Mailed: August 15, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

_____

In re Lance Armstrong Foundation

_____

Serial No. 85018297
Filed April 20, 2010

_____

Heather A. Dunn, DLA Piper LLP, for applicant.

Jason Paul Blair, Law Office 104, Chris Doninger, Managing Attorney.

_____

Before Mermelstein, Ritchie, and Shaw, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

The Lance Armstrong Foundation seeks registration of TEAM LIVESTRONG (in standard characters) for:

> Organization of sports events in the field of running, walking, cycling, and swimming; organizing community sporting events; conducting charity sporting events and tournaments,

in International Class 41.[1]

Applicant appeals from the examining attorney's final requirement to disclaim the exclusive right to use "TEAM" apart from the mark as shown.

We affirm.

---

[1] Based on first use and use in commerce as of February 2009. Applicant claimed ownership of three prior registrations, all for the mark LIVESTRONG for various goods and services.

I. Disclaimers

"The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Trademark Act Section 6(a); 15 U.S.C. § 1056(a). Merely descriptive or generic terms are unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

The examining attorney alleges that "TEAM" is merely descriptive of applicant's goods and services. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods with which it is used. *In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987).

Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle,* 66 USPQ2d 1222, 1224 (TTAB 2002). In

other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). "On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983); *In re Universal Water Sys., Inc.*, 209 USPQ 165, 166 (TTAB 1980).

II. Discussion

The examining attorney's argument for a disclaimer is essentially as follows:

> Applicant must disclaim the descriptive wording "TEAM" apart from the mark as shown ... because it merely describes a feature of applicant's services. *See* 15 U.S.C. § 1056(a); TMEP §§ 1213, 1213.03(a)....
>
> [T]he term "TEAM" means "a number of persons forming one of the sides in a game or contest." Because applicant's sporting contests involve people competing in contests, the term "TEAM" is merely descriptive of applicant's International

> Class 41 services.
>
> ...
>
> And in addition to the term "TEAM" being used in a sporting context, the word also means "a number of persons associated in some joint action." ... Because applicant's services involve people associating for a joint charity action, the term "TEAM" is also descriptive of applicant's services in that context.

Final Ofc. Action (Dec. 21, 2010) (citations revised). In support of his argument, the examining attorney relied upon a dictionary definition of "team," supporting both senses of the term:

> 1. A number of persons forming one of the sides in a game or contest: a *football team*.
>
> 2. A number of persons associated in some joint action: *a team of advisors*.

DICTIONARY.COM UNABRIDGED (http://dictionary.reference.com /browse/team?qsrc-4059 (Dec. 21, 2010)). Applicant does not take issue with these common definitions of "team," instead arguing primarily that the term does not describe its services, App. Br. at 4-6, 9-10, that it is too vague to be descriptive, *id.* at 10-13, and that doubt on the matter should be resolved in its favor, *id.* at 13.

As for the first sense of "team," that of "[a] number of persons forming one of the sides in a game or contest," we note again that applicant's services are identified as "[1] Organization of sports events in the field of running,

walking, cycling, and swimming; [2] organizing community sporting events; [3] conducting charity sporting events and tournaments." To state the obvious, it seems undeniable that the sports events applicant organizes and conducts include "team" sporting events, *i.e.*, those in which groups of people constitute "sides in a game or contest." Nonetheless, applicant argues that it doesn't do any such thing:

> In fact, forming one of the sides of a game or contest has nothing to do with Appellant's services, and such services are not included in Appellant's services description. Appellant's services are focused on the facilitation and organization of events, and not on the formation of groups or sides for a game or contest. Appellant's services include offering logistical support, scheduling volunteers and staff to support the events, making event arrangements, and encouraging participation by the community. These services do not fall under the Examining Attorney's definition of TEAM.
>
> ... Appellant's primary function is to coordinate events to raise money for charity. As forming a side of a game or contest is not a function, attribute or property of Appellant's services, let alone a significant function of such, Appellant's use of the term TEAM is not merely descriptive of Appellant's services.

App. Br. at 4-5.

The problem with applicant's argument is that we are constrained to consider its application for registration on the basis of the goods or services for which registration is sought. "Logistical support, scheduling volunteers, ...

encouraging participation," and the like are not set out in applicant's recitation of services. Those activities may well be within the scope of "organizing" and "conducting" the sports events which applicant has identified (an issue we need not decide), but they certainly do not limit the scope of the services for which applicant seeks registration. The question we must answer is *not* whether TEAM is descriptive of an activity in which applicant is actually engaged, but whether it is descriptive of any of the activities within the scope of applicant's recitation of services. Again, we think it is obvious that applicant's services — as recited — in the subject application could include organizing and conducting TEAM sports,[2] whether or not applicant actually does so, and could in fact encompass "forming one of the sides of a game or contest" (although we do not think the latter would be necessary to a finding that TEAM is descriptive of applicant's services). Applicant's identified services do not exclude TEAM sports explicitly or implicitly, and they

[2] For instance, applicant's services include "organization of sports events in the field of ... cycling...." Applicant can hardly deny that cycling can be organized as a *team* sport. Applicants' founder, Lance Armstrong, App. Br. at 1, is famous for having ridden to a record seven victories in the Tour de France while a member of the U.S. Postal Service team, the Discovery Channel team, and Team Radio Shack.

must therefore be considered as included within the scope of such services.

