

Hearing:
February 11, 1999
THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/24/99

Paper No. 32
DEB

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pace American, Inc. and Jack Bender
v.
Haulmark Industries, Inc.

Cancellation No. 23,473

Terence J. Linn of Van Dyke Gardner Linn & Burkhart, LLP for
Pace American, Inc. and Jack Bender.

James D. Hall of Baker & Daniels for Haulmark Industries,
Inc.

Before Hanak, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Pace American, Inc. and Jack Bender (petitioners) have
petitioned to cancel a registration owned by Haulmark
Industries, Inc. (respondent) for the mark "RACE TRAILERS"
(with the word "trailers" disclaimed) for "towable storage

trailers."¹ As grounds for cancellation, petitioners allege in their amended petition for cancellation, that members of the trade use the term "race trailers" in a descriptive and/or generic sense to refer to a particular type of enclosed cargo trailers; and in the alternative, if there are trademark rights in the phrase capable of being protected, such rights belong with petitioners by virtue of their prior and continuous usage of the trademark "RACE TRAILERS BY JACK BENDER."²

Respondent, in its answer, has denied the salient allegations of the petition to cancel.

The record consists of the file of the involved registration; the testimony deposition (with exhibits) of petitioner's witnesses as follows: Jack Bender, Vice President of Petitioner, Pace American, Inc.; Mitchell I. Bender, President and CEO of Petitioner, Pace American, Inc.; Bradley J. Baker, CEO of Classic Manufacturing Inc.; and Peter L. Russell, President of GM Racing Trailers; petitioner's notice of reliance under Rule 2.122(e) on excerpts from various printed publications and other documentary evidence; the testimony deposition (with

¹ Registration Number 1,581,391, issued on February 6, 1990 from an application filed on March 16, 1989, which sets forth dates of first use of December 21, 1987; Section 8 affidavit accepted.

² This alternative basis for cancellation was not explicitly spelled out in the original petition for cancellation.

exhibits) of respondent's witnesses as follows: L. Michael Arnold, CEO of Markline Industries of Pennsylvania and respondent, Haulmark Industries, Inc.; Bruce Litton, trailer salesman for respondent; and Thomas Gale, a trailer business owner; and respondent's notice of reliance under Rule 2.122(e) on excerpts from various printed publications. Both parties filed briefs on the case and were represented by counsel at the oral hearing.

The instant petition to cancel was filed on November 22, 1994,³ several months before the date of expiration of the fifth year, counted from the date on which the registration of "RACE TRAILERS" was issued. Nonetheless, on March 15, 1995, Haulmark Industries, Inc. filed a combined §8 (use) and §15 (incontestability) declaration⁴ in the

³ However, rather than being prompted by the approach of the fifth anniversary of the registration, it appears as if a letter to petitioner, Pace American, Inc., dated June 23, 1994, from respondent's attorney, actually prompted the instant petition to cancel the contested registration. This letter charged that a specific advertisement placed in National Kart News by Pace American, Inc. infringed respondent's federally registered trademark, and requested that "... the words RACE TRAILER be deleted" from any further Pace American, Inc. ads. The record shows a flurry of similar "policing" actions on the part of respondent in 1993 and 1994.

⁴ Incontestable status is attained by filing a Section 15 affidavit with the Commissioner within one year after a five-year period in which the federally registered mark has been in continuous use and is still in use in commerce. See 15 U.S.C. Section 1065(3)(1994); 37 C.F.R. Section 2.167. An applicant must declare that: (1) there has been "no final decision adverse to ... registrant's right to register the [mark] or to keep the same on the register," and (2) there is "no proceeding involving said rights pending in the Patent or Trademark Office or in a

registration -- four months after the date of institution of the cancellation proceeding by this Board -- as if unaware of the significance of this proceeding on the Section 15 affidavit. Accordingly, the Post Registration unit of the U.S. Patent and Trademark Office made no notation about the filing of the §15 affidavit of incontestability.

