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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steamboat Springs Chamber-Resort Association, Inc.

Serial No. 77939915

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Chamber-Resort Association, Inc.

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Before Holtzman, Bergsman and Lykos, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Steamboat Springs Chamber-Resort Association, Inc. (applicant) to register the mark BIKE TOWN USA in standard characters for services ultimately identified as "organizing athletic competitions, namely, bicycle races" in Class 41.¹ The words BIKE and USA are disclaimed.

¹ Serial No. 77939915, filed February 19, 2010, based on an allegation of a bona fide intention to use the mark in commerce.

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's services, so resembles the registered mark BIKETOWN, in typed form, for the following services as to be likely to cause confusion.²

Promoting the interests of consumers involved in lifestyle enhancement and improved health through the distribution of printed material; promoting public awareness of the need for improved health and lifestyle enhancement; promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with promotional contests, in Class 35.

When the refusal was made final, applicant appealed. Briefs have been filed.³

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the

² Registration No. 2981907; issued August 2, 2005; combined Sections 8 and 15 declaration accepted and acknowledged.

³ The evidence submitted by applicant for the first time with its reply brief is manifestly untimely and will not be considered. See Trademark Rule 2.142(d); and In re Zanova Inc., 59 USPQ2d 1300, 1302 (TTAB 2001) ("By attempting to introduce evidence with its reply brief, applicant has effectively shielded this material from review and response by the Examining Attorney."). Nor will we consider applicant's unsupported arguments in its reply brief which are based on or relate to this untimely evidence.

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goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a comparison of applicant's mark BIKE TOWN USA with registrant's mark BIKETOWN and a consideration of the marks in their entirety in terms of sound, appearance, meaning and commercial impression. See *du Pont*, 177 USPQ at 567. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The test under this *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In addition, while marks must be compared in their entirety, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." In re *National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The term BIKETOWN is registrant's entire mark, and the essentially identical term BIKE TOWN is a prominent part of applicant's mark. BIKE TOWN is the first part of the mark BIKE TOWN USA that purchasers will see or hear when encountering applicant's mark, and it is therefore more likely to have a greater impact on purchasers and be remembered by them when they encounter these marks at separate times. See *Palm Bay*, 73 USPQ2d at 1692-93 (The term VEUVÉ in the mark VEUVÉ CLICQUOT is a "'prominent feature' as the first word in the mark"); and *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

Contrary to applicant's contention, the presence or absence of a space between the two words is an inconsequential difference that even if noticed or remembered by consumers would not serve to distinguish these marks. See, e.g., *Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984). Moreover, applicant's mark is in standard characters, and we must consider that the term BIKE TOWN could be displayed in the same compressed format as registrant uses thereby rendering this portion of the marks visually identical. See *Citigroup v. Capital City Bank*

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Group, Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (standard character or typed drawings "are not limited to any particular presentation.").

The marks have the same meanings and create the same overall impressions. Both marks suggest the idea of a bicycle-friendly community, or a place that would appeal to bicycle enthusiasts. The addition of the geographically descriptive term USA to applicant's mark does not significantly change the commercial impression created by the term BIKETOWN or BIKE TOWN alone. If anything, the term USA serves to increase, rather than decrease, the similarity in overall impression as it simply describes, more particularly, the geographic location of the place called "BIKE TOWN."

Applicant maintains, in view of the descriptive meaning of BIKE, that it is the TOWN USA portion of its mark, rather than the BIKE TOWN portion, that makes the commercial impression in its mark. Noting that applicant is the Chamber of Commerce of Steamboat Springs, Colorado, applicant argues that it is the "town," of Steamboat Springs that is being promoted as being a "bicycle-friendly" community. However, we find this to be a rather strained interpretation of the mark. It is also contradicted by applicant's own promotional materials, wherein applicant promotes the concept of a "BIKE TOWN" and as a "destination" for bicycling enthusiasts:

Steamboat Springs represents the ultimate destination for cycling experiences. ...to someday be recognized as "Bike Town USA" in the summer just as we are known as "Ski Town USA" in the winter. ...our efforts to make Steamboat a more Bicycle Friendly destination.
routtcountyriders.org

Although the word BIKE in applicant's mark is descriptive and disclaimed, it is well settled that "[n]o part of the mark can be ignored in comparing the marks as a whole." *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984). See also *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (finding GIANT to be the dominant portion of a mark consisting of the words GIANT HAMBURGERS with a large background design, even though the wording GIANT HAMBURGERS was disclaimed). The term BIKE still forms part of the mark and it contributes significantly to the commercial impression of the mark as a whole.

