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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

New York Yankees Partnership and Staten Island Minor League Holdings, L.L.C.
v.
Leon P. Hart.

Opposition No. 91156780
to application Serial No. 76288971

Richard S. Mandel of Cowan, Liebowitz & Latman, P.C. for New York Yankees Partnership and Staten Island Minor League Holdings, L.L.C.

Seth Natter of Natter & Natter for Leon P. Hart.

Before Quinn, Drost, and Zervas, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 23, 2001, Leon P. Hart (applicant) filed an intent-to-use application to register the mark BABY BOMBERS in standard character form on the Principal Register for "clothing and athletic wear, namely, shirts, shorts, pants and hats" in Class 25.

On June 11, 2003, New York Yankees Partnership and Staten Island Minor League Holdings, L.L.C. (opposers) filed a notice of opposition to the registration of applicant's

mark on the ground that applicant's mark is likely to cause confusion with opposers' registered and common law marks. Opposers rely on Registration No. 2,595,266 for the mark BRONX BOMBERS in standard character form for "costume jewelry pins; lapel pins" in Class 14, "figurines made of porcelain" in Class 20, "decorative plates" in Class 21, and "sporting goods, namely, baseball bats" in Class 28. The registration issued July 16, 2002, and it contains a disclaimer of the term "Bronx." Furthermore, opposers allege that "the NEW YORK YANKEES team has been commonly known and referred to by the press, media, fans, and public by the name BRONX BOMBERS, BOMBERS and BABY BOMBERS, in addition to its names NEW YORK YANKEES and YANKEES." Notice of Opposition at 2. Opposers also allege that the "STATEN ISLAND YANKEES club is a Minor League team affiliated with the NEW YORK YANKEES club. In recognition of the relationship with the renowned NEW YORK YANKEES, the STATEN ISLAND YANKEES club has been known as and has adopted the name BABY BOMBERS." Id.

Applicant has denied the salient allegations of the notice of opposition.[1]

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[1] Opposers subsequently amended their notice of opposition to add an additional ground that applicant did not have a bona fide intent to use the mark in commerce. Because of our disposition of the likelihood of confusion issue, we do not need to reach this other ground for opposition. We add that this application has also been opposed by a third party in Opposition No. 91156641. Judgment by default was recently granted against applicant in that case.

The Record

The record consists of the pleadings, the file of the involved application; opposers' testimony deposition of Josh Getzler, Chief Operating Officer of Staten Island Minor League Baseball, L.L.C., with exhibits; opposers' testimony deposition of Howard Smith, the head of licensing for Major League Baseball Properties, Inc., with exhibits; opposers' stipulated testimony of Colin Hagen, Vice President of Major League Baseball Properties, Inc., with exhibits; portions of applicant's discovery deposition filed by opposers' notice of reliance; applicant's testimony deposition with exhibits; and several notices of reliance by opposers and applicant on articles and trademark applications and registrations.

Priority

An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit." Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).[2]

[2] Because of the linguistic and functional similarities of the opposition and cancellation provisions of the Lanham Act, "we construe the requirements of those two sections of the Lanham Act consistently." Ritchie, 50 USPQ2d at 1025 n. 2.

Opposers have submitted status and titles copies of Registration No. 2,595,266 for the mark BRONX BOMBERS. This registration establishes opposers' standing and their priority. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Opposers have also submitted evidence that they have used the mark BABY BOMBERS in association with the Staten Island Yankees minor league team and that the New York Yankees have been referred to as the "Baby Bombers." To determine if opposers have priority for their common law rights in the term "Baby Bombers," we look at opposers' and applicant's priority dates. Applicant has not submitted any evidence on the subject of its priority so it can rely on the filing date of its intent-to-use application (July 23, 2001) as its priority date. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991). Opposers have submitted evidence that they have used the term "Baby Bombers" to refer to their minor league team and that the term has been used by the press to refer to both the minor league team and the New York Yankees. See Opposer's Third Notice of Reliance, e.g., *New York Post*, July 19, 1990 ("'They're going out and playing hard, and I think that is contagious,' Merrill said of the baby

Bombers"); *Bergen Record*, August 12, 1990 ("Baby Bombers in Lost Season"); *Newsday*, August 20, 1990 ("The so-called kids, who aren't all that young, were similarly pleased. And it was appropriate on a day when the Yankees passed out posters of the 'Baby Bombers'") and Getzler Ex. 12, 0001-0002 ("The Baby Bomber Bulletin – The Official Newsletter of the Staten Island Yankees" 1999); Ex. 13, 0008 ("The Baby Bomber Bulletin" 2000 – "This newsletter allows Baby Bomber fans to keep up with the SI Yanks").

