

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

Hearing: December 9, 2010 Mailed: May 25, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board

National Park Service¹
v.
Hot Springs Advertising & Promotion Commission

—————
Cancellation No. 92049191

Scott Bolden and Sheryl L. Rakestraw of U.S. Department of the Interior for National Park Service.

Gary N. Speed of Speed Law Firm for Hot Springs Advertising & Promotion Commission.

—————
Before Kuhlke, Cataldo and Taylor,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On April 11, 2008, Petitioner, National Park Service, petitioned to cancel Registration No. 2706344, issued April 15, 2003 on the Principal Register to respondent, Hot Springs Advertising & Promotion Commission, for the mark displayed below for "creating advertising for publications or direct mail advertising; cooperative advertising and

—————
¹ Petitioner's consented motion, filed on December 10, 2010 to substitute National Park Service as petitioner in place of U.S. Department of the Interior, National Park Service, Hot Springs National Park, is hereby granted.

marketing; displaying advertisements for others; and dissemination of advertising for others" in International Class 35. "HOT SPRINGS NATIONAL PARK ARKANSAS" is disclaimed apart from the mark as shown.



As grounds for cancellation, petitioner alleges that respondent's mark is primarily geographically descriptive of the services under Section 2(e)(2) of the Trademark Act.² Respondent, in its answer, denied the salient allegations of the petition for cancellation.³

² Petitioner alleged additional grounds for cancellation in its petition but did not pursue them at trial. Accordingly, they are deemed waived.

³ Respondent asserted certain affirmative defenses in its answer but did not pursue them by motion or at trial. Accordingly, they are deemed waived. Respondent also asserted additional "affirmative defenses" that are more in the nature of amplification of its denials of the allegations contained in the petition to cancel and have been so construed.

The Record

By rule, the record consists of the pleadings and the file of the involved registration. In addition, during its assigned testimony period, petitioner filed notices of reliance upon the following: portions of the discovery deposition of Steve Arrison, respondent's executive director; various printed publications, dictionary definitions and official records; and respondent's responses to petitioner's first set of requests for admissions.

Respondent, during its assigned testimony period, filed notices of reliance upon the discovery depositions, with accompanying exhibits, of the following individuals: Daniel Wenk, acting director of petitioner; Ernest Quintana, regional director for the Midwest Region and acting deputy director of petitioner; Bernard Fagan, chief of petitioner's Office of Policy; Josie Fernandez, superintendent of Hot Springs National Park; Roger Giddings, retired former superintendent of Hot Springs National Park;⁴ and the complete discovery deposition of Mr. Arrison. Respondent also filed notices of reliance upon printed publications and official records; and petitioner's responses to respondent's first set of request for admission.

⁴ The Board notes with approval the parties' stipulation to the admissibility of Mr. Giddings' deposition, subject to petitioner's objections made during the course thereof. Such stipulation is consistent with the collegiality displayed by the parties and their counsel throughout this proceeding.

Petitioner and respondent filed briefs, and petitioner filed a reply brief. In addition, counsel for both parties presented arguments at an oral hearing held before the Board on December 9, 2010.

Evidentiary Objections

Each party has filed objections against certain testimony and exhibits introduced by its adversary. We note, however, that none of the testimony and/or exhibits sought to be excluded is outcome determinative. Given this fact, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

General Facts

The following facts are not in dispute. Petitioner is an agency of the U.S. Department of the Interior that administers "the Nation's natural and cultural heritage and historic resources for future generations,"⁵ including national parks. Hot Springs National Park was granted National Park status in 1921.⁶ It is the smallest of the

⁵ Petitioner's brief, p. 3.

⁶ 41 Stat 1407 (1921), codified at 16 U.S.C. § 2 (2008).

Cancellation No. 92049191

National Parks, but is widely-visited and "distinguished as the oldest federal reserve of land by Congress."⁷ The city of Hot Springs, Arkansas, is located adjacent to Hot Springs National Park, but not on park land.⁸ The United States Postal Service has, since 1922, identified the mailing address for the city of Hot Springs, Arkansas as Hot Springs National Park, although the post office locations therefor are not located within the national park.⁹

Respondent is a commission "created by the city of Hot Springs, Arkansas to promote Hot Springs National Park and the surrounding attractions that make it a popular tourist destination."¹⁰ The city of Hot Springs, Arkansas and respondent are "related entities and two members of [respondent] are elected city officials."¹¹ Respondent "receives revenue from various resources that it promotes, including revenue from the City's convention center, the Hot Springs Mountain Tower (a concessions contract with the National Park Service) and a food and hospitality tax on food and lodging within the City limits."¹² Respondent "creates advertising campaigns through radio, television, Internet, brochures to attract visitors and convention

⁷ Petitioner's brief, p. 3.

