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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Esposito

Serial No. 77248477

Scott J. Major of Millen, White, Zelano & Branigan, P.C.
for Shawn Esposito.

Brian Pino, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Cataldo, Bergsman and Ritchie Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Shawn Esposito ("applicant") has appealed from the final refusal of the trademark examining attorney to register the mark DIRT DRIFTERS, in standard character form, for "television show production," in Class 41. The Trademark Examining Attorney refused registration on the ground that DIRT DRIFTERS when used in connection with television show production services is merely descriptive. Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1). In addition, the Examining Attorney contends

that registration should be refused because applicant did not comply with the request for information pursuant to Trademark Rule 2.61(b). During the prosecution of the application, the Examining Attorney required applicant to answer the following questions:

1. Does DIRT, DRIFTERS, or DIRT DRIFTERS have any significance as applied to the goods and/or services other than trademark and/or service mark significance?

2. Does DIRT, DRIFTERS, or DIRT DRIFTERS have any significance in the relevant trade or industry other than trademark and service mark significance?

3. Do the services feature dirt drifting information or are related to the same?

In his December 3, 2008 Request for Reconsideration, applicant contested the descriptiveness refusal and, in the alternative, requested registration on the Supplemental Register.¹

The appeal has been fully briefed.

A. Whether DIRT DRIFTERS is merely descriptive when used in connection with television show production?

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the

¹ The Examining Attorney approved registration on the Supplemental Register.

Trademark Act of 1946, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the

goods or services are will immediately understand the mark as directly conveying information about them (*i.e.*, whether someone familiar with applicant's television production services will understand that the term DIRT DRIFTERS conveys information about the services). *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002).

The Examining Attorney contends that DIRT DRIFTERS "merely describes drifters that perform drifting techniques on dirt; the applicant's services feature such performances."² *Wikipedia* describes automotive "drifting" as follows:

Drifting refers to a driving technique and to a motor sport involving the use of the technique. A car is said to be drifting when the rear slip angle is greater than the front slip angle, and the front wheels are pointing in the opposition direction to the turn (*e.g.*, the car is turning left, wheels are pointed right), and the driver is controlling these factors.³

According to *Wikipedia*, "[d]rifting has evolved into a competitive sport where drivers compete in rear-wheel drive cars to keep their cars sideways as long as possible." Furthermore, *Wikipedia* defines as a "drifter," *inter alia*, as "[o]ne who participates in the drifting (motorsport

² Examining Attorney's Brief, unnumbered pages 8-9.

³ November 13, 2007 Office Action.

(sic))."⁴ Applicant concedes that "[d]irt drifting is a technique used in the sport," but contends that the sport is known as Rally-X or Rally-Cross, not dirt drifting.⁵

To support his argument that DIRT DRIFTERS is merely descriptive, the Examining Attorney submitted the following evidence:⁶

1. An excerpt from applicant's website which provides the following information:

The Dirt Drifters series takes you cross country with the next generation of champion American rally teams. You won't believe their extreme airs & dirty drifts at blazing speeds.

2. An excerpt from *Petersens' 4 Wheel & Off Road* website (www.4wheeloffroad.com) with a heading entitled

⁴ June 3, 2008 Office Action.

⁵ May 13, 2008 Response.

⁶ We did not consider the *Away Days* website (bottledfusion.com) and the *Bootcrusing.com* website, both attached to the June 3, 2008 Office Action. The *Away Days* website is from the United Kingdom and there is no evidence that it is regularly encountered by consumers in the U.S. With respect to the *Bootcrusing.com* website, we are not sure what it is. It appears to be a table of contents for an online forum and as such it is comparable to search engine hit list because it is merely a list with very little information. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007) (GOOGLE® search results that provided very little context of the use of ASPIRINA deemed to be "of little value in assessing the consumer public perception of the ASPIRINA mark"); *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board rejected an applicant's attempt to show weakness of a term in a mark through citation to a large number of GOOGLE® "hits" because the "hits" lacked sufficient context). The examining attorney should have attached copies of the relevant communications to show how DIRT DRIFTERS is actually used.

"Dirt Drifting" featuring photographs of off road vehicles in action.

3. An excerpt from the *Scooby Blog* website (www.scoobyblog.com) with a video feature entitled "Video: All Wheel Dirt Drifting!" displaying a Subaru Impreza driving off road.

4. An excerpt from the *Hondaswap.com* website with a section on the drifting racing and driving technique. The site features "drifting" videos. In the member commentaries, there was a reference to "dirt drifting":

brian (sic), think about it, if dirt drifting puts you through it faster [the turn] why cant (sic) you do the same on pavement if you have enough hp to lose the same amount of traction (sic)

5. An excerpt from the *Velocity Forums* website (velocity-media.net) featuring "drifting" videos. In the member's online forum, there were references to "dirt drifting" and "drifters":

Best drifter car? Peugeot 206 hands down! Dirt Drifting at its finest.