We turn first to a review of the parties to this action. One of the petitioners is Pace American, Inc., an Indiana corporation that manufactures enclosed cargo trailers for commercial and recreational uses. This company was founded in 1986 by Mitchell I. Bender, and his father, Jack Bender, who serve, respectively, as Chief Executive Officer/President, and Vice President, of Pace American, Inc.⁵ The second listed petitioner in the amended petition to cancel is Jack Bender, as an individual. Mr. Bender became a trailer dealer in the mid-1970's, and continued as the owner of his own business to sell new and used cargo trailers through 1992⁶ - five or six years after helping to found Pace American, Inc., a trailer manufacturer.

Respondent, Haulmark Industries, Inc., founded in 1977, is also a manufacturer of steel-framed, enclosed cargo

court and not finally disposed of." See 37 C.F.R. Section 2.167(d),(e).

⁵ Testimony deposition of Jack Bender, pp. 4-5; Testimony deposition of Mitchell I. Bender, pp. 8-9, 17.

trailers,⁷ and is a direct competitor of Pace American, Inc. The record shows that petitioner, Jack Bender, as a trailer dealer, had actually bought some trailers from respondent, Haulmark Industries, Inc., prior to starting his own manufacturing operation, Pace American, Inc.⁸

Respondent claims that it coined the term "Race Trailers" in December 1987.⁹ This is consistent with claims respondent made while prosecuting the application that resulted in the contested registration.¹⁰ However, after reviewing carefully the complete record in this proceeding, we find that the weight of the evidence belies this claim. Simply stated, the record herein shows that the term "Race Trailers" has never been a trademark, but rather entered the public domain as a generic name from the time of its inception.

⁶ Testimony deposition of Jack Bender, pp. 5-6; Testimony deposition of Mitchell I. Bender, pp. 9, 28-29.

⁷ Testimony deposition of L. Michael Arnold, p. 6.

⁸ Testimony deposition of L. Michael Arnold, p. 19; Testimony deposition of Jack Bender, pp. 6, 22, 25; Testimony deposition of L. Michael Arnold, p. 19.

⁹ Letter from Thomas J. Dodd to Murray Smith on July 8, 1993 (Petitioner's Exhibit No. 12).

¹⁰ "...[T]he term 'race' as used in the mark was first conceived because of the sleek or 'racy' design of the trailer... The applicant's goods are trailers, not race cars... [T]he word combination 'RACE TRAILERS' is inventive, incongruous and imaginative as opposed to descriptive..." Applicant Haulmark Industries, Inc., response to the Patent and Trademark Office's first Office action, dated August 3, 1989, from Thomas J. Dodd.

By the mid-1970's, Jack Bender, along with a few other early competitors, like Peter Russell,¹¹ saw the maintenance and security advantages for race car owners of having fully-enclosed, towable trailers. Prior to this development (i.e., during the muscle-car period of the 1960's), open trailers were the norm for hauling race cars. Unfortunately, open trailers left valuable automobiles and related racing equipment exposed to weather, vandalism, etc.¹²

Interestingly but not surprisingly, many of the "grandfathers" in this burgeoning industry of modifying cargo trailers for hauling a variety of racing vehicles had strong personal or familial involvement with racing -- everything from go-karts, motorcycles and snowmobiles to vintage automobiles, drag-racers and high-performance vehicles on the professional racing circuit.¹³ Also it should come as no surprise that many of the key players have been located in Elkhart County, Indiana -- known for its

¹¹ Mr. Russell: "...If you just get your history, you are going to figure out I was the first one to [use the term 'race trailer'] in this area - period."

Q (Counsel, Terence J. Linn): "When is the first time you can recall having used 'race trailer' for these enclosed trailers?"

Mr. Russell: " '75. 1975"
Testimony deposition of Peter L. Russell, p. 26.

¹² Testimony deposition of Peter L. Russell, pp. 7-8; Testimony deposition of Mitchell I. Bender, p. 15.

recreational-vehicle industry. For example, the record shows that among the most prominent names in this specialized field,¹⁴ Wells Cargo is located in Elkhart, Pace American in Middlebury, and Haulmark in Bristol, each one located minutes from the others. All have quite large manufacturing operations in Elkhart County for these specially modified cargo trailers. The principals of these companies testified to the degree of intense competition that characterizes their industry. Accordingly, trailer manufacturers and their dealers advertise in many of the same national publications.¹⁵ Print advertisements containing their respective trademarks¹⁶ appear in a variety of types of advertisements, with the majority placed by various trailer dealers from around the United States.¹⁷

In the late 1970's and into the 1980's, Jack Bender was probably selling more trailers to racers than anyone else in

¹³ Testimony deposition of Peter L. Russell, pp. 6-7; Testimony deposition of Mitchell I. Bender, pp. 9-13, 15.

