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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re New York Racing Association, Inc.

Serial No. 78918925

Albert Robin of Cowan, Liebowitz & Latman, P.C. for The New York Racing Association, Inc.

Cory Boone, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Seeherman, Kuhlke, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On June 28, 2006, The New York Racing Association Inc. applied to register the mark DISCOVERY (in standard characters) for "entertainment in the nature of horseraces" in International Class 42.<sup>1</sup>

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the registered mark DISCOVERY

<sup>1</sup> Serial No. 78918925; alleging a date of first use anywhere and in commerce of December 31, 1945.

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FARM for "entertainment services, namely, organizing and conducting educational programs, seminars and events to promote the image, care, breeding and ownership of the Arabian horse breed" in International Class 41.<sup>2</sup> The word "FARM" has been disclaimed in the registration. It is the examining attorney's position that applicant's mark so resembles the registered mark that, as used in connection with the identified services, it is likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, applicant filed this appeal. Applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods

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<sup>2</sup> Registration No. 2384096 issued September 5, 2000; Section 8 affidavit and Section 15 declaration have been accepted by the Office.

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and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the *du Pont* factor of the similarity or dissimilarity of the marks. We must determine whether applicant's mark and registrant's mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of

trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In comparing the marks, we initially find that the dominant term in the registered mark, DISCOVERY FARMS, is the word DISCOVERY, which is identical to applicant's mark. Although the registered mark includes the additional word FARM, this merely descriptive and disclaimed word is clearly subordinate to DISCOVERY. The significance of the term DISCOVERY as the dominant element of the registered mark is reinforced by the fact that it is the first part of the mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1896, 1897 (TTAB 1988) ["It is often the first part of a mark which is most likely to be impressed upon the mind of purchasers and be remembered"]. See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ["Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label].

Applicant argues that the examining attorney fails to analyze the marks in their entirety and that the registered mark creates a commercial impression not present in applicant's mark. Specifically, applicant states that the registered mark "logically suggests a farm where

visitors make discoveries." Brief, p. 3. While there is a possibility that consumers may perceive such a commercial impression from registrant's mark, we find it equally plausible that consumers will view registrant's use of the term "discovery" as arbitrary.

In sum, we agree with the examining attorney that when applicant's mark and registrant's mark are considered in their entireties, they are so similar in sound, appearance, connotation and commercial impression that the contemporaneous use thereof in connection with related services is likely to cause confusion as to the origin or affiliation or source of such services. Accordingly, the *du Pont* factor involving the similarity of the marks weighs in favor of finding a likelihood of confusion.

We now compare the services of applicant to those of registrant in order to determine the degree of similarity between them. In doing so, it is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances which could give rise, because of the marks used in connection therewith, to the mistaken belief that the services

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originate from or are in some way associated with the same source. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Further, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services recited in the cited registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

In this case, we find that applicant's "entertainment services in the nature of horseraces" are related to registrant's "entertainment services, namely, organizing and conducting educational programs, seminars and events to promote the image, care, breeding and ownership of the Arabian horse breed." The respective entertainment services are related to the extent that both involve horses. Moreover, we agree with the examining attorney that "the same consumers - fans of equestrian sports, for example - could encounter both parties' services and come to the reasonable but mistaken belief that they share the same ultimate source." Brief, p. 7-8.

Registrant's entertainment services are centered on educating and promoting the image of one breed of horse, the Arabian, and the evidence submitted by the examining attorney establishes that this breed of horse has a rich history and plays a prominent role in applicant's field of horse racing. Indeed, the horses used in thoroughbred racing, which includes "world-famous events as the Belmont Stakes...Kentucky Derby...and Preakness...trace their ancestry to only three stallions," one of which was an Arabian.<sup>3</sup> The breed enjoys such a reputation that there are specific races called "The Arabian Cup Championships," promoted as "the best Arabian racing in the country."<sup>4</sup> In view of the importance of racing for the Arabian breed, registrant's education and promotion services must be deemed to include the Arabians' role in thoroughbred racing.

For the same reason, the term "events" in the cited registration's recitation of services is broad enough to encompass Arabian horse races as a means of demonstrating

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<sup>3</sup> From Encyclopedia Britannica Online ([www.brittanica.com](http://www.brittanica.com)), attached to Office Action dated June 15, 2007.

<sup>4</sup> From ArabianRacing.org website ([www.arabianracing.org](http://www.arabianracing.org)) printouts, attached to Office Action dated December 5, 2006. The website touts itself as "Dedicated to the promotion and education of Arabian racing in the United States."

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or promoting the Arabians' racing heritage.<sup>5</sup> Indeed, the printouts from registrant's website indicate a hypertext link for "Arabian Racing," under the menu for "competitions."<sup>6</sup>

The fact that registrant's entertainment services are focused on a breed of horses closely linked to horse racing and that its services include organizing events, which must, in the context of the identification, be deemed to include races to promote that breed, we find a relationship between these services and applicant's horse racing services. The respective services are of a type which could be encountered by the same persons under circumstances which could give rise, because of the marks used in connection therewith, to the mistaken belief that the services are associated with or sponsored by the same source.

Accordingly, the *du Pont* factor involving the similarity of the services weighs in favor of a finding of likelihood of confusion.

Finally, we address applicant's argument that "the effect of applicant's priority...would seem to be a factor

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<sup>5</sup> We note that the third-party ArabianRacing.org website specifically refers to the Arabian Cup Championships race as an "event". *Id.* ("kicking off the event on Friday...").

<sup>6</sup> Printouts from [www.arabianhorses.org](http://www.arabianhorses.org), attached to Office Action dated June 15, 2007.

to be considered which should tip the scales in favor of registration." Reply brief, p. 3. In this regard, applicant states that it has used its mark since 1945. *Id.* Whether applicant used its mark before registrant is irrelevant to our decision inasmuch as priority of use is not an issue in an *ex parte* proceeding. See *In re Calgon Corporation*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971). And to the extent that applicant is seeking to argue that there has been no actual confusion despite concurrent use of applicant's and registrant's marks, we find the argument equally unpersuasive because we have no evidence regarding the extent of applicant's and registrant's use or whether there has been a meaningful opportunity for confusion to arise. See *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984) (claim of no actual confusion "is of little probative value in an *ex parte* proceeding ... where we have no evidence pertaining to the nature and extent of the use by applicant and registrant ... and the registrant has no chance to be heard from....")

In view of the above and upon balancing all relevant *du Pont* factors, we conclude that persons familiar with the registered mark DISCOVERY FARM for entertainment services, namely, organizing and conducting educational programs, seminars and events to promote the image, care, breeding

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and ownership of the Arabian horse breed, would be likely to believe, upon encountering the substantially similar mark DISCOVERY for entertainment in the nature of horse races, that such services emanate from or are associated with or sponsored by the same source. Moreover, to the extent that there is any doubt on this issue, it is well established that such doubt must be resolved in favor of registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 179 USPQ 729 (CCPA 1973).

Decision: The refusal to register applicant's mark for the identified services is affirmed.