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

Proceeding	91205964
Party	Defendant Susoix LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Central Park Conservancy, Inc.

Opposer,

v.

Opposition No. 91205964

Susoix LLC,

Applicant.

**Reply Brief in Support of
Susoix’s Partial Motion to Dismiss**

To survive a motion to dismiss, an opposer must state a claim to relief that is “plausible on its face.” *See* TBMP § 503.02. To meet this standard, an opposer has an “obligation to provide the ‘grounds’” for his entitlement to relief. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). Here, however, there is no plausible basis for the Conservancy’s argument that the Longboarder Mark appropriates the “same or a close approximation” of the Conservancy’s name. *See* TBMP §1203.03(e). While the Conservancy argues that the Longboarder Mark contains the term Central Park, *see* Response at p. 11, there is, however, no allegation that the term Central Park is an alternate designation for the Conservancy. *See United States Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497, 1984 TTAB Lexis 79, at *6 (TTAB 1984) (hereinafter “*Olymp*”). Nor could there be such an allegation. By definition, Central Park refers to a public park and a recreation area in Manhattan. It is per se a geographic term, not the name of an institution, let alone the Conservancy. *See In re WM Distribution Inc.*, 2005 TTAB Lexis 452 (TTAB 2005). As such, the Conservancy has failed, as a matter of law, to establish the first element of a Section 2(a) claim. Dismissal is therefore the appropriate remedy. *See Olymp*, 1984 TTAB Lexis 79,

at *6 (dismissing a Section 2(a) claim as a matter of law because there was “no proof that ‘OLYMP’ is perceived as an alternate designation for opposer, United States Olympic Committee”).

In a last minute attempt to avoid dismissal, the Conservancy mints a new claim. Now, the Conservancy argues – in its response brief – that the Longboarder Mark falsely suggests a connection with Central Park. *See* Response at pp. 8-9. This new, yet unpleaded, claim fails as a matter of law, albeit for a more fundamental reason – Central Park is a public park; it is not an institution within the meaning of Section 2(a). The Board should therefore dismiss this claim as well.

A. The Longboarder Mark per se does not name the Central Park Conservancy

With respect to the first prong of Section 2(a), the Conservancy cannot establish that the Longboarder Mark appropriates “the same as or a close approximation” of the Conservancy’s name.¹ *See* TMEP §1203.03(e). While the Longboarder Mark contains the term “Central Park,” the Notice of Opposition itself alleges that “[t]he words Central Park primarily refer[] to Central Park, located in New York, New York.” Notice, ¶17. Taking these allegations as true, *see* TBMP § 503.02, the term Central Park merely refers to a geographic location, not an institution.

Dictionary definitions confirm that the term Central Park refers to a public park and a recreation area.²

- The American Heritage Dictionary of the English Language (Fifth Edition 2011 online edition) defines “Central Park” as “An extensive *recreational*

¹ In its motion to dismiss, Susoix highlighted the Conservancy’s failure to provide any grounds for establishing the first two requirements for a Section 2(a) false suggestion of connection claim. *See* Opening Brief, at pp. 5-10. The Conservancy took this focus to mean that Susoix does not contest the two remaining requirements for a Section 2(a) claim. *See* Response at p. 8. This is not the case. Susoix firmly contests the Conservancy’s ability to establish the two remaining elements of TMEP § 1203.03(e), but will save those arguments for another day, if need be.

² The Board may take judicial notice of dictionary definitions. *See Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981).

- area of New York City extending north to south in central Manhattan.”
See <http://www.ahdictionary.com/word/search.html?q=Central+Park> (last visited 8/26/2012) (emphasis added).
- Dictionary.com (2012) defines “Central Park” as “A large park in Manhattan, half a mile wide and over two miles long.” See <http://dictionary.reference.com/browse/Central+Park?s=t> (last visited 8/26/2012).

