

**THIS OPINION IS NOT A
PRECEDENT OF
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cold War Air Museum, Inc.
v.
The Cold War Museum, Inc. and Francis Gary Powers, Jr.¹

Cancellation No. 92047391

W. Thomas Timmons, Esq., for Cold War Air Museum, Inc.

Katrina Edge and John H. Weber, of Baker & Hostetler LLP for
The Cold War Museum, Inc. and Francis Gary Powers, Jr.

Before Seeherman, Drost, and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

Petitioner seeks to cancel respondents' registration
for the mark, "THE COLD WAR MUSEUM" for "museum services,"
in International Class 41.²

¹ Francis Gary Powers, Jr., the founder and proprietor of The Cold War Museum, Inc., assigned his rights in the mark to The Cold War Museum, Inc. during the course of this proceeding. Since the mark was assigned after this proceeding was commenced, by order of February 21, 2008, the Board joined the parties rather than granting a substitution, in accordance with TBMP Section 512.01 (2d ed. rev. 2004).

² Registration No. 2831529, registered on April 13, 2004, based on a filing date of February 4, 2003, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use and first

In the amended petition to cancel, petitioner alleged that "THE COLD WAR MUSEUM" is "merely descriptive (generic)" and that the "application under 2f should not have been permitted." We understand these allegations to aver that respondents' mark is generic and incapable of acquiring distinctiveness, and in the alternative, that respondents' mark is merely descriptive and has not acquired distinctiveness. Petitioner further alleged that the mark was not registered to the proper registrant. Respondents denied the salient allegations of the amended petition to cancel. Both parties filed briefs, and petitioner filed a reply brief. After careful consideration of the evidence and the arguments presented by the parties, for the reasons discussed herein, the petition to cancel is granted for respondents' failure to show acquired distinctiveness of "THE COLD WAR MUSEUM."

The Record

The record in this cancellation proceeding consists of the pleadings and the file of respondents' registration for "THE COLD WAR MUSEUM." Additionally, both parties in their briefs describe the record as including the following:

use in commerce on July 13, 1996, and a prior registration on the Supplemental Register, No. 2096192. The registration claims acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and disclaims the exclusive right to use "MUSEUM" apart from the mark as shown.

1. The testimony deposition of Dale Bruce Stringfellow, Jr., and accompanying exhibits.
2. Registrants' responses to petitioner's first request for admissions and first set of interrogatories, as submitted by petitioner via notice of reliance.
3. Three pages of Google search results on the definition of "cold war," as submitted by petitioner via notice of reliance.

Google search results may not be made of record via notice of reliance. See Trademark Rule 2.122(e), 37 CFR §2.122(e) (providing for the filing of printed publications and official records through a notice of reliance).

However, because respondents listed the search results in their "Description of the Record" in respondents' own brief, we treat the definitions as having been stipulated into the record.³ Therefore, we consider petitioner's submitted Google definitions for the probative value that they may have, as discussed herein. Meanwhile, respondents declined to submit any testimony or evidence into the record.

³ In their brief, respondents referred to the Google search results as "neither a compelling nor informative source of evidence" (Respondent's Brief at 13), but did not object to their entry into evidence.

Standing

Generally, petitioner must show a "personal interest in the outcome of the proceeding" as well as "a reasonable basis for belief of damage." See *Books on Tape Inc. v. The Booktape Corp.*, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (petitioner, as a competitor of respondent, "clearly has an interest in the outcome beyond that of the public in general and has standing.") It is not necessary that petitioner allege or establish its own prior rights in the marks at issue. *Id.* Respondents admitted to having accused petitioner of infringing respondents' "THE COLD WAR MUSEUM" mark by petitioner's use of its business name, Cold War Air Museum. (Response to Interrogatory No. 22). Accordingly, we find that petitioner has established its standing.

Genericness

Generic terms are words or phrases that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.

The Federal Circuit has established a two-part test to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public. The Federal Circuit has further dictated that in evaluating a phrase under the two-pronged test of *H. Marvin Ginn*, we must determine whether there is sufficient evidence of genericness of "the meaning of the disputed phrase as a whole." See *In re American Fertility Soc.*, *supra*, 51 USPQ2d at 1837.