The evidence of record, of which the few examples above are just a small sample, shows that opposers have used the term BABY BOMBERS and the term has been associated with opposers, prior to applicant's priority date. National Cable Television Association v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) ("Moreover, even without use directly by the claimant of the rights, the courts and the Board generally have recognized that abbreviations and nicknames of trademarks or names used *only* by the public give rise to protectable rights in the owners of the trade name or mark which the public modified").

However, we also note that to establish priority, a party must demonstrate that its mark is distinctive.

> Under the rule of Otto Roth, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his

> goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (full citation added).

We will discuss the question of whether the term BABY BOMBERS is distinctive in the final section of the opinion.

Likelihood of Confusion

We now address whether the mark BABY BOMBERS for clothing and athletic wear, namely, shirts, shorts, pants and hats is confusingly similar to opposers' identical mark when used in association with opposers' entertainment services involving baseball games.[3]

In likelihood of confusion cases (Section 2(d)), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The first factor we consider is the similarity or dissimilarity of the marks. Applicant seeks registration for the mark BABY BOMBERS and opposers use the identical

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[3] We will concentrate on the identical marks BABY BOMBERS and discuss opposers' BRONX BOMBERS mark in the context of the BABY BOMBERS mark.

mark in association with the minor league team known as the Staten Island Yankees. Clearly, the marks are identical in sound and appearance.

Regarding the meaning and commercial impression of the marks, we start by noting that the evidence shows that the term BABY BOMBERS is associated with the mark BRONX BOMBERS. Besides the registration for that term (No. 2,595,266), opposers have submitted evidence that the term BRONX BOMBERS has acquired significant recognition and renown as a term that refers to the New York Yankees. Opposers' witness from Major League Baseball Properties, Inc. (Colin Hagin) testified (p. 2) as follows:

> The NEW YORK YANKEES club is one of the most successful sports franchises in the history of the United States, having made thirty-nine appearances in WORLD SERIES championship games and won twenty-six WORLD SERIES titles. Many of the greatest and most famous MAJOR LEAGUE BASEBALL players are known for their accomplishments while members of the NEW YORK YANKEES club, including such members of the national Baseball Hall of Fame as Babe Ruth, Lou Gehrig, Phil Rizzuto, Joe DiMaggio, Reggie Jackson, Yogi Berra and Mickey Mantle. Since 1990, approximately 30 million people have attended YANKEES games played at other stadiums. In addition to its sports entertainment services, the NEW YORK YANKEES club is now and long has been widely known in the United States for its wide variety of merchandise, including, but not limited to, shirts, caps and other apparel.

In addition to being known as the New York Yankees and the Yankees, the "team has been commonly known and referred to by the press, media, fans and public by the nickname BRONX BOMBERS." Hagen stipulated dep. at 2. The witness

identified an entry from *The New Dickson Baseball Dictionary* (1999) that defined the term Bronx Bombers as: "A nickname for the New York Yankees that first became popular in the 1930s when heavyweight boxing champion Joe Lewis was known as the Brown Bomber. The term connotes a team that hits many home runs and is still in common use when referring to the Yankees." A sample of the evidence supporting the argument that BRONX BOMBERS refers to the New York Yankees includes: *Sporting News*, October 1, 1936 (Article about the 1936 World Series referring to the Yankees as the Bronx Bombers); *Sporting News*, September 19, 1964 ("This was far below 1962, when L.A. finished fourth and the Bronx Bombers attracted 412,312 of the Angels total attendance of 1,144,063"); *Washington Post*, March 12, 1978 ("If the Bronx Bombers don't watch out, they will become as sane and dull as their drably brilliant forebearers"); *Newsweek*, January 23, 1978 ("Joseph V. McCarthy, 90, the crusty manager who led the New York Yankees to triumph in seven World Series… During his fifteen years in the Yankee dugout, 'Marse Joe' piloted the Bronx Bombers to eight pennants"); *New York Times*, August 15, 1988 ("The Yankees – the Bronx Bombers – may move to New Jersey one day, after all"); *Atlanta Journal and Constitution*, December 29, 2000 ("On the night the New York Yankees won the World Series, a hacker got into the Yankees' Web site and printed a derogatory remark about the

Bronx Bombers; the site froze like that for hours”). Mr. Hagin also submitted numerous examples of the use of Bronx Bombers in association with various New York Yankees merchandise. See Hagin Exhibits 2-11.

