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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thoroughbred Legends, LLC

Serial No. 78430225

Michael D. Hobbs, Jr. of Troutman Sanders LLP for
Thoroughbred Legends, LLC.

Gina Hayes, Trademark Examining Attorney, Law Office 103
(Angela Bishop Wilson, Managing Attorney).

Before Hohein, Grendel and Kuhlke, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Thoroughbred Legends, LLC has filed an application to register KELSO (in standard character form) on the Principal Register for "printed matter, namely, books featuring information pertaining to horses, comic books, magazines featuring information pertaining to horses, coloring books, children's activity books, children's books; paper goods, namely, stationery, writing paper, envelopes, notebooks, diaries, posters, photographs, book

covers, book marks, calendars, and gift-wrapping paper" in International Class 16.¹

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

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

When the refusal was made final, applicant filed its notice of appeal and requested reconsideration of the final decision. On March 7, 2006, the examining attorney denied the request for reconsideration and the appeal was resumed. Briefs have been filed, but an oral hearing was not held. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality,

¹ Application Serial No. 78430225, filed June 4, 2004, alleging a bona fide intention to use the mark in commerce.

characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single significant ingredient, quality, characteristic, function, feature, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

There is no dispute that KELSO is the name of a now-deceased thoroughbred race horse.² The examining attorney argues that "applicant does not deny the fact that the publications feature information pertaining to the horse Kelso" and concludes that KELSO is descriptive of the subject matter of the books and magazines. Further, the examining attorney notes that although "applicant argues that 'Kelso' is only one such subject matter of the goods, that its publications will also feature information pertaining to horses in general, ... [a] term need not

² The examining attorney's sole support for her contention that KELSO is a race horse is a reference to Wikipedia; however, applicant has conceded that KELSO is the name of a now-deceased and well-known race horse. Br. p. 5. Thus, our determination as to the significance of the name KELSO does not rely on the Wikipedia reference.

describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive." Br. unnumbered p. 5.

In traversing the refusal, applicant argues that KELSO is suggestive rather than descriptive of its recited goods. Specifically, applicant argues that "although the term 'KELSO' in the Applicant's Mark refers to the name of one particular deceased thoroughbred race horse, the term is not immediately descriptive of all horses or of any particular group or breed of horses. Indeed, consumers who are familiar with the features or characteristics of the deceased thoroughbred horse 'Kelso,' may recognize the name and determine that Applicant's goods feature information pertaining to the sport of thoroughbred horse racing. Thus, consumers will have to exercise mature thought and reasoning to make a connection between the thoroughbred horse 'Kelso' and the subject matter of the Applicant's publications." Br. pp. 3-4.

Applicant further argues that the "fame or notoriety of a person does not render use of such person's name immediately descriptive of magazines, books or printed matter that feature information relating to such person's area of expertise or distinction." Br. p. 4. In support of this argument applicant submitted approximately 13

third-party registrations for magazines, books or printed matter "that bear such person's name, including Oprah Winfrey, Rosie O'Donnell, Martha Stewart and Steve Forbes, and feature information regarding the person or his/her area of expertise or distinction, yet were not found to be merely descriptive." Br. p. 4. In addition, applicant submitted one third-party registration and six applications (including some of applicant's other applications) for the names of other thoroughbred horses and noted that "the PTO has acted similarly in registering marks for famous thoroughbred horses for use in connection with goods in Class 16." Br. pp. 4-5. Arguing against the examining attorney's contention that the fame of KELSO does not remove it from being merely descriptive matter, applicant cites to *Lucien Piccard Watch Corp. v. Crescent Corp.*, 314 F.Supp. 329, 165 USPQ 459 (SDNY 1970) (DA VINCI for use on jewelry not merely a surname inasmuch as names of historical figures or noted persons are registrable, provided the primary connotation of the mark is of the historical character) and states that similar to the DA VINCI case applicant "seeks registration for the mark KELSO for printed publications and magazines, among other 'paper' goods. In the same way that the owners of the DA VINCI mark sought to directly connect the attributes,

characteristics, and style of the famous historical figure, Leonardo Da Vinci, with its jewelry by employing the recognizable name DA VINCI, Appellant seeks to convey the bold and courageous spirit and style of the winning thoroughbred horse Kelso with its printed publications by using the mark KELSO." Reply Br. p. 5.

Finally, applicant cites to *In re WNBA Enterprises, LLC*, 70 USPQ2d 1153 (TTAB 2003), where the Board found that "in the same manner that ORLANDO [MIRACLE] is inherently distinctive when used in connection with the applicant's entertainment services, namely, its basketball team, the mark is inherently distinctive when used in connection with applicant's printed publications that feature information pertaining to the sport of basketball and featuring applicant's basketball team." Reply Br. p. 2. Applicant then argues that it is the owner of an application for KELSO for various types of entertainment services, and reasons that this is a similar circumstance to *In re WNBA*. Thus, applicant contends that its "planned use of KELSO to identify its printed publications and magazines that feature information pertaining to horses and the sport of thoroughbred horse racing, including, information pertaining to the now-deceased thoroughbred horse Kelso, among others, is not merely descriptive." Reply Br. p. 3.

It is well settled that where a mark may be merely descriptive of one or more items of goods in an application but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the subject matter for registration is descriptive of any of the goods for which registration is sought. In re Analog Devices, Inc., 6 USPQ2d 1808 (TTAB 1988). See also In re Cannon, Inc., 219 USPQ 820 (TTAB 1983). Applicant, in fact, concedes that the race horse KELSO will be, in part, the subject matter of the books and magazines. Indeed, the identification "featuring information pertaining to horses" is broad enough to include KELSO as, at least, part of the subject matter. Thus, when we view the proposed mark KELSO in the context of the identified goods, as we must, KELSO describes a feature of the applicant's goods, namely, the subject matter of applicant's books and magazines, i.e., horses including KELSO as applicant readily admits. In re Abcor Development Corporation, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (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).

As to applicant's argument that the Office has allowed registration of the names of well-known individuals for

goods in International Class 16 without a showing of acquired distinctiveness, the court in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), expressly stated that: "The Board must decide each case on its own merits, ... Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." (Internal citation omitted.) These third-party registrations may, in fact, fall into the category of the type of registration at issue in *In re WNBA*. The facts of this case, however, are not analogous to *In re WNBA*. There is no underlying registration or service to which these potentially collateral goods would attach. Applicant's reference to its copending application is not persuasive. First, it is not of record. Second, the underlying source identifying significance of KELTSO would have arisen from horse racing services which are not included in the recitation of services in applicant's copending application.

We also agree with the examining attorney that the circumstances of this case are easily distinguished from *Lucien Piccard Watch*. There the name of an historical figure, DA VINCI, was used in connection with jewelry. There was no descriptive significance between the name and

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the goods and the issue there was surname significance. Here, there is no question that KELSO is descriptive of the subject matter of the goods.

We are persuaded, instead, when applied to applicant's goods, the term KELSO immediately describes, without conjecture or speculation, a significant feature of applicant's goods, namely the subject matter of applicant's books and magazines. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective consumers of applicant's goods to perceive readily the merely descriptive significance of the term KELSO as it pertains to applicant's goods.

Finally, we do not have any doubt that this mark is merely descriptive in connection with the identified goods. In re Atavio, 25 USPQ2d 1361, 1362 (TTAB 1992).

Decision: The refusal to register is affirmed.