¹⁴ Testimony deposition of L. Michael Arnold, p. 15.

¹⁵ The record contains articles and advertisements taken from National Dragster, On-Track, Auto Week, Drag Review, Jr. Drag Racer, Sports Car, National Speed Sports News, Super Stock, Open Wheel, Dragster News, Parts Peddler, Circle Track, Performance Racing Industry, Victory Lane Magazine, and National Kart News.

¹⁶ In addition to the trade names qua service marks of the various dealers, the trademarks relevant to this proceeding that most frequently occurred were several trademarks owned by petitioners ("Pace," "Pace American," and "Race Trailers by Jack Bender") and respondent's housemark ("Haulmark").

¹⁷ Petitioner's Exhibits #9, #13, #16, ##18-24, ##34-40; #44, ##51-52, #57, ##61-67, etc.

the industry.¹⁸ Accordingly, Mr. Bender seems to have had an early and frequent presence in the pages of national publications targeted to racers.¹⁹ Nonetheless, these pages of classified advertisements repeatedly reveal the presence of these trademarks,²⁰ along with generic usage's of the designations "race trailer" or "race trailers," all within advertisement copy designed and placed by third party trailer dealers. This variety of both parties' trademarks, along with generic uses by third-parties, often appeared in adjoining columns on the same pages of classified advertisements.²¹ Finally, to further ensure the prominence of their marks (e.g., "RACE TRAILERS BY JACK BENDER," "PACE" AND "PACE AMERICAN") right in the limelight of various racing venues, petitioners also marketed their trailers by sponsoring various racing teams of go-karts, snowmobiles, motorcycles and automobiles.²²

¹⁸ Testimony deposition of Mitchell I. Bender, p. 20.

¹⁹ Testimony deposition of Mitchell I. Bender, pp. 37, 48, 87.

²⁰ Again, the relevant marks include "Pace," "Pace American," "Race Trailers by Jack Bender," and "Haulmark."

²¹ Petitioner's Exhibits #9 ("Race Trailers by Jack Bender," "Race Trailers by Little Red Wagon"); #13 ("Southern Pace Race Trailers, Inc."); #16 ("Race Trailers, Bomar Racing, Ltd."); #21 ("Topeka Race Trailers"); #24 ("Race Trailer Specialists," "Dominador Race Trailers" by Classic); #61 ("Ron Carter's Race™ Trailers"); #64 ("Timber Wolf Race Trailers"); #66 ("Race Trailers Available to Winnebago/Itasca Owners Only!," Stout's RV Sales, Inc.); and #67 (Vintage Trailers Ltd., "Your Race Trailer Specialist").

²² Testimony deposition of Mitchell I. Bender, pp. 70 - 75.

As noted above, in the period of 1993 to 1994, petitioner, Pace American, Inc., was among respondent's competitors who received threatening letters from respondent's attorney about their usage of the term "race trailers" in a generic sense²³ The record shows that some of these firms argued vehemently in correspondence back to respondent's counsel²⁴ and again in testimony taken for this proceeding, that the terms "race trailer" and "race trailers" have been used continuously since the 1970's by manufacturers, dealers and racing enthusiasts alike, to refer to enclosed trailers for hauling go-karts, snowmobiles, bicycles, motorcycles, cars, and the supplies

²³ Classic Manufacturing, Petitioner's Exhibit #6; Pace American, Inc., Petitioner's Exhibit #68; Cars Plus, Inc. & Ron Carter, Respondent's Exhibit #9; Midwest Trailers, Wells Cargo, Inc., Cowboy Coaches, Little Red Wagon, TrailerSource, R.A. Adams Enterprises, Inc., Topeka Race Trailers, Raider Race Trailers, Bomar Racing, Ltd., Hudson River Truck Equipment, Transport Design, Terry's Trailers, and Race Trailers, Inc., Respondent's Exhibit #11.