Because the term BIKETOWN, which is registrant's entire mark, and BIKE TOWN, which is a prominent portion of applicant's mark, BIKE TOWN USA, are essentially identical, the marks as a whole are similar in sound, appearance, connotation and commercial impression.

We turn then to the du Pont factor regarding the similarity or dissimilarity of the respective services. It is the examining attorney's position that the respective services are highly

related, and that they are of a type that may emanate from the same source. She argues that a "promotional contest" includes a promotional competition in the field of athletics; that athletic competitions frequently have sponsors who affiliate their goods and services with the competition; that the services are frequently provided together, in that promotional contests are frequently provided in connection with athletic competitions to enhance participation in the competitions; that the promotional contests can include contests in the field of athletics and bicycling; and that registrant's services "are actually in the field of bicycling."

To support her position, the examining attorney relies on the following evidence:

- A dictionary definition of "contest":

1. competition to find best: an organized competition for a prize or title, especially one in which the entrants appear or demonstrate their skills individually and the winner is chosen by a group of judges.

encarta.msn.com

- A number of printouts from third-party websites showing that companies partner with the organizers of athletic competitions, for example:

An advertisement for the Baltimore Running Festival identifying the many sponsors for the event on its website.

thebaltimoremarathon.com

An advertisement for the 2010 FIFA World Cup South Africa identifying the marketing affiliates, partners and sponsors for the event.

ifa.com

An article wherein ESPN discusses sponsorship flexibility at the X Games:

"At Winter X you will see a glimpse of the transition to a broader base of sponsors, levels and categories. Sponsors can choose to be involved on-site, online, in program, depending on which of those executions meets their specific objectives."

sportsbusinessjournal.com

The website of Performance Research provides marketing analysis for corporate sponsorship of sports and special events and reports on the effectiveness of sponsorship activities on viewers of the events, in this case, the 1999 IRB Rugby World Cup:

Guinness was the only sponsor who managed to take advantage of their official sponsorship position with more than half of the fans reporting them to be involved with the [event]. ... "Until a sponsor develops a relationship with the fans that effectively communicates the benefits of the sponsorship to both the individual and their sport, the opportunity to develop brand-loyal consumers through sponsorship will be missed.

performancereasearch.com

- Printouts from websites showing that various sports competitions, including bicycle races, utilize promotional contests to encourage participation in the competitions and that they partner with the sponsors of the promotional event:

An advertisement for the South Atlantic League (SAL) Hagerstown Suns baseball team announces a promotional contest which will take place before the game:

Suns ATV giveaway concludes tonight via unusual giveaway. The Hagerstown Suns will complete the year-long Twigg Cycles Suzuki ATV Giveaway

contest at tonight's game at Municipal Stadium via a unique promotional contest. ... WAYZ 104.7fm Today's Hottest Country, co-sponsor of the ATV Giveaway, will be on-hand to monitor and judge the contest....
oursportscentral.com

An advertisement for the ABA BMX bicycle race (American Bicycle Association and Bicycle Motocross) showing that the ABA which "organizes BMX racing" and is "the largest promoter of action sports" holds races and also conducts promotional contests:

The Great Suzuki Quad Give Away!
Suzuki and ABA offer chance to win an ATV & More to all ABA BMX Tracks:

The American Bicycle Association (ABA) and American Suzuki Motor Corporation, the official Motorcycle and ATV of the 2007 ABA Bicycle Motocross (BMX) Racing Series, will be conducting an exciting promotional contest among all ABA tracks based on the East, West and Central regions.

