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

Proceeding	91156780
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IN THE UNITED STATES TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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NEW YORK YANKEES PARTNERSHIP
and STATEN ISLAND MINOR LEAGUE
HOLDINGS, L.L.C.,

Opposer, Opposition No. 91156780

v.

LEON P. HART,

Applicant.

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APPLICANT'S BRIEF

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STATEMENT OF ISSUES

Can a likelihood of confusion exist when BABY BOMBERS is nondistinctive.

Can an individual inexperienced in business with limited knowledge of trademark law have a *bona fide* intent to use a mark in commerce in the absence of documents evincing his state of mind at the time of filing?

DESCRIPTION OF THE RECORD

The Application

Applicant filed an intent-to-use application to register BABY BOMBERS for "clothing and athletic wear consisting of shirts, shorts, pants and hats" on July 23, 2001.

An Office Action issued September 25, 2001 wherein registration was refused under Section 2(d) premised upon Registration No. 2,000,494 for the mark BOMBER used in connection with hats and Registration No. 2,133,628 for the mark BOMBERS in connection with shirts.

On February 14, 2002 Mr. Hart engaged an attorney to represent him in connection with the prosecution of the application and executed a power of attorney. On March 22, 2002, a responsive Amendment was filed by Mr. Hart's attorney.

In the responsive Amendment, arguments were presented with respect to the Section 2(d) refusal to register that the weak nature of the term BOMBERS in connection with clothing was evidenced not only by its generic nature with respect to a type of jacket but further by the fact that the Examining Attorney had cited two different registrations for different clothing items owned by different entities which comprise the term BOMBER(S).

In the March 22, 2002 Amendment, Mr. Hart's attorney also presented arguments against a requested disclaimer of the term BABY. The arguments were supported by online reprints of news articles dated August 2001 and September 2001 (subsequent to the July 23, 2001 application filing date) wherein the term BABY BOMBERS was used in connection with baseball teams. The online reprints were dated, at the bottom, right corner, 3/19/2002, three days before the Amendment was filed.

By Office Action dated May 16, 2002, prosecution was suspended pending disposition of Application Ser. No. 75/257,492. Thereafter, on January 22, 2002, a notice of publication issued.

Publication of Mark and Filing of Opposition

The mark was published for opposition on February 11, 2002 and the instant opposition was filed Jun 11, 2002.

Answer

Applicant's answer was filed August 6, 2004.

Motion to Amend and Answer to Amended Pleading

On January 2, 2004, Opposer moved to amend the Notice of Opposition and such motion was granted February 26, 2004. An answer to the amended Notice of Opposition was filed March 31, 2004.

Testimony and Exhibits

Opposer's identification of the testimony taken and documents attached to notices of reliance are substantially correct except, however, for Opposer's description of Applicant's Notice of Reliance dated July 14, 2004 which included a copy of Opposer's response to Applicant's Document Request No. 18, indicating the context under which such documents were produced by Opposer.

RECITATION OF FACTS

Background Facts

Applicant, Leon P. Hart, an individual without any business experience (Hart Dep TR page 5, line 1 through page 7, line 7), filed a *pro se* handwritten intent-to-use application to register BABY BOMBERS for "clothing and athletic wear consisting of shirts, shorts, pants and hats" on July 23, 2001.

Although he is an attorney, Mr. Hart is unfamiliar with the Trademark Rules of Practice. For example, with respect to a *pro se* application he filed for a different mark, he was unaware that an applicant could file a request for an extension of time to file a

statement of use and filed a new application for the same mark when he was unable to file a statement of use within the initial six month period set forth in a Notice of Allowance. (Hart TR page 30, line 14 through page 33, line 2)

Mr. Hart testified, with respect to the circumstances surrounding the creation of his BABY BOMBERS mark, that he wished to get into a side business outside of his employment as an attorney and was hoping his expectant wife would have a boy. He tried to think of a word which would go along with "baby" and "bombers" came to mind as a "ruff and tumble kind of label for clothing that a little boy would wear". (Hart Dep TR page 9, lines 10 – 25, page 10, lines 2 – 6).

Prior to filing the application, Mr. Hart conducted his own search at the USPTO web site for BABY BOMBERS. (Hart Dep TR page 21, lines 6 – 13)

After receipt of the September 25, 2001 Office Action, Mr. Hart engaged trademark counsel for prosecution of the application. Mr. Hart did not participate in the arguments presented with respect to the Amendment filed March 22, 2002 (Hart TR page 66, lines 7 - 18) and did not recall reviewing the Amendment, which made reference to the Staten Island Yankees. He testified that he first became aware of the term BABY BOMBERS in connection with the Staten Island Yankees at about the time the opposition was filed.