²⁴ "...[T]he phrase 'Race Trailers' and 'Race Car Trailers' are used generically to describe the type of trailer...If you asked 100 race car owners what kind of trailer they own, they would say a race trailer. They don't own a cargo trailer, or a utility trailer, they have a race trailer." Bradley J. Baker, President of Classic Manufacturing, April 28, 1993.

"... [T]he words 'race trailer' have been a generic term for many years and continue to be a generic term... It is not at all clear that the Patent and Trademark Office would have granted Haulmark's registration if it has been aware of the existence of this accepted generic use in a national magazine at a point in time during the pendency of the application." T. Murray Smith, Counsel for Classic Manufacturing, June 9, 1993.

and accessories for these various racing vehicles²⁵ - and thus could never have functioned as Haulmark's trademark to indicate origin.²⁶ In fact, on cross-examination, one of respondent's witnesses, Mr. Bruce Litton, seemed to agree that many people in the racing industry use the term "race trailer" in a non-trademark sense to denote a towable trailer for hauling a racing vehicle:

Q by Linn: Back in 1982, did you ever see a Haulmark trailer that was marked with the term "Race Trailer"?

A by Litton: No.

Q by Linn: Did people call that trailer during that time period a "Race Trailer"?

A by Litton: They called it -- I mean, at that time, they called it either a "race trailer" or a "race car trailer." You know, I have no recollection of what they actually called it.

Q by Linn: In -- Just in dealing with the racing industry. I - have you heard people refer to the trailers that they use to haul their race cars as a "race trailer"?

²⁵ One story from the [*San Jose Mercury News*](#), of September 3, 1993, demonstrates just how elaborate these trailers can be when designed for top-of-the-line NASCAR / Winston Cup racers: "A fully outfitted race trailer includes a lounge, workshop, generators, air conditioning, a deck for two cars and a lift gate. About 80% of the teams at Indy use his trailers, which cost from \$50,000 for basic models to four times that much for specialty jobs, he [Bruce Canepa] said..."

²⁶ Testimony deposition of Bradley J. Baker, pp. 12-17; Testimony deposition of Mitchell I. Bender, pp. 11-17; Testimony deposition of Peter L. Russell, pp. 10-27.

- A** by Litton: I've heard them called "race car trailers" and "race trailers" both, yes.
- Q** by Linn: And are those terms used pretty much interchangeably?
- A** by Litton: They - It's kind of - It's kind of where you don't really - I don't know how to say this. You don't - you don't really - you know what they're talking about. They're talking about their enclosed trailers.
- Q** by Linn: That they call their race --
- A** by Litton: (Interrupting) That they - they call - That they haul a race car in. You can like say that they've called them anything from "race car trailer" to "my enclosed car hauler" or - or - They've - They've called it several things.
- Q** by Linn: Now the people that have used "race trailer" in this way, what type of people have you heard say that? I mean, what - what kind of people have you heard making reference to their "trailer" as a "race trailer"?
- A** by Litton: It's been people that's - that's had cars in - inside the trailers.
- Q** by Linn: Would these be drivers?
- A** by Litton: Usually - Usually it's the - the trailer owner, you know. I mean - or whatever. I mean, it could be the driver or the - or whoever, for that matter.
- Q** by Linn: When these people are making reference to their trailer, they aren't meaning to imply Haulmark, are they?
- A** by Litton: To be honest with you, a good portion of them - a good portion of them are Haulmark trailers.
- Q** by Linn: But there's a number that are not Haulmark trailers?

A by Litton: Oh, yes. I mean, there's - there's a number of - several - several trailers out there; but yes, some of them can be Haul - not Haulmark trailers too.

Q by Linn: Is it your belief that people in general in this industry refer to a trailer that they use to haul their race car in as a "race trailer"?

A by Litton: From my - From my point of view...

Q by Linn: (Interrupting) Well no. I didn't ask from your point of view what's the proper terminology. It's whether other people refer to it as such, and whether you have heard people refer to it that way?

A by Litton: Okay, ask the question all over again.

