

This Opinion is not a
Precedent of the TTAB

Mailed: January 23, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Marathon Tours, Inc.

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Serial No. 86086458

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Michael J. Bevilacqua and Barbara A. Barakat of Wilmer Cutler Pickering Hale and
Dorr LLP,
for Marathon Tours, Inc.

D. Travis Bice, Trademark Examining Attorney, Law Office 128,¹
Travis D. Wheatley, Managing Attorney.

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Before Wellington, Ritchie, and Goodman,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Marathon Tours, Inc. (“Applicant”) seeks registration on the Principal Register of
the mark ANTARCTICA MARATHON (in standard characters), for services
identified as “Travel services, namely, organizing and arranging travel, travel tours,
excursions, and sightseeing travel tours; providing travel guide and travel

¹ The case was reassigned to this Examining Attorney after the appeal was filed.

information services; making transport reservation,” in International Class 39 and “Travel services, namely, making hotel reservations for others,” in International Class 43.² The application is based on a claim that the mark has acquired distinctiveness, under Section 2(f) of the Trademark Act.

The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), as likely to cause confusion, mistake, or to deceive, based on the mark ANTARCTIC ICE MARATHON & 100K and design, as shown below, for services identified as “Athletic and sports event services, namely, arranging, organizing, operating and conducting marathon races,” in International Class 41:³



² Serial No. 86086458, filed on October 8, 2013, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging 1995 as the dates of use and of first use in commerce for services in both International Classes. The application claims acquired distinctiveness of the mark “in whole.”

³ Registration No. 5238948 issued July 11, 2017.

The registration contains a disclaimer of the term “ANTARCTIC ICE MARATHON & 100K” and of the geographic representation of Antarctica.⁴ The cited registration, owned by Richard Donovan, contains the following description:

The mark consists of a blue rectangle. Inside the blue rectangle is the artistic rendering of the continent of Antarctica in light blue with five circles emanating out of the left side of the rendering of the continent. The first circle is in red, the remaining four are in light blue. The stylized words “ANTARCTIC ICE MARATHON & 100K” appear in white across the middle of the design.

As background, with the first Office Action on January 28, 2014, the Examining Attorney cited the then-pending application by Richard Donovan for the above-cited mark as a potential bar to this Applicant’s registration due to a likelihood of confusion. That application by Richard Donovan was published for opposition on December 31, 2014, and Applicant herein filed an opposition to its registration on February 13, 2014 on the grounds of likelihood of confusion and fraud. The prosecution of this application was suspended pending the outcome of the opposition. On February 14, 2017, the Board dismissed the opposition on both grounds, finding that Applicant herein had not established priority of use of a distinctive mark, whether inherent or otherwise.⁵ As noted, the cited registration issued to Richard Donovan on July 11, 2017. On February 12, 2018, the Examining Attorney resumed

⁴ The disclaimer applies only to Applicant’s Class 41 services. The registration also identifies goods in International Class 25, which were not discussed by the Examining Attorney and are not relevant to this refusal

⁵ The Board issued a “Corrected Decision” with minor edits on November 27, 2017. As noted, the Board found this Applicant’s mark to be “closer to being highly descriptive” and that it “had not shown that its mark is substantially exclusive nor that it has acquired distinctiveness.” 91214916 39 TTABVUE 15, 16.

prosecution of this application, and issued a refusal on the ground of likelihood of confusion with the cited registration. The Examining Attorney also issued a refusal on the ground that the mark is primarily merely geographically descriptive in accordance with Section 2(e)(2) of the Trademark Act, but deemed that refusal to be satisfied by the Section 2(f) evidence submitted by Applicant with its August 13, 2018 Response to Office Action.

After the Examining Attorney made the Section 2(d) refusal final, Applicant filed this appeal, which is fully briefed. For the reasons discussed herein, we reverse the refusal to register.

I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We note, nevertheless, that in a case where the marks are found to be sufficiently dissimilar, this factor may be dispositive. *See Kellogg Co. v. Pack'em Ent. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive.”)

A. The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant's mark is ANTARCTICA MARATHON. The mark in the cited



registration is . The cited mark contains the literal element ANTARCTIC ICE MARATHON & 100K, and a design described as “an artistic rendering of the continent of Antarctica.”

Applicant argues that the mark in the cited registration is weak. We agree, and note that there is no dispute that any similar wording between the marks is based on terms that are descriptive and disclaimed in the cited registration. Given that Registrant's services are marathon race services, the terms ANTARCTIC and MARATHON in Registrant's mark merely describe the geographic location and type of race. Thus, consumers viewing this mark in the context of marathon race services will accord very little, if any, source-identifying significance to these disclaimed terms. As a result, we find Registrant's scope of protection based on these two terms to be severely limited.

In sum, we find that the descriptive or generic wording in the registered mark curtails its scope of protection as to the use of those terms. Given the differences in

its mark, Applicant's mark does not fall within that narrow scope.⁶ That is, the differences in Applicant's and Registrant's marks are sufficient to distinguish them. We therefore find that the marks are different in sight, sound, connotation, and commercial impression.