These definitions tell us that the park is over two miles long and has an extensive recreational area. The Notice does not allege otherwise. *C.f. Petroleos Mexicanos v. Intermix, S.A.*, 97 USPQ2d 1403, 2010 TTAB Lexis 442, at *6 (TTAB 2010) (alleging that the institution used the “PEMEX name”). There is thus no proof that the term Central Park refers to an institution, let alone the Conservancy. It thus cannot be said that the Longboarder Mark, by taking the term “Central Park,” appropriates the “same as or a close approximation” of the name of the Conservancy. As a matter of law, then, the Conservancy has failed to establish the first prong of a Section 2(a) claim.

This conclusion is fully supported by the Board’s decision in *In re WM Distribution Inc.*, 2005 TTAB Lexis 452 (TTAB 2005).³ There, an applicant sought to register the mark Sandia in connection with the sale of cigarettes. *Id.* at 1. The examining attorney refused the registration on the grounds that the term Sandia, standing alone, falsely suggested a connection with an institution, namely, the Pueblo of Sandia, New Mexico. *Id.* at * 2. On appeal, the Board reversed the examining attorney’s decision, forcefully holding that the geographic term “Sandia *per se* does not name the Pueblo of Sandia, New Mexico.” *Id.* at 14 (emphasis added). Put another way, the Board explained, because the term Sandia refers to the geographic location of the Sandia Pueblo, “it cannot be said that Sandia specifically names the Pueblo of Sandia, New Mexico.” *Id.* at * 13.

³ Even though not binding on the Board, *In re WM Distribution Inc.* is persuasive authority, particularly given that it addresses precisely the arguments raised in this partial motion to dismiss. See TBMP 1203.02(f).

In re WM Distribution Inc. is on all fours with the instant proceeding. Just as the Sandia term refers to a geographic location – a mountain range near Albuquerque, New Mexico, *id.* at *14-15 – so too the term Central Park refers to a geographic location – “[a] large park in Manhattan, half a mile wide and over two miles long.”⁴ According to *In re WM Distribution Inc.*, then, the Longboarder Mark *per se* does not name the Central Park Conservancy Inc. *Id.* at *13.

In re Julie White is not to the contrary. 73 USPQ2d 1713 (TTAB 2004). There, an applicant sought to register the term Apache for cigarettes, arguing that the term Apache, on its own, did not take the name of the Apache Tribes. *Id.* 17-18. Moreover, the applicant argued, the Apache mark did not take the geographic terms of any of the Apache tribes, e.g., Fort McDowell, Fort Still, and White Mountain. *Id.* at 18. The Board rejected this argument, explaining: “an applicant cannot take a significant element of the name of another and avoid refusal by leaving one or more elements behind, *provided that that which has been taken would still be unmistakably associated with the other person.*” *Id.* at *17. (emphasis added). The Board then proceeded to hold that the term Apache, on its own, would still be unmistakably associated with the Apache tribes of the Southwest. Central to this determination was the dictionary definition of the term “Apache,” which means “A Native American people inhabiting the Southwest of the United States.” *Id.* at *2; *see also In re White*, 80 USPQ2d 1654, 2006 TTAB Lexis 263, *13 (TTAB 2006) (“the dictionary definitions submitted by the examining attorney are sufficient to establish that MOHAWK is the same as or a close approximation of the federally recognized St. Regis Band of Mohawk Indians of New York”).

Relying on *In re Julie White*, the Conservancy complains that the Longboarder Mark took the term “Central Park” and thus cannot avoid refusal by simply leaving

⁴ *See* <http://dictionary.reference.com/browse/Central+Park?s=t> (last visited 8/16/2012); *Accord* Notice at ¶17.

