

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

WESTERN DIVISION

CIVIL ACTION NO. _____

NAISMITH MEMORIAL)
BASKETBALL HALL OF FAME, INC.,)
Plaintiff,)

vs.)

NAISMITH’S PUB & PRETZEL, INC.,)
Defendant.)

**COMPLAINT AND
DEMAND FOR A JURY TRIAL**

PARTIES

1. Plaintiff, Naismith Memorial Basketball Hall of Fame, Inc. (“Plaintiff”), is a Massachusetts corporation having a principal place of business located at 1000 Hall of Fame Ave., Springfield, MA 01105.

2. Upon information and belief, Defendant, Naismith’s Pub & Pretzel, Inc. (“Defendant” or “NPPI”), is a Massachusetts corporation with a principal place of business located at 25 South Grand Street, West Suffield, CT 06093.

JURISDICTION AND VENUE

3. This case involves deceit as to affiliation; the creation of false origin, sponsorship or approval; dilution; and unfair competition under the provisions of the Lanham Act and the Commonwealth of Massachusetts General Laws.

4. The case in controversy arises under the provisions of the Lanham Act which grant this court original Federal question jurisdiction and jurisdiction pursuant to 15 U.S.C. § 1121(a), § 1125, and 28 U.S.C. § 1331, § 1338(a).

5. This Court also has jurisdiction over related common-law claims for trademark infringement under Massachusetts General Law chapter 110H and for unfair competition under Massachusetts General Laws chapter 93A, § 11, pursuant to 28 U.S.C. §§ 1338(b) and 1367(a).

6. Plaintiff is a Massachusetts non-profit corporation, and, therefore, this Court has personal jurisdiction over it.

7. Upon information and belief, Defendant is a Massachusetts corporation which operates a restaurant named Naismith Pub & Pretzel (the “NP&P”) which is located at 211 Worthington Street, Springfield, Massachusetts, such that this Court has personal jurisdiction over it.

8. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) because the claims asserted by Plaintiff against Defendant arose in this judicial district by virtue of Defendant’s use of the word “Naismith” in connection with Defendant’s restaurant services to create confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Defendant’s restaurant services by Plaintiff, or as to the origin, sponsorship, or approval of the Defendant’s restaurant services by Plaintiff, in this judicial district.

9. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) because the claims asserted by Plaintiff against Defendant arose in this judicial district by virtue of Defendant’s dilution of the Plaintiff’s federally registered and common law marks.

10. Venue is proper in this Court under 28 U.S.C. § 1391(c) in that, upon information and belief, Defendant is doing business in this judicial district.

FACTS

11. Plaintiff is the owner of U.S. Trademark Reg. No. 3,043,191 (“191”) for the mark NAISMITH MEMORIAL BASKETBALL HALL OF FAME (the “191 Mark”), which was registered with the U.S. Patent & Trademark Office (the “PTO”) on January 17, 2006, and which was first used by Plaintiff at least as early as July 1, 1959 on or in association with “educational and entertainment services, namely, a basketball museum and library; basketball games; basketball contests and enshrinement ceremonies.”

12. Plaintiff’s rights in the ‘191 Mark have become incontestable under 15 U.S.C. § 1065.

13. Plaintiff is the owner of U.S. Trademark Reg. No. 5,371,136 (“136”) for the mark NAISMITH BASKETBALL HALL OF FAME (the “136 Mark”), which was registered with the PTO on January 2, 2018, and which was first used by Plaintiff at least as early as September 8, 2017 on or in association with “educational and entertainment services, namely, a basketball museum and library, basketball games basketball contests and enshrinement ceremonies.”

14. Plaintiff is the owner of U.S. Trademark Reg. No. 5,059,647 (“647”) for the mark NAISMITH COACHES CIRCLE (the “647 Mark”), which was registered with the PTO on October 11, 2016, and which was first used by Plaintiff at least as early as September 11, 2015 on or in association with “organizing and conducting basketball contests and enshrinement ceremonies to recognize, chronical and honor exceptional coaches of the game of basketball.”

15. Plaintiff is the owner of U.S. Trademark Reg. No. 5,576,727 (“727”) for the mark NAISMITH ORANGE (the “727 Mark”), which was registered with the PTO on October 12, 2018, and which was first used by Plaintiff at least as early as July 27, 2018 on or in association with “clothing, namely, shirts, jackets, pants, hats and footwear.”

