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OF THE TTAB

Hearing:
August 24, 2005

Mailed: October 24, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The United States Academic Decathlon Association

Serial No. 76343540

David W. Grace of Loeb & Loeb LLP for The United States
Academic Decathlon Association.

Michael Kazazian, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Chapman, Zervas and Kuhlke, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 30, 2001, The United States Academic
Decathlon Association (a California corporation) filed an
application to register the mark ACADEMIC DECATHLON on the
Principal Register for "educational and entertainment
services, namely, academic competitions and educational
testing" in International Class 41. The application is
based on applicant's claimed date of first use in 1968 and

first use in commerce of 1982. In response to the Examining Attorney's inquiry, applicant claimed ownership of Registration No. 1242384 (issued June 14, 1983, Section 8 affidavit accepted, renewed) for the mark UNITED STATES ACADEMIC DECATHLON USAD and design ("United States Academic Decathlon" and "US" disclaimed) for "educational services in the nature of academic competitions" in International Class 41.

The Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the basis that ACADEMIC DECATHLON, when used in connection with the services of applicant, is generic of them; and that if not generic, then the phrase is merely descriptive of applicant's services, and applicant's alternative claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), is not sufficient in view of the nature of the proposed mark.

When the refusals were made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs. An oral hearing was held on August 24, 2005.

The Examining Attorney contends that "applicant has allowed its mark to become a generic identifier of academic

competitions"; that even if "applicant coined the term many years ago, it has since become a generic term in relation to a class of competition along the lines of spelling bees, chess tournaments and science competitions" (brief, unnumbered page 5), and it is thus incapable of functioning as a mark and it cannot acquire distinctiveness; and that even if the proposed mark is held not to be generic, the phrase is highly descriptive, increasing applicant's burden of proof to establish acquired distinctiveness, which applicant has not met.

The Examining Attorney refers to applicant's specimen of use, which consists of a few pages from applicant's website. Applicant makes the following statements therein:

The United States Academic Decathlon Association is a team competition wherein students match their intellects with students from other schools. Students are tested in ten categories.

...

Based on the model of the athletic decathlon, the Academic Decathlon requires participants to prepare for ten academic events.

...

The Academic Decathlon is a ten-event scholastic competition for teams of high school students.

The Examining Attorney submitted (i) printouts of several excerpted stories retrieved from the Nexis

database,¹ and (ii) printouts of pages from a few third-party websites, all to show that the phrase "academic decathlon" has become generic for a class of academic competitions. Examples of the excerpted stories retrieved from the Nexis database and the Internet pages from third-party websites are set forth below:

Headline: School Volunteer
...During her years of volunteer work, Shafer created an academic decathlon program for elementary students and worked tirelessly to drum up support for a construction bond measure. ...
"City News Service," May 16, 2003;

Headline: Among The Best: Graduates Pursue Far-Flung Careers
...Brittany Oligney is a licensed pilot and an academic decathlon competitor. ...
"The Houston Chronicle," May 29, 2003;

¹ In its brief (footnote 2), applicant "objected" to the submission of short excerpts of stories. Applicant's objection is untimely raised for the first time in its brief on appeal and it is not well taken in any event. Excerpted stories are admissible, and applicant could have submitted the full text of the stories, but did not do so. See TBMP §1208.01 (2d ed. rev. 2004).

Applicant also argues (brief, p. 9) that the Examining Attorney did not submit a "random sample," and he submitted "less than one percent of the stories in the database [searches]"; and (brief, p. 15) that "the examiner violated his duty as described in the TBMP [§1208.01], which admonishes examining attorneys that they must be impartial when submitting articles."

The Board will not put a required percentage number on evidence submitted by either an Examining Attorney or an applicant. And, we disagree with applicant's statement that the Examining Attorney has a duty to be impartial in submitting articles. More accurately, the Examining Attorney should put in representative samples of articles (in full or excerpted form), but he or she need not put in all stories in any particular case (which would be cumbersome for applicant and the Board, and perhaps many of the stories would be irrelevant).

Headline: Here's A Look At Tonight's
Prime Time Line-up For Sunday, April 13
...Malcolm in the Middle -- A teacher
encourages Malcolm and the other
Krelboynes to cheat during an academic
decathlon. "Broadcast News," May 13,
2003;

Headline: Students Compete In SkillsUSA
Event
...Nearly 1,200 students from the states
high schools, vocational-technical
institutes and colleges participated in
the Arkansas Association of SkillsUSA
competition. ... The competition allows
students to demonstrate their skills
and knowledge, much like an academic
decathlon, according to Dick Burchett,
program manager, ... "Arkansas
Democrat-Gazette (Little Rock, AR),"
April 18, 2002;

Headline: Answer Man ACT, SAT No Match
For Kelley Senior
...He plays basketball, ping pong or
reads novels in his free time, although
he has very little now since he is
preparing for an academic decathlon
competition among area high schools.
"Tulsa World (Oklahoma)," March 1,
2000;

Headline: Meeting Agenda
...A report from the South Garland High
School principal and assistant
principal on the 2003 state academic
decathlon competition being held at the
school. ... "The Dallas Morning News,"
February 6, 2003;

Headline: Delphi Students Eager For
Cerebral Workout
...Material covered in the academic
decathlon competitions is similar to a
first semester freshmen schedule at a
liberal arts college Janowaik said.
The material breaks down into 10

categories... "Journal and Courier
(Lafayette, IN)," February 8, 2002;

Headline: Our Times, Orange County
Communities

...Parents are invited to join the
booster clubs at Foothill and Tustin
high schools. The clubs sponsor award
ceremonies, academic decathlon
competitions, a newsletter and
scholarships for graduating seniors.