Q by Linn: Okay. Is it your belief that other people in this industry refer to a trailer in which they haul their race car as a "race trailer"?

A by Litton: Yes, you could say that.

Q by Linn: Now, a race trailer doesn't necessarily have to be used to haul a race car, does it?

A by Litton: No.

Q by Linn: I mean, a race trailer is a term used to refer to a trailer that hauls a racing vehicle of some type, is that correct?

A by Litton: I mean, it could be a street car for that matter. I mean - But it can be any - a type of car, race car or a street car or cargo for that - for that matter.

Q by Linn: And do you believe that people in this trade refer to these other types of trailers as "race trailers" just to

designate the - the style of trailers?

A by Litton: They - they more generally refer to them as both "race car trailers" and "race trailers." You know, they're --

Q by Linn: Used interchangeably?

A by Litton: Used interchangeably, but -- I mean, like when I describe my particular trailer, I call it my "enclosed trailer" or my "race car trailer." I don't - You know, I mean - I mean, I - I mean, you never -- you never ever actually categorize it in the same way when you're referring to an object... ²⁷

The record also shows that from 1976 until the early 1990's, Jack Bender was a dealer of enclosed trailers who actively traded under the name "RACE TRAILERS BY JACK BENDER." Beginning in the early eighties, Jack Bender applied a very large, blue circular "sticker" to all of the new and used trailers he sold, containing the following logo:

²⁷ Testimony deposition of Bruce Litton, pp. 38 - 39.



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Because these stickers did not always stand the test of time, a smaller, aluminum nameplate applied with rivets later replaced this sticker, and included Jack Bender's telephone number:



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Many of the trailers exhibiting these "RACE TRAILERS BY JACK BENDER" designations continue to be in use, and the trailers are still being serviced by Pace American, Inc.³⁰

²⁸ Testimony deposition of Mitchell I. Bender, p. 25. This graphic design was also made into cloth patches to be sewn onto jackets, smocks, hats, etc., Mitchell I. Bender, p. 59.

²⁹ Testimony deposition of Mitchell I. Bender, pp. 27, 62.

³⁰ Testimony deposition of Mitchell I. Bender, pp. 25, 114, 119-120; Testimony deposition of Jack Bender, pp. 8-10.

The record is replete with advertisements and other uses of Jack Bender's circular logo. The record establishes that Jack Bender indeed began using this circular logo (and the attendant trade name in other formats) long prior to the alleged coinage of the term "Race Trailers" by respondent. In fact, Ron Carter, one of the persons originally cited by respondent as having been involved in selecting this trademark for respondent,³¹ had sustained contacts with petitioner, Jack Bender, his trade name and logos prior to Ron Carter's involvement with Haulmark,³² and the date of alleged first use of this term by Haulmark Industries, Inc.

We also find it incredulous that one of respondent's principals³³ and one of its dealers³⁴ could take the position that they did not know of Jack Bender's trade name (i.e., "RACE TRAILERS BY JACK BENDER") - despite the concentration of an intensely competitive industry within miles of each other in Elkhart County, Indiana; that they had not seen Jack Bender's logos over the years prior to 1987³⁵ -- in spite of the large volume of trailers Jack Bender had marked with his large blue stickers and metal plaques, the hundreds of trademarked jackets and clothing patches Mr. Bender

³¹ Testimony deposition of L. Michael Arnold, p. 23.

³² Testimony deposition of Mitchell I. Bender, pp. 21 - 24.

³³ Testimony deposition of L. Michael Arnold, pp. 9

³⁴ Testimony deposition of Thomas Gale, p. 16.

³⁵ Testimony deposition of Thomas Gale, p. 17.

handed out, and the variety of competitive racing teams both petitioners have sponsored; and that they did not remember ever seeing Jack Bender's prominent logo located in each of his many advertisements, or even the constant usage of the term "race trailers" by other third parties³⁶ -- despite the fact that Haulmark's housemark and individual dealership's service marks appeared in advertisements on the same pages of national publications as both these types of usage (e.g., "RACE TRAILERS BY JACK BENDER" and "X-Y-Z ... Race Trailers"³⁷).

