

Paper No. 11
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

DEC. 21, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Virginia Baseball Club LC**

Serial No. 75/002,545

Rober A. Vanderhye of Nixon & Vanderhye for applicant.

Cindy B. Greenbaum, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney).

Before Cissel, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Virginia Baseball
Club LC, a limited liability company of the state of
Virginia, to register the mark VIRGINIA BASEBALL CLUB for
"entertainment services in the nature of baseball

exhibitions" and for a wide range of collateral products falling in several different international classes.¹

The Trademark Examining Attorney has refused registration under Section 2(e)(2) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods and/or services, would be primarily geographically descriptive of them. The Examining Attorney also made final, pursuant to Section 6(a) of the Act, a requirement that applicant disclaim the words "Baseball Club" apart from the mark because, in the Examining Attorney's view, the words are merely descriptive or generic. The Examining Attorney further refused registration based on an improper classification of two of the items listed in the identification of goods. Lastly, the Examining Attorney made final a requirement that applicant affirmatively state whether the goods and/or services will have any connection with the state of Virginia.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.

As an initial matter, we note that applicant responded, in the context of its remarks made in a portion of its brief directed to the Section 2(e)(2) refusal, to

¹ Application Serial No. 75/002,545, filed October 6, 1995, alleging a bona fide intention to use the mark in commerce. The

the Examining Attorney's requirement that applicant state whether the goods and/or services will have a connection with the state of Virginia. The Examining Attorney appears to have implicitly accepted applicant's statements as satisfying the requirement inasmuch as the Examining Attorney did not list in her brief this final requirement as an issue on appeal. Moreover, the Examining Attorney has referred to applicant's statements in arguing the merits of the Section 2(e)(2) refusal. Accordingly, we assume that the Examining Attorney's requirement has been satisfied, and that this issue is moot. No further attention need be given to the matter.

Geographic Descriptiveness

The Examining Attorney, in urging that the Section 2(e)(2) refusal to register be affirmed, contends that the primary significance of the term "Virginia" is geographic and that a goods/place and/or a services/place association is presumed from the fact that applicant's goods and/or services will be produced/rendered in the state of Virginia. The Examining Attorney maintains that the words "Baseball Club" are generic or merely descriptive as applied to the goods and/or services, and that the addition of these words to the geographic term does not diminish the

identification of goods is over four typed pages long.

primarily geographic significance of the mark as a whole. In support of the refusal, the Examining Attorney relied upon dictionary listings for the terms "Virginia," "Baseball" and "Club."

Applicant maintains that its mark is not primarily geographically descriptive since the mark is a unitary mark comprising, in part, non-geographic terms, that the word "Virginia" has non-geographic meanings, and that there is no evidence that consumers associate baseball with the state of Virginia. More specifically, applicant argues that the mark as a whole is "Virginia Baseball Club," not "Virginia" per se; that there has never been a Major League baseball team located in the state of Virginia, so that an association of baseball with Virginia is highly unlikely; and that "Virginia" is commonly used as a given name for women. In connection with its arguments, applicant relied upon dictionary listings of the word "Virginia," as well as several combination of terms which begin with "virginia" (small letter "v"), the definitions of which are silent as to any connection with the state of Virginia. Applicant also submitted copies of third-party registrations and applications wherein the words "Baseball Club" have not been disclaimed, with applicant's contending that the words have not been viewed universally as merely descriptive when

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applied to goods and/or services of the type listed in applicant's application.

In order for registration to be properly refused under Section 2(e)(2), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public, and that (ii) the public would make a goods(services)/place association, that is, believe that the goods and/or services for which the mark is sought to be registered originate in that place. In re California Pizza Kitchen, Inc., 10 USPQ2d 1704 (TTAB 1988), citing In re Societe Generale des Eaux Minerals de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). Where there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods and/or services with the place may ordinarily be presumed from the fact that the applicant's own goods and/or services come from the geographical place named in the mark. In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982).

The term "Virginia," as defined by the dictionary evidence of record, means "a state in the eastern United States, on the Atlantic coast;" "of or from the state of Virginia;" and "a female given name from a Roman family

name." The term "baseball" is defined as "a game of ball...." The term "club" means "a group of persons organized for a social, literary, athletic, political, or other purpose."

