

**THIS DECISION IS  
NOT A PRECEDENT  
OF THE T.T.A.B.**

Mailed:  
August 22, 2013

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Tatham

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Serial No. 77725646

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Scott W. Kelley of Kelly & Kelley, LLP for William Tatham, Jr.

David Elton, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

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Before Zervas, Wolfson and Hightower, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

William Tatham, Jr. ("applicant") filed an intent-to-use application under Trademark Act Section 1(b), 15 U.S.C. §1051(b), to register the mark GRAND PRIX RUGBY on the Principal Register for "television broadcasting of rugby events and tournaments between rugby leagues" in International Class 38; and "organizing and conducting rugby exhibitions and tournaments between rugby leagues" in

International Class 41. Applicant disclaimed the term RUGBY.

Registration of the proposed mark has been refused on the ground of mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).<sup>1</sup> When the refusal was made final, applicant appealed. The appeal is fully briefed.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (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 merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

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<sup>1</sup> The examining attorney notes that applicant filed a number of similar GRAND PRIX formative marks for similar services; and that the Board affirmed the refusals to register these marks on the ground of mere descriptiveness.

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 those 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 (TTAB 1979).

The examining attorney argues that the wording GRAND PRIX describes the subject matter of the identified services - sporting events played at the highest level of competition. Brief at 7. In support of his refusal, the examining attorney relies on applicant's answers to his questions as to whether applicant broadcasts, organizes or conducts high-level rugby tournaments that may be a part of a series of competitions. Applicant responded:

Applicant endeavors to broadcast, organize and conduct high-level rugby tournaments comparable to the type of playoff systems established by MLB, NFL, NHL, etc.

In addition, the examining attorney refers to the following:

- A. dictionary definitions of "grand prix," including:
- "Important sports competitions: any of various competitions in a variety of sports that have the

same importance and prestige as a Grand Prix in automobile racing." *Encarta Dictionary*, (www.encarta.msn.com); and

- "A high-level competition in another sport (as sailing) that is often part of a series." *Merriam-Webster's Online Dictionary* (www.merriam-webster.com).

B. Third-party registrations where the term "Grand Prix" is either registered on (i) the Supplemental Register, or (ii) the Principal Register under Section 2(f) based on acquired distinctiveness or with "Grand Prix" disclaimed, e.g.:<sup>2</sup>

- FINA GRAND PRIX (Registration No. 2620252 - Principal Register, "GRAND PRIX" disclaimed) for "arranging and organization of water sport events and competitions in the fields of swimming, diving, synchronized swimming, water polo and open water swimming";
- K-1 GRAND PRIX (U.S. Registration No. 2396105 - Principal Register, "GRAND PRIX" disclaimed) for "entertainment services in the nature of martial arts tournaments and boxing contests; educational services, namely, providing training programs and seminars in the field of martial arts; motion picture, television, and videotape production; arranging for ticket reservations for sports and fighting sports events; and publication of books, newspapers, and magazines";
- GRAND PRIX OF DOG AGILITY (Registration No. 2551579 - Principal Register, Section 2(f)) claimed for "entertainment services, namely, competitions in the field of sporting events for

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<sup>2</sup> See *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 n.1 (Fed. Cir. 1987) ("Third-party registrations are admissible and competent to negate a claim of exclusive rights in 'sweats' and the disclaimers are evidence, albeit not conclusive, of descriptiveness of the term."); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006).

animals, and establishing and promulgating international rules for such competitions”;

- COLUMBIA CLASSIC GRAND PRIX (Registration No. 3061842 - Principal Register, “GRAND PRIX” disclaimed) for “entertainment services in the nature of an equestrian sporting event and competition”; and
- GRAND PRIX CARD TOURNAMENTS (Registration No. 2903990 - Supplemental Register) for “entertainment in the nature of card game tournaments.”

According to the examining attorney, this evidence reflects that in light of its common, ordinary definition, namely, “important or high level competitions,” GRAND PRIX is “a descriptive designation not only when applied to automobile racing ... but also when applied to vastly divergent *high level or important competitions* ....” Brief at unnumbered p. 8.

Applicant argues that GRAND PRIX is not descriptive of the identified services because the definition “a high level and/or [an] important sporting competition” offered by the examining attorney is not the primary definition; based on the definitions in the record of “grand prix,” the primary definition of GRAND PRIX means a car race, and a level of imagination, thought, and/or perception is needed to associate “car racing” and the disclaimed term in each mark with the recited services. (Brief at 6 - 7).

