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THIS DISPOSITION IS NOT  
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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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R.M.S. Titanic, Inc.

v.

R.M.S. Ltd. N.Y.C.

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Opposition No. 98,964  
to application Serial No. 74/442,212  
filed on September 30, 1993

Opposition No. 99,005  
to application Serial No. 74/442,213  
filed on September 30, 1993

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Edward H. Rosenthal of Frankfurt, Garbus, Klein & Selz, P.C.  
for R.M.S. Titanic, Inc.

Paul Adams of Peacock, Myers & Adams, P.C. for R.M.S. Ltd.  
N.Y.C.

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Before Simms, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

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99,005**

R.M.S. Titanic, Inc. has opposed the applications of R.M.S. Ltd. N.Y.C. to register R M S TITANIC<sup>1</sup> and TITANIC (in block type)<sup>2</sup> for clothing, namely T-shirts, sweatshirts, shirts, hats and caps. As grounds for the oppositions, opposer has alleged that it is the successor-in-interest to Titanic Venture Limited Partnership; that opposer is the sole owner of all salvage rights in the wreck of the RMS Titanic, as well as all items recovered from the wreck; that beginning in 1987 opposer has been conducting expeditions and salvage operations with respect to the wreck; that between 1987 and 1994 approximately 4000 artifacts have been removed; that opposer's activities with respect to the wrecksite and salvage operations have been the subject of worldwide media coverage, and the public recognizes opposer's association with the wreck, with the name Titanic, and with various merchandise associated with the wreck and the artifacts removed therefrom; that beginning in 1984<sup>3</sup> opposer has exhibited artifacts recovered from the wreck and has used the name Titanic in connection with a worldwide tour; that at the time the notices of opposition were filed

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<sup>1</sup> Application Serial No. 74/442,213, filed September 30, 1993 and asserting first use and first use in commerce on April 15, 1992.

<sup>2</sup> Application Serial No. 74/442,212, filed September 30, 1993 and asserting first use and first use in commerce on April 15, 1992.

<sup>3</sup> Based on the other allegations in the notice of opposition it appears that the reference to 1984 is a typographic error.

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in 1995 plans were being made to begin a worldwide tour of the artifacts, including in the United States, in 1996; that applicant's marks, when used in connection with applicant's goods, are likely to cause confusion or mistake or to deceive; that applicant's marks when used on its goods are merely descriptive or deceptively misdescriptive of such goods; that applicant's marks falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols; that applicant's marks are merely ornamental and fail to indicate applicant as the source of the goods; and that applicant's marks, as used on the specimens submitted with its applications, violate opposer's rights in opposer's registration for WHITE STAR and design.

In its answers applicant admitted that it is aware of an exhibit in the United Kingdom of artifacts recovered from the wreck of the ship Titanic; and that there is a registration for WHITE STAR which applicant has petitioned to cancel; and denied the remaining salient allegations of the notices of opposition.<sup>4</sup>

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<sup>4</sup> Applicant asserted, as affirmative defenses, that opposer is barred by laches because its purported predecessor in interest previously abandoned applications for trademarks that include the word TITANIC, and because opposer and its predecessor did not oppose or seek to cancel Registration No. 1,548,153 for a mark which included the word TITANIC, and against which applicant brought a partial cancellation action. However, applicant did not argue these defenses in its brief, and we therefore have deemed them to be waived.

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These opposition proceedings were consolidated by the Board upon applicant's uncontested motion, and because the proceedings involved common factual issues.

The record includes the pleadings; the files of the opposed applications; the testimony, with exhibits, of opposer's witness George Tulloch; of applicant's witnesses Nathan Korn, James Korn, and Sandra Szwarc; and of opposer's rebuttal witness James Korn. Opposer has submitted, pursuant to a notice of reliance, a copy of its cancelled registration for WHITE STAR and design and certain pages from Books in Print 1997-98 by R.R. Bowker. Opposer also submitted with its notice of reliance the results of a search for the word "Titanic" in the database of Barnes and Nobles' "books in print." Although this material is not proper subject matter for a notice of reliance, applicant has treated it as being of record, and we therefore deem it to have been stipulated into the record.

Both opposer and applicant filed briefs on the case, and opposer filed a reply brief. Both parties were also represented at an oral hearing held before the Board.

The record shows that opposer, R.M.S. Titanic, Inc., is the successor-in-interest to a company called Titanic Ventures. Titanic Ventures was a partnership which was created as a way to raise funds for a French governmental oceanographic institute called IFREMER (Institute France for

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the Research and Exploration of the Sea). IFREMER had discovered the wreck of the ship Titanic in 1985, and the money raised through private investment in Titanic Ventures was used to recover objects from the wreck. Hereafter, the term opposer will be used to refer to the activities of both Titanic Ventures and R.M.S. Titanic, Inc.