... "Los Angeles Times," October 4, 1999;

URI [University of Rhode Island]
Residential Complex

Campus. ... they sponsor academic
decathlons, semi-formal dances,
barbeques, in-house movies, and
workshops or presentations on various
topics. ...

www.uri.edu;

California Institute of Technology
From the Pages of... Caltech 336

...

many [students] participated in science
olympiads, academic decathlons, science
bowls, robotics challenges,... ...

pr.caltec.edu; and

CESA #2

...

Cooperative Educational Service
Agencies -- better known as CESAs --
help school districts share staff,
services and purchasing, ...

...

Cesas provide curriculum specialists,
environmental education, gifted and
talented programs, and enrichment
activities such as academic decathlons
and spelling bees. ...

www.cesa2k12wi.us.

Applicant argues that the mark ACADEMIC DECATHLON is a
coined term and is not a generic term for applicant's

identified services; that the Examining Attorney has not submitted clear evidence showing that the public understands ACADEMIC DECATHLON to refer primarily to a genus of services rather than referring to applicant's (and its licensees) academic competitions; that "decathlon" refers to an athletic, not a scholastic event; that the evidence of record does not meet the Examining Attorney's burden necessary to establish genericness, particularly as much of the Examining Attorney's Nexis and Internet evidence actually refers to applicant's ACADEMIC DECATHLON services; that some misuses by news reporters who failed to use initial capital letters when referring to applicant's "Academic Decathlon" competitions do not destroy applicant's use of the phrase as a mark which is so recognized by the public; and that doubt on the issue of genericness is resolved in favor of applicant.²

² In applicant's response dated July 30, 2003, applicant refers to its Registration No. 2655356. However, applicant did not make the registration of record in this application. The Board does not take judicial notice of registrations. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

Further, in its brief (p. 16, footnote 8), applicant, asserts that if the Examining Attorney had searched the website addresses of the state organizations listed on applicant's website, he would have found ACADEMIC DECATHLON used as a mark indicating applicant as the source of the academic competitions. Again, applicant did not make any of those state websites of record herein. It is applicant's responsibility to provide evidence it wishes to be of record. Also, websites frequently have voluminous information which may change over time. See *In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004).

Applicant also argues that the mark is not merely descriptive; and that it offers a claim of acquired distinctiveness only in the alternative.

Applicant submitted Internet dictionary definitions of the word "decathlon" to show that it refers to an athletic not an academic contest; and the declaration, with exhibits, of Les Martisko, applicant's executive director. Mr. Martisko avers that applicant originated its "Academic Decathlon" in 1968 as a California academic competition; that applicant conducted the first national competition under its mark in 1981; that applicant's twenty-third national competition was held in Boise, Idaho in April 2004, with coverage by all three major networks (ABC, CBS, NBC); that the latest national competition was the culmination of the year's local, regional and state "Academic Decathlon" competitions involving approximately 20,000 high school students from about 1800 high schools in forty states; and that applicant enters into license agreements with state organizations to organize state, regional and local competitions, and these licensees must be renewed each year. Mr. Martisko also avers that applicant promotes its "Academic Decathlon" services on its website and through its licensees; that applicant's national, state, regional and local "Academic Decathlon"

competitions "have received substantial press coverage [newspapers, television] for many years" (declaration, p. 3); that in 1999 HBO made a movie titled "Cheaters" about an incident from the 1995 "Academic Decathlon" competition, which applicant licensed the film producers to use the "Academic Decathlon" mark and branded materials in the film. Mr. Martisko further avers that he is aware of about eighty other academic competitions with various marks, for example, Knowledge Bowl, Quiz Bowl, Math Masters; and that he is not aware of any organization (other than applicant and its licensees) which uses the words "Academic Decathlon" in connection with academic competitions.

The Examining Attorney bears the burden of proving that the proposed mark is generic, and genericness must be demonstrated through "clear evidence." See *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, unpubl'd, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *In re Leatherman*

Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994), citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

The test for determining whether a designation is generic, as used in connection with the services in an application, turns upon how the term or phrase is perceived by the relevant public. See *Loglan Institute Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). As noted earlier, "the correct legal test for genericness, as set forth in *Marvin Ginn, supra*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" *American Fertility Society, supra*.

In this case, the Examining Attorney has submitted some evidence of generic use of the words "academic decathlon" to refer to an academic competition.³ However, the record shows that many of the examples (even if in lower case letters) are direct references to applicant and/or its licensees. Applicant contends that virtually all of the uses in lower case letters are misuses by the media of applicant's mark ACADEMIC DECATHLON, and such misuses do not prove that the term has become generic. See *In re First Union National Bank*, 223 USPQ 278 (TTAB 1984).

