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Sent: 6/9/2012 1:02:51 PM

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- TATHAM-52228 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77754249

MARK: GRAND PRIX SPORTS



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TTAB INFORMATION:

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the following proposed marks¹ on the ground that the marks are merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

- 1) GRAND PRIX SPORTS (Serial No. 77754249) for "Organizing sports league events, namely, rugby and soccer tournaments."
- 2) GRAND PRIX SOCCER (Serial No. 77754286) for "Organizing sporting league events, namely, soccer tournaments."
- 3) GRAND PRIX SEVENS (Serial No. 77754290) for "Organizing sporting league events, namely, rugby seven tournaments."

¹ Pursuant to the Examining Attorney's Motion to Consolidate, granted by the Trademark Trial and Appeal Board on April 10, 2012, the appeals for Application Serial Nos. 77754249, 77754286, 77754290, 77782796, 77754270 and 77754276 are presented by the Examining Attorney in the same brief.

- 4) GRAND PRIX RUGBY SEVENS (Serial No. 77782796) for “entertainment in the nature of rugby games; organizing sporting events, namely, rugby games and tournaments.”
- 5) GRAND PRIX FOOTBALL (Serial No. 77754270) for “Organizing sporting league events, namely, football tournaments.”
- 6) GRAND PRIX BASKETBALL (Serial No. 77754276) for “organizing sporting league events, namely, basketball tournaments.”

It is respectfully submitted that the refusals be affirmed.

STATEMENT OF FACTS

On June 8, 2009, the applicant applied to register the marks GRAND PRIX SPORTS, GRAND PRIX SOCCER, GRAND PRIX SEVENS, GRAND PRIX FOOTBALL and GRAND PRIX BASKETBALL, and on July 16, 2009, the applicant applied to register the mark GRAND PRIX RUGBY SEVENS. On September 9, 2009, the examining attorney issued non-final Office actions in which registration of applicant’s proposed marks was refused on the principal register on the ground that the marks were merely descriptive of the identified services within the meaning of Section 2(e)(1). The applicant was also required, in each case, to provide an acceptably worded identification of services, to disclaim the terms SPORTS, SOCCER, SEVENS, FOOTBALL, BASKETBALL and RUGBY SEVENS and to provide specimens of use and dates of first use of the marks for Application Serial Nos. 77754249, 77754286, 77754290, 77754270 and 77754276, as this information was omitted from these Section

1(a) applications as filed.² The applicant responded in each case on March 9, 2010, by providing acceptable identifications of services, providing the required disclaimers, and by amending the filing basis in Application Serial Nos. 77754249, 77754286, 77754290, 77754270 and 77754276 to Section 1(b). The applicant also argued in each case against the refusal to register under Section 2(e)(1). On April 12, 2010 (April 6, 2010 for Serial No. 77782796), the examining attorney issued non-final Office actions continuing the refusal to register under Section 2(e)(1), and, in an effort to clarify the record with respect to the meaning of the proposed marks as applied to the services, requiring additional information about the services. On September 29, 2010, the applicant responded by providing the required additional information and by continuing to argue against the refusal to register under Section 2(e)(1). On October 28, 2010, the examining attorney issued final Office actions in which the refusal to register the proposed marks under Section 2(e)(1) was made final. The applicant filed these appeals on April 25, 2011. At that time, however, Applicant's companion Application Serial No. 77831521 for the mark GRAND PRIX ENTERTAINMENT was already on appeal before the Trademark Trial and Appeal Board. Since the issue on appeal in that case was similar to the issue on appeal in the present cases, the examining attorney requested that these appeals be suspended pending the Board's opinion on that appeal. The Board granted the Examining Attorney's request for suspension of these appeals on August 5, 2011. On September 27, 2011 the Board affirmed the refusal to register applicant's proposed mark GRAND PRIX ENTERTAINMAENT on the Principal Register on the ground that it was descriptive of the identified services within the meaning of Section 2(e)(1). The present

² Application Serial No. 77782796 was not subject to the specimen and dates of first use requirement in the first Office action, as this application was based on Section 1(b) as filed.

applications were returned to the Examining Attorney on January 28, 2012 for resumption of the appeals.³

ISSUE

The sole issue on appeal is whether applicant's proposed marks are merely descriptive of the identified services within the meaning of Section Trademark Act Section 2(e)(1).⁴

ARGUMENT

APPLICANT'S PROPOSED MARKS ARE MERELY DESCRIPTIVE OF THE IDENTIFIED SERVICES WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT

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).