Whether the public regards the designation "Race Trailers" as a generic term is a question of fact to be resolved on the evidence. We are convinced that this terminology was fairly widely used and recognized in the industry (e.g., by trailer manufacturers who designed and built these specialized trailers, and trailer dealers who sold them to racers) as a generic term for at least a decade prior to respondent's alleged adoption. Pursuant to the Trademark Clarification Act of 1984, 15 U.S.C. §1064(3), our

³⁶ Testimony deposition of L. Michael Arnold, p. 16.

³⁷ For example, in addition to the use of the words "Race Trailers" in Jack Bender's trade name, the record contains advertisements showing at various times over the past twenty years the prominent involvement in this industry of Southern Pace Race Trailers, Topeka Race Trailers, Race Trailer Specialists, G.M. Racing Trailers (nee G.M. Race Trailers), etc. Furthermore, many others who never incorporated the term into their actual trade name used and continue to use the term generically within the advertisement copy made of record in this proceeding.

determination of whether a term is generic focuses on the significance of the term to the "relevant public." In defining the relevant public, we focus on the primary significance "to actual and potential purchasers of the goods." Additionally, our primary reviewing court has stated that a party charging genericness must prove its claim by a preponderance of the evidence. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 641, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991) [In determining whether "TOUCHLESS" is generic for automobile washing services, the relevant public *cannot consist solely* of the vendors, operators, and manufacturers of car washing equipment - the primary focus should be on ordinary automobile owners and operators].³⁸ Evidence of what the relevant public understands the term to mean may come from direct testimony, trade journals, newspapers and other publications. See In re Northland Aluminum Products, Inc., 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985) ["Bundt" is not registrable as trademark for "ring cake mix"]; and Dan Robbins & Associates, Inc. v. Questor Corporation, 599 F.2d 1009,

³⁸ In the Magic Wand case, the Board and our reviewing Court discounted the trade articles and advertisements because they were directed to the *owners and operators of car washes* - not to *car owners and operators* who purchased the car washing services. In the instant case, the advertisements of petitioners and third parties are directed to the relevant consuming public - racers of

1014, 202 USPQ 100, 105 (CCPA 1979) [Inadequate evidence to support contention that "TINKERTOY" has become the common descriptive name of Questor's toys].

As far as selecting a single genus of cargo trailers to cover the goods identified in respondent's registration, the documentary evidence and witnesses show that the industry has not settled on a single designation. But of course, there is usually not one, single and exclusive name for a product.³⁹

We noted that in the instant case, what really converts the ordinary, enclosed cargo trailer into a "race trailer" is a combination of specific features of the trailer's design and the intended purpose of the purchaser.⁴⁰ When such trailers are designed specifically for hauling one or more automobiles, we must agree with respondent's arguments, drawn from the testimony of respondent's witnesses as well

all types who are seeking to purchase an enclosed, towable storage trailer for their racing vehicle(s).

³⁹ "Appellant has argued that the descriptive term for its gasoline is 'pump-blended.' I do not question that there is a descriptive - or as appellant calls it 'generic' - term; but a product may have more than one generically descriptive name. Because one merchandiser has latched onto one of the descriptive terms does not mean it can force its competitors to limit themselves to the use of the others, which appellant, it seems to me, is trying to do here..."

In re Sun Oil Co., 426 F.2d 401, 165 USPQ 718, 719, J. Rich, concurring (CCPA 1970) ["Custom-Blended" found unregistrable for gasoline]; See also McCarthy on Trademarks and Unfair Competition, §12.9, p.12-18 (Sept. 1998).

⁴⁰ Testimony deposition of Mitchell I. Bender, p. 101.

as excerpts that respondent submitted from public records, that some trade names, advertisements, and general publications have indeed used alternative terms such as "racing trailers," "race car trailers,"⁴¹ "car haulers," "car carriers," etc., to refer to this genre of enclosed trailers.