With regard to the second sense of the word TEAM cited by the examining attorney – "[a] number of persons associated in some joint action" – it is the examining attorney's position that applicant's services of organizing and conducting various sports events are accomplished jointly by a number of persons, *i.e.*, by a TEAM, and that the term is thus descriptive of how the services are carried out or who does so. Applicant and the examining attorney quibble over whether a team is *required* to perform the identified services (and whether applicant has "admitted" this), Ex. Att. Br. at 3-4 (unnumbered); Reply Br. at 1-2, but the dispute is beside the point.

We fully accept the notion that a sports event such those identified by applicant could be organized or conducted by a single person. But applicant does not dispute – and we think it is undeniable – that those same activities could likewise be performed by "[a] number of persons associated in some joint action," *i.e.*, a TEAM. Again, applicant's recitation of services is not limited in this regard, and we must construe it to cover such services organized and conducted by both individuals and by teams. The examining attorney need not demonstrate that such

services are usually, always, or required to be performed by a team, or that applicant itself actually does so. A mark is properly refused registration if it describes *any* of the services within the ambit of the recitation of services, and applicant's recitation of services neither explicitly nor implicitly excludes services performed by a TEAM.

Applicant argues that TEAM (in either sense) is not descriptive of its services because it does not itself identify with particularity what the services are:

> In order to find mere descriptiveness, one must be able to glean from the mark itself specifically what the services under the mark are.... A consumer would not see the word TEAM and immediately understand Appellant is offering services to organize sporting events and conduct sporting events benefitting charity.

App. Br. at 6 (citing *Tennis in the Round, Inc.*, 199 USPQ at 498).

Applicant's statement of the law is incorrect, and misconstrues our *Tennis in the Round* decision. That case reversed a descriptiveness refusal because the mark was found to be incongruous and not descriptive given the likely public perception of "in-the-round" (a phrase familiar to the public because of its descriptive use in "theater-in-the-round"). Applicant does not argue here that its mark is incongruous or that it is contrary to the

likely understanding by relevant consumers of the word TEAM in this context.

The *Tennis in the Round* panel stated the issue as follows:

> The question of whether a particular term is merely descriptive within the meaning of Section 2(e)(1) of the Act must be determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is used, and the significance it is likely to have to the average purchaser as he encounters the goods or services in the marketplace. *See Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (CCPA 1962); *Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 95 USPQ 264 (D.N.J. 1952); *In re Chicago Pneumatic Tool Co.*, 160 USPQ 628 (TTAB 1968).

Tennis in the Round, 199 USPQ at 498 (citations revised).

Contrary to applicant's apparent contention that *Tennis in the Round* required that "one must be able to glean *from the mark itself* specifically what the services under the mark are" (emphasis added), the case merely repeats the well-worn prescription that descriptiveness must be judged "*in relation to the goods or services* for which registration is sought." *Id.* (emphasis added). *See also In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). It has been repeatedly held that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question

is whether someone who knows what the goods or services are will understand the mark to convey information about them." *Tower Tech*, 64 USPQ2d at 1316-17. *See also Coach Svcs. Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012) ("[D]escriptiveness of a mark is not considered in the abstract. Instead, the mark must be considered in relation to the particular goods for which registration is sought...." (citations and internal quotation marks omitted)). In light of the services recited in the application, the relevant public would clearly understand that applicant's services relate to "team" sports or are provided by applicant's "team" – or both.

Applicant also argues that TEAM is too "vague" to be descriptive, App. Br. at 10-13, pointing out that many services can be rendered by "a number of persons associated in some joint action," concluding that "[t]he term TEAM cannot, therefore, be said to be merely and directly descriptive of such activities." *Id.* at 10. Applicant does not explain how it reaches this conclusion, and it is not at all obvious to us. The test of descriptiveness is not whether the mark uniquely and completely describes applicant's services and no others; rather, a mark is unregistrable if it gives the consumer information about a feature, function, or characteristic of the goods or

service. Neither the fact that a given term may be used by many others in a broad range of endeavors nor that it does not describe exactly and thoroughly applicant's goods or services is a defense to descriptiveness.