The Staten Island Yankees commenced operations in 1999. Getzler dep. at 12. The witness (p. 14) indicated that “Baby Bombers” is a nickname for the Staten Island Yankees. Furthermore, the witness explained (p. 15) that the “New York Yankees are the Bronx Bombers. That’s their – one of their nicknames, and it is an associative term between the major league club and the minor league club, and, you know, it has a ring to it and its alliterative and it makes sense that when referring to us, you know, whether it’s in a headline or an article or, you know, our own material, that rather than referring to us as the Staten Island Yankees, Staten Island Yankees, Staten Island Yankees all the time, that you create a secondary nickname and use it.”

Mr. Getzler explained (p. 16) that the name “Baby Bombers” has been used on everything from the name of our kids’ club to use in both public and private letters. By public I mean letters to many thousands of people from our mailing list. It’s been used in our program, yearbook. It’s been used in press releases.” The Getzler exhibits demonstrate widespread use of the term by the Staten Island Yankees. See, e.g., Getzler Exhibits 20, 0024 (Ad – “[W]e

urge you to take mass transit when you come out to see the Baby Bombers"); 24 (Radio Spot – "Opening night is June 20 [2000] at 7 PM against the Vermont Expos, and tickets … are on sale at the Baby Bombers' offices"); 30 (September 13, 1999 Letter to Season Ticket Holders – "From Opening Night festivities … to the Baby Bombers' mid-August run toward the playoffs"); 32 (2000 Program – "The Baby Bombers' staff hopes you'll find it to be a comfortable, convenient, and friendly place to watch the major leaguers of tomorrow"). Indeed, Mr. Getzler testified that they even considered the name Baby Bombers as the official name of the minor league team. The term (pp. 14-15) was "on the short list of names that we had thought of for the team, so we had thought of the term 'Baby Bombers' initially, but even without us doing anything publicly about it, the press took the term 'Baby Bombers' and started using it as well."

We add that Mr. Getzler's testimony regarding the use by the press of the name "Baby Bombers" to refer to the Staten Island Yankees team is supported by numerous articles that have been made a record. A sample of these articles follows: *New York Post* dated July 16, 1999 (Baby Bomber' Righty Growing Up Fast – While the Single-A State Island Yankees were struggling…"); *New York Post* dated August 6, 1999 ("MTV troublemaker Tom Green was abruptly unplugged at a Staten Island Yankees game the other night, after he

harassed the Baby Bombers…"); *Daily News (New York)*, June 21, 2000 ("The Baby Bombers - Don't tell Staten Island its team is minor league"); *Bergen Record* dated August 13, 2000 ("The Yankees have shipped first baseman Jeff Leaumont … to Staten Island to add punch to the Baby Bombers lineup"); *Village Voice* dated October 3, 2000 ("When the Staten Island Yankees move into their new waterfront digs next year, perhaps the Baby Bombers will be able to compete with the closeness and minor-league atmosphere of the Long Island Ducks"); and *Daily News (New York)*, May 15, 2001 ("The New York-Penn League Champion Baby Bombers will open their new $79 million, publicly funded ballpark").

The evidence convinces us that the meaning and the commercial impression of applicant's and opposers' term BABY BOMBERS would also be identical to the extent that the mark, when used with a minor league baseball team and on athletic clothing including hats and shirts, suggests an association with the New York Yankees, who are also known as the Bronx Bombers.

When both parties are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). The Federal

Circuit has noted that "[w]ithout doubt the word portions of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of words, connotation, and commercial impression weighs heavily against the applicant." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Here, the identical nature of the marks is a factor that strongly supports opposers' position.

Next, we consider whether applicant's goods and opposers' services are related. Applicant's goods are clothing and athletic wear, namely, shirts, shorts, pants and hats. We must consider the goods as they are identified in the identification of goods in the application. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). We do not read limitations into the identification of goods and clearly applicant's athletic wear including hats and shirts would include baseball hats and shirts. Opposers' services include entertainment services in the nature of baseball games. Furthermore, opposers have used the name of their minor league team on various clothing items. Getzler dep. at 78 ("we have accepted licenses for different garments that contain our name"); Getzler Ex. 31 (Staten Island

Yankee Merchandise: Get your Baby Bomber gear now at our on-site Team Shop, or on line at www.siyanks.com. The Team Shop offers a full line of Staten Island Yankees caps, apparel, accessories, and more! New items are added all the time, so stop by or log on”). While the witness indicated (pp. 78-79) that it had not used the mark Baby Bombers itself on these goods, it is clear that it is the source of clothing including caps and apparel and that it has used the mark BABY BOMBERS in association with its baseball services and the sale of apparel.