behind the term “Conservancy.” *See* Response at p. 11. The fundamental flaw with this argument, however, is the fact the term Central Park – that which was freely taken – would not “*still be unmistakably associated*” with the Conservancy. *In re Julien White*, at *17 (emphasis added). As alleged by the Conservancy, the term Central Park refers to a public park, not the Conservancy or any other institution. *See* Notice at ¶17.⁵ The dictionary definition of the term corroborates this point. The term Central Park is thus fundamentally distinct from the terms “Apache” and “Mohawk” – terms which, on their own, unmistakably refer to the respective Apache and Mohawk Tribes. *Id.*; *In re White*, 2006 TTAB Lexis 263, *13. This is not therefore a case, like *In re Julie White*, where “that which has been taken would still be unmistakably associated with” the Central Park Conservancy. For this reason the Board should conclude, as a matter of law, that the Longboarder Mark does not take the “same as or a close approximation” of the name of the Conservancy. *See* TMEP 1203.03(e); *see also In re WM Distribution Inc.*, 2005 TTAB Lexis 452, at *13-14 (distinguishing *In re Julie White* because the term Sandia referred to a geographic location and thus per se did not name the Pueblo of Sandia).

⁵ In its response brief, the Conservancy argues that it has sufficiently alleged in its opposition “that the Longboarder Mark includes the words Central Park and that such mark falsely suggests a connection with [the Conservancy]” Response at p. 12 (citing Notice, at ¶¶ 7-9, 12, 29-32). Susoix checked each of these cited paragraphs (as well as the entire Notice) but found no allegations that the term Central Park is an alternate designation for the conservancy or otherwise refers to the Conservancy. Indeed, even viewing the Notice in the light most favorable to the Conservancy, *see Petroleos Mexicanos*, 97 USPQ2d at 1404, Susoix found nothing that would establish the first element of a Section 2(a) claim – namely, that the Longboarder Mark, by incorporating the Central Park term, appropriated the name or equivalent thereof of the Conservancy. It must be, then, that the Conservancy believes its Notice is sufficient to survive a motion to dismiss because it states: “Applicant’s mark falsely suggests a connection to the Opposer.” Notice at ¶32. Such a formulaic recitation of a Section 2(a) claim is, however, insufficient to survive a motion to dismiss. *See Twombly*, 550 U.S. at 555 (“a formulaic recitation of the elements of a cause of action will not do”). Susoix thus remains convinced that there is no plausible basis for the argument that the Longboarder Mark appropriates the name or equivalent thereof of the Conservancy.

In sum, there is no proof that the Central Park Longboarder Global Rolling Mark is an alternate designation for the Central Park Conservancy. There is thus no plausible basis for the Conservancy's Section 2(a) claim. This holds true notwithstanding the fact that the Longboarder Mark contains the geographic term "Central Park." *See In re WM Distribution Inc.*, 2005 TTAB Lexis 452, at *13-14. Indeed, in the *Olymp* case, even though the Olymp mark was "*entirely encompassed* within the opposer's Olympic mark," 224 USPQ 497 at * 4 (emphasis added), the Board still dismissed the opposer's Section 2(a) claim because there was "no proof that 'OLYMP' is perceived as an alternate designation for opposer, United States Olympic Committee." *Id.* at 6. So too, here, dismissal of the Conservancy's Section 2(a) claim is warranted under *Olymp*.⁶

B. Central Park is not an Institution within the Meaning of Section 2(a)

Because the Longboarder Mark per se does not name the Central Park Conservancy, the Conservancy mints a new argument in its reply brief: the Longboarder Mark takes the name "Central Park" and thus falsely suggests a connection with Central Park in violation of Section 2(a). *See* Response at p. 10. This claim, however, appears nowhere in the Conservancy's Notice. There, the Conservancy argued that the Longboarder Mark falsely suggested a connection with the opposer, the Central Park Conservancy. *See* Notice, at ¶29. If the Conservancy wanted to argue that the

⁶ The Conservancy attempts to distinguish *Olymp* in a footnote. *See* Response, at p. 11 n.5. According to the Conservancy, the *Olymp* case is a weak precedent because "the Board acknowledged that opposer had given up its Section 2(a) claim." *Id.* In support of this position, the Conservancy provides the Board with a quotation from the case: it "appears that opposer is not pressing its Section 2(a) ground with any conviction." *Id.* (quoting *Olymp*, 1984 TTAB Lexis 79, *7 n.2). If this were the whole truth, *Olymp* might be a weak precedent. To be clear, though, the Board in *Olymp* had this to say: "It thus appears that opposer is not pressing its Section 2(a) ground with any conviction, *although our conclusion on the point does not rely upon that assumption.*" *Olymp*, 1984 TTAB Lexis 79, at * 7 n. 2 (emphasis added). The Board thus dismissed the Section 2(a) claim as a matter of law because there was no proof that the term Olymp was an alternate designation for the Olympics. *Olymp* is thus a powerful, citable precedent that warrants dismissal as a matter of law in this case.