In a cancellation proceeding, the petitioner has the burden of proving genericness by a "preponderance of the evidence." *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006) (in counterclaim for cancellation, "[i]t is applicant's burden to demonstrate by a preponderance of the evidence that DARJEELING is generic, or that the mark has become generic as a result of opposer's failure to exercise control over use of the mark," citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991)). Therefore we look to the record to see whether petitioner has proven by a preponderance of the evidence that the relevant public would understand "THE COLD

WAR MUSEUM," as a unitary phrase, to be generic for the museum services offered by respondents.

Evidence of the relevant public's understanding of a term may be obtained from any competent source, including consumer surveys, dictionary definitions, newspapers and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). Petitioner here has presented evidence of several Internet definitions of the term "cold war" as retrieved by a Google search. A sampling of petitioner's highlighted definitions includes:

1. "The struggle for power between the Soviet Union and the United States that lasted from the end of World War II until the collapse of the Soviet Union. The war was considered 'cold' because the aggression was ideological, economic, and diplomatic rather than a direct military conflict."
History1900s.about.com/od/greateventsofthecentury/a/cwglossary.htm.
2. "a period after World War II (1945-89) marked by political tension and an arms race between the Soviet Union and the United States."
www.wcit.org/tradis/glossary.htm.
3. "The state of antagonism and military conflict readiness which marked the relationship between the United States and the Soviet Union from 1946 and 1991 [sic]."
www.orlok.com/hair/holding/links/vietglossary.html.
4. "The Cold War is the name given to the period between the end of the Second World War (1945) and 1991 when the United States of America, representing Capitalism, and the Soviet Union, representing Communism were 'at war.'"

www.dmu.ac.uk/faculties/interfaculty/globalisation/global_gloss.jsp.

5. "a struggle with little military conflict between socialist and non-socialist countries. The principal opponents were the United States and the Soviet Union. Historians now believe there was little chance of nuclear conflict." naiadonline.ca/book/01Glossary.htm.
6. "Policy of US, West European and Japanese imperialism toward the Soviet Union following World War II. Period of active hostility to socialist countries, including subversion, sabotage and acts of terrorism with counterrevolutionary wars fought against emerging independence movements in Asia . . ." www.workers.org/marcy/perestroika/glossary.html.

Petitioner further included respondents' answers to interrogatories indicating that the primary subject of respondents' "museum services" is "the study of the Cold War." (Response to Interrogatory No. 11A; Response to Request for Admissions No. 2). Finally, petitioner submitted deposition testimony, with exhibits including printouts from respondents' website.

While the evidence shows that "cold war" would be understood as meaning the struggle between the United States and the Soviet Union in the period 1945-1991, there is insufficient evidence in the record that the relevant public understands "THE COLD WAR MUSEUM" as a whole to refer to the museum services offered by respondents. *In re American Fertility Soc., supra*, 51 USPQ2d at 1837. Accordingly, we simply cannot conclude based on this record that petitioner

has proven by a "preponderance of the evidence" that the mark is generic.

Descriptiveness and Acquired Distinctiveness

Petitioner has alleged in its pleadings and its brief that "THE COLD WAR MUSEUM" is merely descriptive. Respondents do not dispute that allegation, and the mark is registered with a Section 2(f) claim of acquired distinctiveness. 15 U.S.C. §1052(f). Accordingly, that the mark is "merely descriptive" is an established fact in these proceedings. See *Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (when a mark is registered under the provisions of Section 2(f), "the statute accepts a lack of inherent distinctiveness as an established fact"); *Omnicom Inc. v. Open Systems Inc.*, 19 USPQ2d 1876, 1878 (TTAB 1989) (registrant's claim of secondary meaning pursuant to Section 2(f) is evidence that the mark in question is not inherently distinctive). As previously discussed, the record shows that "cold war" is a recognized term regarding a particular conflict between nations in the latter half of the twentieth century. The evidence further indicates that the primary subject of respondents' "museum services" is "the study of the cold war," and we conclude that consumers viewing the mark "COLD WAR MUSEUM" for "museum services" would immediately understand that the respondents' museum contains artifacts and information relating to the cold war. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re*

Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Accordingly, we find that petitioner has met its burden of proving a *prima facie* case that respondents' mark is highly descriptive, and that it has not acquired distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., supra*, 6 USPQ2d at 1004 (the "one opposing a Section 2(f) registration published for opposition on the basis of that section must have at least the initial burden of challenging or rebutting the applicant's evidence of distinctiveness made of record during prosecution which led to publication of the proposed mark."). Accordingly, the burden is shifted to respondents to show that their mark has acquired sufficient distinctiveness to overcome its status as "merely descriptive." *Id.* at 1005.

