DMCLANE.017T TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant	:	David McLane Enterprises, Inc.
Serial No.	:	78/168,844
Filed	:	September 27, 2002
Mark	:	TRIPLE CROWN OF POLO
Examining Attorney	:	LaVerne T. Thompson
Law Office	:	116

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: P.O. Box 1451, Alexandria, VA 22313-1451, on

May 16, 2005
(Date)

Diane M. Reed

APPEAL BRIEF

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

ATTN: BOX TTAB NO FEE

Dear Sirs:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration under Trademark Act Section 2(d). This Appeal is from the Final Refusal issued by the Examining Attorney dated September 16, 2004 and follows Applicant's Notice of Appeal timely filed on March 15, 2005.

The Application

The subject application is for the mark TRIPLE CROWN OF POLO, covering:

Entertainment services, namely, promoting polo competitions and tournaments of others by awarding prizes to winners of designated polo tournaments, promoting the sport of polo by awarding prizes to winners of designated polo tournaments, in International Class 35; and

05-18-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #39

Entertainment services, namely, organizing and conducting polo competitions and tournaments, in International Class 41.

Basis of Final Refusal

The Examining Attorney based her final refusal on the 3 following registrations, all owned by Triple Crown Productions, Inc. :

1. Registration No. 984,679 for the mark TRIPLE CROWN for promoting the competitiveness of thoroughbred horse racing;

2. Registration No. 1,479,895 for the mark  for organizing and supervising the process of nominating thoroughbred horses for a series of thoroughbred races; and

3. Registration No. 1,902,003 for the mark TRIPLE CROWN CHALLENGE for promoting thoroughbred horse racing though a system established for awarding prizes to the owners of thoroughbred horses, based upon their finish in a series of thoroughbred horse races."

Prosecution History

The Examining Attorney initially refused registration of Applicant's mark on the basis of the following registrations:

1) Registration No. 984679 for the mark TRIPLE CROWN for "promoting the competitiveness of thoroughbred horse racing."

2) Registration No. 1479895 for the mark TRIPLE CROWN and Design for "organizing and supervising the process of nominating thoroughbred horses for a series of thoroughbred races."

3) Registration No. 1902003 for the mark TRIPLE CROWN CHALLENGE for "promoting thoroughbred horse racing through a system established for awarding prizes to the

owners of thoroughbred horses, based upon their finish in a series of thoroughbred horse races."

4) Registration No. 1675398 for the mark TRIPLE CROWN for "entertainment services, namely, organizing and conducting slow pitch softball tournaments."

5) Registration No. 1688185 for the mark TRIPLE CROWN for "entertainment services, namely, organizing and conducting soccer tournaments."

6) Registration No. 1999737 for the mark TRIPLE CROWN for "organizing and promoting state and national street hockey festivals, state and national three-on-three basketball tournaments, state and national volleyball tournaments, state and national baseball tournaments, college women's pre-season national invitational basketball tournaments, state and national soccer tournaments, and state and national fast pitch softball tournaments."

7) Registration No. 2023608 for the mark TRIPLE CROWN OF SURFING for "entertainment services, namely, organizing and conducting international competitions in the field of ocean sports."

8) Registration No. 2244756 for the mark TRIPLE CROWN OF SKATEBOARDING for "entertainment services, namely, organizing and conducting international skateboarding competitions."

9) Registration No. 2245145 for the mark TRIPLE CROWN OF WAKEBOARDING for clothing and "entertainment services, namely, organizing and conducting international competitions in the field of ocean sports."

10) Registration No. 2248328 for the mark TRIPLE CROWN OF SNOWBOARDING for "entertainment services, namely, organizing and conducting international competitions in the field of snowboarding."

11) Registration No. 2384138 for the mark TRIPLE CROWN OF FREESTYLE MOTOCROSS for clothing and "entertainment services, namely, organizing and conducting international motorcycle competitions."

12) Registration No. 2482821 for the mark TRIPLE CROWN OF BMX for clothing and "entertainment services, namely, organizing and conducting international competitions in the field of bicycle sports."

