

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 26,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Virginia Rhodes, dba Cycle Shirts**

Serial Nos. 74/574,596; 74/574,597; 74/574,598; and
74/574,599

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Gilchrist, P.A. for Virginia Rhodes.

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Before **Cissel**, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 16, 1994, applicant filed the above-
referenced applications to register the following marks on
the Principal Register for "clothing, namely, t-shirts and
caps," in Class 25: "BLACK HILLS MOTOR CLASSIC," S.N.
74/574,596; "BLACK HILLS MOTORCYCLE RALLY AND RACES," S.N.
74/574,597; "STURGIS RALLY AND RACES," S.N. 74/574,598; and
"BLACK HILLS RALLY AND RACES," S.N. 74/574,599.

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All of these applications were based on use of the marks in interstate commerce since August of 1966. All were subsequently amended to seek registration under the provisions of Section 2(f) of the Lanham Act based on applicant's claims that the marks had become distinctive as a result of applicant's use and promotion of them.

These applications are now before the Board on appeal from refusals to register under Section 2(d) of the Act on the ground that applicant's marks, as applied to the clothing items set forth in the applications, so resemble the mark shown below that confusion is likely.

The cited mark is registered¹ for "promoting sports competitions and/or events of others, namely, motorcycle rallies, exhibits and competitions; and promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming," in Class 35.

The registration indicates that registrant makes no claim to the exclusive right to use "MOTOR CLASSIC" or "RALLY & RACES BLACK HILLS S.D." apart from the mark as shown. The registration further reveals that it was granted in light of registrant's claim of distinctiveness under Section 2(f) with respect to the words "BLACK HILLS MOTOR CLASSIC."

The four applications were consolidated for purposes of appeal, so this opinion relates to each application. No oral hearing was requested by applicant, but briefs were filed by both applicant and the Examining Attorney.

Based on careful consideration of the materials of record in these applications and the written arguments of applicant and the Examining Attorney, we hold that the refusals to register are appropriate. Confusion is likely because each of applicant's marks is similar to the cited

¹ Reg. No. 1,948,097, issued to the Sturgis Area Chamber of Commerce, a South Dakota non-incorporated, non-profit association, on January 16, 1996.

registered mark and the goods set forth in the applications are commercially related to the services specified in the registration.

As is frequently the case in resolving the issue of whether confusion is likely, our analysis focuses primarily on the similarities between the marks sought to be registered and the mark cited as a bar to registration, as well as on the relationship between the services specified in the cited registration and the products set forth in the applications.

Turning first to the respective goods and services, we find that the clothing items identified in the four applications are clearly commercially related to the services set forth in the cited registration. The caps and t-shirts applicant sells are souvenirs or commemorative clothing items sold in conjunction with the "BLACK HILLS MOTOR CLASSIC," which is the motorcycle event that registrant promotes with its registered mark. The Examining Attorney's exhibits show that promoters of sporting events market both t-shirts and the events under the same marks. People who attend this event and purchase applicant's shirts or caps bearing marks which are similar to the mark used to promote the event have an obvious reason to assume that such clothing items emanate from, or

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are somehow authorized or licensed by, the same source that promotes the event. The affidavit submitted by applicant in support of her claim of distinctiveness under Section 2(f) of the Act establishes that she in fact sells her shirts and caps bearing the marks she seeks to register at the event promoted by the registrant under the registered mark. The trade channels and customers are not just similar, they are identical.

As to the similarity of the marks, we note that the cited registered mark represents a composite mark which combines both words and graphic designs. The literal portions of the mark are "BLACK HILLS MOTOR CLASSIC," "STURGIS," and "RALLY & RACES BLACK HILLS S.D." Each of the four marks which applicant seeks to register is either one of these literal elements in registrant's mark or a juxtaposition of different literal elements taken from registrant's mark, with or without the addition of a descriptive term.

"BLACK HILLS MOTOR CLASSIC" is the mark in S.N. 74/574,596. These words constitute the entire phrase that appears at the top of the registered mark between the concentric circle designs. It is the dominant literal portion of the registered mark, the part most likely to be used and recalled in referring to or recommending

registrant's services. It is the component of the mark that the registrant claimed had acquired secondary meaning in connection with registrant's services, and unless that claim had been established to the satisfaction of the Examining Attorney, the registration would not have issued as it did.