* * *

One of the best drifters in Japan, Nomura Ken, usually wins by using his Skyline ER-34.

6. An excerpt from the online forum of the North American Subaru Impreza Owners Club website (nasioc.com) with references to "dirt drifting":

Then we head out for good old fashion Subaru Jumping contest, followed up with dirt drifting session at an undisclosed location.

* * *

I will be doing some dirt drifting but no jumping for me.

The site also features drifting videos.

7. An excerpt from the Automotive Forums website (automotiveforums.com). The website features "drifting" videos and its members forum contains references to "dirt drifting" and "drifters."

So all drifters can get other drifters input.

* * *

well (sic) i (sic) was actually being pretty serious about my dirt drifting, it was more than just sliding around, i (sic) was practicing a lot of J turns and control e-brake slides.

* * *

lol (sic) yea those zambonies are crazy drifters.

8. Excerpts from the *Rally America* website (rally-america.com). In what appears to be a blog-type entry, the

writer states that he/she would like to meet racers of any kind, including drifters.

9. An excerpt from the *Drifters 2.0* website (drifting2.com) featuring information about American racers referred to as "drifters."

10. An excerpt from the Virginia International Raceway website (virclub.com). In describing the upcoming GT Live/KONI Challenge, the weekend of October 5-7, 2007, the following drifting event was referenced:

US Drift Shootout: the best amateur and professional drifters competing on the Patriot Course for cash.⁷

11. A chain of messages from the *Drift 411* online forum (drift411.com) where the writers refer to drivers or competitors as "drifters."

As drifters and Road Racers, we need to jump on the oppertunrity (sic) to show that there are better Automotive sports than NA\$CAR since it is on a downward slope.

* * *

It's also the source of why drifters tend to create and join teams apart from the moral, technical, and wrench support it also offers . . .

⁷ See also the *RoushPerformance.com* website posting the same information.

12. A review of the movie *Chasing the Touge: The story of canyon racing in America* in the *Apartment107.com* website.

The film follows drifters, rally racers and tuners who run the canyons and aspire to be break into the world of professional Motorsports.

* * *

The film features never before seen footage from the Falken Tire Pike Peak Hill Climb where pro drifters tackle the world famous hill for the first time in its history as well as other location in the U.S.

13. An excerpt from the *Darksyde Motorsports.com* website announcing that Wanli Performance Tire has become a sponsor of the NOPI Professional Drift Series.

The Wanli S-1088 is a perfect fit for NOPI Professional Drift Series. These tires are a great performance tire, and not to mention they can be purchased at a very reasonable price, which means Drifters can tear through several sets of tires in a single weekend and not break the bank.

14. The list of forums in the *Racing Southwest.com* website, "an online community" dedicated to the automotive world, including a forum for "drifting" inviting "[a]spiring and experienced drifters, come on in!"

15. A personal website accessed through *Geocities.com* entitled "Dirt Drifter Project." The writer refers to the automobile that he uses for drifting as a "dirt drifter."

16. A video posted on *MySpaceTV.com* entitled "Sangudo Dirt Drifters" about high speed cars drifting on a dirt oval.

17. An excerpt from the *DrifterVideo.com* website that posts drift racing videos.

18. Applicant has a video posted on the *Yahoo!Search* website under the title "Drifting at Rim of the World 2005: Dirt Drifters." The video is accompanied by the following text:

Drifting has been the fastest growing form of motorsports in the last few years. The west coast immediately embraced the style and aggression of drifting. It turns out that for many asphalt drifters, the left foot braking and e-brake techniques of WRC rally are their inspiration.

19. An excerpt from the *SportCompactCar.com* website featuring photographs of a "Rally Dodge Srt4 Dirt Drifting."

20. A forum on the *MM Madison Motorsports* website (*mmsports.org*) commenting on the poster's version of a Toyota Camry converted into a dirt car.

Basically Andy, I went to a dirt race track that my brother was in, and some

of those cars are ridiculous (sic) its like dirt drifting, only I think the drifters could learn a thing or two on control from these guys.

* * *

As for drifters learning from dirt track drivers, they probably could learn some, but I'm not sure how much stuff would translate over.

The evidence establishes the following:

1. Drifting is a motor sport.
2. Drifters participate and compete in drifting competitions and exhibitions.
3. Dirt drifting is drifting on dirt roads.