Longboarder Mark falsely suggested a connection with Central Park, it could have done so. It did not.⁷ This Board should refuse to consider the Conservancy's newly minted, yet unpleaded, claim. *See* TBMP § 314 (“A plaintiff may not rely on an unpleaded claim.”); *see also Internet Inc.*, 38 U.S.P.Q.2d 1435, 1996 WL 218762, at *2 n.6 (TTAB Jan. 4, 1996) (denying opposer's attempt to substitute a new, unpleaded institution to survive a motion to dismiss).

In refusing to consider the Conservancy's new claim, the Board can rest assured that it too fails as a matter of law, albeit for a more fundamental reason. Fatal to the Conservancy's new claim is the fact that Central Park is a public park, not an institution within the meaning of Section 2(a).⁸ According to this Board's precedent, an “institution” must be “[a]n established organization,” and an “organization” is a “body of persons . . . formed for a common purpose.” *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1173 (Fed. Cir. 2009) (quoting Black's Law Dictionary 813, 1133 (8th ed. 2004)). The Conservancy provides a number of dictionary definitions of the term “institution,” all of which emphasize the importance of an “organization” – that is a body of persons formed for a common purpose. *See* Response at p. 9.

By definition, though, Central Park is not an organization of persons. Instead, as noted above, Central Park is defined as a public park and recreational area. *See supra* at pp. 2-3 (providing dictionary definitions of the term Central Park). Not one single

⁷ By contrast, in its opposition to the Longboarder Mark, the City alleges that “Central Park is an institution” and that the Longboarder Mark falsely suggests a connection with Central Park. *See* Doc 1, at ¶¶ 1, 27 (Opposition No. 91205879). The City thus makes clear its allegation that Central Park is an institution. The Conservancy's Notice makes no such claim. Nor did the Conservancy join in the City's Section 2(a) claim. Instead, it opted to allege that the Longboarder Mark falsely suggests a connection with it, the Conservancy. It should be stuck with this claim.

⁸ Susoix has moved to dismiss the City's claim that the Longboarder Mark falsely suggests a connection with Central Park. In that proceeding, Susoix was not blind-sided by a new claim regarding Central Park; thus, it had the opportunity to articulate in more detail why Central Park is not an institution. *See* Docs. 3, 9 (Opposition No. 91205879) (collecting cases interpreting the term “institution” and Section 2(a)'s history).

definition states, let alone even hints, that Central Park is an organization of persons. Rather, the definitions tell us that the park is over two miles long and has an extensive recreational area. Apparently, a park is a park. As a matter of law, then, the Conservancy cannot establish the threshold requirement of a section 2(a) claim – namely that Central Park is an “institution.” *See, e.g., In re WM Distribution Inc.*, 2005 TTAB Lexis 452, at * 12 (TTAB 2005) (Sandia, “the name of [a] mountain wilderness . . . and two towns”, not considered an institution within the meaning of Section 2(a)). The allegations in the Notice do not state otherwise. Rather, they *confirm* that Central Park is a park in New York, not an institution. *See* Notice at ¶17.

Central Park is not an institution for another reason: it has no means of effecting its own independent action. In *In re North American Free Trade Association*, 43 USPQ2d 1282, 1997 Lexis TTAB 19 (TTAB 1997) (hereinafter “NAFTA”), the Board reasoned that NAFTA was an institution because it “contain[ed] within itself an organism by which it effects its own independent action, continuance, and generally its own further development.” *Id.* at *8 n.6. The NAFTA treaty satisfied this definition of an institution because it contained provisions creating committees, regional offices, working groups, and the like. *Id.* at 10. Central Park, unlike NAFTA, contains no such mechanism for independent action. It is a place, not an “organism” that can “effect its own independent action.”

