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

Proceeding	92055800
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**City of New York, By And Through Its
Department of Parks & Recreation,**

Opposer,

v.

Cancellation No. 92055800

Susoix LLC,

Applicant.

**Susoix's Reply in Support of its
Partial Motion to Dismiss**

The City's Petition made an aggressive claim: the Skateboarder Mark falsely suggests a connection with Central Park, an institution within the meaning of Section 2(a).¹ Susoix moved to dismiss the claim, pointing out the obvious: Central Park is a public park, not an institution. Nothing in the City's response brief suggests otherwise. Indeed, the City's brief confirms that Central Park is not an organization of persons.

Unable to overcome the obvious, the City mints a new Section 2(a) claim in its response brief. Now, the City argues that the Skateboarder Mark falsely suggests a connection with the Parks Department. Not only is this last-minute substitution inappropriate, it is too little, too late. There are no allegations in the Petition to support a claim that the Skateboarder Mark falsely suggests a connection with the Parks Department. Indeed, there is no reasonable basis for such a claim. As a matter of law, then, this Board should not hesitate to dismiss both of the City's Section 2(a) claim.²

¹ The City's Petition also asserted a claim of fraud on the USPTO. Susoix moved to dismiss the claim on the grounds that (1) the claim failed to plead the essential elements of fraud, and (2) there was no basis for the claim. *See* Opening Brief, at pp. 11-15. In response, the City promptly dropped the fraud claim.

² Effectively, the City has now asserted two Section 2(a) claims: (1) the Skateboarder Mark falsely suggests a connection with Central Park, and (2) the Skateboarder Mark

At the same time, the City appears to have misapprehended Susoix’s motion to dismiss the Section 2(e)(2) claim. By the City’s own logic, the Skateboarder Mark cannot be geographically descriptive of Susoix’s online retail services.

I. Central Park is not an Institution.

The threshold question in Susoix’s motion to dismiss was whether Central Park qualifies as an “institution” within the meaning of Section 2(a).³ The parties agree that an “institution” must be “[a]n established organization,” and that 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)); *see* Response at p. 11 (favorably citing *Shinnecock Smoke Shop*). Indeed, the City 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, preferably a “public purpose.” *See* Response at pp. 12-13.

By definition, Central Park is not an organization of persons. Thoughtfully, the City provides the Board with a number of dictionary definitions of the term “Central Park.” *See id.* at p. 14.⁴ Every single definition cited by the City defines Central Park as a public park or recreational area.

falsely suggests a connection with the Parks Department. Both claims fail as a matter of law.

³ The City spends considerable time arguing that it can meet all four elements of a claim for false suggestion of connection with an institution. *See* Response at pp. 6-8. These arguments are irrelevant to the instant motion to dismiss – a point conceded by the City. *See id.* at p. 8 (“The only issue at this preliminary stage is whether Central Park [can] be considered an ‘Institution’ as a matter of law.”). As such, Susoix did not contest the City’s ability to establish the four elements of TMEP § 1203.03(e); rather, Susoix focused on the fundamental issue of whether a park is an institution. The City appears to take this as a sign that Susoix concedes the Skateboarder Mark falsely suggests a connection with Central Park. *Id.* at pp. 2-3. This is not the case. Susoix firmly contests the City’s ability to establish the four elements of TMEP § 1203.03(e), but will save those arguments for another day, if need be.

⁴ The Board may take judicial notice of dictionary definitions. *See Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981).

- The American Heritage Dictionary of the English Language (Fifth Edition 2011 online edition) defines “Central Park” as “An extensive *recreational 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 8/12/2012) (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 8/16/2012).

Not one single 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 City has failed to 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 fame of Central Park in no way alters this conclusion. The City’s Response contains a hefty dose of the terms “popular” “famous” and “known to millions.” But, a public park, even a famous one, is not an institution within the meaning of Section 2(a). The Board and Federal Circuit have made this point abundantly clear, consistently emphasizing that an institution must be an organization of persons. See *Shinnecock Smoke Shop*, 571 F.3d at 1173; see also Opening Brief at p. 8 (collecting cases). Fame does not factor into the equation.⁵

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

⁵ If anything, the fame of Central Park would go to the fourth prong of a Section 2(a) claim. See TMEP § 1203.03(e) (“the fame or reputation of the person or institution is such that, when the mark is used with the applicant’s goods or services, a connection with the person or institution would be presumed”). Fame does not, however, factor into the threshold question of whether a park is an institution.