Registration Nos. 1-3 are owned by related companies, Triple Crown Productions, Inc. and Triple Crown Productions, LLC. Registration Nos. 4-6 are owned by Triple Crown Sports, Inc. and Registration Nos. 7-12 are owned by Vans, Inc.

Following Applicant's arguments made in its Response date August 27, 2004, the Examining Attorney withdrew the Section 2(d) refusals because of Registrations Nos. 1,675,398, 1,688,185, 1,999,737, 2,023,608, 2,244,756, 2,245,145, 2,248,628, 2,384,138, 2,482,821 (numbers 4 – 12 above), and maintained and made Final her refusal based on the 3 cited registrations first listed above.

Summary of Argument

The Examining Attorney has incorrectly refused registration of applicant's TRIPLE CROWN OF POLO mark for the following reasons (1) "Triple Crown" is a very common element of many registered marks in use in the marketplace, and thus, each such mark is entitled to a very narrow scope of protection; (2) the cited marks and TRIPLE CROWN OF POLO mark are significantly different; (3) the services are sufficiently different because the marks are used in connection with very different sports.

1. **The Cited Registrations Are Entitled To A Very Narrow Scope of Protection**

The Examining Attorney initially cited 12 registrations against this application. Those registrations are owned by at least three different entities. The existence on the Trademark Register of 12 registrations for similar marks owned by at least three different entities demonstrates the weakness of the cited registrations and that there is no likelihood of confusion between the cited marks and TRIPLE

CROWN OF POLO. Certainly, Applicant's mark is no more similar to these registered marks than they are to each other.

The Examining Attorney argues that the third-party registrations are entitled to little weight on the question of likelihood of confusion, and are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks.

To the contrary, third party registrations containing the words TRIPLE CROWN illustrate that "[t]he term has weak trademark significance in [the applicable] field because of its suggestiveness, which is evidenced by its widespread adoption and registration." In re Hamilton Bank, 222 U.S.P.Q. 174, 177 (T.T.A.B. 1974).

In In re Hamilton Bank, the Trademark Trial and Appeal Board reversed the refusal to register under Section 2(d) based on the fact that the federal register showed over twenty registrations for banking services incorporating the word "key." Id. "What this case boils down to is the fact that the term "KEY' is part of at least twenty registered service marks adopted in the banking field." The TTAB held that "the applicant's mark is no more likely to cause confusion with the five cited registered marks than the five cited registered marks are likely to cause confusion with the fifteen other registered marks which contain the term 'KEY.'" Id. Likewise, Applicant's mark is no more likely to cause confusion with the cited marks than the cited marks are likely to cause confusion with the other registrations containing the words TRIPLE CROWN.

Third party registrations have often served as evidence or a crowded field and relative weakness of cited marks. In *Western Publishing Co. v. Rose Art Industries, Inc.*15 U.S.P.Q.2d 1545 (2nd Cir. 1990),the Second Circuit said that the mere "numerosity of third party registrations" using a term weakens its strength as a mark. In *Ocean Bio-Chem, Inc. v. Turner Network Television, Inc.*, 16 U.S.P.Q.2d 1264 (S.D. Fla. 1990), the court viewed registrations standing alone as evidence of third party use and hence weakness of the mark.

According to *In re Hamilton Bank*, third party registrations are *evidence that* the marketplace can distinguish between certain marks. And in fact, the marketplace can distinguish between all of the "Triple Crown" marks because they are all extensively used in the marketplace. Triple Crown Sports, owners of the Registration Nos. 1,675,398, 1,688,185, and 1,999,737, operates TRIPLE CROWN hockey tournaments, baseball tournaments, fast pitch softball tournaments, slow pitch softball tournaments, basketball tournaments, basketball tournaments, and soccer tournaments. In addition, Vans, Inc.'s TRIPLE CROWN OF SURFING event (Registration No. 2,023, 608) is a major event each year in competitive surfing. Vans also operates the TRIPLE CROWN OF SNOWBOARDING, TRIPLE CROWN OF SKATEBOARDING, TRIPLE CROWN OF WAKEBOARDING, TRIPLE CROWN OF FREESTYLE MOTOCROSS and TRIPLE CROWN OF BMX competitions. Although Applicant cannot introduce "new" evidence into the record, the common and extensive use of these third party marks is splattered all over the Internet, is very well known, and should have been readily apparent to the Examining Attorney in her research.