16. Plaintiff is the owner of U.S. Trademark Reg. No. 5,201,075 (“075”) for the mark:



(the “075 Mark”),

which was registered with the PTO on May 9, 2017, and which was first used by Plaintiff at least as early as September 4, 2016 on or in association with “organizing and conducting basketball contests and enshrinement ceremonies to promote the game of basketball and to recognize, honor and honor exceptional players of the game of basketball.”

17. Plaintiff is the owner of U.S. Trademark Reg. No. 5,257,151 (“151”) for the mark:



(the “151 Mark”),

which was registered with the PTO on August 1, 2017 and which was first used by Plaintiff at least as early as September 4, 2016 on or in association with “organizing and conducting basketball contests and enshrinement ceremonies to promote the game of basketball and to recognize, honor and honor exceptional players of the game of basketball.”

18. The word “NAISMITH” forms the dominant portions of the ‘191 Mark, the ‘136 Mark, the ‘647 Mark, the ‘727 Mark, the ‘075 Mark, and the ‘151 Mark (collectively referred to as the “Registered Marks”).

19. Plaintiff is the owner of U.S. Trademark Reg. App. Serial No. 87/731,983 (“983”) for the mark:



(the “983 Mark”),

which was filed with the PTO on December 22, 2017 and which was first used by Plaintiff at least as early as February 1, 2019 on or in association with “education and entertainment services in the field of basketball, namely, organizing and conducting basketball games and tournaments, providing recognition and incentives by way of awards to basketball players and coaches to demonstrate excellence in the field of basketball, organizing and conducting award ceremonies for basketball players and coaches; basketball museum services.”

20. The word “NAISMITH” forms a dominant portion of the ‘983 Mark.

21. Plaintiff runs and operates the Naismith Memorial Basketball Hall of Fame (the “BHOFF”) which is located in Springfield, Massachusetts.

22. Plaintiff has operated the BHOFF under the name NAISMITH MEMORIAL BASKETBALL HALL OF FAME (the “BHOFF Name”) since at least as early as 1959.

23. The “Naismith” portion of the BHOFF Name is taken from James Naismith who created the game of basketball in Springfield, Massachusetts on or around 1891.

24. The BHOFF is a museum that provides exhibits and information on amateur and professional basketball players, coaches, and contributors to the basketball world who are known on both the national and international level.

25. The BHOFF contains over 40,000 square feet of basketball history which includes a full size basketball court.

26. The BHOFF holds an annual enshrinement celebration which includes a week of events that culminates in the BHOFF’s enshrinement ceremony, and which includes VIP galas, awards dinners, and press conferences.

27. The Enshrinement Ceremony inducts renowned basketball players and coaches into the BHOFF.

28. The BHOFF currently holds over 400 inductees including former basketball players Michael Jordan, Shaquille O'Neal, Kareem Abdul-Jabbar, and Larry Bird.

29. Nearly 200,000 people visit the BHOFF each year.

30. On an annual basis, the BHOFF operates over 70 high school and collegiate basketball competitions, nationally and internationally.

31. Plaintiff advertises the museum and its induction and basketball competition services (the "BHOFF Services") under the Registered Marks and the '983 Mark (collectively referred to as the "BHOFF Marks") via Plaintiff's web site located at <http://www.hoophall.com/> (the "BHOFF Website"), via its Facebook account located at <https://www.facebook.com/BBHOFF/> (the "BHOFF Facebook Account"), via a Twitter account located at https://twitter.com/Hoophall?ref_src=twsrc%5Egoogle%7Ctwcamp%5Eserp%7Ctwgr%5Eauthr, (the "BHOFF Twitter Account"), via other social media outlets, and via radio, television, postal mailings, e-mail, and internet outlets.

32. Plaintiff's advertising of the BHOFF Services under the BHOFF Marks occurs on a national and international level.

33. Over the course of the past ten years, Plaintiff has spent approximately \$200,000.00 per year in advertising under the BHOFF Marks.

34. In 2018, Plaintiff spent approximately \$240,000.00 in advertising under the BHOFF Marks.

35. Plaintiff spends approximately \$2,000,000.00 per year in television rights fee value.

36. In 2018, the BHOFF Website had approximately 1,968,803 page views.

37. To date, approximately 97,758 users follow the BHOFF on the BHOFF Facebook Account.

38. To date, approximately the BHOFF has approximately 321,000 followers on Instagram and approximately 64,000 followers on the BHOFF Twitter Account.