⁸ Arrison Deposition, Exhibit p. 184-6.

⁹ Respondent's Notice of Reliance, Exhibits 5-7, 27.

¹⁰ Respondent's brief, p. 8, citing to Arrison Deposition, p. 8-11.

¹¹ Id.

¹² Petitioner's brief, p. 4, citing to Arrison Deposition, p. 13.

business to the City and community."¹³ Respondent advertises Hot Springs National Park in many of its marketing campaigns.¹⁴

Petitioner's Standing

Petitioner has demonstrated that it is a Federal agency that administers national parks. Petitioner further has demonstrated that respondent: uses the involved mark as a brand identity for the city of Hot Springs, Arkansas;¹⁵ licenses the mark for use by tourist entities that provide services in the region but not within the park;¹⁶ and denies use of the mark to entities that it believes will not properly promote the city of Hot Springs, Arkansas or with which the city does not want to be associated.¹⁷ Petitioner argues it is "concerned that [respondent] began using the Mark to advertise services that were not approved, endorsed, or associated with the National Park Service."¹⁸ Petitioner further argues respondent's "use of the Mark, and the geographically descriptive nature of the Mark, was causing consumers to be confused as to the origin of the goods and services."¹⁹

¹³ Id. citing to Arrison Deposition at 14.

¹⁴ Arrison Deposition at 47.

¹⁵ Id. at 23.

¹⁶ Id. at 56; Quintana Deposition at 25; and Fernandez Deposition at 52.

¹⁷ Id. at 56-8, 65.

¹⁸ Petitioner's brief, p. 6.

¹⁹ Id.

Based upon the foregoing, we find that petitioner, as the agency that administers national parks in the United States of America, has a direct and personal stake in the outcome of this cancellation proceeding which involves a mark incorporating the name of a national park. We further find that petitioner's belief of damage based upon respondent's use of a mark incorporating the name of a national park in connection with services not approved or endorsed by or associated with petitioner has a reasonable basis in fact. Thus, petitioner has a "real interest" in the proceedings and a "reasonable basis" for its belief of damage. See *Ritchie v. Simpson*, 170 F.3d 1092, 1094-5 (Fed. Cir. 1999). As a result, we find petitioner has standing to demonstrate that respondent is not entitled to continued registration of its mark.

Geographic Descriptiveness

Section 2 of the Trademark Act, 15 U.S.C. §1052, provides, in part, as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it-

(e) Consists of a mark which ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4....

Section 2(e)(2) of the Trademark Act prohibits registration of marks which, when used in connection with the identified

Cancellation No. 92049191

goods and services, are primarily geographically descriptive. For petitioner to establish that respondent's mark is primarily geographically descriptive, it must show that the mark is the name of a place known generally to the public, and that the public would make a goods/place association, *i.e.*, believe that the goods or services for which the mark is registered originate in that place. See *In re Societe Generale des Eaux Minerals de Vittel, S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988). However, "a case of unregistrability cannot be made out simply by evidence showing that the mark sought to be registered is the name of a place known generally to the public." See *In re Societe Generale* 824 F.2d at 959, 3 USPQ2d at 1452. Further, it has been held that a designation coined and promoted as a mark but which incidentally designates a particular location can function as a mark and is not primarily geographically descriptive. See *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991). See also *Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Improvement Corporation*, 53 S.W.3d 799 (Tex. App. 2001).

Turning to the mark at issue, respondent concedes "that Hot Springs National Park is a geographically descriptive term. However, the Registrant disclaimed the exclusive

Cancellation No. 92049191

right to use the words Hot Springs National Park Arkansas apart from the mark as shown."²⁰ In its answer to the petition to cancel, respondent states as follows:

Registrant admits the term Hot Springs National Park is geographically descriptive as a place name, although Registrant denies that its mark as registered is geographically descriptive due to incorporated [sic] the design element and the acquisition of secondary meaning by Registrant, so the allegations contained in Paragraph 13 [are] denied.²¹

Further, respondent provided the following response to petitioner's first request for admission:

REQUEST FOR ADMISSION NO. 1: Admit that the primary significance of the phrase "Hot Springs National Park" is a generally known geographic location.