In any event, the Board should presume that the third party registrations are in use in the marketplace. The Examining Attorney initially cited all 12 of these registrations against this application, and in so doing, took the position that the effect in the marketplace would be to create a likelihood of confusion or mistake on the part of the purchasing public. TMEP §1207.01. The Examining Attorney cannot now take the inconsistent position that the 9 registrations with respect to which she withdrew her refusal, are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks.

According to *In re Melville Corp.* 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991), one of the cases cited by the Examining Attorney, the TTAB says that third party registrations may be considered to demonstrate "the meaning of a word which comprises the mark, ..., to show that there is a well-known and commonly understood meaning of that word and that the mark has been chosen to convey that meaning.... The conclusion to be drawn in such a case is that there is an inherent weakness in a mark

comprised in whole or in part of the word in question and that, therefore, the question of likelihood of confusion is colored by that weakness to the extent that only slight differences in the marks may be sufficient to distinguish one from the other." Clearly, under *Melville*, the term TRIPLE CROWN is inherently weak, and the analysis of likelihood of confusion must take into account that weakness.

Applicant requests that the TTAB take judicial notice of the dictionary definition of TRIPLE CROWN. TBMP §1208.04. Attached as Exhibit A is a definition from the *Merriam-Webster Online* dictionary which defines "Triple Crown" as "an unofficial title in horse racing representing the championship achieved by a horse that wins the three classic races for a designated category" and as "the unofficial title signifying the achievement of a baseball player who at the end of a season leads the league in batting average, home runs and runs batted in." This definition establishes that "Triple Crown" is commonly used in connection with more than one sport without confusion.

Because the TRIPLE CROWN mark is a common mark and commonly used in the marketplace in connection with a wide variety of sporting events, the cited marks are weak marks and are entitled to only a narrow scope of protection for purposes of determining likelihood of confusion. "The Trademark Trial and Appeal Board and the courts have recognized that ... weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word." T.M.E.P. §1207.01(b)(ix) (emphasis added). Applicant submits that the cited marks should be construed narrowly in view of the large number of similar marks used in connection with related services.

Applicant also wants to bring to the Board's attention that in addition to the 12 registrations initially cited against this Application, the Applicant made of record 4 additional registrations and 8 pending applications that at the time had already received a Notice of Allowance or had published for opposition, for the marks: TRIPLE CROWN OF BUSINESS; TRIPLE CROWN WORLD LEADER IN PET EDUCATION; TRIPLE CROWN CHASE; TRIPLE CROWN; TRIPLE CROWN ACADEMY THE SMART CHOICE IN CANINE CAREERS; TRIPLE CROWN OF JET SKIING; TRIPLE CROWN ACADEMY FOR PROFESSIONAL DOG TRAINERS; TRIPLE CROWN OF SKATEBOARDING;

TRIPLE CROWN OF SNOWBOARDING; TRIPLE CROWN OF WAKEBOARDING; TRIPLE CROWN OF SNOWCROSS; and TRIPLE CROWN OF SURFING. *See* Applicant's response to Office Action No. 1. The TRIPE CROWN WORLD LEADER IN PET EDUCATION mark is now registered.

2. TRIPLE CROWN OF POLO is Sufficiently Different from the Marks in the Cited Registrations.

The Examining Attorney argues that the cited marks and the TRIPLE CROWN OF POLO mark are confusingly similar because the dominant portions are the same and applicant has merely added a descriptive term to the literal portion of the registrant's marks.