Based on the record before us, we find that the primary significance of the term "Virginia" in applicant's mark is geographical. We further find that the state of Virginia is neither an obscure nor a remote geographical place, but rather is the name of a place known generally to the public. In saying this, we recognize that the term "Virginia" is a given name for women and that there are dictionary listings for combinations of terms comprising, in part, the word "virginia" (as, for example, "virginia opossum" and "virginia reel") wherein no reference is made to the state of Virginia. However, in the context of the mark as a whole, we cannot help but conclude that the significance of the term "Virginia" in applicant's mark is primarily geographical. That is, it is common knowledge that sports team names are usually preceded by place names.

With respect to whether the public would make a goods/place and/or a services/place association, applicant described its connection with the state of Virginia as follows (brief, pp. 2-3):

[A]pplicant's present intent is to conduct [M]ajor [L]eague baseball exhibitions and games in the State of Virginia. However certainly at least as a preliminary matter, games may be conducted in the District of Columbia or Maryland, and in any event there will be exhibition games and services provided at a spring training location or locations; probably in Florida or Arizona. The goods that will be sold with the mark will not necessarily be manufactured in Virginia, but may be manufactured anywhere in the world, but likely will be sold wherever the baseball team is conducting games or exhibitions, e.g. Florida, Arizona, the District of Columbia, Virginia, or Maryland, or from corporate headquarters, presently in the State of Virginia, or from Major League baseball outlets anywhere.

We note that applicant is a limited liability company under the laws of the state of Virginia and that applicant is located in Alexandria, Virginia. Further, as applicant itself has acknowledged, its intent is to conduct baseball games and exhibitions in the state of Virginia. Inasmuch as applicant is headquartered in Virginia, and the team would be located in Virginia and playing at least some of their games there, a public association of the goods and/or services with Virginia may be presumed. In re Handler Fenton Westerns, Inc., supra. See also: In re Nantucket Allserve Inc., 28 USPQ2d 1144 (TTAB 1993). Indeed, given the specific nature of applicant's services and goods, it is likely that the public would view the services, and any collateral products bearing the mark, as having their

origin in Virginia, where the baseball team is located. Such is the case with any professional sports team relative to its location. Moreover, applicant here has left open the possibility that its goods will, in fact, be manufactured in Virginia.

Applicant's evidence and arguments simply do not rebut the prima facie case established by the Examining Attorney. That is to say, consumers would reasonably expect, upon encountering the mark VIRGINIA BASEBALL CLUB for applicant's goods and/or services, that the goods and/or services originate in Virginia, and applicant has not submitted sufficient evidence to show that the primary significance of VIRGINIA BASEBALL CLUB is not geographical or that there would be no association between Virginia and applicant's goods and/or services. The facts that Virginia is not "noted for" baseball or that a Major League baseball team has never been located in Virginia are of little moment. In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 867-868 (Fed. Cir. 1985); and In re Pan-O-Gold Baking Co., 20 USPQ 1761 (TTAB 1991) [the goods(services)/place association does not require proof that the place named in the mark is well-known or noted for the goods(services)]. Likewise, the fact that there are dictionary definitions of "virginia--" word combinations that do not indicate origin in that state is of minor relevance given applicant's specific mark (VIRGINIA BASEBALL CLUB) and the specific services and collateral

products (baseball-related services and goods) involved here. Also, the fact that "Virginia" is a woman's name does not diminish our view that the word "Virginia," as it appears in applicant's mark, would have a primary geographical significance.

The mere addition of the highly descriptive words (see discussion, infra) "Baseball Club" does not detract from the primary significance of VIRGINIA BASEBALL CLUB when the mark is considered as a whole. In re Chalk's International Airlines Inc., 21 USPQ2d 1637, 1639 (TTAB 1991). Further, as the Board has stated in the past, the determination of registrability under Section 2(e)(2) should not depend on whether the mark is unitary or composite. In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986).

We finally note that applicant, in its application Serial No. 75/013,460 to register the mark VIRGINIA BASEBALL CLUB L.C. and design, disclaimed the words "Virginia Baseball Club." Although the Examining Attorney points to this disclaimer as an admission of geographic descriptiveness, applicant disagrees (brief, p. 8): "the disclaimer in the co-pending application is of the corporate entity name, which includes the 'LC' at the end thereof, and which has an entirely different unitary impression and significance than 'Virginia Baseball Club' per se does here."

We are not persuaded by the distinctions drawn by applicant. However, although we have considered the prior

disclaimer, we also do not view the disclaimer to be dispositive of the Section 2(e)(2) issue here.

In view of the above, we affirm the refusal to register.

