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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Richard Donovan
Granted to Date of previous extension	01/17/2018
Address	95 Rosan Glas Rahoon Road Galway, 0 IRELAND

Attorney information	Eric Perrott, Esq. Gerben Law Firm, PLLC 1050 Connecticut Ave NW, Suite 500 Washington, DC 20036 UNITED STATES Email: jgerben@gerbenlawfirm.com, eperrott@gerbenlawfirm.com

Applicant Information

Application No	86089411	Publication date	09/19/2017
Opposition Filing Date	11/14/2017	Opposition Period Ends	01/17/2018
Applicant	Marathon Tours, Inc C-5 Shipway Place Boston, MA 02129 UNITED STATES		

Goods/Services Affected by Opposition

Class 039. First Use: 1995/09/00 First Use In Commerce: 1995/09/00
All goods and services in the class are opposed, namely: travel services, namely, organizing andarranging travel, travel tours, excursions, sightseeing travel tours; providingtravel guide and travel information services; making transport reservation

Grounds for Opposition

The mark is merely descriptive	Trademark Act Section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act Section 2(e)(1)
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)
Deceptiveness	Trademark Act Section 2(a)
Other	Judicial estoppel based on prior TTAB decision

Marks Cited by Opposer as Basis for Opposition

U.S. Application	86088840	Application Date	10/10/2013

No.			
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE 7 CONTINENTS MARATHON CLUB		
Design Mark			
Description of Mark	The mark consists of the artistic rendering of a human being running in blue. The human being is drawn to appear holding a small rendering of the planet Earth in blue and green and running into a finish line ribbon in blue and white. The stylized words "THE 7 CONTINENTS MARATHONCLUB" appear below the human being in blue and white.		
Goods/Services	Class 025. First use: First Use: 2013/09/00 First Use In Commerce: 2013/09/00 T-shirts; Singlets; Running shorts; Hats; Beanies; Clothing, namely, base layers; Fleece tops; Wind pants; Wind jackets Class 041. First use: First Use: 2013/09/00 First Use In Commerce: 2013/09/00 Providing recognition and incentives bythe way of awards to promote running in-marathons; Providing an honor society in which runners are admitted in recognition of marathon running achievement		

U.S. Application No.	87118108	Application Date	07/27/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE 7 CONTINENTS MARATHON CLUB		
Design Mark	THE 7 CONTINENTS MARATHON CLUB		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2009/00/00 First Use In Commerce: 2009/00/00 Providing recognition and incentives bythe way of awards to promote running in-marathons; Providing an honor society in which runners are admitted in recognition of marathon running achievement		

Attachments	86088840#TMSN.png(bytes) 87118108#TMSN.png(bytes) Seven Continents Club_Notice of Opposition Nov 14.pdf(48440 bytes)

Signature	/Eric Perrott, Esq./
Name	Eric Perrott, Esq.
Date	11/14/2017

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

Richard Donovan Opposer, v. Marathon Tours, Inc. Applicant.	Opposition No.: Mark: SEVEN CONTINENTS CLUB Application No: 86089411

Notice of Opposition

1. Opposer Richard Donovan (hereinafter referred to as "Opposer"), an Irish citizen, believes that he will be damaged by the registration of the mark shown in Application Serial No. 86089411 and hereby opposes this application. This application was filed by Marathon Tours, Inc., a Massachusetts corporation (hereinafter referred to as "Applicant"), and was published in the Official Gazette on September 19, 2017.

2. On October 13, 2013, Applicant filed a trademark application for SEVEN CONTINENTS CLUB ("Applicant's Mark") for "travel services, namely, organizing and arranging travel, travel tours, excursions, sightseeing travel tours; providing travel guide and travel information services; making transport reservation" in International Class 39 ("Applicant's Services") and was assigned Serial Number 86089411 (the "Applicant's Application").

3. Opposer believes that his own use of the phrase "7 Continents Marathon Club" will be damaged by the registration of Applicant's Mark, as such registration would give Applicant a *prima facie* right to exclusive use of the trademark.

COUNT 1: APPLICANT IS ESTOPPED FROM CLAIMED ACQUIRED DISTINCTIVENESS IN ITS HIGHLY DESCRIPTIVE MARK

4. February 13, 2014, Applicant filed a Notice of Opposition against Opposer on the grounds that it was the owner of the SEVEN CONTINENTS CLUB trademark for travel services and apparel.