“In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources.” McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). Here, inasmuch as opposers are the source of various clothing items and that it is also the source of baseball services and that applicant intends to use the mark on athletic clothing including hats and shirts, consumers are likely to assume that there is some association between the source of

these goods and services. Therefore, applicant's and opposers' goods and services are related.

Some of the other factors we consider are the channels of trade and prospective purchasers. Here, we have evidence that patrons of baseball games would also expect that the team would sell apparel associated with the team. Indeed, patrons at opposers' baseball games would see that opposers are the source of goods that overlap with applicant's goods ("The Team Shop offers a full line of Staten Island Yankees caps, apparel, accessories, and more"). Customers of baseball services and athletic hats and shirts would at least overlap and they would likely also be exposed to the sale of hats and shirts, as general consumer items in other channels of trade. In addition, neither the prospective purchasers of these goods and services would be sophisticated or careful purchasers. Therefore, these factors do not eliminate or even diminish the likelihood of confusion and these factors favor opposers.

In response to opposers' position concerning the likelihood of confusion, applicant maintains (p. 10) that its mark "Baby Bombers is nondistinctive… In sports vernacular, 'Baby Bombers' is descriptive of a minor league or rookie team having potential for explosive play, such as slugging or home run hitting." Applicant points out and opposers' witness (Getzler dep. at 61) has acknowledged that

another minor league is known as the Capital City Bombers. Applicant also argues that others have adopted the word Bombers and registered the mark for clothing. Applicant seems to be arguing that opposers' BABY BOMBERS mark is descriptive of a sports team and that it is also a weak mark. We will address both points.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218.

In this case, the evidence does not show that potential patrons of opposers' services will immediately associate the term BABY BOMBERS with a quality or characteristic of opposers' services. First, the fact that another sports

team has adopted the word "Bombers" as part of its team name hardly establishes that the term is descriptive. Indeed, the opposite is just as likely to be true, i.e., that the term was chosen to serve a trademark function as in the term NEW YORK YANKEES for a New York baseball team known as the Yankees.

Second, we note that the record clearly establishes that the term Bronx Bombers is a term that refers to the New York Yankees. Indeed, even the evidence about a Little League team occasionally referred to as the "Baby Bronx Bombers" in some press articles only appears to reinforce the connection with the New York Yankees, who also play in the Bronx, as opposed to demonstrating that the mark is descriptive. When a sporting goods retailer applied to register the term BABY BRONX BOMBERS, opposers' witness personally called the retailer and objected to this application. Smith dep. at 10-11. The record does not indicate that the term ever registered.

Third, the evidence shows that the term "Baby Bombers" has been overwhelmingly used to refer to either opposers' Staten Island Yankees or New York Yankee teams or players. This evidence that the term identifies a specific Major League team and/or its minor league affiliate contradicts applicant's argument that the term describes *any* rookie or minor league team associated with explosive play.

Therefore, we conclude that opposers' BABY BOMBERS mark is not descriptive. Furthermore, because we hold that the term is inherently distinctive, opposers clearly have priority for use of the term for baseball services as indicated earlier.

Regarding applicant's suggestion that other registrations indicate that opposers' mark BABY BOMBERS is weak, it is clear that none of the evidence is for the term BABY BOMBERS. Furthermore, "[t]he probative value of third-party trademarks depends entirely upon their usage. E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd., 544 F.2d 1167, 1173 (2d Cir. 1976) ('The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers')." Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Similarly in this case, the evidence does not show that there is widespread use and recognition of the term "Bombers" to refer to third parties. Thus, the evidence does not indicate that opposers' mark BABY BOMBERS is entitled to a narrow scope of protection.

Therefore, we conclude that opposers have priority and if applicant's mark BABY BOMBERS were used on the identified

goods, there would be likelihood of confusion inasmuch as opposers use the identical mark on baseball entertainment services.

Decision: The opposition to the registration of application No. 76288971 is sustained.