Disclaimer

The Examining Attorney required a disclaimer of the words "Baseball Club" apart from the mark. The Examining Attorney maintains that the words, if used in connection with applicant's goods and/or services, would be generic or merely descriptive thereof. In support of this position, the Examining Attorney submitted copies of third-party registrations of marks including the words "Baseball Club," or slight variations thereof, covering baseball exhibition services and collateral products. The registrations include disclaimers of the words "Baseball Club" apart from the mark. Also, the Examining Attorney once again refers to applicant's previously issued registration wherein the words were disclaimed.

Applicant contends that the words "Baseball Club" are not universally considered to be descriptive, pointing to a registration owned by The San Diego Padres Baseball Partnership wherein the words "Baseball Club" are not disclaimed. Applicant states that "although it ["Baseball Club"] is considered descriptive for entertainment services

in the nature of baseball exhibitions, it is not considered descriptive for goods in general." (brief, p. 9)

Applicant also contends that the disclaimer in its earlier registration is not an admission of genericness/mere descriptiveness inasmuch as the words "Baseball Club" per se were not disclaimed, but rather the words "Virginia Baseball Club L.C." were disclaimed.

It is well settled that a term is considered to be merely descriptive of goods/services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods/services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods/services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods/services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). In this connection, registration must be refused if the term is

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descriptive of any of the goods/services for which registration is sought. In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); and In re Richardson Ink Co., 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975).

In this case, the words "Baseball Club" clearly are highly descriptive when applied to services and goods related to baseball and, even more specifically, to the activities of a baseball club (team). The third-party registration evidence submitted by applicant and the Examining Attorney shows that the words have been disclaimed in all but one case. We would point out that, in any event, we are not bound by the actions of Examining Attorneys in prior cases.

The requirement of a disclaimer of the words "Baseball Club" is affirmed.

Identification of Goods

There were two issues which were the subjects of the final refusal, one of which has been resolved. The one no longer on appeal involved the classification of "temporary tattoos." Applicant, in its brief, noted that "[i]t is clear that the 'temporary tattoos' goods listing amendment in the January 24, 1997 paper was merely an error, and this will be corrected upon remand to the examining attorney by

removal of 'temporary tattoos' from the Class 28 description, and insertion into the Class 16 description." (brief, p. 10) The Examining Attorney, in her brief, notes applicant's statement, and indicates that "there is no need to further address this issue herein." (brief, p. 3, n. 1) Inasmuch as applicant and the Examining Attorney are in agreement on this point, and in order to avoid the inherent delay in any remand situation, the identification of goods is deemed to be amended to reflect the transfer of the item "temporary tattoos" from Class 28 to its proper place in Class 16.

The other issue involves the classification of applicant's "batting helmets" and "catcher's helmets." The essence of applicant's argument is that these goods are sporting goods and belong in Class 28. Although the Examining Attorney insists that the items belong in Class 9, applicant maintains that the fact that the helmets may have some protective function does not mean that they are classified in Class 9 (a class not included in this combined application). In making this argument, applicant contends that the Office "ID Manual" does not have the force and effect of law. Applicant also points out that golf gloves, baseball gloves and football equipment all have protective functions, yet these goods are classified

in Class 28. Applicant also highlights two previously issued third-party registrations wherein "batting helmets" appear in Class 28.

The Examining Attorney maintains that all helmets, including batting helmets and catchers' helmets, are properly classified, according to the "Office's Acceptable ID Manual," in Class 9. Thus, the Examining Attorney asserts that the items must be deleted from the identification of goods inasmuch as applicant did not add Class 9 to the listing of goods. A copy of the pertinent page from the manual has been made of record.

We would point out that the matter of proper classification is not a substantive one and, thus, generally not a matter for appeal. In re Tee-Pak, Inc., 164 USPQ 88, 89 (TTAB 1969). Nonetheless, neither applicant nor the Examining Attorney have made mention of this view, but rather have briefed the issue. In the interest of judicial economy, we have elected to consider the issue.

However arbitrary the classification system may seem at times, the *U. S. Patent and Trademark Office Acceptable Identification of Goods and Services Manual* controls in these types of situations. The classification system is set up for the convenience of the Office. In the present

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case, we readily appreciate the fact that batting helmets and catchers' helmets serve two purposes, that is, as sports equipment and as safety equipment. For whatever reasons, the items are classified in Class 9, and applicant's position cannot be adopted. The two third-party registrations relied upon by applicant would appear to contain classification errors, a situation that need not be repeated here. *TMEP* §§ 1401.02 and 1401.10.

Decision: The refusals to register are affirmed.

R. F. Cissel

T. J. Quinn

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

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