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 City attempts to breathe life into the park with a last-minute substitution of the Parks Department. According to the City, the Parks Department maintains all of New York City’s public parks and open spaces, including Central Park.⁶ The City then asserts that the Parks Department’s maintenance of Central Park transforms it – the park, that is, not the Parks Department – into an institution.

This substitution misses the point and inverts the definition of an institution. According to *NAFTA*, the key inquiry is whether the alleged institution “contain[s] *within*

⁶ In addition to maintaining parks, the Park Department also provides recreational facilities and programs and puts on concerts and sports events in all of the City’s parks.

Parks & Recreation is the steward of approximately 29,000 acres of land — 14 percent of New York City — including more than 5,000 individual properties ranging from Coney Island Beach and Central Park to community gardens and Greenstreets. We operate more than 800 athletic fields and nearly 1,000 playgrounds, 550 tennis courts, 66 public pools, 48 recreational facilities, 17 nature centers, 13 golf courses, and 14 miles of beaches. We care for 1,200 monuments and 23 historic house museums. We look after 650,000 street trees, and two million more in parks. We are New York City’s principal providers of recreational and athletic facilities and programs. We are home to free concerts, world-class sports events, and cultural festivals.

<http://www.nycgovparks.org/about> (last visited 8/17/2012). The Board may take judicial notice of the Park Department’s role in maintaining the City’s parks and properties, promoting recreational and athletic events, and providing free concerts. *See* Fed.R.Evid. 201(b)(2) (“A judicially noticed fact must be one not subject to reasonable dispute in that it is ... capable of accurate and ready determination by resort to sources whose accuracy cannot be reasonably questioned.”); *Massachusetts v. Westcott*, 431 U.S. 322, 323 n. 2 (1977) (public records “may be judicially noticed”).

itself an organism by which it effects its own independent action[.]” *NAFTA*, 1997 Lexis TTAB 19, at * 9 n.6 (emphasis added). Central Park – the alleged institution in this case, *See* Petition at ¶ 1 – contains no such organism within itself, nor does the Petition allege otherwise. It may be that employees of the Parks Department maintain and patrol the park.⁷ That, however, simply means that Central Park is maintained by another governmental agency, the Parks Department. *See* Response at p.2. 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.

⁷ In its response brief, the City includes a number of new factual allegations not found in the Petition or the Amended Petition. Specifically, the City now alleges that Central Park “has its own administration and employees. It has its own police force and rules and regulations.” Response at p. 13. Notably, these factual allegations appear for the first time in the City’s response brief without any citation to the Petition or Amended Petition. Clearly, then, the City has asserted new factual allegations in its response. It is, however, well established that a district 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. *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 these new allegations, it will see that they establish little more than the fact that employees of the Parks Department maintain Central Park. In its own opposition to the Skateboarder Mark, the Central Park Conservancy has adopted a similar tactic in its response brief. *See* Doc. 4, p. 9 (Cancellation No. 92055812). There, however, the Conservancy is more accurate, explaining: “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* Doc. 6, p. 9 (Cancellation No. 92055812) (emphasis added). The Conservancy thus makes clear that the employees, officers, and rules and regulations in Central Park are not Central Park’s “own” employees; they are merely employees, officers, and rules and regulations provided “through” the Parks Department.

In sum, then, the City’s new allegations establish little more than the fact that Parks Department employees patrol and maintain the park. This is but another attempt by the City to substitute the Parks Department for Central Park – a tactic which fails to turn a park into an institution.

To hold otherwise would result in an absurdly expansive view of the term “institution.” Under the City’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 – a place – an institution.

At the end of the day, Central Park is not an institution within the meaning of Section 2(a). This may explain why the Board has permitted numerous other corporations and individuals to register marks with the term Central Park.⁸ Susoix humbly requests the same opportunity and thus registered the mark Central Park Skateboarder Global Rolling.

