and Design assorted toys and sporting goods registration no. 2,375,604 issued on August 8, 2000.

¹² Applicant's prior NEW YORK LIBERTY and Design assorted on-line store, retailing, and catalog services registration no. 2,515,237 issued on December 4, 2001.

¹³ Applicant's prior NEW YORK LIBERTY and Design assorted cybercasting services registration no. 2,515,236 issued on December 4, 2001.

¹⁴ Applicant's prior NEW YORK LIBERTY and Design assorted basketball entertainment services registration no. 2,498,544 issued on October 16, 2001.

MONARCHS and Design, UTAH STARZZ and Design, and Star and Ball Design registration records¹⁵, which are attached as Exhibit 1; the Statements of Use relating to the aforementioned prior registrations, which are attached as Exhibit 2; its prior NEW YORK LIBERTY and Design registration records¹⁶, which are attached as Exhibit 3; and sample pages taken from a typical music industry compact disc packaging insert, attached as Exhibit 4. Fed. R. Evid. 201; *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff'd. 703 F.2d 1372, 217 USPQ 505 (Fed Cir. 1983); *Trademark Trial and Appeal Board Manual of Procedure* § 712 (1995).

**V.
STATEMENT OF THE CASE**

The only issue in the current application is whether the proposed mark, as used on the specimens of record, functions as a source indicator for goods within Applicant's identification of goods.

**VI.
GOVERNING LAW**

A. Sufficiency of Specimens to Evidence Source-Identifying Function

The Examining Attorney must consider the specimens of record along with any other evidence submitted by the Applicant in determining whether a proposed mark functions as a trademark, for registration purposes. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (CCPA 1976); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975). Specimens must depict the mark on or in connection with the relevant goods; labels, tags,

¹⁵ Records of U.S. Registrations Nos. 2,500,622; 2,465,905; 2,465,903, and 2,659,873.

¹⁶ Records of U.S. Registration Nos. 2,500,586; 2,645,973; 2,522,893; 2,375,604; 2,515,237; 2,515,236; and 2,498,544.

containers, and displays are illustrative of acceptable specimens. 37 C.F.R. §§ 2.56 and 2.88. The PTO also may accept other types of documents related to the goods or the sale of the goods, if, for instance, it may not be possible to depict the mark directly on goods or packaging. Id.

B. Standard of Review on Appeal

On appeal, the Board need not adopt the Examining Attorney's rationale in reviewing whether to register a mark. *In re AFG Industries, Inc.*, 17 USPQ2D 1162 (TTAB 1990). Rather, the Board is bound to review all the evidence of record and decide whether, on the whole, the evidence supports registration. *In re Avocet Inc.*, 227 USPQ 556 (TTAB 1985); *In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985).

**VII.
ARGUMENT**

Applicant made of record two sets of specimens: 1) packaging inserts for a musical compact disc entitled "*Divas of the Court: Songs from the WNBA Volume I*" (the "WNBA Compact Disc")¹⁷; and 2) printouts of computer screen displays associated with on-line downloadable software. The underlying goods for the specimens include musical recordings and computer programs and software. Specimens such as those submitted by Applicant are commonly used in industries relating to such goods, and are typical of evidence submitted to and accepted by the PTO as reflecting proper trademark usage. Further, the particular specimens of record are used by Applicant in commerce in

¹⁷ The Examining Attorney's August 2, 2001 office action, in which the application is initially refused, misidentifies the packaging inserts as "labels."

the ordinary course of business and depict the proposed mark as a source-identifier in connection with the underlying goods.

The Examining Attorney does not dispute that compact disc packaging inserts or on-line software displays may be proper trademark specimens, but states that it is the "type of use on this particular specimen that renders the proposed mark ineffective as a source indicator." See Final Refusal, dated June 12, 2002, at 2.¹⁸ In support of this assertion, the Examining Attorney alleges only that the proposed mark appears on the compact disc packaging insert specimen as an "illustration" of the WNBA statistics also included on the insert, and not as a source identifier for the compact disc itself. The Examining Attorney further asserts that, "[d]ownloadable photographs and drawings are not the same thing as downloadable computer software," see Response to Request for Reconsideration, dated December 16, 2002, at 2, ignoring a variety of other downloadable software offered on-line and featured in the record specimen, including video and audio clips, e-newsletters, and links to trivia and games.

The Examining Attorney does not provide any evidentiary data or legal authority supporting the conclusory allegation that the proposed mark fails to function as a trademark, or offer any real analysis of whether the mark is used by Applicant in connection with the underlying goods in a manner sufficient to establish a source-identifying function. In fact, the PTO has registered several prior WNBA team logos for which Applicant provided specimens either identical to or similar to the record specimens submitted in connection with the current application.

¹⁸ In the Response to the Request for Reconsideration Examining Attorney misidentified the Applicant as "Jack Daniel's Properties, Inc.," the mark as "JACK DANIEL'S GRILL"; and the serial number as "76/235,781."