39. Upon information and belief, Defendant owns and operates the NP&P under the name NAISMITH PUB & PRETZEL (the "NP&P Name").

40. Upon information and belief, the real estate property upon which the NP&P is established (the "Property") was purchased by Edale Reality, LLC ("Edale Reality") in November 2016.

41. Upon information and belief, Edale Reality is a limited liability company organized under the laws of the Commonwealth of Massachusetts.

42. Upon information and belief, Edward D. Kenney, Jr. (“Mr. Kenney”) is the manager of Edale Reality.

43. Upon information and belief, Edale Realty sold the Property to NPPI.

44. Upon information and belief, Mr. Kenney is the President of NPPI.

45. Upon information and belief, the NP&P offers sandwiches, salads, and libations including craft beers, wine, liquor, and cocktails in a pub-like atmosphere (the “NP&P Services”).

46. Upon information and belief, the NP&P Name was being used by NPPI without Plaintiff’s permission to promote the NP&P Services at least as early as the summer of 2018.

47. Upon information and belief, the grand opening of the NP&P to the general public was on December 8, 2018.

48. The dominant portion of the NP&P Name is the word “Naismith.”

49. Upon information and belief, NPPI acquired the NP&P Name with the intent to trade off the goodwill established by Plaintiff in the BHOF Name and to draw customers to the NP&P.

50. NP&P is approximately a 1.3 mile drive from the BHOF.

51. Upon information and belief, the NP&P has images and/or illustrations of James Naismith displayed throughout.

52. Upon information and belief, the NP&P has images of basketball players throughout, and also displays a variety of vintage and modern basketball paraphernalia throughout.

53. Upon information and belief, the NP&P has screens upon which basketball games are viewable by patrons.

54. Defendant’s use of the name “Naismith” in the NP&P Name and its reference to James Naismith, its display of basketball paraphernalia, and its showing of basketball footage in combination with the NP&P Name, creates confusion, causes mistake, or deceives as to the affiliation, connection, or association of the NP&P Services with Plaintiff.

55. Defendant's use of the name "Naismith" in the NP&P Name and its reference to James Naismith, its display of basketball paraphernalia, and its showing of basketball footage in combination with the NP&P Name, creates a false association between Plaintiff and Defendant, wherein such false association is intentionally created by Defendant.

56. On or about July 26, 2018 through on or about January 15, 2019, BHOF, through counsel, sent a series of letters to Mr. Kenney and to Alisa Kenney ("Ms. Kenney"), and/or to their legal representative(s), in which NPPI was called upon to remove the word "Naismith" from the name NP&P as it was asserted in the letters that the word "Naismith" is proprietary and owned by BHOF and that NPPI's use of the word "Naismith" on or in association with the NP&P Services creates a false association or affiliation of NPPI with BHOF.

57. Upon information and belief, NPPI is the owner of the naismithpub.com domain name (the "NP&P Domain Name") which was registered with godaddy.com on or about August 8, 2018.

58. The NP&P Domain Name contains the word Naismith, which is the dominant portion of the BHOF Marks.

59. The NP&P Domain Name has been used to host a website (the "NP&P Website") which advertises and promotes the NP&P Services and which displays the NP&P Name without Plaintiff's consent.

60. The NP&P Website contains illustrations of James Naismith and references James Naismith and basketball.

61. Upon information and belief, NPPI advertises, without Plaintiff's consent, the NP&P Services under the NP&P name under a Facebook page accessed via the worldwide web at <https://www.facebook.com/naismithspub/> (the "NP&P Facebook Page").

62. The NP&P Facebook Page contains illustrations of James Naismith and references James Naismith and basketball.

63. Upon information and belief, NPPI began advertising the NP&P Services under the NP&P name via the NP&P Facebook Page on or around February 2018.

64. Upon information and belief, NPPI advertises the NP&P Services under the NP&P name in a variety of ways via the Internet and social media

65. To date, NPPI continues to use the word "Naismith" on or in association with the NP&P Services and without Plaintiff's permission.

COUNT ONE
UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN
UNDER 15 U.S.C. § 1125(a)

66. Paragraphs 1-65 are incorporated by reference as though set forth in their entirety herein.

67. Defendant's unauthorized use of the term "Naismith" in the NP&P Name and the NP&P Domain Name and on the NP&P Website and the NP&P Facebook Page on or in association with the NP&P Services ("NPPI's Use") has a tendency to deceive or to confuse consumers into believing that NP&P is affiliated with Plaintiff, is sponsored or approved by Plaintiff, or is otherwise associated with or authorized by Plaintiff.