First, as established above, the "Triple Crown" component is weak and entitled to a narrow scope of protection. Further, the addition of "OF POLO" to the mark is critical to distinguishing applicant's mark from the cited marks. Applicant's TRIPLE CROWN OF POLO mark is clearly associated with the sport of Polo and not with thoroughbred racing. Thus, when used in the marketplace in connection with the identified services, the marks are significantly different.

A. The Marks Must Be Compared In Their Entireties

In making a determination of likelihood of confusion, marks must be compared in their entireties and should not be dissected and their parts compared separately. In fact, it has been held that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely. See Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). Two of the cited registrations are significantly different from TRIPLE CROWN OF POLO. Registration No. 1,479,895 is dominated by its design element  and Registration No. 1,902,003 includes the word "Challenge."

B. Common Words Are Not Enough. Applicant's mark, TRIPLE CROWN OF POLO, considered in its entirety, is not likely to be confused with the cited marks. In *Textronix v. Daktronics, Inc.*, the court notes that "[b]ecause marks, including any suggestive portions

thereof, must be considered in their entireties, the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of a likelihood of confusion [citations omitted]." 534 F.2d 915, 916-17 (2nd Cir. 1976). Similarly, the court in *Matter of P. Ferrero & CSPA* found TIC TAC for candy not confusingly similar to TIC TAC TOE for ice cream even though both marks contained the words "tic tac" and were applied to goods in the same class. 178 U.S.P.Q. 167 (C.C.P.A. 1973). "[The Trademark Trial and Appeal] board has made too much of the indisputable fact that TIC TAC is two-thirds of TIC TAC TOE and that TIC TAC would "bring to mind" TIC TAC TOE. Neither fact determines the issue of likelihood of confusion." Id. at 168. The court reasoned that despite the common words, each mark considered as a whole was sufficiently different to avoid confusion.

The Examining Attorney states that the Applicant "has merely added descriptive terms to the [registered] marks" and this is insufficient to overcome a likelihood of confusion. The Examining Attorney's discussion does not take into account the essential role of the additional words in Applicant's mark. Although the terms OF POLO may be descriptive as applied to Applicant's services, the words OF POLO are critical in conveying the meaning of Applicant's mark. The words OF POLO cause the dominant impression of Applicant's mark to be related to the sport of polo. Without the words OF POLO, consumers have no point of association between Applicant's mark and Applicant's services. The words OF POLO add meaningful context to Applicant's mark.

The descriptive nature of the words OF POLO do not properly justify ignoring their importance in a likelihood of confusion determination. To dismiss the significance of the words OF POLO in a likelihood of confusion analysis would be equivalent to finding that the words OF POLO essentially have no meaning, serve no purpose and leave no impression upon consumers in the context of Applicant's mark.

In fact, focusing only on the TRIPLE CROWN portions of the marks would be improperly dissecting Applicant's mark. As discussed above, the courts have held that ultimate conclusions cannot be based on only part of a mark. As McCarthy notes, "It has been held to be a violation of the anti-dissection rule to focus upon the 'prominent' feature of a mark and decide likely confusion solely upon that feature ignoring all other elements of the mark. Similarly it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains." *See McCarthy on Trademarks and Unfair Competition,* §23:41 (emphasis added).

Applicant's position is supported by the findings of the Examining Attorneys who examined all of the third party TRIPLE CROWN registrations listed above. For example, why should TRIPLE CROWN OF POLO be treated differently than Vans Inc.'s application to register TRIPLE CROWN OF BMX? The 3 cited registrations and the 3 registrations owned by Triple Crown Sports (Registration Nos. 1,675,398, 1,688,185, and 1,999,737) were all issued prior to issuance of the earliest registration owned by Vans Inc. These first six cited registrations were for variations of the mark TRIPLE CROWN in connection with the promoting, organizing and conducting of sporting competitions. Thereafter, Vans, Inc. applied for several marks, listed above as registrations 7-12. These marks all contain the words TRIPLE CROWN, and differ from the earlier registrations only by the addition of the descriptive words, e.g., OF SURFING, OF SNOWBOARDING, OF BMX, etc. Based on the Examining Attorney's reasoning in the instant case, Vans merely added descriptive terms to the words TRIPLE CROWN, and this should be considered insufficient to overcome a likelihood of confusion. In addition, Vans disclaimed the descriptive wording in each mark, e.g., disclaimer of SURFING, SNOWBOARDING, and BMX, leaving the claim of exclusive rights to the TRIPLE CROWN portion of the marks. Further, Vans marks were all in the field of promoting sports and conducting sporting competitions.