On yet the other hand, in light of the totality of the evidence, the recognition of alternate generic terms for these enclosed trailers does not answer the question of what the relevant public thought the term "race trailer" or "race trailers" meant in December of 1987, or at any point in time through the close of the testimony period in the instant case (i.e., into the summer and fall of 1997). In answering that query, what is compelling from this record is that many of the key players in the industry (e.g., trailer manufacturers and dealers) had been using the short-hand term "race trailers" as the generic designation for these enclosed trailers long prior to the date on which respondent claims it coined the term. It was used then, and continues to be used to the present, in advertisements, in general

⁴¹ As petitioner points out, however, inasmuch as many racing trailers are designed specifically for hauling snowmobiles, motorcycles, or go-kart, they would technically *not* fit into the genre of "race car trailers."

news stories⁴² and within the trade names of various dealers of racing trailers, as a generic term. In fact, any neutral assessment of the totality of the evidence in this record shows that the term "race trailers" has been used as a category designator for almost twenty-five years. Furthermore, that some in the industry agreed in recent years under extreme pressure (i.e., after getting ominous cease-and-desist letters from respondent's attorney) to discontinue temporarily the use of this term in advertisements rather than risking protracted litigation, hardly supports a contrary result.

Depending upon the grounds pleaded, the exact timing of a petition to cancel a registration is most relevant to our consideration. This is true as the grounds available to a petitioner are materially restricted if the petition is

⁴² The individual LEXIS/NEXIS entries and Internet references are largely split as to which "generically descriptive name" (using Judge Rich's term from *Sun Oil*, supra) they reflect. Not surprisingly, most of those placed in the record by petitioner show "race trailer" used in a generic sense, while respondent's cited references use "race car trailers." While not conclusive as to which is "preferred," these media excerpts demonstrate that many writers, like other members of the public at large, do perceive the term "race trailers" as a generic designation. They use "race trailers" interchangeably with "racing trailers" or "race car trailers," much as do the entrepreneurs who are immersed in the cargo trailer and/or racing industries. In effect, the consuming public has merely followed the lead of many of the manufacturers and dealers (viz. earlier discussion of trade advertisements showing such usage) in adopting this generic use of the term. The evidence demonstrates that petitioner, others in industry, and the relevant public all use this term generically. Hence, on balance, this evidence too is of probative value in connection with our decision.

filed more than five years from the date of the registration of the mark on the Principal Register. Section 14 of the Trademark Act, 15 U.S.C. §1064; Park 'N Fly v. Dollar Park 'N Fly, Inc. 469 U.S. 189, 105 S. Ct. 658, 224 USPQ 327, 331 (1985). For example, if a petition to cancel a registration is filed after the fifth anniversary, mere descriptiveness is no longer available as a ground for canceling such a registration on the Principal Register. On the other hand, such a petitioner could still plead genericness as a ground for cancellation after expiration of this five-year period.

Inasmuch as the instant petition to cancel was filed *prior* to the fifth anniversary of the registration's issue, it would be sufficient to cancel this registration had we found the term to be merely descriptive and lacking in acquired distinctiveness during the relevant time period. Accordingly, all the same evidence reviewed above to support genericness also demonstrates, *a fortiori*, that the term was merely descriptive in 1987. Furthermore, respondent has put forward no evidence to support its alternative contention, that even if once merely descriptive, this term has acquired distinctiveness as a source indicator for its enclosed trailers. The record clearly does *not* support such a finding as of any arguably relevant time period from the time of the filing of the federal trademark application in

1989, up to and including the time when the evidence in this trial was being collected.

In light of our disposition of this case, we need not pursue petitioners' alternative ground for cancellation.⁴³ It is clear that petitioners, Pace American, Inc., and Jack Bender, have no intentions of claiming proprietary rights in this designation or of trying to remove it from its generic usage in the industry -- unless, of course, this Board were to decide that the designation was capable of becoming a source identifier. Having decided it is generic, anyone, including petitioners, should be free to use the designation "race trailers" in literature, advertisements, trade names, and the like, to designate these enclosed, towable storage trailers used to haul racing vehicles.

Decision: The petition to cancel is granted and respondent's registration will be cancelled in due course.

E. W. Hanak

⁴³ As noted in the preceding paragraphs, the cancellation petition alleging priority and likelihood of confusion was filed early enough to be available as a possible ground for cancellation under Section 14 of the Trademark Act.

P. T. Hairston

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial
and Appeal Board