68. Such conduct on the part of Defendant demonstrates a willful intent on the part of the Defendant to trade on Plaintiff's reputation and on the goodwill generated by Plaintiff's use of the word "Naismith" in the BHOF Marks and in the BHOF Name.

69. Defendant's acts of unfair competition have caused and are causing great and irreparable injury to Plaintiff and to the services and goodwill represented thereby, in an amount that cannot be ascertained at this time, and, unless restrained, will cause further irreparable injury, leaving Plaintiff with no adequate remedy at law.

70. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendant, restraining further acts of unfair competition and false designation of origin, and to recover attorneys' fees and any damages proven to have been caused by reason of Defendant's aforesaid acts of unfair competition and false designation of origin.

COUNT TWO
DILUTION OF THE '191 MARK BY BLURRING
UNDER 15 U.S.C. § 1125(c)

71. Paragraphs 1-70 are incorporated by reference as though set forth in their entirety herein.

72. The '191 Mark is inherently distinctive and/or has acquired secondary meaning.

73. The '191 Mark, the dominant portion of which is the word "Naismith," is a famous mark as Plaintiff has used the '191 Mark extensively and exclusively for at least approximately 60 years, as Plaintiff has invested a substantial amount of money in the national and international advertising and promotion of the BHOF Services under the '191 Mark in a variety of channels of trade, as the '191 Mark has a wide degree of recognition in its respective trading areas and channels of trade, as the '191 Mark is registered with the U.S. Patent & Trademark Office on the Principal Register, and as the '191 Mark is well-known by the public.

74. NPPI's Use began after the '191 Mark had become famous.

75. NPPI's Use impairs or is likely to impair the distinctiveness of the '191 Mark as the NP&P Name shares the dominant "Naismith" portion of the '191 Mark, the '191 Mark is highly distinctive, Plaintiff engages in substantially exclusive use of the '191 Mark, and the '191 Mark is highly recognized by consumers.

76. Defendant intended to create an association with the '191 Mark as shown by the fact that Defendant displays basketball paraphernalia in the NP&P, has depictions of and references to James Naismith in the NP&P, televises basketball games in the NP&P, makes references to and depicts James Naismith on the NP&P Facebook Page and on the NP&P Website, and as the NP&P is in close geographical proximity to the BHOF.

77. Such dilution by blurring of the Mark was willful on the part of Defendant.

78. Defendant's act of dilution by blurring has caused and is causing great and irreparable injury to Plaintiff and to the services and goodwill represented thereby, in an amount that cannot be ascertained at this time, and, unless restrained, will cause further irreparable injury, leaving Plaintiff with no adequate remedy at law.

79. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendant, restraining further acts of dilution by blurring, and to recover Defendant's profits, attorneys' fees, and any damages proven to have been caused by reason of Defendant's aforesaid acts of dilution by blurring.

COUNT THREE
DILUTION OF THE '191 MARK BY TARNISHMENT
UNDER 15 U.S.C. § 1125(c)

80. Paragraphs 1-79 are incorporated by reference as though set forth in their entirety herein.

81. The NP&P Services are likely to reflect adversely upon the BHOF as Plaintiff has no ability to control the type of menu items featured at the NP&P, the quality of the NP&P Services and/or the atmosphere or ambience of the NP&P.

82. Defendant's act of dilution by tarnishment has caused and is causing great and irreparable injury to Plaintiff and to the services and goodwill represented thereby, in an amount that cannot be ascertained at this time, and, unless restrained, will cause further irreparable injury, leaving Plaintiff with no adequate remedy at law.

83. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendant, restraining further acts of dilution by tarnishment and to recover attorneys' fees and any damages proven to have been caused by reason of Defendant's aforesaid act of dilution by tarnishment.

84. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendant, restraining further acts of dilution by tarnishment.

**COUNT FOUR
DILUTION OF THE BHOF MARKS
UNDER M.G.L. c. 110H, §§ 13 and 16**

85. Paragraphs 1-84 are incorporated by reference as though set forth in their entirety herein.

86. The BHOF Marks, all of which contain the word “Naismith,” as a/the dominant portion thereof, are distinctive of the BHOF Services.