The term "dirt drifters," therefore, means people who compete and participate in dirt drifting activities (e.g., competitions, exhibitions and for fun). Accordingly, we find that the term DIRT DRIFTERS, when used in connection with "television show production" (which is broad enough to encompass television shows about dirt drifting) immediately informs the purchaser, without any need for a multistep reasoning process, that the subject of the television show is dirt drifting and its participants. *See Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1999 (TTAB 1986) (SYSTEM USER is merely descriptive for a

publication in the field of data processing because people in the field are referred to as "system users").⁸ See also *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (LAWYERS.COM is generic for an online database in the field of law, legal news and legal services because lawyers are a necessary part of such services); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001) (MAJOR LEAGUE UMPIRE is merely descriptive of products designed and used by major league umpires); *In re E. I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (OFFICE MOVERS, INC. used in connection with moving services is so highly descriptive that it is incapable of functioning as a mark); *In re Carmel Manufacturing Co., Inc.*, 222 USPQ 1031, 1032 (TTAB 1984) (MOUNTAIN CAMPER is merely descriptive of retail and mail order services in the field of outdoor equipment and

⁸ However, the Board held that SYSTEM USER was not generic for a publication because there was no evidence showing that persons in the industry would refer to a publication about data processing as a SYSTEM USER. *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d at 1999. See also *Int'l Assn. of Fire Chiefs v. H. Marvin Ginn Corp.*, 782 F.2d 987, 228 USPQ 528, (Fed. Cir. 1985) (while FIRE CHIEF may be descriptive of a magazine in the field of fire fighting, it is not generic because FIRE CHIEF does not refer to a class of fire fighting publications); *In re Management Recruiters International, Inc.*, 1 USPQ2d 1079, 1080 (TTAB 1986) (even though SALES CONSULTANTS for employment agency services may be merely descriptive, it is not generic); *In re Failure Analysis Associates*, 1 USPQ2d 1144, 1146 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES is merely descriptive for a business rendering failure analysis investigations, but it is not generic).

apparel because the mark identifies the category of purchaser to whom the applicant sells).

Applicant contends, on the other hand, that

DIRT DRIFTERS is a play on the industry term of art "dirt drifting" and is suggestive of the primary focus of applicant's production - - the participants in Rally-X racing, their real-life stories, and their adventures as they "drift" from town-to-town.⁹

However, the very fact that the "primary focus of applicant's production" is the participants in dirt drifting events (*i.e.*, the subject of the television shows) makes the mark DIRT DRIFTERS merely descriptive.

In view of the foregoing, we find that the mark DIRT DRIFTERS is merely descriptive of television show production services.

B. Whether applicant complied with the Examining attorney's requirement to provide information?

As indicated above, in the first Office Action, the Examining Attorney required applicant to answer the following questions:

1. Does DIRT, DRIFTERS, or DIRT DRIFTERS have any significance as applied to the goods and/or services other than trademark and/or service mark significance?

⁹ Applicant's Brief, p. 2.

2. Does DIRT, DRIFTERS, or DIRT DRIFTERS have any significance in the relevant trade or industry other than trademark and service mark significance?

3. Do the services feature dirt drifting information or are related to the same?

In his May 13, 2008 Response, applicant explained that "dirt drifting" is a technique used in Rally-X or Rally-Cross, "dirt drifting" is not the name of the sport, and racers are called Rally-X drivers, not "dirt drifters" or "drifters."

Despite applicant's explanation, the Examining Attorney repeated, and made final, the requirement for applicant to answer the following questions:

1. Does DIRT, DRIFTERS, or DIRT DRIFTERS have any significance as applied to the goods and/or services other than trademark and/or service mark significance?

2. Does DIRT, DRIFTERS, or DIRT DRIFTERS have any significance in the relevant trade or industry other than trademark and service mark significance?¹⁰

Applicant repeated the explanation in his December 3, 2008 Request for Reconsideration and, in the alternative,

¹⁰ June 3, 2008 Office Action.

agreed to amend the application to the Supplemental Register if the mark was found to be merely descriptive.

There is no dispute that the Examining Attorney may require an applicant to provide information regarding the goods and services identified in the application pursuant to Trademark Rule 2.61(b). The rule reads as follows:

The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.

In response to the Examining Attorney's inquiry as to the significance of the words "dirt," "drifters," and "dirt drifters," applicant provided the following information:

1. "Dirt drifting" is a technique used in Rally-X or Rally-Cross;
2. "Dirt drifting" is not the name of the sport;
and,
3. Racers are called Rally-X drivers, not "dirt drifters" or "drifters."

We find that applicant has fully complied with the request for information and, therefore, the refusal to register the mark on this ground is not well taken.

Decision: The refusal to register the application on the ground that applicant did not comply with the Examining Attorney's request for information pursuant to Trademark Rule 2.61(b) is reversed.

The refusal to register the application on the ground that the mark DIRT DRIFTERS is merely descriptive for "television show production" services is affirmed.

In view of applicant's amendment to the Supplemental Register contingent upon our decision that the mark is merely descriptive, applicant's amendment to the Supplemental Register is approved and the mark will register on the Supplemental Register in due course.