As explained previously, our primary reviewing Court, the Court of Appeals for the Federal Circuit, has held that the burden of establishing genericness of a term or a whole phrase rests with the Office and that the showing must be based on clear evidence. See *In re Merrill Lynch*, supra, 4 USPQ2d at 1143; and *In re The American Fertility Society*, supra, 51 USPQ2d at 1835. Because the record before us shows varied uses of the phrase "ACADEMIC DECATHLON," we find that there is insufficient clear evidence that the phrase ACADEMIC DECATHLON has become the generic or common

³ Both the Examining Attorney and applicant have discussed the issue in relation to applicant's academic competition services, rather than applicant's educational testing services. In our decision, the Board will do likewise.

descriptive term for the academic competitions to which applicant first applied the phrase.

With regard to the second prong of the genericness test, the evidence of record as to how the relevant purchasers would perceive this term in relation to applicant's identified educational and entertainment services is mixed. There is evidence of ACADEMIC DECATHLON referring to applicant (or its licensees) and its educational services offered under the mark ACADEMIC DECATHLON. Further, many of the asserted examples of generic use (showing the words in lower case letters) actually refer to applicant or its licensees and are apparent misuses by journalists. Moreover, none of the evidence submitted by the Examining Attorney predates applicant's first use in 1968 and first use in interstate commerce of 1982. Thus, the Examining Attorney has not established that the relevant purchasing public would perceive the phrase ACADEMIC DECATHLON as the name of the genus of the services.

We find that the Examining Attorney has not established a prima facie showing that the phrase ACADEMIC DECATHLON is (or has become) generic for applicant's identified educational and entertainment services.

We next address whether the phrase ACADEMIC DECATHLON is merely descriptive of applicant's identified services. A mark is merely descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). See also, *In re Abcor Development Corporation*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995).

Applicant claims ownership of Registration No. 1242384 in which applicant disclaimed the words "United States Academic Decathlon," thereby acknowledging in that registration that the words were merely descriptive. We take judicial notice of The American Heritage Dictionary (Fourth ed. 2000) definitions of "academic" as "adjective ... 2a. Relating to studies that are liberal or classical rather than technical or vocational. ..."; and "decathlon" as

"noun ... an athletic contest usually limited to men in which each contestant participates in the following ten track and field events:" In addition, although the evidence submitted by the Examining Attorney does not establish the phrase ACADEMIC DECATHLON is generic, it certainly establishes that the phrase is merely descriptive of a significant feature of applicant's academic competition services, specifically that its services involve a ten-event scholastic competition. That is, there is ample evidence regarding use of the phrase "ACADEMIC DECATHLON," considered as a whole, and in connection with educational services, namely, academic competitions, to establish that the phrase is merely descriptive thereof. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Thus, we will now determine whether applicant has submitted sufficient evidence of acquired distinctiveness under Section 2(f) to overcome the mere descriptiveness of the phrase.

Applicant has the burden of establishing that its mark has become distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). The question of acquired distinctiveness is one of fact which must be determined on the evidence of

record. As the Board stated in the case of Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996, 1999 (TTAB 1986):

[e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use.

There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, supra 6 USPQ2d at 1008. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:17 and 15:66 and 15:70 (4th ed. 2005).

Having carefully reviewed the evidence of record, we find that applicant's evidence of acquired distinctiveness is sufficient to establish a prima facie showing thereof. Applicant has submitted a declaration of its executive director that the mark has been in use since 1968 in California and since 1982 in a national competition; that recently this competition involves about 20,000 high school students from about 1800 high schools each year; that there

is significant media coverage of the local to national events; and that an HBO movie has been made of an incident at applicant's 1995 ACADEMIC DECATHLON. In addition, applicant submitted printouts of applicant's website pages showing the list of applicant's licensees in 40 states (plus one Canadian province).

Based thereon, the record shows that applicant has used the mark ACADEMIC DECATHLON for its academic competition services since 1968; and that the use has been substantially exclusive and continuous for a period well exceeding the five years prior to the filing of applicant's application in November 2001. Applicant uses its mark ACADEMIC DECATHLON for its academic competition services on an annual basis throughout forty states. Thus, there has been substantial exposure to the relevant public. Even though applicant has not supplied annual advertising or sales figures, we find that applicant has established a prima facie case that its mark has acquired distinctiveness. See *In re Mine Safety Appliances Company*, 66 USPQ2d 1694 (TTAB 2002).

Decision: The refusal to register on the Principal Register on the basis that applicant's mark is generic under Section 2(e)(1) of the Trademark Act is reversed. The refusal to register the mark as merely descriptive

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under Section 2(e)(1) of the Trademark Act is affirmed, and the refusal to register the mark under Section 2(f) of the Trademark Act is reversed.

Accordingly, the application will proceed to publication with a notation of applicant's claim of acquired distinctiveness under Section 2(f).