A. The Compact Disc Packaging Insert Specimen

First, to support registration of the proposed mark, Applicant submitted a copy of the entire compact disc packaging insert of the WNBA Compact Disc, including the cover, back, and page on which the proposed mark appears. The Examining Attorney describes this first specimen as a “WNBA career leader statistic sheet.” See Final Refusal at 2. This characterization of the specimen is too narrow. The specimen is not merely a “statistic sheet”; similar to packaging for other audio recordings, the disc holder for the WNBA Compact Disc includes a multi-paged insert relating to the musical recording sold in that packaging. The insert page that depicts the proposed mark also includes assorted basketball statistics. The inclusion of this basketball-related information is consistent with standard practice in the recording industry, in which the artist, producer, or others associated with a recorded work may include lyrics and background information related to the recording on the insert packaging for that recording. See Exhibit 4 (sample compact disc packaging insert for the music industry).

Regardless of the information contained on the WNBA Compact Disc insert, it is undisputed that Applicant also included various team logos on the insert, including the New York Liberty logo. A review of the specimen of record shows that the NEW YORK LIBERTY and Design logo at issue is set apart from the textual and statistical content by its border, size, and placement on the page. This layout and design establishes that the Liberty logo, like the other WNBA team logos depicted (all of which are owned by Applicant¹⁹), is a source identifying logo within the compact disc insert, indicating that Applicant is the source of the WNBA Compact Disc.

¹⁹ Applicant’s ownership of all of the team logos is of record. See Response, dated January 30, 2002, at 2, to Office Action, dated August 2, 2001.

Although the Examining Attorney provided only a scant explanation for the failure to function refusal, the refusal appears to be based on the position that the Liberty logo is merely “illustrating a WNBA career leader statistic sheet.” The fact that a design mark may potentially be described or used by third parties as an “illustration” in certain contexts does not constitute a sufficient basis for finding that the proposed mark used by the mark owner on or in connection with goods sold in commerce serves no source-identifying function.

Here, the proposed mark does not appear on the specimen merely as a design having artistic value, but functions as an indicator of the source of the WNBA Compact Disc, sold in packaging containing the insert. In fact, the PTO previously came to the same conclusion regarding several of Applicant’s prior registrations, accepting specimens of identical compact disc packaging inserts as sufficient evidence of trademark usage. See Exhibit 2.

B. The Computer Screen Display Specimens

Applicant also submitted a display associated with on-line downloadable software. The computer screen printout display submitted depicts various basketball software products that New York Liberty fans may download. The proposed mark appears as part of an on-line display for various downloadable WNBA products, including photographs, audio and video excerpts, and e-mail newsletters.

Again, the Examining Attorney does not object to the nature of the specimen, itself; there is no contention that the specimen is not a computer screen display or that such display is proscribed as evidence of trademark usage. Instead, the Examining Attorney focuses narrowly on specific software content identified on the computer screen

printouts, namely, photographs and drawings, contending that such items are not downloadable software. See Response to Request for Reconsideration at 2. Although the Examining Attorney refers to the Nice Agreement in acknowledging that downloadable computer software provided over the Internet is properly classified in International Class 9, the Examining Attorney does not suggest that the treaty provides a basis for disallowing photographs and drawings as downloadable software. Further, even assuming arguendo the Examining Attorney's assertion regarding downloadable photographs and drawings is correct, this assertion wholly ignores assorted other downloadable software identified in the record specimen, including video and audio excerpts, e-newsletters, and links to trivia and games. In fact, the PTO accepted a similar screen display specimen as evidence of trademark usage in Applicant's prior Star and Ball Design registration for International Class 9 goods. See Exhibit 3.

VIII. CONCLUSION

Applicant has made of record relevant packaging insert and on-line software display specimens as evidence of use of the mark NEW YORK LIBERTY and Design in connection with goods in the relevant identification of goods in the identified application. Such specimens are commonly accepted to show trademark usage in support of registration for the types of goods identified in the application, including compact discs and downloadable computer software.

The Examining Attorney has not provided any evidentiary data or legal authority to support a failure to function refusal based on the specimens of record. Indeed, the evidence of record clearly supports a showing that the proposed mark is used by Applicant as a source indicator in connection with the relevant goods. Such a showing is

further supported by the PTO's identical or similar specimens in connection with several of Applicant's prior registrations.

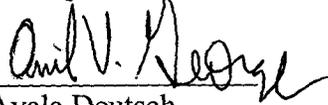
Applicant, therefore, respectfully requests that the Board reverse the Examining Attorney's final refusal that the proposed mark fails to function as a trademark under Sections 1, 2, and 45.

Respectfully submitted,

March 10, 2003

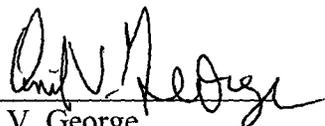
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Trademarks, BOX TTAB, NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on March 10, 2003.


Anil V. George
March 10, 2003



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03-12-2003
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Re: WNBA Enterprises, LLC
NEW YORK LIBERTY AND DESIGN
Application Serial No. 75/235781 in Class 9

Dear Sir:

Applicant is submitting herewith the Appeal Brief for the captioned application.

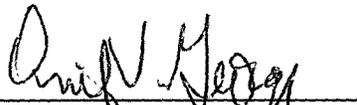
Sincerely,


Anil V. George
Associate Counsel

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Dated: March 10, 2003


Anil V. George