Notwithstanding the above, the several Examining Attorneys of the respective Vans registrations found that there was no likelihood of confusion between the Vans marks and the prior registered TRIPLE

CROWN marks, although the marks all contained the words TRIPLE CROWN, and were used for promoting various sporting events.

Like the marks in the mentioned Vans registrations, Applicant's TRIPLE CROWN OF POLO mark differs from the other "TRIPLE CROWN" marks by the addition of words which identify a particular sport. As the Vans marks were not found to be confusingly similar to the other TRIPLE CROWN marks, surely, Applicant's mark should neither be found confusingly similar to the registered marks.

A proper analysis of **all** the elements in Applicant's mark would lead to a conclusion that the words OF POLO in Applicant's mark completely change the meaning and impression of Applicant's mark such that confusion is unlikely.

Applicant presumes, as does the Trademark Office, that the registered marks containing the words TRIPLE CROWN (the 3 cited registration and the 9 third party registrations), owned by at least three different parties, are able to co-exist with no likelihood of confusion. Applicant submits that its mark is no more similar to the cited registrations than any of the third party registrations is similar to the cited registrations or to each other. The Trademark Office has previously determined that the commonality of the words TRIPLE CROWN used on similar services is not sufficient to find a likelihood of confusion between the marks. Because Applicant's mark is no more similar to any of the registered marks than they are to the other registered marks, to refuse registration to Applicant based on the commonality of the TRIPLE CROWN words would be to single out Applicant's mark and subject it to inconsistent treatment. The TTAB has stated that the PTO should avoid inconsistent practices. *See, e.g., In re Women's Publishing Co., Inc.*, 23 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1992).

3. <u>Polo and Thoroughbred Horse Racing Are Sufficiently Different and Unrelated Sports.</u>

The Examining Attorney contends that applicant's services and the registrant's services are closely related because both provide promotional services for "related sports, both are equestrian sports, both would appeal to horse enthusiasts, both are forms of horse competitions. In support of her

contention, the Examining Attorney provided copies of excerpted articles from the LEXIS/NEXIS database to show that the sport of polo and horse racing are related sports.

The sports are polo and horse racing are not related and the Examining Attorney has failed to establish that they are so related. It is true that both sports involve horses, just as baseball, basketball, football, tennis and water polo are played with a ball, and just as polo and croquet are played with a mallet. Yet, they are all entirely different sports and clearly treated as unrelated in the marketplace.

The Examining Attorney's evidence does not support her proposition for the following reasons:

Ref. No.	Reason
1	suggests only that horse racing and polo enthusiasts drink champagne
2	suggests only that the lower tailgate on a Rolls-Royce is used for picnics, or as an elevated platform for watching horse racing or polo.
3	suggests only that the same facility hosts polo matches and horse racing tournaments
4	reports that a well known hotel bar in Beverly Hills, The Beverly Hills Hotel's Polo Lounge, held a party for the opening of the movie "Seabiscuit" and decorated the lounge to resemble a 1930's horse racing club.
5	suggests only that a sports writer wrote about baseball, basketball, horse racing, hunting, polo and many other sports
6	same as 3 above
7	suggests only that in Shanghai in the 1920's there were polo and horse racing grounds and many nightclubs.
8	reports that there is a visitors center in Kershaw County that has a sporting-life gallery celebrating polo, horse racing and hunting.
9	suggests that parents should take precautions when children ride horses and mentions that other forms of horse competition, such as polo and horse racing, show the dangers of horse riding

10 suggests that horse racing and polo are popular in the United Arab Emirates and the football is becoming more popular

11 suggests that historically in India, India's royalty was known for its thriving patronage of equine events.