All 274 ABA tracks across North America will be challenged to create and execute a promotional program, which enhances participation at their local track. ... Representatives from American Suzuki and the ABA will then pick the best 5 promotions from each region, then allow the tracks in each respective region to vote on a winner based on originality, creativity, exposure, success and cost effectiveness. ...
ababmx.com

- Printouts from the websites of various companies that conduct promotional contests, including contests involving sports activities, that may be held during athletic competitions:

The web page for Sports & Events Promotions advertises available "Sports Promotions & Competitions," for example:

Footy Target Kick
Team up with Sports & Events Promotions for the best football payoff promotions around! With

innovative Footy Contests such as a Footy Target Kick, you'll go all the way, Target Kick is a very entertaining game of skill promotion, popular with the spectators. Randomly select participants from the crowd or pick a contestant attending the event out of a draw, to kick through a target or through a hole in a banner with your brand for maximum effect.

Hole in One Golf

Add some excitement to your next golf tournament with a Hole in One Golf Contest offering irresistible high value prizes underwritten by our prize insurance cover. Sports & Events Promotions insured contests are used by retailers, FMCG companies, event organizers and many others. ... Make your next golf event challenging and rewarding by giving your golfers a chance of a lifetime to win cash, cars or holidays with a Hole in One Competition....

Basketball Contests

Consider the following popular basketball contests: 3 Point Shoot Out; Half Court; Around the World; Pick a Spot
sportsandeventspromotions.com

The website of OddsOn Promotions lists the various basketball-themed skills contests on the "Sports" section of the website, including "Full Court Shot" "Two of Three from Half Court" and "Series Shoot Out (25 secs)"
oddsonpromotions.com

• Four third-party registrations, two of which arguably cover the types of services identified in both the application and cited registration:

Registration No. 3839629 for the mark TEAM VELOCITY lists "promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with sports and entertainment events and sports competitions"; as well as "organizing exhibitions in the fields of sports and entertainment; organization of competitions for

entertainment purposes in the fields of sports and games."

Registration No. 3420569 for the mark SOUTH SHORE SPORTS PROMOTIONS A DEPARTMENT OF THE LAKE COUNTY CONVENTION & VISITORS BUREAU (and design) lists "promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with an awards program, a sports competition and sporting events"; as well as "organizing sporting events, namely, any and all amateur and professional sports competitions."

- A printout from the website, bicycling.com, showing that registrant is promoting bicycling under the mark:

BikeTown Africa 2010. Attend a BikeTown Africa Event. You could help build and distribute bikes in Africa this fall. ... About the Bikes: This year BikeTown participants will receive the Jamis Commuter 1 and Citizen bikes.

We turn to a comparison of the respective services. In doing so, we acknowledge that the marks are very similar and that the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the services on which they are used in order to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

However, the services must still be related in some viable manner such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they

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emanate from or are associated with the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Even if the marks are identical, if these conditions do not exist, we have held that confusion is not likely. See *In re Unilever Limited*, 222 USPQ 981 (TTAB 1984) and *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983).

We also point out that the question of likelihood of confusion must be determined based on the identification of services in the application and cited registration, regardless of what the record may reveal as to the actual nature of the services, the actual channels of trade or the class of purchasers to which the services are directed. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application [and registration]").

Applicant's services are identified as "organizing athletic competitions, namely, bicycle races." Registrant's services are identified, in pertinent part, as "promoting the goods and

services of others by arranging for sponsors to affiliate their goods and services with promotional contests.”⁴

To begin with, we point out that registrant’s services are not promotional contests. As identified, registrant’s services involve the affiliation of sponsors with promotional contests. These services are specifically different from organizing a sports competition, such as a bicycle race. In view of the distinct differences between the services, the two third-party registrations submitted by the examining attorney which arguably cover both services are insufficient to establish that it is customary or typical for the services of affiliating sponsors with promotional contests to emanate from the same entities that organize sports competitions, or that purchasers would naturally assume that the services emanate from the same source if they were offered under the same or similar marks.

