

Hearing:
March 20, 2002

Paper No. 26
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Speedway Motorsports, Inc.

Serial No. 75/160,194

Warren E. Olson of Fitzpatrick, Cella, Harper & Scinto for
Speedway Motorsports, Inc.

Cathleen Pace Cain, Trademark Examining Attorney, Law
Office 104, (Sidney Moscovitz, Managing Attorney).

Before Cissel, Chapman and Drost¹, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 4, 1998, applicant, a Delaware
corporation with its business address in North Carolina,
filed the above-referenced application to register the mark
"TEXAS INTERNATIONAL RACEWAY" on the Principal Register for
goods and services in ten International Classes. Included
were "clothing, namely, sweatshirts, warm-up sets, shorts,

¹ Administrative Trademark Judge Drost has been substituted for
Administrative Trademark Judge Wendel, who has retired from
Federal service.

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shirts, sport shirts, golf shirts, t-shirts, suspenders, sweaters, jackets, headbands, caps, visors, straw hats, socks and infant sets," in Class 25, and "entertainment services in the nature of conducting and sponsoring automobile races and in the nature of participating in professional automobile races and related exhibits," in Class 41. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the goods and services set forth in the application.

In addition to raising a number of informalities, the Examining Attorney refused registration under Section 2(e)(3) of the Lanham Act on the ground that the mark applicant seeks to register is primarily geographically deceptively misdescriptive. The Examining Attorney reasoned that the primary significance of the word "TEXAS" is geographic, and that in view of the fact that applicant is a Delaware corporation doing business in North Carolina, it does not appear that the goods and services will come from Texas. Alternatively, the Examining Attorney refused registration under Section 2(e)(2) of the Act on the ground that the mark is primarily geographically descriptive of the goods and services specified in the application. This refusal was made to cover the situation if applicant's

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goods and services will come from Texas, the geographical place named in the mark.

The Examining Attorney also required applicant to submit a disclaimer of the descriptive term "INTERNATIONAL RACEWAY."

Applicant amended the identification-of-goods clause and the recitation of services and disclaimed the exclusive right to use the word "TEXAS" apart from the mark as shown. In the text of its response to the first Office Action, applicant also offered to disclaim the term "RACEWAY," but did not actually amend the application to include a disclaimer of this term.

Additionally, applicant argued against the two alternative refusals to register. Applicant submitted that its mark is used in connection with a facility conducting business in the state of Texas and that the proposed goods and services will be merchandised from or associated with a Texas entity, so that the refusal based on geographic deceptive misdescriptiveness under Section 2(e)(3) of the Act is not appropriate and should be withdrawn. With regard to the refusal under Section 2(e)(2), applicant argued that its disclaimer of the geographic term "TEXAS" required withdrawal of the refusal to register. Applicant also argued that the term "INTERNATIONAL" is not merely

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descriptive of its goods or services, and therefore does not need to be disclaimed.

The Examining Attorney maintained the refusal to register under Section 2(e)(2), refused to accept applicant's disclaimer of the word "TEXAS" and withdrew the requirement to disclaim the term "INTERNATIONAL," but maintained the requirement to disclaim the term "RACEWAY." Attached in support of the contention that this word is merely descriptive of the services were copies of three third-party registrations wherein the services are similar to the ones set forth in this application and either the word was disclaimed or the registration issued under the provisions of Section 2(f) of the Act or on the Supplemental Register.

In connection with the services in Class 41, applicant disclaimed "RACEWAY" apart from the mark as shown, and presented arguments against the refusal to register. Applicant again offered to disclaim "TEXAS" if that would allow the Examining Attorney to withdraw the refusal to register.

The application was assigned to a new Examining Attorney, who maintained and made final the refusal to register under Section 2(e)(2) of the Act.

Applicant's response was to propose amendment to the Supplemental Register, but the next Examining Attorney who was assigned this application properly refused to enter the amendment because applicant had not yet amended the application to state that applicant had actually used the mark in commerce in connection with the goods and services set forth therein. He maintained the final refusal to register.

Applicant then filed a lengthy response to the final refusal to register under Section 2(e)(2), requesting reconsideration and withdrawal of the refusal. Applicant argued that the term "TEXAS" is not primarily geographically descriptive of applicant's entertainment services and related products because Texas is not an area which is known for or associated with organizing and conducting motor vehicle races and exhibitions. Applicant argued that such races are conducted in most states, and that the goods set forth in the amended application "are merchandised universally and are not unique to Texas or indicative of Texas culture." Additionally, applicant argued that it is not the uniform practice of the Office to require a disclaimer of the term "TEXAS," listing thirty-three third-party registrations and one third-party

application wherein the marks incorporate the term without disclaimers.

The Examining Attorney was not persuaded by applicant's arguments. The final refusal was maintained. Attached to the refusal were additional third-party registrations wherein the term "TEXAS" is disclaimed in connection with various kinds of entertainment services.

