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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nike, Inc.

Serial No. 77615883

Stephanie Vardavas for Nike, Inc.

Richard F. White, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Quinn, Cataldo and Taylor, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Nike, Inc. filed an application to register the mark
VICTORY RED for "golf club heads; golf club shafts; golf
bags; [and] golf ball markers" (in International Class 28).¹

The trademark examining attorney refused registration
based on applicant's failure to comply with a requirement
to disclaim the term "RED" apart from the mark as used in
connection with applicant's goods. According to the

¹ Application Serial No. 77615883, filed November 17, 2008,
asserting first use anywhere and first use in commerce on
November 1, 2008.

examining attorney, the term is merely descriptive of applicant's goods because the color red appears on the golf equipment.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. We reverse.

Before turning to the merits of the disclaimer requirement, a preliminary matter requires our attention. Applicant, in its request for reconsideration filed February 5, 2010, reiterated its position that the term "RED" is not merely descriptive, but it also referenced for the first time acquired distinctiveness under Section 2(f) of the word "RED" as used in connection with applicant's goods; a declaration setting forth sales figures accompanied the request. In denying the request for reconsideration on March 23, 2010, the examining attorney neither noted nor responded to applicant's reference to Section 2(f). Applicant, in its appeal brief, maintained that the term "RED" is not merely descriptive, but it also stated that even if the Board disagrees, "the word 'RED' in the Mark has acquired secondary meaning and can be allowed for this reason." (Brief, p. 13). The examining attorney, in his brief, addressed for the first time applicant's references to acquired distinctiveness, indicating that

"applicant has not explicitly claimed acquired distinctiveness in the alternative, as to the term RED and it appears that it would be inappropriate to treat the applicant's assertions as such." (Brief, p. 13). In its reply brief, applicant makes no further reference to acquired distinctiveness.

TMEP §1212.02(f)(i) (7th ed. 2010) provides that a claim of acquired distinctiveness may apply to a portion of a mark (a claim of Section 2(f) "in part"). However, neither applicant nor the examining attorney followed the preferred practice when an applicant asserts (or attempts to assert), in the alternative, a claim of acquired distinctiveness, as would appear to be the case herein. An applicant may argue against the merits of a Section 2(e)(1) mere descriptiveness refusal and, *in the alternative*, claim that the matter sought for registration has acquired distinctiveness under Section 2(f). See TMEP §1212.02(c) (7th ed. 2010); and TBMP §1215 (2d ed. rev. 2004). See also *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983). It is applicant's responsibility to make clear that it is taking alternative positions; further, the examining attorney, beginning with his initial silence to applicant's first reference to Section 2(e)(1), failed to clearly state his position with respect to applicant's

apparent attempt to claim, in the alternative, acquired distinctiveness.

As just noted, applicant, in its reply brief, did not dispute the examining attorney's statement in his brief that a Section 2(f) claim was never explicitly raised and, thus, was inappropriate for consideration. In view of the uncertainty with the alternative claim, and the fact that applicant and the examining attorney did not effectively engage on this specific issue, we decline to give it any further consideration. However, as is apparent from our decision on this appeal, the point is moot inasmuch as resort to Section 2(f) is not necessary.

We now turn to the substantive merits of the disclaimer requirement. Applicant argues that the term "RED" is not merely descriptive of its goods that display red color accents. Rather, the term is

inextricably associated with the professional golfer Tiger Woods. His persona is the red Nike shirt. As such the mark as a whole signifies and suggests Tiger Woods and his incredible abilities on the golf course, and evokes an image of victory on the golf course, which then resonates to the goods. The word "RED," when used in the mark VICTORY RED, has its own specific meaning and significance, and is not merely descriptive of the goods

(Brief, p. 1). Applicant highlights the renown of Tiger Woods as the most famous athlete in the world, and his tradition of always wearing a red Nike shirt on the final day of golf tournaments in which he is playing. According to applicant,

the red accents on Applicant's products are used to evoke - just as the use of "RED" within VICTORY RED is used to evoke - the connection of three things: (1) the world class golfer Tiger Woods, (2) his red Nike shirt, and (3) winning the game of golf. The mark VICTORY RED makes consumers imagine Tiger Woods wearing the red Nike shirt, and VICTORY RED suggests to consumers that, with VICTORY RED golf equipment, they too can visualize themselves as powerful, victorious golfers.