Moreover, the evidence is insufficient to persuade us that the respective services are commercially related. It is true, as the evidence shows, that promotion, through sponsorship of a sports competition is necessary to the organization, presentation and success of the event, and to that extent there is an inherent relationship between organizing the event and promoting the event. The evidence also shows that one form of

⁴ Inasmuch as the examining attorney has not separately addressed the other services in the identification, we will focus on the services identified above in our analysis.

promotional support for a sports competition might be to hold a sports-related promotional contest in conjunction with the sports competition in order to increase participation in the event or attendance at the event.⁵

Again, however, the problem is that the cited mark is not registered for promotional contests, or for conducting them or presenting them to the public. Nor is registrant affiliating sponsors with athletic competitions. While the term "contest" may broadly include competitions in general, and more particularly sports competitions such as bicycle races, the examining attorney has not shown that a "promotional contest" is the equivalent of a sports competition, and the differences may be qualitatively significant. Furthermore, the fact that registrant may actually be promoting bicycling, as the examining attorney contends, is not relevant. The mark is not registered for that service and the identification does not encompass that

⁵ While we agree with applicant that "promotional contests" may involve the giveaway of cash or products to promote a company's goods or services, we disagree that "promotional contests" are limited to games of chance. One purpose of the contest may be to promote the sale of goods and services of the sponsors, but the contest is also intended to entertain the public, and the evidence clearly shows that the contests can involve athletes or others who compete for prizes by accomplishing something that requires athletic skill or ability. Furthermore, at least one of the dictionaries referenced by applicant shows that a "contest" in the marketing context may involve a "competition": "A form of sales promotion in which consumers are induced to buy earlier, or in greater quantity, by the offer of prizes of cash or merchandise to be won in a competition." MONASH University Marketing Dictionary (buseco.monash.edu.au).

service. Registrant's activities, as identified, are limited to affiliating goods and services with promotional contests.

The respective services are specifically different, and based on this record any relationship between them is tenuous at best. Registrant is essentially providing a marketing service and applicant is organizing bicycle races. These services are related only in the remote sense that the organizer of a sports competition who happens to want to include a promotional contest in conjunction with the event, would contact registrant to provide sponsors for the contest.

Regarding the purchasers for the respective services, the examining attorney contends that "the services of both parties are directed to consumers interested in bicycling." In particular, the examining attorney argues that applicant's services are directed to consumers interested in bicycling and competing in bicycle races and registrant's services "are directed to promoting interest in bicycling by increasing the number of bicyclists." Brief unnumbered, p. 16.

Applicant's bicycle races are directed to the general public, including participants in the event, as well as those who may attend or view the event. Registrant, on the other hand, essentially provides a marketing service. Its services are directed to businesses or companies who might wish to use a promotional contest to sell their products or services, as well

as to the potential sponsors for those promotional contests. There is nothing in the record to indicate that the participants or spectators who would encounter applicant's bicycle race would ever be exposed to or be aware of registrant's mark for its services.

The one class of purchaser that might encounter both marks comprises sponsors or potential sponsors that would be interested in promoting their goods or services through both sports competitions and promotional contests. It is possible that both services might appeal to the same sponsors. This overlap might occur, for example, if a company which had previously sponsored applicant's BIKE TOWN USA bicycle race, later decides to use a promotional contest to promote its goods or services, the company would then encounter registrant's BIKETOWN marketing services to accomplish that purpose. However, the likelihood that this company will believe that the services of organizing bicycle races come from the same source as a marketing service that affiliates goods and services with promotional contests seems theoretical and speculative. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) ("We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations.").

Furthermore, the potential customers that these services might have in common would be sophisticated and knowledgeable, and as such, would be expected to exercise greater care in making purchasing decisions. *Electronic Design & Sales*, 21 USPQ2d at 1392 (Fed. Cir. 1992) ("sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care."; finding no likelihood of confusion resulting from the contemporaneous use of E.D.S. and EDS despite the fact that "the two parties conduct business not only in the same fields but also with some of the same companies." *Id.*, at 1391).

In view of the foregoing, we find that although the marks in this case are similar, given the distinct differences in the services and the sophistication of the purchasers for those services, confusion is not likely.

Decision: The refusal to register is reversed.