RESPONSE: Request for Admission No. 1 is admitted.²²

Based upon respondent's above admissions, there is no dispute that the wording HOT SPRINGS NATIONAL PARK ARKANSAS in respondent's mark is primarily geographically descriptive of respondent's services. Petitioner cites to *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501 (TTAB 2008) in support of its contention that respondent's "inclusion of the word ARKANSAS to HOT SPRINGS NATIONAL PARK does not detract from the geographic significance of the Mark; indeed, the inclusion reinforces the geographic

²⁰ Respondent's brief, p. 22.

²¹ Answer, paragraph 13.

²² Petitioner's notice of reliance, Exhibit II.

significance."²³ We agree, and respondent does not argue the point. However, respondent's mark, displayed below, includes both the geographically descriptive wording and an abstract, geometric design.



As such, the mark is a geographic composite mark, composed of admittedly geographic matter, *i.e.*, the wording HOT SPRINGS NATIONAL PARK ARKANSAS, and additional matter, in this case, a design element. We must therefore determine whether the primary significance of the mark, *as a whole*, is a generally known geographic location. See *In re Save Venice New York Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001).

Petitioner argues that respondent's "use of a generic blue diamond and teal rectangle do [sic] not detract from the geographic significance of the Mark"²⁴ and, therefore, "the primary significance of the overall Mark is

²³ Petitioner's brief, p. 9.

²⁴ *Id.* It is noted that respondent has made of record examples of its mark presented in the colors described by petitioner; however, color is not claimed as a feature of the mark.

geographic.”²⁵ However, the only evidence of record of the possible significance of the design is the following exchange from the discovery deposition of respondent’s executive director, Steve Arrison:

Q. And other than the wave design, do you know whether there’s any significance to the diamond shape or the rectangle design?

A. No clue. I always wondered if they tied it into the Crater of Diamonds in Arkansas, but I have no knowledge of why they came up with this design or what the components are. I just always assumed the waves signified water.²⁶

This exchange indicates only that Mr. Arrison does not know the significance of the design, and his mere speculation as to the possible meaning of components thereof falls far short of establishing that the geometric design in respondent’s mark has any significance, let alone geographic significance. There is no other testimony or evidence of record that addresses the significance of the design element in respondent’s mark. Furthermore, respondent denied all of petitioner’s requests for admission directed to the geographic significance of the mark as a whole.²⁷

Petitioner’s reliance upon *In re Save Venice New York Inc., supra*, in support of its position is misplaced. In that case, the Federal Circuit affirmed this tribunal’s determination that the image of a winged Lion of St. Mark

²⁵ Petitioner’s brief, p. 10.

²⁶ Arrison Deposition, p. 24.

²⁷ Petitioner’s Notice of Reliance, Exhibit II.

Cancellation No. 92049191

was recognized as a symbol of the city of Venice, Italy, and thus reinforced the geographic significance of the wording SAVE VENICE and THE VENICE COLLECTION in the mark at issue. In this case, however, the abstract design has no recognized significance and, as such, does not reinforce the geographically descriptive wording HOT SPRINGS NATIONAL PARK ARKANSAS. In that regard, all of the cases relied upon by petitioner involve marks consisting of a geographic term and additional word or design components that reinforce the geographic significance of that term. All of these cases can be distinguished from the case at issue because there simply is no testimony or evidence that the design portion of respondent's mark possesses any geographic significance or reinforces the geographic significance of the disclaimed wording HOT SPRINGS NATIONAL PARK ARKANSAS.

We find, therefore, that petitioner has failed to establish that the mark as a whole is the name of a place known generally to the public. Rather, the evidence of record supports a finding that only the disclaimed wording in the mark is the name of a geographic location. Thus, the disclaimed geographically descriptive wording HOT SPRINGS NATIONAL PARK ARKANSAS in respondent's mark is a separate element from the inherently distinctive design. See generally TMEP §1210.06(a). As discussed above, there is no evidence that the design is geographically descriptive, nor

Cancellation No. 92049191

can we construe any statement by respondent or its officers as an admission that the design is geographically descriptive.

Because petitioner has failed to establish the first element of its claim of geographic descriptiveness, namely, that the mark as a whole is the name of a place known to the public, we find that petitioner cannot prevail on its pleaded ground for cancellation, and we need not consider whether the public would make a goods/place association, *i.e.*, believe that the goods or services for which the mark is registered originate in that place. *Cf. In re Societe Generale des Eaux Minerals de Vittel, S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988).

As a result, we find that respondent's mark is entitled to continued registration with the geographically descriptive wording disclaimed.²⁸

DECISION: The cancellation is dismissed with prejudice.

²⁸ In view thereof, the parties' arguments directed toward the issue of whether respondent's mark has acquired distinctiveness under Trademark Act Section 2(f) will be given no consideration.