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Id.*; *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (CCPA 1960); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983). The more descriptive the mark, the greater the burden is on the respondent to prove its distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., supra*, 6 USPQ2d at 1008-1009. In *Yamaha*, the Court of Appeals for the Federal Circuit affirmed the Board's ruling that with a product

design configuration, there was a greater burden on the applicant to show acquired distinctiveness. *Id.* Since we have likewise found the mark here to be "highly descriptive," respondents must present a heightened showing of acquired distinctiveness to meet their burden.

The evidence submitted by petitioner shows that respondents first used "THE COLD WAR MUSEUM" as a mark in 1996. (Response to Interrogatory No. 11A). However, there is no evidence of record that respondents have used the mark *continuously* since that date. Furthermore, in response to petitioner's interrogatory asking: "For each calendar year since Registrant commenced use of the COLD WAR MUSEUM Mark or alleged Mark alone, state the amount expended by Registrant in the advertisement of [museum services] in the United States," respondents answered (after objections): "The Cold War Museum, Inc. relies heavily on press stories, press releases and public service announcements to promote THE COLD WAR MUSEUM." (Response to Interrogatory No. 19). However, the only evidence provided regarding media coverage for respondents' Cold War Museum dates from 1997. (Response to Interrogatory No. 18). The evidence of record does indicate that respondents have made efforts to stop third parties from using the term "COLD WAR MUSEUM" in their business or domain names without a license from respondents. (Response to Interrogatories No. 24 and 25). However, there is insufficient evidence for us to conclude that respondents' mark has acquired distinctiveness.

Although respondents appear to have submitted evidence of acquired distinctiveness when they made their claim of acquired distinctiveness in prosecuting the application which issued as Registration No. 2831529, respondents chose not to submit that evidence, or any other evidence, into the record of this proceeding. This situation is reminiscent of that discussed by the Board, and affirmed by the Court of Appeals for the Federal Circuit, our primary reviewing court:

Before proceeding with the merits of the claim of distinctiveness, we must clarify a number of questions regarding the evidence we have considered. To begin with, during the *ex parte* phase of the prosecution of this application, applicant submitted materials which persuaded the Examining Attorney that the color had acquired secondary meaning. Numerous exhibits, affidavits, and a market survey convinced the Examining Attorney to publish the mark for opposition. These materials, with the exception of those made of record otherwise in this *inter partes* proceeding (in connection with testimony or by proper notices of reliance), have not been considered by the Board. While the application file is automatically part of the record in an opposition proceeding by means of Trademark Rule 2.122(b), the allegations made, and documents and other things filed in connection with the application, are not evidence in the *inter partes* proceeding on behalf of the applicant. See: *Kellogg Co. v. Pack'em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 21 USPQ2d 1142 (Fed. Cir. 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989). Accordingly, the materials submitted only in the *ex parte* effort to establish registrability under Section 2(f) of the Act were not considered in reaching our decision in this opposition proceeding.

British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197, 1200 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

Because we cannot consider the evidence from the registration file, there is insufficient evidence of acquired distinctiveness. Accordingly, on this record, we find that respondents have not met their burden of proving acquired distinctiveness of the mark "THE COLD WAR MUSEUM." Since we are ruling for petitioner on this ground, there is no need for us to discuss petitioner's allegations as to the proper registrant.

Conclusion

The petition to cancel "THE COLD WAR MUSEUM" registration is granted on the basis that the mark is merely descriptive and respondents' have failed to show acquired distinctiveness.

DECISION: The petition to cancel is granted.
Registration No. 2831529 will be canceled in due course.