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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Madison Square Garden, L.P.

Serial Nos. 75866744 and 75861962

Kathryn Barrett Park, Ayala Deutsch, Anil V. George and Erik J. Levin of NBA Properties, Inc. for Madison Square Garden, L.P.

Christopher L. Buongiorno, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Madison Square Garden, L.P. has filed applications to register the design mark shown below for

clothing, namely, hosiery, footwear, T-shirts, sweatshirts, sweat pants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters belts, ties, nightshirts, hats, warm-up suits, jackets, parkas, coats, cloth bibs, head bands, wrist bands, aprons, boxer shorts, slacks,

caps, ear muffs, gloves, woven and knit shirts (Class 25)¹ and

toys, games and sporting goods, namely basketballs, golf balls, playground balls, sports balls, rubber action balls and foam action balls, basketball nets, basketball backboards, pumps for inflating basketballs, and needles therefore, golf clubs, golf bags, golf putters, golf ball gift sets with divot repair tools, and /or tees and ball markers, golf accessories, namely bag covers, club head covers, golf bag den caddie, golf gloves, golf ball sleeves, stand-alone, electronic basketball table top games, basketball board games, electronic video arcade game machines, basketball kit comprised of a basketball net and whistle, dolls, stuffed toys, jigsaw puzzles and Christmas tree ornaments (Class 28).²



¹ Application Serial No. 75866744, filed December 8, 1999. The application was initially based on an asserted bona fide intention to use the mark in commerce; applicant subsequently filed a statement of use asserting first use and first use in commerce as early as 1999.

² Application Serial No. 75861962, filed December 1, 1999. The application was initially based on an asserted bona fide intention to use the mark in commerce; applicant subsequently filed a statement of use asserting first use and first use in commerce as early as June 2000.

Registration has been refused in both applications pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the ground that the applied-for design does not function as a trademark for the identified goods, but would be viewed as an ornamental feature.

Applicant has appealed. Because both applications involve common questions of law, and essentially the same evidence, we hereby consolidate the appeals and are deciding both in a single opinion.

Applicant and the Examining Attorney have filed briefs in both appeals, but an oral hearing was not requested.³

The Examining Attorney has asserted that applicant's logo, as it is depicted on the specimens, will be perceived as ornamentation and not as a trademark. The Examining Attorney also asserts that applicant has not shown that the logo has achieved secondary meaning in the minds of present-day consumers.

³ In its briefs applicant has requested that the Board take judicial notice of various third-party registrations and evidence from the files of those third-party registrations. The Examining Attorney has objected, asserting that this material is not proper subject matter for judicial notice. We agree. It is well established that the Board does not take judicial notice of registrations that reside in the U.S. Patent and Trademark Office. In re Duofold Inc., 184 USPQ 638 (TTAB 1974).

The specimens showing the manner in which applicant's logo is used are shown below.



First, we note that in its appeal briefs, applicant states that "the primary issue in the current application is whether the proposed mark...functions as a source indicator" and that, "in the alternative the issue is whether the proposed mark functions as a secondary source indicator for the goods identified in the application." Brief, SN 75861962, pp. 4-5; brief, SN 75866744, p.4. However, in response to the first Office action in which the Examining Attorney refused registration on the basis that the logo does not function as a mark, applicant unequivocally stated that "its mark functions as a trademark to identify Applicant as the secondary source of the goods." Applicant never indicated that this claim was being made in the alternative, and that it wished to

preserve its right to assert that the logo functioned as a trademark without regard to the secondary source argument. In view thereof, applicant cannot now argue that its logo inherently functions as a trademark and that consumers, without any other information about collateral uses of the logo, would immediately perceive it to be a trademark as it is used on the identified goods.

In any event, we agree with the Examining Attorney's statement, in the Office actions which first raised the refusal, that the logo, without evidence of secondary source or secondary meaning, would be viewed as mere ornamentation. In this connection, we note the following language, set forth by the Board more than forty years ago in *In re Olin Corporation*, 181 USPQ 182 (TTAB 1973):

It is a matter of common knowledge that T-shirts are "ornamented" with various insignia, including college insignias, or "ornamented" with various sayings such as "Swallow Your Leader". In that sense what is sought to be registered could be construed to be ornamental. If such ornamentation is without any meaning other than as mere ornamentation it is apparent that the ornamentation could not and would not serve as an indicia of source. Thus, to use our own example, "Swallow Your Leader" probably would not be considered as an indication of source.