Applicant should not be permitted to appropriate this now distinctive, dominant phrase from the registered mark and register it for goods which are commercially related to the services registrant renders under the mark.

We turn, then, to the application to register "BLACK HILLS MOTORCYCLE RALLY AND RACES." Although the word "MOTORCYCLE" does not appear in the registered mark, graphic representations of motorcycles do, and the registration makes it clear that the services rendered by registrant center around a motorcycle rally and motorcycle races, the very same rally and races that are referred to by the marks used on applicant's clothing. The word "MOTORCYCLE" is merely descriptive of both registrant's services and applicant's goods. That applicant has claimed distinctiveness for the mark in which it is incorporated is a concession of its descriptiveness in connection with the caps and shirts bearing it.

"BLACK HILLS MOTORCYCLE RALLY AND RACES" is simply a rearrangement of the words shown at the bottom of the registered mark, "RALLY & RACES BLACK HILLS," combined with the descriptive word "MOTORCYCLE." Combining the descriptive term with the aforementioned elements taken from registrant's mark has certainly not created a mark which is sufficiently different from the registered mark to avoid a likelihood of confusion. Applicant's mark still creates a commercial impression which is similar to the one the registered mark creates. As applied to the goods set forth in the application, the mark "BLACK HILLS MOTORCYCLE RALLY AND RACES" is likely to cause confusion with the cited registered mark.

Applicant's next mark, "STURGIS RALLY AND RACES," represents a combination of part of the aforementioned phrase from the bottom of the registered mark, "RALLY & RACES," with the name "STURGIS," which is shown in the center of the registered mark in large black letters. Combining these two literal elements, both appropriated from the registered mark, does not create a mark which is readily distinguished from the mark which is the source of its elements. Rather, the mark applicant seeks to register so resembles the registered mark on which it is based that confusion is clearly likely when both marks are used on the

commercially related goods and services with which we are presented in this case.

The fourth and final mark applicant seeks to register, "BLACK HILLS RALLY AND RACES," combines the first two words from the distinctive, dominant element shown at the top of the registered mark with the "RALLY & RACES" language shown at the bottom of the mark. As with the other marks that applicant is attempting to register, this mark is, in its entirety, quite similar to the registered mark. Applicant has appropriated two of the literal elements from it and has rearranged them, but the two marks in their entireties are quite similar. As applied to the related products set forth in the application, the mark "BLACK HILLS RALLY AND RACES" is likely to cause confusion with the cited registered mark.

Applicant argues that because the literal portions of the registered mark are either disclaimed or were registered under the provisions of Section 2(f), the public associates the design, rather than the words, with registrant's services. Further, applicant contends that because applicant's marks consist of only words, whereas the registered mark is dominated by the design components of it, the overall commercial impressions these marks

engender are sufficiently different that confusion is unlikely.

As the Examining Attorney points out, however, applicant has ignored the well-settled principle that the word, or literal, portions of marks combining both words and designs generally dominate such marks because people are more likely to recall the words and use them in referring to such marks. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). It is for this reason that we accord more significance to the literal portions of the marks in resolving the issue of whether confusion is likely, regardless of whether such words are disclaimed or are the subject of claims of distinctiveness. A disclaimer does not somehow remove a word from a mark for purposes of a likelihood of confusion analysis. The marks must still be considered in their entirety. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant raises the argument that the existence of several third-party registrations of marks which include the term "BLACK HILLS" dictates that applicant's marks should be registered as well. The problem with this argument is that, contrary to applicant's contention, the third-party registrations list goods and/or services which are unrelated to those of either applicant or registrant.

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Indeed, those marks, when considered in their entireties, are each quite distinguishable from both the registered mark and the marks applicant is trying to register.

Typical examples include "BLACK HILLS FLAVORED HONEY" and design for honey; "CRAZY HORSE SPRING WATER OF THE BLACK HILLS" for spring water; and "ORIGINAL DAKOTA BLACK HILLS GOLD JEWELRY" and design for jewelry.

In summary, confusion is likely between applicant's marks, as applied to applicant's clothing, and the registered mark for promoting sporting events because the marks create similar commercial impressions and applicant's goods are commercially related to the services for which the cited mark is registered. Accordingly, the refusals to register in each case are affirmed.

R. F. Cissel

G. D. Hohein

D. E. Bucher
Administrative Trial Judges,
Trademark Trial & Appeal Board

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