The first *du Pont* factor weighs against finding a likelihood of confusion.

B. Services, Trade Channels, and Purchasers

When considering the similarity or dissimilarity of the services, we note that services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association between the providers of the parties' services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The application includes travel services, identified specifically as "Travel services, namely, organizing and arranging travel, travel tours, excursions, and sightseeing travel tours; providing travel guide and

⁶ We note that Applicant's claim of acquired distinctiveness is a concession as to the descriptiveness of its own mark. *See Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."). Nevertheless, the Examining Attorney accepted Applicant's claim of acquired distinctiveness, and that is not an issue in this appeal. We do not opine as to Applicant's right to enforce its mark.

travel information services; making transport reservation,” and “Travel services, namely, making hotel reservations for others.” The cited registration identifies “Athletic and sports event services, namely, arranging, organizing, operating and conducting marathon races.”

To show that these services are related, the Examining Attorney submitted web evidence of organizations that offer both the travel guide, tour and hotel reservation services, as identified by Applicant, as a complementary service to the operation of marathon races, as identified in the cited registration. These third-party providers include Albatros Adventure Marathons, Amazing Running Tours (Kenya Wildlife Marathon), Conquer the Wall Marathon, Wild Frontiers (Kilimanjaro Marathon) and RIA Ethiopia Sports (EthioTrail).⁷ Applicant itself also admits to providing both the travel services identified in the application, and the marathon operation service identified in the cited registration.

In this regard, Applicant submitted a declaration from its CEO, Thomas F. Gilligan, in support of Applicant’s claim of acquired distinctiveness. In the declaration, Mr. Gilligan explained as follows:⁸

With applicant’s ANTARCTICA MARATHON mark, applicant organizes a two week itinerary that includes three nights in Buenos Aires, followed by a 10 night cruise that leaves from Ushuaia, Argentina. The marathon takes place on the fourth day of the cruise and is followed by travel along the Antarctic Peninsula into the fjord area for wildlife viewing, kayaking, zodiac cruising and visits to research bases on the continent.

⁷ Attached to February 12, 2018 Office Action, at 6-29 and October 8, 2018 Final Office Action, at 2-16.

⁸ Attached to August 13, 2018 Response to Office Action, at 3.

Applicant further reiterated in its brief that it provides “full-service travel agency services,” stating:⁹

When [Applicant] organizes a marathon, it sets up the traveler/runner’s race registration, coordinates all the logistics of getting to and from the marathon, and provides tour services around the landmarks and sites of the cities and locales of the marathon.

Based on the third-party web evidence, as well as the declaration from Applicant’s CEO, which Applicant further confirms in its brief, we find that the services are complementary and related.

In addition to demonstrating the similarity of the services, the evidence shows the similarity of the channels of trade for the services in the application and in the cited registration. This is further supported by evidence submitted by the Examining Attorney that certain third-party providers of marathon services, including Jerusalem Marathon and Virgin Money London Marathon, list Applicant as an official partner and designated tour operator for participants travelling from the United States.¹⁰ We find that the services, which are complementary and related, travel through similar and at times overlapping channels of trade to general classes of consumers.

The second and third *du Pont* factors favor finding a likelihood of confusion.

⁹ 4 TTABVUE 7.

¹⁰ Attached to October 8, 2018 Final Office Action, at 20-35.

C. Co-existence and Lack of Actual Confusion

Applicant argues in its brief that the parties have coexisted “apparently without incident” since Registrant began use of its mark in “August 2013.”¹¹ Applicant has submitted declaratory testimony, along with supporting documentary evidence, of its use. There is, however, no evidence of how Registrant uses its mark, or as to whether there is significant overlap in the consumer market such that there has been meaningful opportunity for actual confusion in the marketplace.

Furthermore, we note that in this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. *See, e.g., In re Opus One, Inc.*, 60 USPQ2d 1812 (2001) (“The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”); *In re Wilson*, 57 USPQ2d 1863, 1869 (TTAB 2001) (“[I]nasmuch as we have heard from neither registrant nor the Highland Orange Association in this appeal, we cannot conclude that, in fact, no instances of actual confusion ever occurred.”); *In re Cruising World, Inc.*, 219 USPQ 757 (1983) (“Concerning the lack of actual confusion argument, in an ex parte hearing where only the

¹¹ 4 TTABVUE 8.

applicant's position is expressed and there is no way to assess what the experience of the registrant has been, it is impossible to conclude that actual confusion has never occurred.")

We find the seventh and eighth *du Pont* factors to be neutral.

D. Conclusion

After considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that although the services are complementary and related, and travel through similar and at times overlapping channels of trade to general classes of consumers, Registrant's mark, which disclaims the relevant wording and design, is weak and entitled to a narrow scope of protection, and that such narrow scope does not extend to Applicant's mark. Rather, considering the weakness of the mark in the cited registration, we find the marks to be so dissimilar in similar in sight, sound, connotation, and commercial impression that there is no likelihood of confusion. *See Kellogg Co. v. Pack'em* 21 USPQ2d at 1145.

Decision: The Section 2(d) refusal to register Applicant's mark is reversed.