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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vans, Inc.

Serial No. 75/614,036

Carol Anne Been of Sonnenschein Nath & Rosenthal for Vans, Inc.

Marcie R. Frum Milone, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Seeherman and Rogers, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Vans, Inc. (applicant), a Delaware corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark TRIPLE CROWN for "entertainment services in the nature of exhibitions of skateboarding, surfing, snowboarding, wakeboarding, BMX, motorcross and street luge; and arranging and conducting athletic competitions in skateboarding, surfing, snowboarding, wakeboarding, BMX, motorcross and street

Serial No. 75/614,036

luge."¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of three registrations of the mark TRIPLE CROWN, two owned by Triple Crown Softball, Inc., and the other by Triple Crown Sports, Inc., both located at the same address in Fort Collins, Colorado. These are Registration No. 1,675,398, issued February 11, 1992 (Sections 8 and 15 accepted and acknowledged, respectively) for entertainment services; namely, organizing and conducting slow pitch softball tournaments; Registration No. 1,688,185, issued May 19, 1992 (Sections 8 and 15 accepted and acknowledged, respectively), for entertainment services; namely, organizing and conducting soccer tournaments; and Registration No. 1,999,737, issued September 10, 1996 (Sections 8 and 15 accepted and acknowledged, respectively), for organizing and promoting state and national street hockey festivals, state and national three-on-three basketball tournaments, state and national volleyball tournaments, state and national baseball tournaments, college women's pre-season national

¹Application Serial No. 75/614,036, filed December 28, 1998, based upon applicant's allegation of a bona fide intention to use the mark in commerce. In the application, applicant claims ownership of two registrations covering the mark TRIPLE CROWN OF SURFING (Registration No. 1,624,956, issued November 27, 1990, renewed, and Registration No. 2,023,608, issued December 17, 1996, Sections 8 and 15 accepted and acknowledged, respectively).

Serial No. 75/614,036

invitational basketball tournaments, state and national soccer tournaments, and state and national fast pitch softball tournaments. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

We affirm.

The Examining Attorney argues that the respective marks are identical and that, therefore, the relationship between the respective services need not be as close in order to support a finding of likelihood of confusion. Concerning the services, the Examining Attorney contends that both applicant's and registrant's services involve the organizing of sporting exhibitions and competitions. As discussed more fully below, applicant contends that its services involve "extreme" or alternative sports while registrant's services involve "traditional" or conventional sports. However, the Examining Attorney maintains that there are no limitations in the identifications of applicant's application or in the cited registrations, respectively, making reference to "extreme" or "traditional" sports. Further, the Examining Attorney argues that there are some similarities between the sporting events of registrant and applicant: for example, street hockey, a sporting tournament listed in one of the cited registrations and a variation of ice hockey played on

pavement by players wearing shoes or in-line skates, is, she argues, closely related to the sport of skateboarding. Also, the Examining Attorney has made of record a number of third-party registrations for services which include the sporting competitions of both registrant (volleyball, softball, basketball and soccer) and applicant (surfing, skateboarding, and motorcross). Other third-party registrations made of record by the Examining Attorney are for services which include providing sporting facilities for sports listed in the cited registrations as well as the application. The Examining Attorney argues that one may engage in, or view the performance of, sports listed in the cited registrations and in the application (baseball, basketball, soccer, snowboarding and skateboarding) at the same facility. In addition, she contends that the sporting events listed in the registrations and in the application are also reported and discussed in the same publications and covered by the same sports channels. The Examining Attorney concludes that consumers who encounter applicant's mark will believe that the exhibitions and competitions are sponsored by the same source that puts on registrant's athletic tournaments, because they would be viewed as sporting events in the normal field of expansion of

registrant. Finally, the Examining Attorney asks us to resolve any doubt in favor of registrant.

Applicant, on the other hand, maintains that, in view of all the circumstances, confusion is unlikely. First, applicant maintains that the term TRIPLE CROWN is commonly used in the field of sports to identify different sporting activities. In this regard, applicant notes the well-known use of this mark by Triple Crown Productions LLC for thoroughbred horse racing events,² as well as the fact that, in baseball, "triple crown" signifies a player who leads his league in three specific achievements--batting average, home runs and runs batted in. Applicant asserts that because this term signifies "high esteem and championship, numerous businesses have adopted TRIPLE CROWN as a marketing tool to associate their goods and/or services with prestige and excellence." Appeal brief, 11. In this regard, applicant points to third-party registrations for golf clubs (Registration No. 1,623,786) as well as for indicating membership in an association of retailers of shotguns (Registration No. 2,046,397). Applicant also

² Owner of two registrations for the marks TRIPLE CROWN and TRIPLE CROWN and design. These are Registration No. 984,679, issued May 21, 1974, renewed, for "promoting the competitiveness of thoroughbred horse racing"; and Registration No. 1,479,895, issued March 8, 1988, Sections 8 and 15 accepted and acknowledged, respectively, for "organizing and supervising the process of nominating thoroughbred horses for a series of thoroughbred races." In the latter registration, the words "TRIPLE CROWN" have been disclaimed.

Serial No. 75/614,036

points to about 20 registrations of marks containing these words for goods or services not related to sports (watches, fences, mattresses, tires, fruit, whiskey and floor polish). Applicant has also made of record copies from Dun & Bradstreet's Locator Service showing over 30 different companies using this term in their trade names to identify recreational facilities, country clubs, sporting goods and bicycle shops, as well as bars and restaurants. Applicant maintains that there is a "crowded field" using this laudatory mark and that it must be considered a "weak" mark entitled to a narrow scope of protection.