³ On November 27, 2011, the examining attorney, upon belief that the Office had adopted the position that the wording GRAND PRIX would not be treated as a descriptive term as applied to the specific sporting disciplines of soccer, rugby, football and basketball, approved these applications for publication. The Office, in fact, had not adopted such a position; therefore, the applications were subsequently withdrawn from publication and returned to the examining attorney for resumption of the appeals. The Examining Attorney offered apologies to the applicant for any inconvenience caused by withdrawal of the applications from publication.

⁴ With the exception of the term GRAND PRIX, applicant has disclaimed all other wording appearing in the proposed marks. Therefore, the descriptiveness of each mark, as a whole, rests on the question of whether the term GRAND PRIX is descriptive of the identified services within the meaning of Trademark Act Section 2(e)(1).

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, 593 (TTAB 1979).

Applicant has applied to register the above referenced series of GRAND PRIX formative marks for organizing sporting events in the nature of rugby, soccer, football, and basketball tournaments. GRAND PRIX is defined as:

- **“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).
- **“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).
- **“Any competitive event or, often, series of events.”** *Webster’s New World College Dictionary*, (www.yourdictionary.com).

The applicant confirmed, through responses to a series of questions⁵ posed by the examining attorney in each of the referenced applications, that the types of sporting competitions it intends to provide through its services are the types of sporting competitions contemplated within the ordinary meaning of the term GRAND PRIX. A representative sample of the questions posed by the examining attorney and the applicant’s responses thereto is provided here for the convenience of the Board:

⁵ The four questions and answers presented in this brief are a representative sample of the questions and answers found in Application Serial No. 77754249. It is noted, for the record, that while the questions and answers appearing here are samples of the questions and answers from Application Serial No. 77754249, the questions and answers in Application Serial Nos. 77754276, 77754270, 77754286, 77754290 and 77782796 are substantially identical.

- Q: At what level of competition will the identified tournaments be played?**
 A: At the highest level possible, both from a domestic and international competition standpoint. Just as Formula One Grand Prix auto racing is the elite event of its kind (Ferrari, Porsche, Maserati, etc.), the goal of Grand Prix Rugby, Basketball, Soccer, etc., is to be the elite events as relating to their respective sports.
- Q: Will any of the identified tournaments involve a high-level of competition in the field of rugby or soccer?**
 A: It is the goal of Grand Prix to provide fans, viewers and gamblers with the highest level of on the field integrity and expertise possible. For example, Grand Prix Rugby will showcase the world's elite union rugby sevens teams from day one, made possible by Grand Prix's Exclusive Sanction, Broadcast and License Agreement with USA Rugby, the nation's governing body for the sport of union rugby. In all likelihood, the international teams competing in Grand Prix Rugby's tournaments shall also comprise each nation's Olympic Rugby Sevens National Team for the 2016 Rio De Janeiro Summer Olympics.
- Q: Will any of the identified tournaments involve a high-level of rugby or soccer competition made up of a series of games, rounds, or contests?**
 A: Yes. It is the goal of Grand Prix to brand its tournaments as played by the world's elite teams and players in regard to the respective sport being branded.
- Q: Will any of the identified tournaments involve rugby or soccer competitions that have, or will have, the same or similar importance and prestige as a Grand Prix in automobile racing?**
 A: It is hopeful that one day the prestige of the applicant's trademarks and brands will have the importance and prestige as the Grand Prix in automobile racing.

Thus the term GRAND PRIX describes a significant feature of the identified services, namely, the subject matter – applicant organizes sporting events in the nature of rugby, soccer, football and basketball tournaments played at a high level of competition.

In further support of the Examining Attorney's position that GRAND PRIX is descriptive of the applicant's services involving the organizing of sporting events – events that the applicant has admitted and confirmed will be played at the highest level of competition – the examining attorney made of record third-party registration evidence consisting of live U.S. Registrations in which GRAND PRIX was either disclaimed, allowed to register on the Principal Register under Section 2(f), or was allowed to register

on the Supplemental Register. Although applicant contends that the primary connotation of GRAND PRIX is its association with automobile racing, it is important to note here that the following third-party registrations, hard copies of which were made of record in the Examining Attorney's final Office actions, are for services involving sporting or gaming events unrelated to automobile racing:

- **FINA GRAND PRIX**

for **“arranging and organization of water sport events and competitions in the fields of swimming, diving, synchronized swimming, water polo and open water swimming”**

(U.S. Registration No. 2620252 - Principal Register, “GRAND PRIX” disclaimed).