Mr. Hart's Intent to Use BABY BOMBERS

Mr. Hart testified that at the time of filing of his application for registration of

BABY BOMBERS, in his mind he had a legitimate intent-to-use the mark on the identified goods in interstate commerce (Hart TR page 11, lines 20 – 25, page 12, lines 1 – 25, page 13, lines 1 – 2) and that he has a continued intent-to-use the mark (Hart TR page 13, lines 7 – 23).

Although Mr. Hart did not intend to personally manufacture the goods, he planned to obtain goods from a manufacturer or wholesaler (Hart TR page 14, lines 3 – 8). Among his actions in connection with sourcing the goods were researching in the telephone directory under "apparel" or "wearing apparel" and "t-shirts" for wholesalers or manufacturers shortly after the filing of his application (Hart TR page 14, lines 17 – 25, page 15, line 1, page 23, lines 11 – 24).

Mr. Hart also testified that he intended to apply the mark to labels (Hart TR page 15, line 21) and that he was considering low cost advertising in the Pennysaver (Hart TR page 16, lines 12 – 21, page 27, lines 19 –25).

Among the steps Mr. Hart did pursue with respect to eventual use of the BABY BOMBERS mark was the formation of a corporation, Hart's Pursuits, and reserving the domain name "hartspursuits.com" for marketing products under the BABY BOMBERS mark (Hart TR page 17, lines 7 – 25, page 18, lines 1 – 19).

Mr. Hart also considered obtaining financial backing from family and friends (Hart TR page 19, lines 8 – 17).

Mr. Hart also testified that the reason he did not proceed further with efforts to establish actual usage was that he was awaiting final approval from the Patent and Trademark Office, i.e. a Notice of Allowance, before incurring the costs involved (Hart TR page 16, lines 22 – 25, page 17, lines 1 – 6).

The Little League BABY BOMBERS

Mr. Hart became aware of the Little League team in the Bronx known as the BABY BOMBERS soon after the filing of his application (Hart TR page 5, lines 13 – 20). The BABY BOMBERS Bronx Little League Team gained nationwide prominence commencing in about August of 2001 and was widely referred to as the BABY BOMBERS, not only in metropolitan New York newspapers, such as the Daily News and the New York Times (Smith TR Ex. E, Ex. N) but in newspapers throughout the country such as the Augusta Chronicle (Smith TR Ex. D), the San Diego Union-Tribune (Smith TR Ex. F), the Grand Rapids Press (Smith TR Ex. L) and the Gary Indiana Post-Tribune (Smith TR Ex. M).

The Little League BABY BOMBERS were also recognized as such in various nationwide publications such as USA Today (Smith TR Ex. G), the Christian Science Monitor (Smith TR Ex. H), Newsweek (Smith TR Ex. I), the Wall Street Journal (Smith TR Ex. J) and Time (Smith TR Ex. K).

The Staten Island Yankees

Opposer, Staten Island Minor League Holdings, LLC (hereinafter "Staten Island

Yankees") acknowledged that it was aware of the Bronx Little League Team being referred to as BABY BOMBERS and raised no objection (Getzler TR page 62, lines 9 – 19).

The Staten Island Yankees commenced operation in 1999 (Getzler TR page 12, line 7 – 8) and from its inception through May 12, 2004 has been unprofitable (Getzler TR page 64, lines 5 – 24). The name BABY BOMBERS was considered for the team, however, it was not adopted because **players would not want to be playing for a team known as "babies"** (Getzler TR page 68, lines 17 – 25).

Its Chief Operating Officer, Joshua Getzler, testified that the term BABY BOMBERS was first used by the press to describe the team (Getzler TR page 14, lines 19 – 25, page 15, lines 1 – 6). BABY BOMBERS has been used only in connection with promotion of the team (Getzler TR page 63, lines 14 – 25, page 64, lines 1 – 21). The term BABY BOMBERS has not been applied to team uniforms, has not been licensed to others to use and has not been used on any items of clothing (Getzler TR page 63, lines 19 – 25, page 64, lines 1 – 3).

Third Party Usage/Registration of BOMBERS marks

By Baseball Teams

In addition to the Little League BABY BOMBERS, Mr. Getzler testified that he was aware of a minor league baseball team named the CAPITAL CITY BOMBERS (Getzler TR page 61, lines 10 – 19).

