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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Thoroughbred Owners and Breeders Association, Inc.**

Serial No. 78156327

**Andrew D. Dorisio of King & Schickli, PLLC for Thoroughbred Owners and Breeders Association, Inc.**

**Linda M. King**, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Quinn and Holtzman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Thoroughbred Owners and Breeders Association, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register THOROUGHBRED CHAMPIONSHIP TOUR for the services of "organizing and conducting thoroughbred horse racing events."<sup>1</sup> Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C.

<sup>1</sup> Application Serial NO. 78156327, filed August 21, 2002, and asserting a bona fide intention to use the mark in commerce.

§1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified services.

The appeal has been fully briefed.<sup>2</sup> Applicant did not request an oral hearing.

The Examining Attorney contends that each of the words comprising the mark are descriptive. She notes that there is no dispute that the horse racing events involve thoroughbred horses, and specifically has pointed to the identification of services, which specifically state that the racing events are for thoroughbreds.

With respect to the word "tour," she has submitted a dictionary definition of "tour" as meaning "a journey to fulfill a round of engagements in several places."<sup>3</sup> She has also submitted numerous third-party registrations involving services similar to applicant's (although the subject matter of the contests differs) in which the word TOUR has

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<sup>2</sup> Applicant notes, in its reply brief, that the Examining Attorney's appeal brief did not bear a mailing date, and that applicant was unable to ascertain the date the document was mailed, thereby leaving applicant uncertain as to the due date for its reply brief, which was filed on October 11, 2004. Office records show that the brief was mailed on Monday, September 20, 2004, although the due date for filing the brief was Friday, September 17. The Board hereby exercises its discretion and accepts the brief, which was late by only one business day. Applicant's reply brief, which would have been due on October 12, 2004 (20 days from the mailing of the Examining Attorney's brief was October 10, which was a Sunday; October 11 was a federal holiday--see Trademark Rule 2.196) is timely.

<sup>3</sup> The American Heritage Dictionary of the English Language, 3d ed. © 1992).

been disclaimed. Some examples include CORE TOUR for, inter alia, entertainment in the nature of a series of extreme sporting events (Registration NO. 2580406); GOLDEN SPIKE TOUR for "entertainment services in the nature of track and field, running and race-walking competitions and events" (Reg. No. 2558553); NUVEEN TOUR for "entertainment services, namely, the organization and conducting of tennis competitions (Reg. No. 2176288) and LADIES PROFESSIONAL GOLF ASSOCIATION TOUR for, inter alia, "sponsoring, promoting and conducting golf tournaments and related golfing events" (Reg. 2397059). The Examining Attorney also points to descriptions of applicant's proposed services, as reported in newspapers, to show that applicant's services will involve a series of races:<sup>4</sup>

...Thoroughbred Championship Tour, a series of races that would fill the void between the Triple Crown and the Breeder's Cup. [The h]orse would earn points for high finishes (as in NASCAR'S Winston Cup), and the financial rewards would be large enough....

"The Times Union," June 22, 2003

The Thoroughbred Owners and Breeders Association has floated an idea for a not-for-profit, televised racing series called the Thoroughbred Championship

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<sup>4</sup> Newspaper articles cannot generally be used to prove the truth of the statements contained therein. However, applicant has confirmed the accuracy of these statements in its brief, and, in fact, specifically quoted the article from "The Times Union" in providing factual background about applicant and its activities.

Tour, where racetracks would coordinate their stakes schedules to build an attractive season-long package to sell to network television.

"Las Vegas Review-Journal," September 13, 2002.

As for the term CHAMPIONSHIP, the Examining Attorney has made of record a definition of this word as meaning "a competition or series of competitions held to determine a winner."<sup>5</sup>

A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services with which it is used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question is not decided in the abstract, but in relation to the goods or services for which it is used or intended to be used. See *In re Abcor Development Corporation*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). Moreover, it is not necessary that the term have to describe every characteristic, quality, function or feature of the goods or services; it is sufficient if it describes a single significant quality, function or feature. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

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<sup>5</sup> The American Heritage Dictionary of the English Language, 3d ed. © 1992).

As applicant has explained, it intends to use the applied-for mark in connection with a series of races that would fill the void between the Triple Crown and the Breeder's Cup. This would be an annual event involving horse races (although the races themselves would be conducted by others).

We agree with the Examining Attorney that the individual words in the mark all have a descriptive significance as conveying a characteristic of applicant's identified services: THOROUGHBRED describes the animals that are the subject of the horse racing events; CHAMPIONSHIP, which is defined as a series of competitions held to determine a winner, is clearly descriptive of the series of racing events with which applicant intends to use its mark. The word TOUR also has a descriptive significance in connection with conducting sports competitions, as shown by the third-party registrations in which the word TOUR is disclaimed.<sup>6</sup>

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<sup>6</sup> We note that applicant has submitted two third-party registrations for TOUR marks in which TOUR was not disclaimed. One, HEALTHY LIFESTYLE TOUR for promoting goods and services through the distribution of products at a mobile health exhibit and providing health information and health screening and testing services, is clearly for very different services and is irrelevant to our decision herein. The second registration is for SOUTHERN DIRT TOUR for "entertainment services in the nature of an automobile racing series." We do not know why this registration issued without a disclaimer of the word TOUR, but in view of the large number of third-party registrations in which

The question, however, is whether, when these words are combined as THOROUGHBRED CHAMPIONSHIP TOUR, the mark is merely descriptive of the services of organizing and conducting thoroughbred horse racing events.