(Brief, pp. 4-5). Applicant points out that the amount of the color red used on its products is minimal, and sometimes is non-existent; and that, in any event, red accents are an ornamental touch that serve no purpose other than to suggest to consumers an image of Tiger Woods winning a golf tournament while wearing a red Nike golf shirt. "The clear meaning of 'red' within VICTORY RED is to suggest Tiger Woods and the red Nike shirt that he has made into a sports icon, and to the consumer VICTORY RED means a better golf game. RED in VICTORY RED does not describe an accent of color, it conveys the symbol of Tiger Woods and being the best." (Reply Brief, pp. 5-6).

Applicant has introduced several exhibits in support of its position, including excerpts from printed publications, photographs, and third-party registrations (with file history specimens showing use of each of the registered marks).

The examining attorney maintains that color names like "red" appearing in trademarks may be merely descriptive when used in connection with goods that appear in the named color. In this case, the examining attorney states that the term "RED" in applicant's mark merely describes a characteristic of the goods, namely "that the color RED appears on the applicant's identified golf products." (Brief, p. 4). The examining attorney specifically points to the facts that applicant's golf clubs display a red stripe in the club head cavity or back, and that the stylized letters "VR" are displayed, of which the upper-right corner appears in the color red; according to the examining attorney, "potential consumers considering the purchase of golf equipment are likely to expect Victory Red equipment to feature a color red somewhere on the product." (Final Refusal, 8/6/09). The examining attorney is not persuaded by applicant's argument based on a red shirt worn by Tiger Woods because, in the view of the examining attorney, the connection between the red accent on golf

equipment and Tiger Woods' red golf shirt is not supported by the record. (Brief, pp. 6-8). But, at the same time, the examining attorney states that the color red "is a significant feature/characteristic because as the applicant provides, it is used to 'suggest to the consumer that Tiger Woods endorses the product...'" (Brief, p. 9). In support of the refusal, the examining attorney relied upon two third-party registrations of marks that include the term RED as a portion thereof covering golf equipment, both registrations with disclaimers of RED. On the other hand, the examining attorney discounted the third-party registrations of marks that contain color names (not disclaimed) relied upon by applicant, asserting that each case must stand on its own set of facts. The examining attorney also introduced excerpts of third-party websites showing the color red used as "accents" on golf clubs of applicant's competitors.

The examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act, 15 U.S.C. §1056. This section of the statute was amended in 1962 to allow the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary. See TMEP §1213.01(a) (7th ed. 2010). Merely descriptive or

generic terms are unregistrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

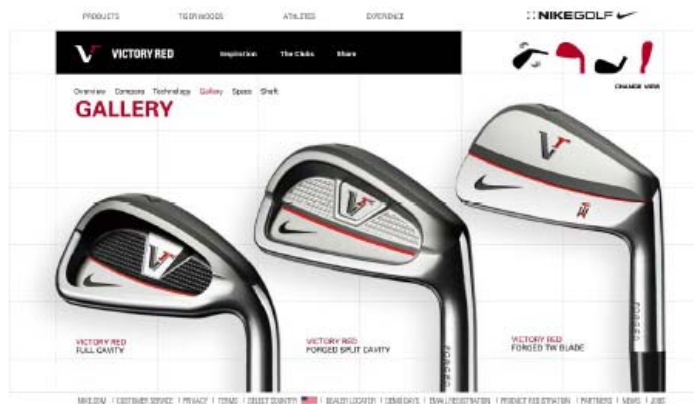
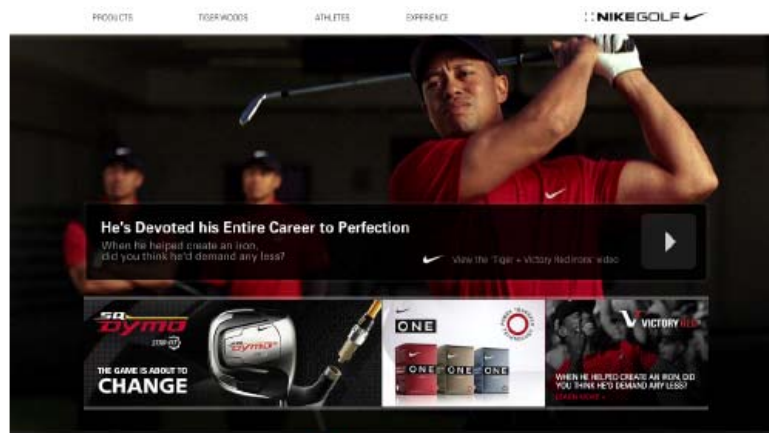
The examining attorney bears the burden of showing that "RED" is merely descriptive of applicant's golf equipment. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A term is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976) (emphasis added). See *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the term must immediately convey information as to the qualities, features or characteristics of the goods and/or services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981). See *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949,

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952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork.