On Clothing

On August 23, 2001, the New York Daily News reported that Bronx BABY BOMBERS t-shirts were set to hit the shelves at Modell's (Smith Ex. E) and on August 24, 2001, the San Diego Union-Tribune reported fans at the Williamsport, PA Little League World Series were wearing Bronx BABY BOMBER t-shirts (Smith TR Ex. F).

Modell's had advertised the sale of BABY BOMBERS t-shirts at least as early as August 25, 2001 (Hart TR Ex. A, page 8, lines 19 – 25, page 9, lines 1 – 25, page 10, lines 1 – 8). The Ex. A advertisement includes an illustration of a t-shirt together with the notation "EXCLUSIVE Baby Bomber tees" and "Support the Baby Bombers".

Registrations for BOMBERS marks on clothing

Of record are 17 third-party registrations for marks including BOMBER(S) in connection with clothing, including the two registrations which were cited by the Examining Attorney in the September 25, 2001 Office Action as follows:

Mark	Registration No.	Goods
THE BAY BOMBERS	2,686,927	Shirts, t-shirts, sweatshirts, sweatpants, sweatsuits, etc.
DESERT BOMBERS	2,528,143	Fleece tops and bottoms, caps, headwear, t-shirts, etc.
BLAKE STREET BOMBERS	2,390,143	Shirts, t-shirts and sweatshirts.
JOURNEYMAN BOMBER	2,369,427	Jackets.

Mark	Registration No.	Goods
BLAKE STREET BOMBERS	2,362,470	T-shirts.
DAYTON BOMBERS (plus design)	2,336,139	Jerseys, jackets, coats, sweatpants, etc.
BLAKE STREET BOMBERS	2,284,314	Hats, t-shirts, cloth bibs, etc.
BLAKE STREET BOMBERS (plus design)	2,265,930	T-shirts, sweatshirts, shorts, sweaters, jackets, etc.
DAYTON BOMBERS (plus design)	2,136,679	Hats, caps, coats, jackets, jerseys, sweaters, shirts, etc.
BOMBERS	2,133,628	Shirts.
BOMBER	2,000,494	Hats.
BLIZZARD BOMBER	1,951,329	Hats.
LIL' BLIZZARD BOMBER	1,949,143	Hats.
LIL MAD BOMBER	1,949,139	Hats.
CURLY BOMBER	1,945,918	Hats.
POLAR BOMBER	1,945,915	Hats.
MAD BOMBER	1,424,002	Fur hats, silk lingerie.

There are additional registered marks and applications for registration of marks including the term BOMBERS in connection with clothing of record which were

produced by Opposers in response to a document request, copies of which are attached to Applicant's Notice of Reliance dated July 14, 2004. For some unknown reason, Opposer's have marked the produced copies of Patent and Trademark Office records dated 8/13/1999 with a "CONFIDENTIAL" stamp and such copies have therefore been filed by Applicant under seal.

ARGUMENT

BABY BOMBERS IS NONDISTINCTIVE

Mr. Getzler testified that BABY BOMBERS is the nickname for the Staten Island Yankees (Getzler TR page 14, lines 9 – 13) and that the press was the first to use the nickname in reference to the team (Getzler TR page 14, lines 19 – 25, page 15, lines 1 – 6).

In sports writer's vernacular, "baby bombers" is descriptive of a minor league or rookie team having potential for explosive play, such as slugging or home run hitting. The phrase "baby bombers" would be apparent to sports fans as a descriptive laudatory nickname and was in fact adopted by the press throughout the country for the Bronx Little League team (Smith TR, pages 17 – 27, Ex. C through N).

The term "bombers" was adopted by the Capital City Bombers baseball team as part of its name (Getzler TR page 61, lines 10 – 19). It is evident that the usage of "bombers" in their name was for describing the team's potential for explosive play.

There is no proof that BABY BOMBERS has become distinctive of the Staten Island Yankees' services, as for example through secondary meaning. Indeed, there is no evidence that the general public would associate BABY BOMBERS with the Staten Island Yankees as opposed to the Little League team which gained nationwide prominence, or even the Capital City Bombers.

The Staten Island Yankees have not obtained a federal registration for BABY BOMBERS, they have not used BABY BOMBERS on any goods and have not licensed BABY BOMBERS for use by others.