12 reports that both polo horses and racing horses are thoroughbreds

13 suggests that northerners brought horse racing and polo to Savannah

14 - 20 suggests that certain people that own racing horses also play polo (in some cases "racing" refers to steeplechase riding and not thoroughbred racing)

21 suggests that horse racing, show horses, polo, veterinary medicine, therapeutic/handicapped riding programs, and feed and tack stores, are part of the horse industry employing many people in the state

Applicant submits that the Examining Attorney's evidence supports only the fact that both thoroughbred horse racing and polo involve horses. From that, the Examining Attorney has made an unsupported leap that the services are so related that consumers in the marketplace will think the services of (1) promoting the competitiveness of *thoroughbred horse racing;* and (2) promoting *polo competitions and tournaments* of others by awarding prizes to winners of designated polo tournaments, *promoting the sport of polo* by awarding prizes to winners of designated polo tournaments, and organizing and conducting *polo competitions and tournaments* emanate from the same source.

Sports fans are sophisticated enough and knowledgeable enough about the sports they watch to differentiate the sports. Those consumers will not think that sporting events emanate from the same source merely because they use similar "equipment" or are played in the same location or involve some of the same athletes. For instance baseball and football are often played on the same field. In addition, many professional athletes have played unrelated sports. For example, Michael Jordan played professional baseball for a period of time.

Sports fans are also used to the same championship "titles" being used in connection with many different sports. In addition to being accustomed to "Triple Crown" being used in connection with many different sports, sports fans are accustomed to "World Series" and "World Cup" being used in connection with many different sports. The term "World Series" first brings professional baseball to mind, however, the World Series of Poker is one of the most popular competitions right now. There is also a ChampCar World Series. Similarly, the World Cup is most closely associated with soccer, but is also used in connection with surfing competitions.

Based on the above, Applicant respectfully requests that the Trademark Trial and Appeal Board to overturn the Examining Attorney's refusal and direct that the subject application be approved for publication.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 5/10/2005

By: _____

Diane M. Reed
2040 Main Street
14th Floor
Irvine, CA 92614
(949) 760-0404

1712453:nr1
051305

EXHIBIT "A"

Merriam-Webster OnLine

Merriam-Webster FOR KIDS Encyclopædia BRITANNICA
Merriam-Webster ONLINE Merriam-Webster COLLEGIATE® Merriam-Webster UN

HOME
PREMIUM SERVICES
M-WCollegiate.com
M-WUnabridged.com
Britannica.com
Multi-User Licenses
DOWNLOADS
WORD OF THE DAY
WORD GAMES
WORD FOR THE WISE
ONLINE STORE
HELP

Merriam-Webster Inc.
Company information

Merriam-Webster Online Dictionary

Thesaurus

One entry found for **Triple Crown**.

Main Entry: **Triple Crown**
Function: *noun*
1 : an unofficial title in horse racing representing the championship achieved by a horse that wins the three classic races for a designated category
2 : the unofficial title signifying the achievement of a baseball player who at the end of a season leads the league in batting average, home runs, and runs batted in

For **More Information on "Triple+Crown" go to Britannica.com**

Get the **Top 10 Search Results for "Triple+Crown"**

Merriam-Webste
Dictionary
Thesaurus

Britan
Triple+Crowi

Palm & Pock
Browse and downl
Merriam-Webster
e-books and game
Palm and Pocket P
and Mobile Phones
Merriam-Webs
Online Store

Handheld Collegiate
Now you can take
Eleventh Edition w
anywhere as Franl
new Speaking Elec
Handheld!
Franklin.com/

Merriam-Wet
Collegiat
14-day Free

Pronunciation Symbols

Products Premium Services Company Info Contact Us Advertising Info Privacy P

© 2005 Merriam-Webster, Incorporated