II. The Skateboarder Mark does not Falsely Suggest a Connection with The Parks Department.

Because Central Park is not an institution, the City is left with but one option: to mint a new claim alleging that the Skateboarder Mark falsely suggests a connection with the Parks Department.⁹ Amazingly, in its response brief, the City attempts just such tactic. The City argues that the Skateboarder Mark “creates a connection with the City and Central Park.” Response at p. 10. The City further argues “there can be no dispute that the City and the Parks Department, whether considered separately or as a whole, are institutions within the meaning of Section 2(a).” *Id.* Finally, the City alleges, “There can be no doubt that the City is also entitled to protection under Section 2(a).” *Id.* at p. 11. In

⁸ Among many other registrations, the USPTO has permitted registration of such marks as 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).

⁹ Susoix anticipated that the City might attempt to argue that the Conservancy is an institution and that the Skateboarder Mark falsely suggests a connection with the Conservancy. To foreclose this argument, the Susoix made it clear to the City that it lacks standing to raise a claim on behalf of the Conservancy. *See* Opening Brief, at pp. 9-11. The City does not contest this argument; thus, it makes no arguments on behalf of the Conservancy in its response brief.

short, the City argues that the Skateboarder Mark falsely suggests a connection with the City's Parks Department. Yet, these allegations appear nowhere in the Petition.

The Board need not and should not consider this unpleaded claim. In its Petition, the City could have pleaded a false connection between the Skateboarder Mark and the Parks Department. Instead of taking such a sensible approach, the City took an aggressive position and alleged, unequivocally, that Central Park is an institution and that the Skateboarder Mark falsely suggests a connection with Central Park. *See* Petition, at ¶¶ 1, 27. As already explained, this claim fails as a matter of law: Central Park is a public park, not an institution. The City should be stuck with this hard truth. It follows then that the Board should refuse to consider the City's new, yet unpleaded, claim that the Skateboarder Mark falsely suggests a connection with the Parks Department. *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 so doing, the Board can rest assured that the City's newly-minted claim fails as a matter of law. Under this Board's precedent, it is well established, indeed "critical[,] that the matter for which the registration is sought *must be* the name or an equivalent which is sought to be appropriated by the applicant." *In re White*, 73 USPQ2d 1713, 2004 WL 2202268, at * 6 (TTAB 2004) (emphasis added); TMEP § 1203.03(e). The Central Park Skateboarder Global Rolling Mark does not, however, "remotely resemble" the name of the City of New York Department of Parks and Recreation. *See McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 USPQ 45, 1985 TTAB Lexis 144, at 13 (TTAB 1985) (dismissing, as a matter of law, the claim that the mark "DataStat" falsely suggests a connection with the McDonnell Douglas Corporation because "the mark sought to be canceled is 'DataStat', which does not remotely resemble petitioner's name, McDonnell

Douglas”). As a matter of law, then, dismissal would be appropriate and is readily supported by the caselaw. *Id.*; *see also United States Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497, 1984 TTAB Lexis 79 (TTAB 1984); *see also American Speech-Language-Hearing Assoc.*, 224 USPQ 798, 1984 TTAB Lexis 19, at *19 (TTAB 1984); *In re WM Distribution*, 2005 TTAB Lexis 452, at * 13-14 (TTAB 2005) (“We find that Sandia per se does not name the Pueblo of Sandia, New Mexico tribe.”).

In an attempt to avoid this result, the City argues in its response brief that the Skateboarder Mark contains a map of Central Park. *See* Response at pp. 9-10. Due to this design element, the City then asserts that the Skateboarder Mark falsely creates a connection with the Parks Department in violation of Section 2(a). *Id.* at p. 10.

For this claim to survive a motion to dismiss, the City must establish two additional points. First, the City must establish (or at least allege) that a map of Central Park is a symbol uniquely indicative of the Parks Department. *See United States Postal Service v. Lost Key Rewards, Inc.*, 102 USPQ2d 1591, 2010 TTAB Lexis 424, at *10 (TTAB 2010) (hereinafter “USPS”). Then, the City must allege that the Skateboarder Mark’s design incorporates a map of Central Park, and in so doing, appropriates “the same as, or a close approximation of, the name or identity previously used by” the Parks Department. *See* TMEP § 1203.03(e). The City cannot and thus has not even attempted to establish either of these points, thereby warranting dismissal.