The inanimate nature of Central Park is apparent in the Conservancy’s response brief. The Conservancy argues that it has standing to raise a Section 2(a) claim because it “has served to operate Central Park under a contract with the City of New York and New York City Department of Parks and Recreation.” Response at p. 2 (citing Notice at ¶7). To be clear, then, the Conservancy has a contract with the City and Parks Department; it does not have a contract with Central Park for the simple reason that the park itself cannot enter into a contract on its own.

The Conservancy attempts to breathe life into the park with a last-minute substitution of the Parks Department. In its response brief, the Conservancy claims that Parks Department employees maintain and patrol the park. Specifically, the Conservancy states: “Central Park, which has its own employees, police force, rules and regulations *through the New York City Department of Parks and Recreation*, and provides recreational services to the general public, clearly falls within that definition and is therefore protected as an institution under Section 2(a).” *See* Response at p. 9 (emphasis added). These new allegations are irrelevant for at least two reasons. First, these allegations appear for the first time in the Conservancy’s response brief without any citation to the Notice. Clearly, then, the Conservancy has asserted new factual allegations in its legal memorandum. It is, however, well established that a court errs when it “relies on factual allegations contained in legal briefs or memoranda in ruling on a 12(b)(6) motion to dismiss.” *See Friedl v. City of New York*, 210 F.3d 79, 83-84 (2d Cir. 2000). The Board should therefore refuse to consider these new facts as alleged by the Conservancy in its response brief. *See e.g., Concepcion v. City of New York*, 2008 WL 2020363, at * 10 (S.D.N.Y. May 7, 2008) (refusing to consider additional facts alleged in Plaintiff’s response brief and thus granting defendants’ motion to dismiss); *Vandermark v. City of New York*, 615 F.Supp.2d 196, 200 n. 13 (S.D.N.Y. 2009) (same).

Even if the Board considers the Conservancy’s new allegations about the Parks Department, it will realize that they fail to establish that Central Park is an institution. According to *NAFTA*, the key inquiry is whether the alleged institution “contain[s] *within itself* an organism by which it effects its own independent action[.]” *NAFTA*, 1997 Lexis TTAB 19, at * 9 n.6 (emphasis added). Central Park contains no such organism within itself, nor does the Conservancy argue otherwise. Rather, the Conservancy argues that the employees and officers in Central Park are provided “through the New York City Department of Parks and Recreation” Response at p. 9. The Conservancy’s

allegations, even when take as true, merely establish that Central Park is maintained by another governmental agency, the Parks Department. Such outside maintenance does not, however, transform Central Park into its own institution; it merely makes Central Park a well-maintained, safe and decidedly pretty park.

To hold otherwise would result in an absurdly expansive view of the term “institution.” Under the Conservancy’s rationale, every public park in New York City – indeed every public space – would qualify as an institution for the simple reason that these public spaces are all managed by governmental agencies such as the Parks Department. To state this result makes it apparent that the Park Department’s management of the Central Park does not render the park an institution. As a matter of law, then, Central Park is not an institution within the meaning of Section 2(a).⁹

WHEREFORE, Susoix respectfully prays that the Board dismiss the Conservancy’s Section 2(a) claim pursuant to Fed. R. Civ. P. 12(b)(6).

⁹ This likely explains why the USPTO has permitted registration of numerous marks including the term Central Park. *See, e.g.*, Central Park Financial (Reg. # 4027243), Central Park Bike Tours NYC (Reg. # 3232782), Dr. Brown’s Central Park Carousel (Reg. # 3195783), Central Park Zoo (Reg. # 73216833), and The Great Central Park Treasure Hunt (Reg. # 78382945).

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Respectfully submitted,

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing motion to dismiss and memorandum in support thereof has been served on the City by electronic transmission mutually agreed upon by the parties to:

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