87. NPPI’s Use detracts from, draws on, or otherwise appropriates the good will and reputation associated with the BHOF Marks

88. NPPI’s Use causes the diminution in the uniqueness and individuality of the BHOF Marks.

89. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendant, restraining further acts of dilution.

**COUNT FIVE
UNFAIR COMPETITION UNDER M.G.L. c 93A**

90. Paragraphs 1-89 are incorporated by reference as though set forth in their entirety herein.

91. Defendant is using the BHOF Marks in a manner that misappropriates Plaintiff’s goodwill in the BHOF Marks. Such actions constitute an unfair method of competition and unfair or deceptive acts or practices in the conduct of trade or commerce.

92. Defendant’s participation in these unfair and deceptive acts has occurred primarily and substantially within the Commonwealth of Massachusetts.

93. By engaging in the activities described above, Defendant has engaged in an unfair method of competition and in unfair and deceptive acts and practices in violation of the Commonwealth of Massachusetts Consumer Protection Laws, M.G.L.c. 93A, § 11.

94. Defendant’s acts of unfair competition were willful and knowing and have caused and are causing great and irreparable injury to Plaintiff and to the BHOF Marks and to the products and goodwill represented thereby in an amount that cannot be ascertained at this time and, unless restrained, will cause further irreparable injury, leaving Plaintiff with no adequate remedy at law.

95. By reason of the foregoing, Plaintiff is entitled to injunctive relief against Defendant, restraining further acts of unfair competition, and to recover attorneys' fees and any damages proven to have been caused by reason of Defendant's aforesaid acts of unfair competition.

PRAYER FOR RELIEF

Wherefore, Plaintiff respectfully requests:

1. That Defendant, its agents, servants, employees, representatives, attorneys, subsidiaries, related companies, successors, assigns and all others in active concert or participation with defendant be permanently enjoined and restrained:

A. From using on or in association with the NP&P Services, in any manner, the word "Naismith," or any colorable imitation of the word "Naismith," or anything confusingly similar thereto or likely to cause dilution of the distinctiveness of the word "Naismith," or injury to Plaintiff's business reputation; wherein

1) Defendant is to notify Plaintiff in writing that Defendant has stopped all unauthorized uses of the word "Naismith" in the NP&P Name and the NP&P Domain Name, and on the NP&P Webpage and the NP&P Facebook Page, wherein such use includes the use of the word "Naismith" in Meta tags, caches, and other Web site location identifiers.

B. From representing by any means whatsoever, directly or indirectly, that Defendant, or any products or services offered by Defendant, are associated in any way with Plaintiff or its products or services and from otherwise taking any action likely to cause confusion, mistake or deception on the part of consumers; and

C. From doing any other acts calculated or likely to cause confusion or mistake in the mind of the public or to lead consumers to believe that Plaintiff's products or services come from or are the products or services of Defendant, or somehow sponsored, underwritten by, or affiliated with Defendant and from otherwise unfairly competing with Plaintiff or misappropriating that which rightfully belongs to Plaintiff;

2. That Defendant, its agents, servants, employees, representatives, attorneys, subsidiaries, related companies, successors, assigns and all others in active concert or participation with Defendant, take affirmative steps to dispel such false impressions that heretofore have been created by Defendant's use of the word "Naismith."

3. That Defendant account to Plaintiff for Defendant's profits arising from the foregoing acts of dilution, false designation of origin, and unfair competition.

4. That pursuant to 15 U.S.C. § 1117(a), Plaintiff be awarded for three times the greater of:

- A. Plaintiff's damages, in an amount to be determined at trial; and
- B. Defendant's profits, in accounting demanded in the preceding paragraph.

5. That Plaintiff have and recover its costs, including its reasonable attorneys' fees and disbursements in this action, pursuant to 15 U.S.C. § 1117(a).

6. That pursuant to M.G.L.c. 93A, § 11, Plaintiff be awarded double or treble damages, attorneys' fees, and costs.

7. That Plaintiff be awarded punitive damages pursuant to the law of the Commonwealth of Massachusetts in view of Defendant's intentional and willful infringement of the BHOE Marks.

8. That Plaintiff have such other and further relief as the Court may deem just and proper.

JURY DEMAND

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff demands a trial by jury on all issues so triable.

Dated: March 28, 2019

Respectfully submitted,

/s/ Jesse W. Belcher-Timme

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