Therefore, we turn to the question of whether the logo acts as an indicator of a secondary source of the goods,

that is, to indicate not the manufacturer, but the sponsor of the goods. Applicant contends that its logo indicates the New York Knicks basketball team, which is owned and operated by applicant. Accordingly to the evidence submitted by applicant, the logo, known as the "Father Knickerbocker Logo," was the main logo for the basketball team from 1946 to 1964. The logo was developed by a sports cartoonist named William Mullin, who worked for the New York "World-Telegram," and depicts a basketball-dribbling knickerbocker, in a reference to the early Dutch settlers of New York.

The Examining Attorney takes the position that present day consumers would not be aware of the former logo, and therefore would not regard the logo on the goods at issue as a reference to the basketball team and applicant. We do not agree. Applicant has stated that "even after the Knicks adopted a new primary team logo, and throughout its entire life of more than five decades, the Knickerbockers Logo has continued to function as a service mark and trademark to promote the Knicks basketball team and assorted collateral merchandise." Briefs, p. 10.

In support of this statement, applicant has submitted excerpts from its website⁴ which show the logo as part of a history of the Knicks team. In fact, there is an entire article entitled "Why Knickerbockers?", with a subsection entitled "The Logo." This subsection discusses the origin of the logo, and features a depiction of it.

Applicant has also stated that products bearing the logo "are marketed in connection with the NBA's Hardwood Classics program, which commemorates the history and heritage of the NBA and its predecessors through a collection of products and services bearing the logos of its old teams that are marketed to basketball fans interested in the history of the sport and other collectors of memorabilia." Responses dated June 6, 2002. Applicant has submitted a Hardwood Classics brochure which depicts the logo at issue, as well as logos formerly used by other basketball teams. The brochure includes, inter alia, the phrases, "Hardwood Classics apparel and non-apparel collection"; "Now fans and collectors can have jerseys made in the exact styles and fabrications worn by the legendary NBA stars"; and "Hardwood Classics Collectible Basketballs— This Spalding basketball features a timeline with the

⁴ The web pages were printed on April 15, 2002, thus demonstrating current promotion of the logo.

History of your team and interesting facts. Available for Bulls, Celtics, Lakers and Knicks." Applicant has also stated that since 1999, when Knickerbockers' apparel was added to the Hardwood Classics Collection, its apparel sales have been nearly \$2,500,000.

Finally, applicant asserts that its goods will be primarily purchased by, or for, fans of professional basketball interested in memorabilia, the history of the sport and the NBA, and that, before making such purchases, "these fans are extremely familiar with team insignia and logos." Responses dated June 6, 2002.

As the Examining Attorney points out, applicant has given general sales figures for all apparel sold under its Hardwood Classics program, but has not broken out the actual sales figures for apparel bearing the logo at issue, nor has it presented any specific information about sales of the Class 28 products bearing the logo. The evidence that applicant has submitted would not demonstrate that an otherwise ornamental design had acquired distinctiveness as a trademark simply by the use of the design on the goods in question. However, applicant is not claiming this type of acquired distinctiveness. Rather, applicant is claiming that its logo functions as a mark because it shows a secondary source for the goods, a source that consumers

will recognize because they are aware of this use in connection with the New York Knicks basketball team.

Although the applied-for mark is no longer the primary logo for the team, and has not been so for many years, we cannot say that this logo is unknown to consumers today. The evidence is sufficient to demonstrate that the logo is still in use and is promoted. In fact, although neither applicant nor the Examining Attorney has mentioned it, we note that the wording next to the logo on the basketball specimen of use consists of the phrases "Vintage 1946 Logo," "Father Knickerbocker" and "Charter NBA Franchise,"⁵ thus reinforcing that this was the logo of the basketball team. In view of applicant's statements and evidence, we must conclude that sports fans and collectors of memorabilia, the main purchasers of the goods, will be aware of it. Thus, consumers seeing the logo on applicant's identified goods will recognize it as a logo of applicant's New York Knicks basketball team, and will understand that it is a trademark identifying applicant as a secondary source of sponsorship of the goods.

⁵ This wording is almost impossible to make out in the photograph that was submitted, which reduced the size of the entire basketball to approximately one inch in diameter. Therefore, we are not surprised that the Examining Attorney would not have noticed it or commented on it. However, when the actual basketball is viewed by consumers, we have no doubt that the wording would be clearly visible.

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Decision: The refusals of registration are reversed.