Applicant timely filed a Notice of Appeal concurrently with an amendment to delete the existing identification-of-goods clause and recitation of services and to substitute therefor the following: "clothing, namely, sweatshirts, warm-up sets, shorts, shirts, sport shirts, golf shirts, t-shirts, suspenders, sweaters, jackets, headbands, caps, visors, straw hats, socks and infant sets," in Class 25, and "entertainment services in the nature of conducting motor vehicle races and exhibition[s],"² in Class 41.

Applicant argued that prospective purchasers of these goods and services, upon encountering the mark applicant seeks to

² Although this recitation appears to constitute an impermissible broadening of the original recitation of services, which was limited to "automobile races," the Examining Attorney did not object to applicant's amendment. See Trademark Rule 2.7`1(a); In re Swen Sonic Corp., 21 USPQ2d 1994 (TTAB 1991); In re M.V. Et Associes, 21 USPQ2d 1628 (Comm'r 1991). Because our resolution of this appeal would be the same whether or not the amendment is proper, we have not remanded the application for resolution of this issue. If, however, on appeal, applicant were to prevail, the application would have to be remanded to the Examining Attorney in order to correct this apparent mistake.

register, "TEXAS INTERNATIONAL RACEWAY," would not make a goods/place or services/place association. Applicant contended that the Examining Attorney was ignoring the word "INTERNATIONAL" in his analysis, but that when the mark is considered in its entirety, its primary significance is not geographic.

The Board instituted the appeal, but suspended and remanded and the application to the Examining Attorney for consideration of applicant's amendment and request for reconsideration. The Examining Attorney maintained the final refusal to register, and attached to this action excerpts from twenty-two published articles in which "Texas," "car racing," or "Texas raceways" appeared. The Examining Attorney contended that these materials establish that a relationship exists between Texas and motor vehicle racing services. The articles refer to several different tracks and racing series which operate in Texas. The Examining Attorney addressed applicant's argument with respect to the significance of the term "INTERNATIONAL" in applicant's mark with the submission of fifteen additional excerpts from articles in which "international" and "racing," or "international raceways" appeared. He argued that these articles demonstrate the descriptiveness of the word "INTERNATIONAL" in applicant's mark in connection with

services relating to racing. Additionally, he attached five third-party registrations wherein the terms "international raceway," "raceway" and "speedway" have been disclaimed, contending that these registrations are evidence of the descriptive nature those terms have in relation to the identified services. He noted that where the marks in these registrations combine these descriptive terms with place names, the registrations are either on the Supplemental Register or on the Principal Register with claims of distinctiveness under the provisions of Section 2(f).

The Board resumed action on the appeal, and applicant filed its appeal brief and requested an oral hearing before the Board. Attached to applicant's brief were copies of records obtained from the Office's electronic search system showing that Richmond International Raceway, Inc. had applied to register a mark consisting of the words "Richmond International Raceway" superimposed on a stylized oval-shaped letter "R" for clothing, with one application, and for games and toys, with another application, and that both applications had recently been passed to publication.³

³ Serial No. 76/170,356 and Serial No. 76/170370, both filed based on the applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the specified goods.

The word "RACEWAY" was disclaimed in the application covering games and toys.

Applicant argued that its amendment to the identification of goods and recitation of services after final rejection was only a "proposal," an "offer" to amend, and that because the Examining Attorney did not "approve" the amendment, the goods in the other eight classes in addition to the classes for clothing and entertainment services were not deleted. Also, applicant charged that the Examining Attorney had made the refusal final on new grounds. Applicant withdrew the "offer" to amend the application to delete reference to all but two classes of goods and services and argued as if the goods and services in all ten classes were still in the application.

Applicant moved to strike the evidence submitted by the Examining Attorney in response to applicant's request for reconsideration, contending that this evidence was beyond the scope of what the Board remanded the application to the Examining Attorney to consider.

In addition to these arguments, applicant reiterated its previously stated argument with respect to the refusal to register under Section 2(e)(2) the Act. The key element of this argument is that the word "INTERNATIONAL" is not

generic for the goods or services, so the primary significance of the mark in its entirety is not geographic.

The Examining Attorney then filed his appeal brief, responding to each contention raised in the brief of applicant. Attached to the Examining Attorney's appeal brief was an excerpt from to the 1997 edition of Meriam-Webster's Geographical Dictionary, Third Edition, wherein "Texas" is identified has "a southwestern state of U.S.A..."

Applicant then filed a reply brief, again arguing that this appeal extends to the goods and services in the ten classes listed in the application as filed, continued its motion to strike the evidence submitted by the Examining Attorney in response to applicant's request for reconsideration, and added a motion to strike the dictionary definition submitted with the Examining Attorney's brief as well. Applicant's reply brief repeated the argument that no evidence of record in this appeal establishes that the primary significance of the composite term sought to be registered is geographic.

The oral hearing requested by applicant was held before the Board on March 20, 2002. At that hearing, it became apparent that confusion existed as to which goods and services in which classes remained in issue in the appeal. Following the hearing, the application was

therefore remanded to the Examining Attorney for clarification of this issue. The application was assigned to yet another new Examining Attorney, who reviewed the file and issued a brief Office Action concluding that pursuant to applicant's amendment after final rejection and request for consideration, filed November 16, 2000, the goods and services remaining in the application were only the Class 25 goods and the services in Class 41. The application file was returned to the Board for a determination of the appeal on its merits.

