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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77754249
Applicant	William Tatham
Applied for Mark	GRAND PRIX SPORTS
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Applicant: William Tatham

Serial No.: 77/754,249  
Mark: GRAND PRIX SPORTS  
Int. Class: 041  
Our Docket: TATHAM-52228

Serial No.: 77/754,276  
Mark: GRAND PRIX BASKETBALL  
Int. Class: 041  
Our Docket: TATHAM-52301

Serial No.: 77/754,290  
Mark: GRAND PRIX SEVENS  
Int. Class: 041  
Our Docket: TATHAM-52299

Serial No.: 77/754,270  
Mark: GRAND PRIX FOOTBALL  
Int. Class: 041  
Our Docket: TATHAM-52302

Serial No.: 77/754,286  
Mark: GRAND PRIX SOCCER  
Int. Class: 041  
Our Docket: TATHAM-52300

Serial No.: 77/782,796  
Mark: GRAND PRIX RUGBY SEVENS  
Int. Class: 041  
Our Docket: TATHAM-52313

Commissioner of Trademarks  
Trademark Trial and Appeal Board  
VIA EFILE

**REPLY BRIEF BY APPELLANT/APPLICANT**

**STATEMENT OF FACTS**

Applicant William Tatham filed the subject U.S. App. Serial Nos. 77/754,249, 77/754,290, 77/754,286, 77/754,276, 77/754,570, and 77/782,796 requesting registration on the Principal Register. The applied-for marks are contemplated to be used for the following services:

- GRAND PRIX SPORTS – “organizing sports league events, namely, rugby and soccer tournaments”;

- GRAND PRIX SEVENS – “organizing sporting league events, namely, rugby seven tournaments”;
- GRAND PRIX SOCCER – “organizing sporting league events, namely, soccer tournaments”;
- GRAND PRIX BASKETBALL – “organizing sporting league events, namely, basketball tournaments”;
- GRAND PRIX FOOTBALL – “organizing sporting league events, namely, football tournaments”; and
- GRAND PRIX RUGBY SEVENS – “entertainment in the nature of rugby games; organizing sporting events, namely, rugby games and tournaments”.

It is respectfully submitted that the marks are not merely descriptive of the recited services and that the refusal to register be reversed.

## **ARGUMENTS**

In the Examining Attorney’s Appeal Brief, the Examining Attorney argued that, “the term GRAND PRIX describes a significant feature of the identified services, namely, the subject matter – applicant organizes sporting events in the nature of ... tournaments played at a high level of competition.” There is a disconnect between the meaning of the GRAND PRIX marks asserted by the Examining Attorney and the recited services. Applicant submits that such disconnect is fatal to the refusal to register.

### **1. The Applied-For Marks Are Not Descriptive of the Recited Services**

“Grand Prix” may sometimes be used in connection with a sporting contest at the highest level of competition. However, there is a distinction between the types of competitions commonly associated with that term and the competitions associated with the services intended

to be used under the applied for marks. In each of the primary examples cited to by the Examining Attorney – equestrian, automobiles, and sailing – the competition relates to a course and determination of the fastest competitor to complete a run of that course. Other cited examples – water sports, dog agility, card games – comprise a field of one competitor against many.

Equestrian competition typically involves one of two types – either individual or simultaneous timed runs through a course or around a track. Car competitions or races typically involve timed runs around a track or through a course, often with multiple laps. Sailing competitions typically involve timed runs through a course defined by buoys or other markers in the water. In each instance, the course or track has a starting line and a finishing line. The common thread in each of these competitions is that each generally involves a field of many participants competing against each other for the fastest time from the starting line to the finishing line.

The sporting competitions involved in applicant’s recited services – rugby, soccer, basketball, and football – are head-to-head competitions between two teams.<sup>1</sup> In contrast to the sports referenced by the Examining Attorney, these types of head-to-head competitions involve matches on a field or court where the participants take alternating turns attacking and defending a goal or zone. These events are often limited in time by chronological means or similar limitations, i.e., innings in baseball or sets in tennis. The aim of the participants in these types of competitions is to get a ball into a goal or zone in order to score the most points within the allotted time.

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<sup>1</sup> Such competitions could also involve individuals competing against each other. Multiple teams or individuals may be involved in a tournament, but each match is still between two teams or individuals with the winner moving on in the tournament to face the winner of another match.

Applicant cannot find and the examining attorney cannot point to a single instance where the term “Grand Prix” has been used in reference to the latter type of competition including head-to-head competition between two teams. The typical sports viewer recognizes the differences between the two types of competitions and would not view the term “Grand Prix” as being descriptive of such head-to-head competitions between two teams or individuals. Examples of some of the more common terms used to describe events in head-to-head competitions at a high level include the following:

- “World Series” – Major League Baseball;
- “Super Bowl” – National Football League;
- “NBA Finals” – National Basketball Association;
- “Grand Slam” – Professional Tennis; and
- “World Cup” – Soccer, Rugby, Baseball, Basketball or Cricket.

Such head-to-head competitions are not described by the term “Grand Prix”.

## **2. A Level of Imagination is Necessary to Make the Leap from “GRAND PRIX” to the Recited Services**

Because the typical consumer, i.e., sports viewer, associates the term “Grand Prix” with racing type events, such does not “forthwith convey an immediate idea” of the recited services. Upon hearing “Grand Prix”, a sports fan would immediately or forthwith perceive a racing event, not the head-to-head competitive events of the recited services. A level of imagination, thought or perception is required to shift the association of “Grand Prix” from racing-type events to head-to-head competition events as contemplated by the recited services.

Because of the need for this logical leap, the term “Grand Prix” is not descriptive of the services recited in each of the subject applications. The term “Grand Prix” is at least suggestive if not fanciful when used in connection with the recited services. Seeing as the term “Grand

Prix” is suggestive/fanciful when used in connection with the recited services, the applied for marks are inherently distinctive. See TMEP §1209.01(a) (suggestive marks are “inherently distinctive” and are immediately “registrable on the Principal Register without proof of acquired distinctiveness” under Section 2(f)). It is well settled that suggestive marks do not have to be devoid of all meaning in relation to the goods and/or services to be registrable on the Principal Register. See *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); TMEP §1209.01(a).

Accordingly, the applied for marks – GRAND PRIX SPORTS, GRAND PRIX SEVENS, GRAND PRIX RUGBY SEVENS, GRAND PRIX SOCCER, GRAND PRIX BASKETBALL, and GRAND PRIX FOOTBALL – are not merely descriptive of Applicant’s recited services, insofar as those services relate to head-to-head competition sports such as rugby, soccer, football and basketball.

### CONCLUSION

In view of the discussion of law and facts above, Applicant’s GRAND PRIX SPORTS, GRAND PRIX SEVENS, GRAND PRIX SOCCER, GRAND PRIX BASKETBALL, GRAND PRIX FOOTBALL, and GRAND PRIX RUGBY SEVENS marks are not merely descriptive of the Applicant’s services and it is therefore respectfully requested that the TTAB reverse the Examining Attorney’s decision and direct the subject applications be advanced to publication.

Dated: June 28, 2012

Respectfully submitted,

*/Scott W. Kelley/*

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