- **K-1 GRAND PRIX**

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.”**

(U.S. Registration No. 2620252 - Principal Register, “GRAND PRIX” disclaimed).

- **GRAND PRIX OF DOG AGILITY**

for **“entertainment services, namely, competitions in the field of sporting events for animals, and establishing and promulgating international rules for such competitions.”**

(U.S. Registration No. 2551579 – Principal Register, Section 2(f)).

- **COLUMBIA CLASSIC GRAND PRIX**

For **“entertainment services in the nature of an equestrian sporting event and competition.”**

(U.S. Registration No. 3061842 – Principal Register, “GRAND PRIX” disclaimed).

- **GRAND PRIX CARD TOURNAMENTS**

for “**entertainment in the nature of card game tournaments.**”

(U.S. Registration No. 2903990 – Supplemental Register).

These registrations demonstrate that the Office, in light of the common, ordinary definition, namely, “important or high level competitions,” views the term GRAND PRIX as a descriptive designation not only when applied to automobile racing, as the applicant has suggested should be the case, but also when applied to vastly divergent *high level or important competitions* – swimming competitions, martial arts competitions, dog agility competitions, and even card game competitions among them.

APPLICANT’S ARGUMENTS AGAINST THE REFUSAL TO REGISTER UNDER SECTION 2(e)(1) ARE NOT SUPPORTED BY THE EVIDENCE OF RECORD

In asserting that its proposed mark is not descriptive, the applicant has set forth a number of arguments, none of which are persuasive. The applicant first argues that GRAND PRIX is not descriptive of the identified services because the definition supplied by the examining attorney is not the *primary* definition. Applicant attempted to support this argument by stating that “the primary definition of GRAND PRIX means a car race.” (Applicant’s Brief, Pg. 6). This argument, however, fails when considered in the light of two basic principles of a proper descriptiveness analysis – (1) that descriptiveness is determined not in the abstract, but in relation to the goods or services for which registration is sought, and (2) that a term may have other meanings in different contexts is not controlling on the issue of descriptiveness. The fact that a particular definition is not

the first definition listed in a dictionary for a given term does not mean that said definition is invalid or that it somehow loses all meaning or significance as a definition for said given term. The definitions provided by the Examining Attorney define GRAND PRIX as *important or high level competitions*, separate and apart from any specific field or discipline, such as automobile racing. Applicant's services involve high level sporting competitions. Thus, the definitions supplied by the examining attorney for GRAND PRIX, whether or not they were listed first in the dictionaries⁶ in which they appeared, are the appropriate definitions to apply in determining the descriptiveness of the term GRAND PRIX not in the abstract, but in relation to the identified services. Conversely, while GRAND PRIX may have other meanings in different contexts – contexts unrelated to rugby, soccer, football and basketball competitions – e.g. the meaning of GRAND PRIX in the context of automobile racing, such meanings are not controlling on the issue of descriptiveness.

Applicant also argues that the marks on appeal are not descriptive because some “imagination, thought, or perception is required to reach a conclusion on the nature of the goods.” Applicant attempts to bolster this argument by claiming that “[a] consumer in attendance at an entertainment property of the Applicant would have to do some thought and imagination to combine the meaning of GRAND PRIX (being ‘car racing’) with the meaning of SPORTS⁷ (being ‘activities for exercise’) to associate the GRAND PRIX

⁶ The dictionaries from which the definitions provided by the examining attorney were taken (*Encarta*, *Merriam-Webster's*, and *Webster's New College*) are neither obscure nor obsolete resources.