5. On March 9, 2017, the Trademark Trial and Appeal Board sustained the Applicant's opposition on the grounds that the phrase "SEVEN CONTINENTS CLUB" was inherently distinctive for apparel and overlapped with Opposer's application's goods also in class 25.

6. In its March 9, 2017 decision, the Trademark Trial and Appeal Board held Applicant "has not, however, shown that its proposed mark has acquired distinctiveness for its services, nor in particular that its use of the mark has been substantially exclusive in connection with [Applicant's] travel services, including offering a club for those who run marathons on all seven continents." (Marathon Tours, Inc. v. Richard Donovan, Proc. No. 91214917, p. 14 (TTAB May 9, 2017).

7. Based on the Trademark Trial and Appeal Board's prior decision in a case involving identical facts and an identical trademark to the present proceeding, Applicant is estoppel from re-litigating an issue already decided by this Board.

8. As this Board has already stated, Applicant's Mark has not acquired distinctiveness, as it does not have widespread recognition or exclusivity of use of Applicant's Mark in the United States.

9. Applicant should not get to reargue a case that took over three years to prosecute and the Examining Attorney clearly erred in accepting Applicant's 2(f) claim based on five years of use in the marketplace.

COUNT 2: APPLICANT'S MARK IS MERELY DESCRIPTIVE AND HAS NOT ACQUIRED DISTINCTIVENESS

10. Applicant's Mark is descriptive of Applicant's Services, as admitted by the Applicant through its filing of a claim of "acquired distinctiveness" under Section 2(f) of the Lanham Act during the prosecution of Applicant's Application.

11. Applicant offers services that claim to provide travel accommodations to consumers on seven continents. If true, the phrase SEVEN CONTINENTS CLUB merely describes Applicant's Services and is a highly descriptive mark, as stated by the TTAB in the prior proceeding. *Marathon Tours, Inc. v. Richard Donovan*, Proc. No. 91214917, p. 14 (TTAB May 9, 2017.

12. Applicant's Mark has not acquired distinctiveness and, therefore, does not function as a trademark.

13. The Applicant's registration of Applicant's Mark would be inconsistent with the Opposer's right to use the descriptive phrase "7 Continents Marathon Club" for its own services.

14. By reason of all the foregoing, Opposer would be gravely damaged by the registration of the Applicant's Mark.

COUNT 3: APPLICANT'S MARK IS DECEPTIVELY MIS-DESCRIPTIVE

15. Applicant's use of the phrase SEVEN CONTINENTS CLUB is deceptively mis-descriptive under Lanham Act §2(e).

16. Applicant does not render its services on all seven continents, as Applicant's event is on King George Island, an island that is not within the Antarctic Circle or on the Antarctic continental landmass.

17. Applicant's use of the phrase "Seven Continents Club" makes the Applicant's Mark deceptively mis-descriptive as it misrepresents facts concerning Applicant's Services and consumers are likely to believe the mis-description.

18. The Applicant's registration is inconsistent with the Opposer's right to use and register Opposer's Mark for the Opposer's association services.

19. By reason of all the foregoing, Opposer is would be gravely damaged by the registration of the Applicant's Mark.

CLAIM 4: DECEPTIVE UNDER LANHAM ACT SECTION 2(a)

20. Applicant's Mark is deceptive under Lanham Act Section 2(a) and is ineligible for registration with the United States Patent and Trademark Office.

21. Applicant does not render its services on all seven continents, as Applicant's event is on King George Island, an island that is not within the Antarctic Circle or on the Antarctic continental landmass.

22. Applicant willfully deceives consumers through its claim that it renders tour guide services for consumers on all seven continents.

23. Applicant's deception bestows upon its services an appearance of greater quality or salability than it has in fact and is material to consumers' decision to purchase Applicant's Services.

24. The Applicant's registration is inconsistent with the Opposer's right to use the phrase "7 Continents Marathon Club" for the Opposer's association services.

25. By reason of all the foregoing, Opposer is would be gravely damaged by the registration of the Applicant's Mark.

WHEREFORE, by its undersigned attorneys, Richard Donovan respectfully requests that this Notice of Opposition be sustained and that registration of the mark SEVEN CONTINENTS CLUB, Serial No. 86089411, be refused.

Dated: November 14, 2017

Respectfully submitted,

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