

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: October 2, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re New York Racing Association, Inc.

Serial No. 78918925

Request for Reconsideration

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:

The Board, in a decision dated June 27, 2008, affirmed the refusal to register based on likelihood of confusion.

Applicant filed, on July 18, 2008, a request for reconsideration of the Board's decision.

It has often been stated that the premise underlying a request for reconsideration under Trademark Rule 2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it

issued. See TBMP §544 (2d ed. rev. 2004) and the authorities cited therein. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. See *Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978). Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. See, for example, *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984). Cf. *In re Kroger Co.*, 177 USPQ 715, 717 (TTAB 1973).

With the above principles in mind, we now address applicant's self-described "points" in its request for reconsideration. First, applicant states the decision "is wrong as a mater (sic) of law" because "the law does intend...that registration and use be coincident so far as possible," citing to *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In this regard, applicant argues that it has used its mark since 1945, long before the date of first use in the cited registration. Contrary to applicant's assertion that the Board "appears to have ignored" this argument, we explicitly stated in our

decision that "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," citing to *In re Calgon Corporation*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971). And, while applicant correctly identifies language from the *du Pont* decision, made in the context of weighing a right to use (and right to register) versus protection of the public interest, we further note that the Court went on to say that the USPTO's role lies "in the protection of a mark by registering it and then rejecting later improper attempts, of which the registrant is unaware, to register it or a similar mark." *E. I. du Pont de Nemours & Co.*, 476 F.2d 1364. Also, in that case, the registrant was aware of the applicant's attempt to register the mark, and had given its consent thereto. In the present case, there has been no consent, nor is there any evidence that the owner of the cited registration is aware of applicant's attempt to register its mark.

Second, applicant argues that the Board erred as "a matter of fact" because evidence submitted by applicant regarding the registrant's use of its mark was "ignore[d]," whereas the Board "accepted evidence [submitted by the examining attorney] of how the owner of the cited mark uses its name as if it were evidence of how [registrant] uses

the mark." While the Board may not have identified in detail all evidence of record in its decision, applicant may rest assured that the Board's decision was based upon a careful consideration thereof, including the press release submitted by applicant. In making its point, applicant also states that the website [www.arabianracing.org](http://www.arabianracing.org) "has nothing to do with either the cited mark or its owner." In the decision, the Board clearly and correctly attributed the aforementioned website as belonging to a third party and the website [www.arabianhorses.org](http://www.arabianhorses.org) as belonging to the cited registrant.<sup>1</sup> In any event and regardless of ownership, these websites help show that the term "events" in the cited registration's recitation of services is broad enough to encompass Arabian horse races as a means of demonstrating or promoting the Arabian horse breed.

Third, applicant asserts that the Board's decision is "wrong as a matter of policy" because "in order to avoid its present predicament, applicant would have had to oppose the cited mark when it was published for opposition even though applicant did not have, and does not have, a good faith belief that such an opposition would have any merit."

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<sup>1</sup> USPTO records show the cited registration is currently owned by Arabian Horse Association (by way of assignment recorded on May 16, 2003, at reel 2656, frame 0692). The website [www.arabianhorses.org](http://www.arabianhorses.org) identifies itself as being owned by the same entity.

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The law is clear that a mark may not be registered if it is likely to cause confusion with a previously registered mark. Applicant's belief, at the time the registrant's mark was published for opposition, that it was not likely to cause confusion with applicant's mark, cannot substitute for the Board's judgment that such confusion is likely.

In view thereof, applicant's request for reconsideration of the Board's decision is denied, and the decision of June 27, 2008 stands.