After carefully reviewing the extended prosecution history in this application, we agree with the Examining Attorney that the sole issue in this appeal is whether Section 2(e)(2) of the Lanham Act precludes registration of the mark in connection with the clothing products listed in Class 25 and the entertainment services in Class 41 as they are specified in applicant's November 16, 2000 amendment. This amendment was simply not an "offer" which would take effect only upon acceptance by the Examining Attorney, but even if that were the case, the Examining Attorney's arguments from that point forward make it clear that the Examining Attorney thenceforth considered the application to have been amended in accordance with applicant's

instructions, so it is clear that the amendment was accepted.

Applicant's motions to strike are similarly not well taken. The materials submitted responsive to the request for reconsideration and the subsequent remand to the Examining Attorney are properly considered of record in this appeal. The first group of materials is clearly within the scope of a proper response to the reconsideration request, and the dictionary definition submitted with the Examining Attorney's brief is admissible by judicial notice (even after the briefs had been filed and the oral hearing had been conducted).

Contrary to applicant's assertion, the Examining Attorney has not introduced new grounds for refusing registration. Two alternative grounds were raised in the first Office Action, and the refusal based on Section 2(e)(2) has been consistently maintained since then.

Turning, then, to the issue before us in this appeal, we note that the test for registrability under Section 2(e)(2) of the Lanham Act is well settled. This section of the statute bars registration of a mark which is primarily geographically descriptive in connection with the goods or services with which the applicant uses, or intends to use, the mark. The addition of generic or highly descriptive

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terms to a geographic term does not obviate a determination of geographical descriptiveness. In re Cambridge Digital Systems, 1 USPQ2d 1659 (TTAB 1986); In re BankAmerica Corp., 231 USPQ 873 (TTAB 1986). In order to show that a mark is unregistrable under this section of the Act, the Examining Attorney must demonstrate that the mark sought to be registered is the name of a place known to the public and that the public would associate the goods and services with the place named in the mark, i.e., that the public would believe that the goods or services for which the mark is sought to be registered originate in that place. When there is no genuine issue that the geographical significance of the term is its primary significance and where the geographical place is neither obscure nor remote, a public association between the goods and services and place may ordinarily be presumed from the fact that applicant's goods and services will or do come from the place named in the mark. In re California Pizza Kitchen, 10 USPQ2d 1704 (TTAB 1989); In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982).

In the instant case, the primary significance of the term "TEXAS" is without question geographic. The geographic dictionary listing submitted by the Examining Attorney plainly establishes this fact. Moreover, Texas is

neither obscure nor remote, so the first part of the test for refusing registration under Section 2(e)(2) of the Act is satisfied.

The question thus becomes whether the primary significance of the mark in its entirety is geographic. As noted above, combining a place name with generic or descriptive words has been held not to alter the primary geographic significance of the combination of such terms. This is the situation with which we are presented in the instant case. The primary significance of "TEXAS" is geographic, and that significance is not changed by the addition of the term "INTERNATIONAL RACEWAY," which this record demonstrates is descriptive in connection with the goods and services applicant intends to offer under the mark.

Applicant contends that the significance of the word "INTERNATIONAL" in the mark applicant seeks to register is not merely descriptive in relation to the specified services, but the ordinary meanings of the words "international" and "raceway," as well as the excerpted articles made of record by the Examining Attorney, make it clear that these words are understood by prospective customers of the products and services listed in the amended application as an indication that the facility in

connection with which they are provided is a track that seeks to attract racers and spectators from outside the United States. Just as an international airport offers flights to and from other countries, an international raceway attracts competitors and spectators from other countries.

That third parties may have been able to register or have published marks combining other place names with arguably similar descriptive terminology is not determinative of this appeal. Two of the third-party registrations of record actually provide support for the Examining Attorney's position. Reg. Nos. 1,879,804 and 1,534,870 are either on the Supplemental Register or contain a disclaimer of "INTERNATIONAL RACEWAY." This is evidence of the descriptiveness of the term in connection with the Class 25 goods and Class 41 services listed therein. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978).

Moreover, even if this were not the case, it is well settled that each case must be decided on its own merits, and that neither an Examining Attorney nor the Board is bound by prior decisions of other Examining Attorneys to

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register other marks. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

In summary, the refusal to register under Section 2(e)(2) of the Act is well taken. The primary significance of "TEXAS INTERNATIONAL RACEWAY" is geographic and the goods and services in connection with which applicant intends to use the mark will emanate from Texas, so the people who will purchase these goods and services will make an association between the goods and services and Texas. This record establishes that entertainment services in the nature of races and exhibitions do, in fact, emanate from that state, so prospective purchasers would have ample basis upon which to make an association between the services and the place named in the mark. Simply put, the public would understand, from consideration of the mark in connection with the goods and services set forth in the application, that the races and exhibitions applicant will render under the mark will take place in Texas, and that the clothing items listed in the application, all of which are collateral goods of the type which are sold at such racing events, will also come from Texas.

DECISION: The refusal to register under Section 2(e)(2) is affirmed.