

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

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tatham

Serial Nos. 77754249, 77754270, 77754276, 77754286,
77754290, 77754297, 77754306, 77754327 and 77782796

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

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

Before Zervas, Wolfson and Hightower, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

William Tatham ("applicant") filed the following
intent-to-use applications under Trademark Act Section 1(b),
15 U.S.C. §1051(b), to register the following proposed marks
on the Principal Register:

GRAND PRIX SPORTS (Serial No. 77754249) for
"Organizing sports league events, namely, rugby
and soccer tournaments";

GRAND PRIX FOOTBALL (Serial No. 77754270) for
"Organizing sporting league events, namely,
football tournaments";

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GRAND PRIX BASKETBALL (Serial No. 77754276) for
"organizing sporting league events, namely,
basketball tournaments";

GRAND PRIX SOCCER (Serial No. 77754286) for "Organizing
sporting league events, namely, soccer tournaments";

GRAND PRIX SEVENS (Serial No. 77754290) for
"Organizing sporting league events, namely, rugby
seven tournaments";

GRAND PRIX STUDIOS (Serial No. 77754297) for
"Production and distribution of motion picture
films featuring rugby, rugby sevens, basketball,
soccer and football; production of sports related
radio and television programs featuring rugby,
rugby sevens, basketball, soccer and football, and
production of musical sound recordings" in
International Class 41;

GRAND PRIX ONLINE (Serial No. 77754306) for
"Broadcasting of video and audio programming in
the nature of sports entertainment in the field of
soccer and rugby via the internet";

GRAND PRIX GAMING (Serial No. 77754327) for
"Providing a web-based system and on-line portal
for customers to participate in on-line gaming,
operation and coordination of game tournaments,
leagues and tours in the field of rugby, rugby
sevens, basketball, soccer and football;
conducting and providing facilities for special
events featuring casino and gaming contests,
tournaments, and wagering services in the field of
rugby, rugby sevens, basketball, soccer and
football;" and

GRAND PRIX RUGBY SEVENS (Serial No. 77782796) for
"entertainment in the nature of rugby games;
organizing sporting events, namely, rugby games
and tournaments."

With the exception of the term GRAND PRIX, applicant
disclaimed all other wording appearing in the proposed
marks. The GRAND PRIX ONLINE services are in International
Class 38; all of the remaining services are in International
Class 41.

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Registration of each proposed mark has been refused on the ground of mere descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).¹ When each refusal was made final, applicant appealed. The appeals are fully briefed. Because the appeals involve the same issue and similar records, we hereby consolidate the appeals and decide each appeal in this single opinion.²

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.*,

¹ The examining attorney notes that on September 27, 2011, the Board affirmed the refusal to register a related term, GRAND PRIX ENTERTAINMENT (application Serial No. 77831521 for "Entertainment services in the nature of development, creation, production and distribution of multimedia entertainment content, namely motion pictures, television shows, online media, music, sports and gambling"), on the ground of mere descriptiveness.

² The Board consolidated the appeals for the GRAND PRIX STUDIOS, GRAND PRIX GAMING and GRAND PRIX ONLINE applications on April 17, 2012, and consolidated the appeals for the remaining applications on April 10, 2012. In view of the similar evidentiary records and similar issues in each of the nine applications, we hereby consolidate all nine applications for purposes of this appeal and issue one decision for all nine applications.

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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 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 the following:

A. Information supplied by applicant in response to several questions propounded by the examining attorney, including:

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.

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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 [sic] on the field [sic] 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.

B. 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);

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- "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); and
- "Any competitive event or, often, series of events." *Webster's New World College Dictionary*, (www.yourdictionary.com).

C. 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.:³

- 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 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

³ 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."); and *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006).

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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 9.⁴

Applicant argues that GRAND PRIX is not descriptive of the identified services because the definition "a high level and/or important sporting competitions" 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., *The American Heritage Dictionary* (4th ed. 2000) located at dictionary.com, audioenglish.net and answer.com, which

⁴ See Response of September 29, 2010. Unless otherwise noted, citations are to filings made in application Serial No. 77754297. The evidentiary record in each application is substantially the same.

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define or discuss "grand prix" only as an international road race for sports cars.⁵

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 third 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. Applicant has described its services as occurring "at the highest level possible, both from a domestic and international competition standpoint." And, applicant too references automobile racing, as does the encarta.com definition, in his response to the examining attorney's request for information, stating that "[j]ust as Formula One Grand Prix auto racing is the

⁵ The definition submitted by applicant from *Webster's New World College Dictionary* (2009), however, includes "any competitive event or, often, series of events; usually used as part of the title" in the definition of "grand prix."

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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."

Applicant also argues that GRAND PRIX conveys a secondary meaning⁶ of "prestige of services," suggesting that by including GRAND PRIX in the proposed marks, they convey an air of importance or aggrandizement which requires the consumer to have a level of imagination, thought and perception.⁷ 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

⁶ 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.

⁷ 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).

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PATENTS.COM. There, the Court discussed a 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.

At p. 2 of its reply brief, applicant takes a different tack. After conceding that "'Grand Prix' may sometimes be used in connection with a sporting contest at the highest level of competition," applicant 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 the competitions which are the subject of applicant's services (rugby, soccer, basketball and football). 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 or court where the participants take alternative turns attacking and defending a goal or zone. Reply at 3. In view of this distinction, applicant maintains that a

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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.

Finally, in connection with the proposed marks GRAND PRIX GAMING, GRAND PRIX ONLINE, and GRAND PRIX STUDIOS, applicant argues that the services do not relate immediately or forthwith to the particular sports set forth in the recitations of services, but to production and distribution services; gaming, tournament and wagering services; and broadcasting services. This argument is not persuasive because the recitations of services specifically identify those sports listed by applicant and such sports are involved as a feature of applicant's services. It is the content of such services that purchasers are ultimately purchasing and such sports feature prominently in rendering the services.

In sum, each element of each proposed mark is descriptive and when combined these elements do not lose

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their descriptive significance. The term GRAND PRIX informs the consumer that the subject matter of the services includes "grand prix" competitions. 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 marks immediately describe, 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.

Decision: The refusal to register each application under Section 2(e)(1) is affirmed.