It is the Examining Attorney's position that applicant's mark is merely descriptive because it describes the subject matter of the services, i.e., that it immediately tells consumers that the services are "a championship tour, or series of races, involving thoroughbred horses." Brief, p. 5. The Examining Attorney also asserts that "the commercial impression of the mark is that it is used with a championship tour of thoroughbreds, or a thoroughbred championship tour." Brief, p. 4.

Applicant contends, on the other hand, that the mark does not "only describe" applicant's services. It points out that there is no dictionary definition of the phrase CHAMPIONSHIP TOUR as having a particular meaning as applied to events involving races. Noting the dictionary definition of "championship" relied on by the Examining Attorney ("a competition or series of competitions held to determine a winner"), applicant asserts that there is nothing in the record to establish "that any champion is

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TOUR has been disclaimed, and the dictionary meaning of TOUR, we regard this registration as an anomaly.

ever declared of the 'tour' or that Appellant's services have anything to do with declaring a single champion." Brief, p. 9. Applicant further argues that "the fact that a winner of an individual race may be declared or that the term CHAMPIONSHIP is used in connection with races does not make it descriptive of Appellant's services (which again, relate to organizing and conducting horse racing events) with the degree of particularity necessary to support the extant Section 2(e)(1) refusal." Brief, p. 10.

The Examining Attorney's response to applicant's argument that there is no evidence that a champion is declared is that "applicant does not state that there is not a champion declared." The Examining Attorney also points out that at the every least, because there are winners of the races, there are champions of each race in the tour, "making the term 'championship tour' descriptive of [applicant's] services, whether or not there is a final champion or the winners are labeled 'champions.'"

As a preliminary comment, much of this dispute about the exact nature of applicant's services could have been avoided if the Examining Attorney had simply asked applicant to provide details about the nature of the horse racing events which it planned to organize and conduct. And, obviously, applicant could easily have resolved any

questions by clarifying the nature of the events with which it intends to use its mark, rather than making statements such as that quoted above, i.e., that "nothing in the record establishes that any champion is ever declared of the 'tour' or that Appellant's services have anything to do with declaring a single champion." Brief, p. 9. In fact, applicant's obvious decision to focus on this lack of evidence, rather than to provide this information, is telling.

However, the record does show that the horse racing events are designed to result in a championship for a participating horse. The article in "The Times Union" states that horses would earn points for high finishes, as in NASCAR's Winston Cup. We think it obvious that the horse with the most points would win the championship, and that consumers seeing the mark THOROUGHBRED CHAMPIONSHIP TOUR would immediately understand that the horse racing events organized and conducted by applicant describe a tour in which one of the thoroughbred horses would be named champion or, in other words, that these events comprise a championship tour for thoroughbreds.

Applicant argues that there is no evidence in the record that others in the industry have a competitive need to use either THOROUGHBRED CHAMPIONSHIP TOUR, THOROUGHBRED

CHAMPIONSHIP or THOROUGHBRED TOUR. Although evidence of competitors' use of the applied-for mark would be powerful evidence of the mark's descriptiveness, the opposite is not true, i.e., the lack of such evidence does not show that a mark is not merely descriptive. It is a well-established principle that the fact that an applicant may be the first and only user of a descriptive term does not make that term registrable. See *In re American Society of Clinical Pathologists, Inc.*, 169 USPQ 800 (CCPA 1971), *In re Interco Inc.*, 29 USPQ2d 2037 (TTAB 1993) *In re Acuson*, 225 USPQ 790. (TTAB 1985).

Applicant also argues that the mark does not describe the identified services with any particularity, "as numerous other activities may involve 'thoroughbreds' (which *per se* does not necessarily 'only describe' horses)." Brief, p. 8. However, as noted above, the determination as to whether a mark is descriptive is not made in a vacuum, but is based on how the mark will be perceived when used in connection with the identified goods or services. Applicant's services are "organizing and conducting thoroughbred horse racing events." Obviously when used in connection with such services, consumers will immediately understand the word "thoroughbred" to refer to horses. Moreover, although thoroughbreds may well be

involved in activities other than horse racing events, and specifically with the series of horse racing events with which applicant intends to use its mark, when the mark is used with such services, consumers will immediately understand that the thoroughbreds are taking part in racing competitions.

Applicant further contends that its mark presents a double entendre. Specifically, applicant asserts that, because "championship" also means "defense or support," it suggests that the purpose of applicant's tour is the championship or support of thoroughbreds. We are not persuaded by this argument. The concept of a double entendre is that consumers will readily understand that a mark has two different meanings. The fact that an attorney can construct a concept from using different definitions of the words in the mark does not make a term a double entendre. We simply do not believe that consumers, viewing the mark in connection with the identified horse racing events, would understand it to mean the support of thoroughbred horses.

Decision: The refusal of registration is affirmed.