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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 19, 2007

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Cancellation No. 92045257

ROBERT A. SCHEDER

v.

TOURISTIK ARBEITSGEMEINSCHAFT
ROMANTISCHE STRABE GbR

Before Walters, Rogers and Cataldo,
Administrative Trademark Judges.

By the Board:

Touristik Arbeitsgemeinschaft Romantische Strabe
("Registrant") owns U.S. Reg. No. 3011652, issued on
November 1, 2005,¹ on the Principal Register for the mark
ROMANTIC ROAD for certain tourism services and certain
publication services in, respectively, Classes 35 and 41.²

¹ The application which matured into the subject registration was filed under the Madrid Protocol, Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f). The application as filed was based on International Registration No. 0837370, which was itself based on German Registration No. 302 39 858.

² U.S. Reg. No. 3011652 is for "Promotion of tourism through marketing and advertising; distribution of advertising material, preparing signboard advertising for others; conducting promotional events in the field of tourism and marketing in connection with tourism and exhibitions for commercial and advertising purposes; providing of commercial information for business purposes about all members and partners; advertising for flat rate offers for providing of food, drink and temporary accommodation" in Class 035 **and** "Publication of printed information material in different languages, publication of

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On December 12, 2005, Robert A. Scheder ("Petitioner") filed a petition to cancel only the International Class 35 services in the registration, claiming that the mark is primarily geographically descriptive. Petitioner alleges that Registrant's continued use and registration of ROMANTIC ROAD in connection with the identified services "damages [his] business because [he is] engaged in the sale of related goods and services and [he has] an interest in using the term 'Romantic Road' descriptively in [his] business" (Pet. ¶ 1).³

Registrant denied all of the salient allegations.

This case now comes up on Registrant's motion for summary judgment on petitioner's claim of geographic descriptiveness, filed September 1, 2006.⁴ In its motion,

printed matter, printed information material and printed media notes; publication of brochures, prospectuses, accommodation lists, events calendars, cards and stickers conducting of seminars and lectures in the field of tourism for commercial and advertising purposes" in Class 041. It is noted that registrant also owns U.S. Reg. No. 3085665 for ROMANTIC ROAD and Design in connection with services in Classes 35, 41 and 43.

³ Petitioner alleges that he has operated the Internet domain www.romanticroad.com since 1997 and currently hosts forty websites on it. (Resp. at p. 22). Petitioner alleges that his service is related to registrant's because he provides information about the Romantic Road region of Germany. (*Id.*).

⁴ Petitioner filed two motions of his own, namely, a "motion to cancel amendments" and a "motion to void" the application, both based on allegedly incorrect owner names on the U.S. registration. The ministerial change to the list of owner names on the U.S. registration was a technical correction initiated by the International Bureau in regard to the international registration and subsequently effected by the USPTO in regard to the Madrid Protocol extension filing. See 37 C.F.R. § 7.14. Additionally, the International Registration has been assigned

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Registrant contends that the mark is **not** primarily geographically descriptive of the services it renders⁵ and in support Registrant provides documentary evidence of the history of the mark. In response, Petitioner challenges Registrant's documentary evidence and has submitted maps and other references to the area known as the "Romantic Road".

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences, which may be drawn from the underlying undisputed facts, must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary

and the assignment recorded in the USPTO. Accordingly, the new owner, as reflected in the Assignment Branch records, recorded at Reel 3472/Frame 0712 on February 1, 2007 with an execution date of October 6, 2006, is hereby substituted as the registrant.

We note that the petition for cancellation contains only a single claim, geographic descriptiveness, against only one (1) class in the involved registration. The two motions directed to ownership are essentially motions that seek entry of judgment for petitioner based on unpleaded issues and therefore are denied for that reason, apart from their being rendered moot by the International Bureau's actions.

⁵ Registrant also argues that Petitioner does not have standing to bring this petition. However, to the extent Petitioner alleges that he is being sued in Germany by registrant to obtain the domain name www.romanticroad.com, and registrant is using ownership of its U.S. registration in support of that suit, Petitioner has pleaded standing.

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judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Section 2(e)(2) of the Trademark Act prohibits registration of marks which, when used in connection with the identified goods and services, are primarily geographically descriptive. For a plaintiff to establish that a mark is primarily geographically descriptive, the party must typically 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 originates 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); *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

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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).

In this case, Registrant does not dispute that ROMANTIC ROAD has come to identify a specific geographic region, and that its goods and services originate from there, but argues that ROMANTIC ROAD is not primarily geographically descriptive because its primary significance is as a trademark/service mark to designate Registrant's goods and services.

According to the documented history provided by Registrant, the term ROMANTIC ROAD⁶ was coined⁷ in 1950 by a small group of city tourist boards in Southern Germany who formed a joint venture⁸ to offer travel services and promote tourism in the American-occupied portion of Southern Germany. (Reg.'s Mot. Summ. J. Ex. A, Decl. of Wunschenmeyer, managing director of current registrant at ¶¶

⁶ In German the term, as translated, is Romantische Straße.