With respect to the first requirement, there is not one single allegation in the Petition that a map of Central Park is uniquely indicative of the Parks Department. Indeed, there is no plausible basis for the City to claim that a map is a symbol uniquely indicative of the Parks Department. According to the Merriam-Webster Dictionary, a map is defined as “a representation usually on a flat surface of the whole or a part of an

area.”¹⁰ By definition, a map identifies an “area,” not an institution. It follows that a map of Central Park identifies Central Park, the public park found “in the heart of New York City, extending northerly from 59th street to 110th street and cross-town from Fifth Avenue to Eight[h] Avenue.” For this reason, it cannot be said that a map of Central Park points uniquely and unmistakably to an institution such as the Parks Department.

The lack of a symbol uniquely associated with the Parks Department stands in stark contrast to the United States Postal Service’s blue round-top mailboxes. In *United States Postal Service v. Lost Key Rewards, Inc.*, 102 USPQ2d 1591, 2010 TTAB Lexis 424 (TTAB 2010) (hereinafter “USPS”), the USPS established that “its round-top mailbox design is a famous mark and a symbol that is ubiquitous and *uniquely indicative of the USPS.*” *Id.* at * 10 (emphasis added). Because the applicant’s mark incorporated a blue USPS collection box, the Board concluded that the applicant’s mark was a “close approximation of the identity of the USPS.” *Id.* Based on this unquestioned similarity, the Board proceeded to conclude that applicant’s mark falsely suggested a connection, not with blue mailboxes, but rather with the USPS – an institution within the meaning of Section 2(a).

Despite relying on the *USPS* case, *see* Response at p. 10, the City fails to even identify the symbol that is allegedly uniquely identified with the Parks Department. At best, the Petition might allege that the Park’s Department is uniquely associated with the symbol in its Central Park Mark – a London plane tree leaf surrounded by a circle. *See* Petition at ¶¶12, 46; *See also* Ex. A (providing an image of the Central Park Mark). It goes without saying, however, that there is zero relationship between the design in the Skateboarder Mark and a London plan tree leaf surrounded by a circle. *Compare* Petition, Ex. A with Ex. B. The City’s reliance on the *USPS* case is thus misplaced.

¹⁰ <http://www.merriam-webster.com/dictionary/map> (last visited 8/21/2012).

Even assuming the Parks Department is uniquely and unquestionably associated with a map of Central Park, it cannot be said that the Skateboarder Mark appropriates “the same as, or a close approximation of” the map presumably associated with the Parks Department. *See* TMEP § 1203.03(e). As should be clear from Exhibit B, the Skateboarder Mark takes the curved shape of a longboard, thereby creating the playful impression of a longboard mounted on a set of trucks rolling in a horizontal plane. It would not be perceived as a map. *See Artcraft Novelties Corp. v. Baxter Lane Co. of Amarillo*, 685 F.2d 988, 216 U.S.P.Q. 654 (5th Cir. 1982). Indeed, the mark lacks any of the essential elements of a map. It thus cannot be said that the Skateboarder Mark appropriates the “same as, or a close approximation of, the name or identity previously used by” the Parks Department. *See* TMEP § 1203.03(e). As a matter of law, then, neither the literal nor the design element of Skateboarder Mark appropriates the name of the City of New York Department of Parks and Recreation or a symbol uniquely associated with the Parks Department. The City’s newly-minted claim thus fails.

III. The Skateboarder Mark is Not Geographically Descriptive

Susoix provides online retail services in the area of longboards, skateboards, and bikes under the Skateboarder Mark. According to the City, “The Place identified in the [Skateboarder] Mark is Central Park, not the internet.” Response, at p. 17. Based on the City’s arguments, then, the Skateboarder Mark is not geographically descriptive of the internet services provided by Susoix. As a matter of law, then, the Skateboarder Mark is not geographically descriptive of online retail services. Hence, Susoix moved to dismiss the City’s Section 2(e) claim, 15 U.S.C. § 1052(e)(2).

WHEREFORE, Susoix respectfully prays that the Board dismiss the City’s above identified claims pursuant to Fed. R. Civ. P. 12(b)(6).

Dated: 8/24/2012

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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