We agree that TEAM (in the second sense) is widely applicable to many services. In common parlance, service providers might tout the advantages of having one's car maintained by the speedy "team" at an automobile dealer's service department, trusting one's tax preparation to the "team" of experienced tax preparers at an accounting firm, or having complex surgery performed by the highly trained "team" of surgeons and nurses at a hospital. Although these examples all involve very different services, the term "team" in this sense is used to describe the same thing, *i.e.*, that the services are performed by "[a] number of persons associated in some joint action." Such terms should not be considered the exclusive property of any one competitor, and the fact that they are used by a *broad* range of service providers presents, if anything, even more reason to prevent their registration by any single entity. "[F]or policy reasons, *descriptive words* must be left free for public use." *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 383 (CCPA 1968). *See also Estate of P.D. Beckwith, Inc. v. Comm'r Pats.*, 252 U.S. 538, 543

(1920) ("Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public." (referring to the 1905 Trademark Act)).[3]

We also agree with applicant that TEAM (again in the second sense) would not inform the relevant public "*specifically* what the services under the mark are." App. Br. at 6 (emphasis added). But again, there is no requirement that a descriptive term must describe the recited services with particularity or describe every aspect of them; if this were the standard, very few marks would be held descriptive. It is well-established that

> [a] proposed mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Lanham Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987), *In re Abcor Dev.*

[3] To be clear, although "competitor need" is part of the policy underlying the statutory prohibition against registering descriptive marks, it should not be confused with the *test* for descriptiveness as the Board and our reviewing courts have long applied it. *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (distinguishing *No Nonsense Fashions Inc. v. Consol. Foods Corp.*, 226 USPQ 502 (TTAB 1985)). Thus, the examining attorney is not required to prove that others *need* to use the term in question (or that others actually *do* use it) in order to hold a mark descriptive. *Id.*

> *Corp.*, 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. *In re Venture Lending Assoc.*, 226 USPQ 285, 286 (TTAB 1985). Also, a mark need not describe all of the goods or services for which registration is sought; registration must be refused if the mark is merely descriptive of any of the goods or services for which registration is sought. *See In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); *In re Patent & Trademark Svcs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

In re Venture Lending Assocs., 226 USPQ 285, 286 (TTAB 1985) (citations revised).

Applicant submitted several third-party registrations during examination, and argues that these records are probative of the meaning of the term TEAM in its mark. Each of the registrations submitted by applicant comprise the term TEAM, yet were registered without a disclaimer. App. Br. at 7-9 ("Consumers are accustomed to seeing the term TEAM used in such a manner, including in connection with the organization of sporting events and conduct of sporting events for charity.").

While we agree with the examining attorney that each application must be considered on its own merits, Ex. Att. Br. at 6 (unnumbered), applicant is also correct that third-party registrations have *some* probative value in

determining the meaning of a mark. *See* Reply Br. at 5 (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) ("third-party registrations ... may be given *some weight* to show the meaning of a mark in the same way that dictionaries are used" (emphasis added; citation omitted))).

Although applicant argues that seven third-party registrations are relevant here, App. Br. at 8, we find the number to be two,[4] at best: TEAM GOLF PLAY FORE A CAUSE (and design) for "organizing and conducting golf events with the proceeds donated to charity," and TEAM PREVENT GESUND UND SICHER ARBEITEN GMBH (and design) for a variety of services including "organizing community sporting and cultural events."[5]

While we do not ignore these registrations, we are unable to draw any conclusion as to the descriptiveness of TEAM from two (or even seven) registrations. These registrations feature different marks (which may have been

[4] The services recited in the other five registrations are considerably different than those at issue here, as none of them appear to be related to the organization or conduct of sporting events for charity or other purposes.

[5] The TEAM PREVENT... mark was registered pursuant to Trademark Act Section 66, and not use in commerce, and there is no evidence that the mark is actually in use in the United States. Therefore this registration does not support applicant's argument that "[c]onsumers are accustomed to seeing ... TEAM used" as a source identifier. *See* App. Br. at 7.

seen to engender different meanings), and we are not privy to the evidence of record regarding whether TEAM is descriptive in them, and if so, whether a disclaimer would have been appropriate. We find that the small number of third-party registrations cited by applicant do not outweigh the examining attorney's evidence of descriptiveness.

Further, while consistency in examination is clearly an important goal for the USPTO, we are not bound by the prior decisions of examining attorneys; those matters are not before us. *In re Boulevard Entm't Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) ("the PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the agency or this court" (citing *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001))). *See In re Omega SA*, 494 F.2d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007) (examining attorney's requirement, although inconsistent with past practice, was "was within the PTO's discretionary authority.").

III. Conclusion

We have carefully considered all of the evidence and argument properly presented, including any which we have not specifically discussed. We conclude that the term TEAM

is merely descriptive of applicant's identified services, and that it must be disclaimed pursuant to Trademark Act Section 6(a).

Decision: The refusal to register in the absence of a disclaimer of TEAM is AFFIRMED.

However, this decision will be set aside if, within thirty days of the mailing date of this order, applicant submits to the Board a proper disclaimer of "TEAM." *See* Trademark Rule 2.142(g); TBMP § 1218 (3d ed. rev. 2012). The disclaimer should be worded as follows: "No claim is made to the exclusive right to use TEAM apart from the mark as shown." TMEP § 1213.08(a)(i).