⁷ The following terms and accompanying definitions therefor, provided by the applicant in the brief for each respective mark, may be used interchangeably for the term SPORTS and definition therefor appearing in this paragraph:

SOCCER – (being “a sport played with a round ball by two teams, usually of eleven players, on a field with a goal at either end”) (Applicant's brief for Serial No. 77754286)

SEVENS – (being “a type or class of sporting competition characterized by the playing of rugby with seven players on a team”) (Applicant's brief for Serial No. 77754290)

SPORTS trademark with the various content, league, and/or tournament the consumer was engaged in.” (Applicant’s Brief, Pg. 7). Applicant’s argument ignores the appropriate definition of GRAND PRIX, namely, *important or high level competitions*, and thus is not persuasive. It does not take any mental leap to conclude that GRAND PRIX SPORTS describes a significant feature of the identified services. Rather, when used in the context of applicant’s services, the phrase GRAND PRIX SPORTS immediately describes, without the need for conjecture or speculation, a significant feature of those services, namely, that they feature *high level* or GRAND PRIX sports competitions.

Applicant also argues that the term GRAND PRIX conveys a secondary meaning⁸ of “prestige of services,” suggesting that the marks convey an air of importance or aggrandizement from the GRAND PRIX portion of the marks to the SPORTS, SOCCER, SEVENS, RUGBY SEVENS, FOOTBALL and BASKETBALL portions. Applicant, however, provided no evidence to support such a double entendre theory. The dictionary definition does not include a more amorphous or generalized meaning of high “prestige” or “aggrandizement” separate and apart from *high level competitions*. Rather, the dictionary definition continues to define GRAND PRIX as a high level competition, which is the subject matter of applicant’s services – applicant organizes high level rugby, soccer, football and basketball competitions.

RUGBY SEVENS – (being “a type or class of sporting competition characterized by the playing of rugby with seven players on a team”) (Applicant’s brief for Serial No. 77782796)

FOOTBALL – (being “a sport played on a field that is 100 yards long, with 2 teams of 11 players and a goal at each end”) (Applicant’s brief for Serial No. 77754270)

BASKETBALL – (being “a sport played between two teams of five players each, the object being to throw a ball through an elevated basket on the opponent’s side of a rectangular court”).

⁸ The Examining Attorney understands applicant’s use of the term “secondary meaning” to refer to an *alternative meaning* that it claims the mark conveys, not to refer to any claim that the mark has acquired distinctiveness – a claim not made by the applicant during prosecution.

Finally, applicant has argued that case law actually supports registration of its proposed marks. The standard is not whether the marks describe the seminal aspects of the goods or services, however. Citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed.Cir.2001), the Court of Appeals in *In re Oppedahl, supra*, stated that "a mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services. The Court found that "patents" merely described a feature of the applicant's software that was identified as, "computer software for managing a database of records and for tracking the status of the records by means of the Internet." Consequently, the Court affirmed the TTAB's finding even though the identification of services did not specifically indicate that the software was for the purpose of managing and tracking *patents*. In that situation, the appellant's website demonstrated that it offered software to record and track patent applications. The Court held that tracking of patents fell within the scope of the goods identified as "tracking records" in the application. Thus, the term "patents" described a feature of the goods offered. Here, the applications are based on an intent to use the marks in commerce. However, the applicant has admitted that its services will include high level, or GRAND PRIX, sporting events. In determining descriptiveness of a mark as it relates to the services, the subject matter cannot simply be ignored. GRAND PRIX is merely descriptive of a feature – the subject-matter – of the services, just as "patents" merely described the applicant's software.

CONCLUSION

Applicant's organizes sporting events in the nature of soccer, rugby, football and basketball competitions, and has confirmed for the record that said sporting events will be

played at the highest level of competition. The term GRAND PRIX is defined as important or high level competitions. Thus GRAND PRIX describes a significant feature of applicant's services, namely, the subject matter – applicant organizes *high level sporting competitions*. Moreover, when combined with the terms SPORTS, SOCCER, SEVENS, RUGBY SEVENS, FOOTBALL and BASKETBALL – terms that describe the specific types of competition - both the individual components and the composite results are descriptive, i.e. the combining of said terms does not create unique, incongruous or nondescriptive meanings in relation to the identified services. In light of the evidence of record and the arguments presented herein, applicant's proposed marks were properly refused registration on the Principal Register under Trademark Act Section 2(e)(1). Accordingly, the Examining Attorney respectfully requests that the Board affirm the refusal to register the proposed marks on the Principal Register under Trademark Act Section 2(e)(1).

Respectfully submitted,

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