The record is replete with articles (some with photographs) about the accomplishments of Tiger Woods as a professional golfer, and his status as the most famous athlete in the world, and one of the most recognizable celebrities on the planet. The fact that Tiger Woods wears a red shirt on the final day of a golf tournament is commonly known, and this tradition has been well documented by the media and others. (Applicant's request for remand, 5/19/10, Exs. A-Z, AA-MM). The examples include pictures of Tiger Woods in a red shirt on the cover of the video game "Tiger Woods PGA Tour '10," and on the cover of Sports Illustrated magazine for a story about him captioned "Red Alert!". In an article about Tiger Woods at the Masters golf tournament, the author wrote about "[t]he return of the red shirt on the leaderboard in Sunday's final round." (Cleveland Plain Dealer, 4/12/10).

Below is a typical advertisement run by applicant showing Tiger Woods in a red Nike golf shirt, and applicant's golf clubs bearing red accents. This appearance of the color red on applicant's golf equipment is the basis upon which the examining attorney asserts that the term "RED" is merely descriptive of the golf clubs.



Based on the record before us, we find that relevant purchasers will not perceive the term "RED" as merely

describing the golf equipment, even though red may be used as ornamentation on the equipment. We agree with applicant's assessment that its use of the color red on golf equipment is strictly as an accent splash or an ornamental touch. In the words of applicant, this "use of the color red is not prominent or conspicuous, nor is it even a distinguishing feature." (Brief, p. 6). Rather, the color is "simply an ornamental, suggestive touch, used for no reason except to further suggest to the consumer that Tiger Woods endorses the product, and when it comes to him, 'RED' equals victory." (Brief, p. 6). Unlike the situation with some products, there is nothing in the record to suggest that consumers perceive color names as descriptive terms for golf equipment. Simply put, the term "RED" does not merely describe any attribute of the equipment itself; rather, it only names the color that is used as an accent or decorative feature on the equipment. The examining attorney has failed to give appropriate consideration to the full context in which the term "RED" is used as part of applicant's mark VICTORY RED for golf equipment. *In re Ramacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

Consumers will not perceive the term "RED" in the mark VICTORY RED as somehow merely describing the fact that

applicant's goods have a red accent or stripe on them, even though they do. The term "RED," as used in applicant's mark and in the context of applicant's goods, has a greater meaning in context than the fact that the goods display a red accent. Thus, the present case is readily distinguishable, as explained by applicant, from the principal case relied upon by the examining attorney. See *In re The Molson Industries Limited*, 192 USPQ 402 (TTAB 1976) (required disclaimer of "GOLDEN ALE" for ale).

Applicant has introduced numerous third-party registrations and, in each case, a specimen from the file history. As often stated, we are not bound by the prior actions of examining attorneys. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."). Nevertheless, the registrations are illustrative in suggesting that the Office on numerous occasions has not required disclaimers of color names appearing in trademarks, even when the goods display the named color.

Applicant highlights numerous third-party registered marks that include a color name (no disclaimer) for golf

equipment whereon the color is displayed (e.g., BLACK THUNDER for golf clubs that are black or have black accents; RED MAX for golf balls with a red dot; and BLUE MAGIC for blue-colored golf shafts). Applicant states that the examples "show that minor uses of color ornamentation, when used in connection with a suggestive mark containing a color word, do not require a disclaimer when the mark itself is suggesting a greater idea." (Brief, p. 12).

As shown by some of the other registrations, a word in a trademark often conveys ideas that do not describe the product, but instead reference a decorative feature on the goods that evokes the same idea set forth in a word in the trademark. The examples include uses of the words "TIGER" or "SHARK" in marks for products (e.g., fishing rods or sport balls) on which is depicted a representation of a tiger or a shark, respectively. The fact that the word describes a decorative feature on the product does not mean that the word merely describes a characteristic or feature of the goods.

Accordingly, while the term "RED" in applicant's trademark may name the color of ornamentation or accent on applicant's goods, the term does not describe any attribute of the equipment itself. Accordingly, the term "RED" is

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not merely descriptive when used in connection with applicant's golf equipment.

Decision: The refusal to register is reversed.