Significantly, Opposers acquiesced to the usage of BABY BOMBERS in connection with the nonaffiliated Little League team (Getzler TR page 62, lines 9 – 19, Smith TR pages 17 – 28). The Grand Rapids Press (Smith Ex. L), reported on February 18, 2002 that the Bronx BABY BOMBERS withdrew from the Little League and joined the Pony League.

Of record are more than 17 third party registrations for marks containing BOMBERS in connection with Applicant's goods, i.e. clothing items. Third party registrations are competent to show that others in the clothing industry have adopted and registered marks including the word BOMBERS and BOMBERS is entitled only to a narrow scope of protection. *Henry Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ 2d 1154 (TTAB 1987), in re: *Hamilton Bank*, 222 USPQ 174 (TTAB 1984), *BAF Industries v. Pro-Specialties, Inc.*, 206 USPQ 166 (TTAB 1980), *Plus Products v. Sterling Food Co. Inc.*, 188 USPQ 586 (TTAB 1975).

MR. HART HAD AND CONTINUES TO HAVE A BONA FIDE INTENTION TO USE THE MARK

Mr. Hart's intention to use the BABY BOMBERS mark is clearly set forth in his testimony. As an individual inexperienced in business, he did not have written business plans, market surveys, or other documents pertaining to intended usage which might have been made by an ongoing business establishment in the ordinary course of trade.

Concrete steps to create and introduce a new product are not required, provided there is in fact an intention to use the mark. *McCarthy on Trademarks and Unfair Competition* (4th Ed. 2004, §19:14, page 19 – 40).

One should not expect an individual planning to open a business without prior business experience to engage in activities and generate business records of an ongoing business enterprise.

Mr. Hart conducted limited research with respect to sourcing the goods to be sold under the mark, formed a business corporation and reserved a domain name for marketing goods under the mark.

Mr. Hart did not proceed with further efforts to establish usage of the mark because he was awaiting final approval from the Patent and Trademark Office, i.e. a Notice of Allowance, before incurring the costs involved in bringing products to market.

The requirement for documenting activities evincing an Applicant's intent to use a mark is not found in the Trademark Rules of Practice. Trademark Rule 2.89 (37 CFR

§2.89) presents the requirement for an Applicant to state ongoing efforts to establish usage of a mark (without requiring documentation) only in connection with requests for extension of time to file a statement of use and only after the first extension of time has been granted.

The statutory requirement for an applicant to have a bona fide intent to use a mark was intended to act as a "filter" to bar businesses from filing applications for numerous or an excessive number of marks or the stockpiling of marks in an effort to unfairly preclude competitors. *McCarthy*, *supra.* §19:17, page 19 – 45.

Circumstances which may cast doubt upon an Applicant's bona fide intent to use a mark include:

1. Filing numerous applications for the same mark for more new products than are seriously intended,

2. Filing numerous applications for a variety of marks used on one product,

3. Filing numerous applications for marks including descriptive terms,

4. Filing numerous applications to replace applications which have lapsed for failure to file a Statement of Use,

5. Filing an excessive number of applications in relation to the number of products an Applicant is likely to introduce, and

6. Filing applications unreasonably lacking in specificity in describing the goods. *McCarthy*, *supra.* §19:14, pages 19 –42.

None of these exemplary circumstances, which might indicate that an application was filed without a bona fide intent to use, is present. Some of these factors were alluded to in *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1504, wherein it was asserted that the applicant filed various applications to register two marks for many goods in many classes.

Opposers have suggested that because the Answer to the Amended Notice of Opposition did not respond to paragraph 11, Opposers' contention with respect to the Applicant's bona fide intention was admitted, i.e. did not have to be proven.

The lack of response to paragraph 11 was an obvious typographical oversight. The Answer to the Amended Notice of Opposition included a request for judgment dismissing the opposition. Rule 8(f) FRCP provides that all pleadings shall be so construed as to do substantial justice.

More significant is the fact that the issue was fully tried by consent. Both Opposer and Applicant submitted testimony on the issue. See Opposer's First and Second Notices of Reliance dated May 13, 2004 and Hart TR.

Rule 15(b) FRCP provides that when issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings.

SUMMARY

The opposition should be dismissed because Mr. Hart's bona fide intent to use the mark has been clearly established and the term BABY BOMBERS is more readily associated in the minds of the public with the Little League team than with the Staten Island Yankees.

Dated: January 7, 2005

Respectfully submitted,
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CERTIFICATE OF SERVICE

A true and correct copy of the Applicant's Brief is being mailed, first class, postage prepaid to attorney for Applicant this 7th day of January 2005:

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