Applicant submitted definitions of “grand prix” from, e.g.,

answers.com, askoxford.com and thefreedictionary.com, which define or discuss "grand prix" only as an international road race for sports cars.

Descriptiveness, however, is determined not in the abstract, but in relation to the goods or services for which registration is sought, and that a term may have other meanings in different contexts is not controlling on the issue of descriptiveness. *Bright-Crest, supra*. The fact that a particular definition is not the first listed definition in a dictionary does not mean that a second or third definition is inapplicable or that imagination or thought would be necessary in arriving at a secondary or tertiary definition. Indeed, the definition from encarta.com makes clear that the competition can be in a variety of sports and there is no reason to exclude any of the sports considered by applicant from the definition. Further, the definitions define "grand prix" as important or high level competitions which are not tied to any specific field or discipline. Automobile racing is mentioned only as an example in the encarta.com definition; and applicant has described its services as broadcasting, organizing and conducting high-level rugby tournaments.

Applicant also argues that GRAND PRIX conveys a secondary meaning<sup>3</sup> of "prestige of services," suggesting that by including GRAND PRIX in the proposed mark, it conveys an air of importance or aggrandizement which requires the consumer to have a level of imagination, thought and perception.<sup>4</sup> Brief at 10. Applicant, however, provided no evidence to support applicant's theory of a double entendre. Moreover, even if the record included evidence to establish that "grand prix" had another meaning - e.g., "high level" or "prestigious" in general, regardless of context - then it could be laudatory and as such also merely descriptive. See TMEP §1209.03(k) (October 2012) ("Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1)").

Also on the subject of double entendres, applicant mentions the TENNIS.NET example noted by the Federal Circuit in the case of *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) involving the mark PATENTS.COM. There, the Court discussed a

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<sup>3</sup> We understand applicant's use of the term "secondary meaning" to pertain to its position that the terms present double entendres and not that the terms have acquired distinctiveness.

<sup>4</sup> Applicant relies on a Board decision which was not designated as a precedent of the Board. Decisions which are not designated as precedent are not binding on the Board, but may be cited for whatever persuasive weight to which they may be entitled. TBMP § 101.03 (3d ed. rev. 2012).

hypothetical mark TENNIS.NET which was a "witty double entendre relating to tennis nets," and applicant argues that the TENNIS.NET example is similar to its GRAND PRIX marks "where the secondary meaning of GRAND PRIX conveys an air of importance or aggrandizement" to the term following GRAND PRIX that makes the mark not merely descriptive.

Brief at 11. We disagree. As stated earlier in this decision, we find no double entendre in any of applicant's proposed marks and applicant has not provided any evidence to support its theory of a double entendre.

Applicant also argues that there is a distinction between the types of competitions noted by the examining attorney in which "Grand Prix" is used (equestrian, automobiles, sailing, water sports, dog agility and card games) and rugby matches. Specifically, those noted by the examining attorney involve a course or track with a starting line and a finish line, while those activities which are the subject of applicant's services involve head-to-head competitions on a field where the participants take alternative turns attacking and defending a goal. Reply at 3. In view of this distinction, applicant maintains that a level of imagination, thought or perception is required to associate "Grand Prix" with head-to-head competition events as contemplated by the recited services.

The problem with the distinction that applicant offers is that the dictionary definitions are not limited to or exclude particular activities. As reflected by the dictionary definitions which contain no such restrictions, the consuming public of applicant's services would apply the definition of "grand prix" to either type of competition. There is no reason, and the record does not support the conclusion, that the consuming public would make such a distinction.

In sum, each element of each proposed mark is descriptive and when combined these elements do not lose their descriptive significance. The term GRAND PRIX informs the consumer that the subject matter of the services includes "grand prix" competitions. RUGBY identifies the sport to which the services pertain. It does not take any mental leap to conclude that each of the applied-for terms describes a significant feature of the services. Rather, when used in connection with applicant's services, the proposed mark immediately describes, without need for conjecture or speculation, a significant feature of applicant's services, namely, that the content of applicant's services features "high level" or "grand prix" competitions in rugby.

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**Decision:** The Section 2(e)(1) refusal to register is affirmed.