Applicant also argues that registrant's services cover specifically different sporting events, registrant's being traditional, team-oriented sports such as softball, basketball, volleyball, soccer and street hockey, which are directed to "socially mainstream adults and children" (appeal brief, 8) including Little Leaguers and soccer moms. In contrast, applicant argues, its services cover "extreme" sports directed to a younger market and not played with balls or pucks on a court or a field. According to applicant, reply brief, 3-4, applicant's individual sports use different equipment and "elicit a feeling of exhilarating risk and rebellious excitement based on individual challenges against natural or urban

Serial No. 75/614,036

obstacles." It is applicant's position, therefore, that these exhibitions are of different sports which will not be viewed as related to registrant's.

Furthermore, applicant maintains that the respective sports are directed to different markets for which the perceptions of the public are different. According to applicant, its sports are directed to "Generation Y" young adults with "an alternative mindset seeking different challenges, thrills and experiences." Reply brief, 9.

Applicant also maintains that its use of the TRIPLE CROWN mark has co-existed with that of the cited registrations since at least 1983 without any actual confusion.³ Finally, applicant points to a consent agreement which it entered into in April 2000 with Triple Crown Productions, the owner of the TRIPLE CROWN mark for horse racing events. In that agreement, Triple Crown Productions states that its registrations have co-existed with applicant's registrations without confusion, and it consents to use and registration by applicant provided that applicant does not refer to or use the mark in connection with horse racing. Applicant points to that agreement as evidence that there is no likelihood of confusion between

³ Applicant's registration of the mark TRIPLE CROWN OF SURFING claims use since 1981.

Serial No. 75/614,036

TRIPLE CROWN marks for two very distinct sports-related services (horse racing and applicant's sponsorship of various sporting competitions), and that the public is no more likely to confuse applicant's mark with the cited registered marks than it would confuse the mark of registrant with the mark of Triple Crown Productions for horse racing events.

In response, the Examining Attorney maintains that applicant's agreement with a third party whose registrations have not been cited is entitled to minimal weight on the question of likelihood of confusion involving the cited marks and applicant's mark. Further, the Examining Attorney contends that third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with those marks. With respect to applicant's attempts to distinguish the various sporting events covered by the registrations and by applicant's application, the Examining Attorney responds that because a young consumer may participate in one kind of sporting event does not necessarily mean that he or she does not also participate in other sports.

Upon careful consideration of this record and the arguments of the attorneys, we conclude that applicant's

Serial No. 75/614,036

mark so resembles the registered mark, covering closely related services, that confusion is likely.

First, the marks here are identical. As the Examining Attorney has noted, the greater the degree of similarity of the marks, the lesser the degree of similarity in the respective goods or services needed to support a finding of likelihood of confusion. *In re Concordia International Forwarding Corporation*, 222 USPQ 355, 356 (TTAB 1983).

With respect to the services, while it is true that registrant's tournaments involve specifically different sporting events from those of applicant's exhibitions and competitions, applicant has acknowledged, reply brief, 3, that a common function of the respective services is to organize, conduct and promote sporting exhibitions and tournaments. Although there are differences in the sporting events, even applicant acknowledges that there may be some overlap between the so-called traditional and extreme sports in both participants as well as viewers. Response filed December 27, 1999, 3.

Moreover, it is worth noting that registrant's services have indeed expanded, according to the use dates listed in its registrations, from softball tournaments (1983) to soccer tournaments (1990) to basketball, volleyball and street hockey tournaments (1994). We also

note the following excerpt from a printout from registrant's Web site (submitted by applicant):

The sports events and marketing industry is growing. Sports sponsorships have experienced double digit growth. Team participation is exploding, particularly in the highly populated youth market. This age group is seeing tremendous growth in teams and clubs that wish to play more games in different locations against different quality competition.

With respect to the third-party registrations covering golf clubs and other goods and services, they are of little weight because they are for different goods and services offered in different channels of trade. Contrary to applicant's arguments, they do not serve to demonstrate that the registered mark is "weak" in its field (organizing and conducting tournaments) or that it is entitled to a narrow scope of protection. It is certainly entitled to protection against the registration of an identical mark for arranging and conducting the specific exhibitions and competitions listed in the application. Further, while we have considered the agreement entered into between applicant and the owner of the TRIPLE CROWN horse-racing event registrations, that agreement indicating that there is no likelihood of confusion between the marks used for the distinct sport of horse racing and applicant's

exhibitions and competitions is of little weight in this case, which involves the arranging and conducting of tournaments and athletic competitions by both registrant and applicant.

With respect to applicant's argument concerning the lack of instances of actual confusion, we note that applicant's earlier use of the mark TRIPLE CROWN was accompanied by the descriptive phrase "OF SURFING." In any event, the mark for which applicant now seeks registration is based on an intent to use, rather than on actual use, so that there has not been an opportunity for confusion to occur. Even if applicant has now commenced use of its mark after the December 1998 filing of its application, we do not regard that as a sufficient amount of time to show that there has been an adequate opportunity for confusion to occur. Further, we do not have any information as to the extent of applicant's use of its mark for us to assess any alleged lack of actual confusion.

In sum, we agree with the Examining Attorney that potential purchasers and participants, aware of registrant's TRIPLE CROWN softball, soccer, basketball, volleyball and street hockey tournaments, who then encounter applicant's exhibitions and competitions for skateboarding, surfing, snowboarding, street luge, etc.,

Serial No. 75/614,036

offered under the identical mark TRIPLE CROWN, are likely to believe that all of these tournaments and competitions are sponsored by the same source. Of course, if we had any doubt about this conclusion, that doubt must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988).

Decision: The refusal of registration is affirmed.