⁷ Petitioner states that the explicitly English term "Romantic Road" does not appear in the minutes and that the German National Tourist Board officially gave the series of roads the name "Romantic Road". There is no genuine dispute that Registrant's predecessors created the term.

⁸ Petitioner challenges registrant's translation of a German term, contending it does not translate to joint venture, but rather to working group. This is not, however, an issue of fact material to the involved claim.

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4-7). The term was coined to refer to their promotional and travel services along the 350-kilometer series of roads connecting Würzburg near the River Main to the city of Füssen near the Alps. (Reg.'s Mot. Summ. J Ex. B., Minutes of Meeting of the Joint Venture at pp. 9-10).⁹

During the initial meeting of the members of the joint venture, the members agreed to set up a guided tour involving eighteen cities along the route and decided to create a pictorial guidebook to illustrate the tourist opportunities along the route.¹⁰ Since then additional cities have joined the joint venture; the mark has been put on signs alongside the roads through those cities; and publicity has been extensive with each member city promoting and offering services under the mark by publishing and disseminating directories of local hotels and inns, providing guided tours and most recently hosting

⁹ Excerpts from the minutes of the 1950 meeting (as translated) provide, in pertinent part:

The actual promotion shall only encompass the route between Wuerzburg and Fuessen to be designated as "The Romantic Road between Main River and the Alps". Said route leads from Wuerzburg through the Taubertal valley via Weikersheim, Creglingen, Dettwang,

...

As the joint venture's activities are planned in the long term, it is intended to launch further promotional activities in the course of time, such as the issuance of a promotional mark, a poster, a pictorial work, a tour guide, as well as a special signage for the "Romantic Road".

¹⁰ Petitioner again challenges the translation of the minutes contending that the words translating as "set up guided tour" is really a proposal for a committee to organize a tour along the new street "for members of the press and relevant tourist offices in order to promote the new street." (Br. at ¶ 3). This is not, however, an issue of fact material to the involved claim.

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informational websites.¹¹ (Decl. of Wunschenmeyer at ¶¶ 13, 16 and Reg's. Mot. Summ J. Ex. C, Shareholder's Agreement).

On January 1, 2005, a Shareholders' Agreement went into effect that legally established a civil law corporation¹² as a successor-in-interest to the unincorporated association (joint venture). (Reg's. Mot. Summ J. Ex. C). Additionally, Registrant has approximately forty partners consisting of local enterprises such as hotels, museums, restaurants, etc., which promote services offered under the mark, including tourism organizations, whose promotional activities are directed by Registrant. (Ex. C at p. 16; Decl. of Wunschenmeyer at ¶¶ 13-14; Reg's Resp. 12 to Petr's Interrog. # 12).

Petitioner has offered in response to the motion, his own declaration disputing parts of Registrant's translations¹³ and providing copies of maps, road signs, websites, internet search results and documents in German, all purporting to demonstrate that ROMANTIC ROAD identifies a physical location.

¹¹ The "Official Website" of registrant is www.romantischestrassen.de/, and the romantischestrassen portion translates as romantic road. The ".de" is a top-level domain, specifically, the country code for Germany.

¹² The agreement established Touristik-rbeitsgemeinschaft Romantische Strasse, GbR. (Ex. C at p. 15).

¹³ Petitioner's challenges to respondent's translations do not raise any genuine disputes as to any material fact.

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As noted above, the burden is on the party moving for summary judgment, in this case Registrant, to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Undisputed facts as established by Registrant in this case¹⁴ are that the mark, ROMANTIC ROAD, was coined in 1950 to offer travel services and promote tourism to an area of occupied Germany and the term continues to be used by registrant in connection with these services and the term, now in use for over fifty (50) years, has become a known travel destination. Thus, Registrant has set out a prima facie case that ROMANTIC ROAD functions primarily as a mark and qualifies for protection under the *Pebble Beach* analysis.

Petitioner, in responding to the motion and attempting to counter the prima facie case, has not presented countervailing facts sufficient to raise a genuine issue of material fact.

In this case, we find no genuine issue that, as a term coined by Registrant to promote tourism, ROMANTIC ROAD is a mark that is used variously by Registrant and those authorized by Registrant to promote tourism among the member

¹⁴ The minutes of a joint venture in 1950; and a shareholder's agreement that went into effect on January 1, 2005 establish these facts.

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cities. It is not merely or primarily a geographic term, but has always been a term associated with Registrant and its services. The fact that the coined term has developed a reputation connoting tourism in a particular geographic region does not necessarily make that term primarily geographically descriptive under Section 2(e)(2). Indeed, the undisputed fact that the mark ROMANTIC ROAD is well known, and that people may be familiar with the tourism area comprising the ROMANTIC ROAD, establishes that it functions primarily as a mark, because it is through Registrant's efforts that the name given by Registrant and its predecessors in interest to the region has come to be recognized as a source of tourism-related services, albeit in a particular location. *In re Pebble Beach*, 19 USPQ2d at 1688-89.

Therefore, because the Board finds that there is no genuine issue of material fact, and because Registrant is entitled to judgment as a matter of law on this issue, Registrant's motion for summary judgment is granted and summary judgment in favor of Registrant is hereby entered. The petition to cancel is dismissed with prejudice.

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