Opposer entered into an arrangement with IFREMER in 1987 by which opposer, as a result of its funding of IFREMER, would attempt to recover and conserve artifacts from the wreck Titanic and make a return on its investment by presenting exhibitions to the public and selling video and still images and merchandising materials related to the ship. These plans included selling replicas of artifacts.

Opposer has conducted four expeditions to the wreck, the first of which occurred in the summer of 1987, followed by expeditions in 1993, 1994 and 1996. Although opposer's ultimate plan was to mount exhibitions of the artifacts in the United States, it started with so-called test runs abroad. Artifacts from the first expedition were first exhibited in a Paris museum. Additional museum exhibitions occurred in Scandinavia in 1991 and 1992, and in England in 1994. As part of these museum exhibitions opposer sold collateral merchandise, such as mugs, T-shirts, flashlight and pens. These items bore various "Titanic" related markings, including the White Star flag and banner.

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Opposer engaged in discussions with various venues in the United States about mounting exhibitions, including a Maryland museum in 1990, Sea World in approximately 1992, and the Chicago Museum of Science. The first exhibition in the United States of artifacts opposer recovered from the Titanic opened in Norfolk, Virginia in November 1996, and went on to be displayed on the Queen Mary in California in 1997. A larger exhibition opened in Memphis, Tennessee in 1997. Clothing with the word "Titanic" on it was offered for sale at all of these exhibits.

Opposer's various recovery expeditions received a significant amount of publicity. In particular, the "Today" show did an on-site interview when the second expedition returned to Norfolk with artifacts. A British television crew joined the third expedition in 1994, and the documentary they produced was televised on both British and U.S. television.

Applicant was started in 1992, and it deals exclusively with the sale of clothing related to the ship RMS Titanic. This clothing was first sold at Kaufman's Surplus, Inc., an army-navy store in Manhattan, and at Kaufman West, a store in New Mexico owned by the brother of applicant's president.<sup>5</sup>

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<sup>5</sup> Kaufman's Surplus, Inc. is the family company of James Korn, applicant's president. Mr. Korn, who testified for applicant, frequently used the word "we" without differentiating whether he

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The first item of clothing sold by applicant, in 1992, was a T-shirt with the words WHITE STAR LINE (WHITE STAR LINE was the shipping line which launched the ship Titanic), a design of a flag, and the words TITANIC CREW on the front. On the back were the words MAIDEN VOYAGE R♦M♦S TITANIC 1912. The line has increased through the years, with the introduction of T-shirts saying, in place of "CREW," "FIRST CLASS," "LOOKOUT," "STEERAGE," "SHIPS' OFFICER," and "MUSICIAN." The most recent is a tank top with the words "Titanic gymnasium."

Applicant's clothing has been sold at various museums which have featured Titanic exhibitions or shows. For example, the South Street Seaport Museum in New York has ordered Titanic T-shirts, caps and Zippo lighters from applicant; applicant's T-shirts were also sold at a Fort Lauderdale, Florida museum in connection with their IMAX film Titanica.

In addition to T-shirts, applicant has sold seamen's caps with a band bearing the legend RMS TITANIC. At first applicant used actual World War II vintage sailor's caps; subsequently it used replicas of a turn-of-the-century seaman's cap. Applicant also, beginning in 1994, started

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was referring to applicant or to Kaufman's Surplus, but because on September 24, 1993 Kaufman Surplus assigned its rights in the various Titanic trademarks to applicant, we have, unless otherwise noted, collectively referred to both Kaufman and applicant as "applicant."

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selling a baseball cap bearing the words R■M■S TITANIC on the front.

Before discussing opposer's grounds for opposition, we must first determine what those grounds are. In its notices of opposition opposer asserted that applicant's mark violated Section 2(a) of the Trademark Act. However, opposer never referred to such a claim in its main or reply briefs at trial. At the oral hearing opposer's attorney was asked if that claim had been waived, and even though the attorney answered in the negative, opposer provided no argument as to how it had established such a claim. Since opposer obviously felt no need to discuss the Section 2(a) claim which it apparently still asserts, we will not burden this opinion with such a discussion. We will simply state that opposer has failed to prove that its oppositions should be sustained on the basis of Section 2(a).

Opposer also asserted in its notices of opposition that applicant's use of its marks in its specimens violated opposer's rights in the WHITE STAR name reflected in opposer's registration. Opposer did not argue this claim in its briefs and, indeed, its registration for WHITE STAR was cancelled for failure to file a Section 8 affidavit of use. Accordingly, we deem this claim, to the extent that it can even be considered a valid ground for opposition, to have been waived.

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This brings us to the ground of likelihood of confusion, one of the grounds asserted in opposer's notices of opposition which opposer also argued in its briefs. Opposer's notices of opposition with respect to this ground are rather vague. As noted above, opposer essentially alleged that it is the owner of salvage rights in the wreck of the RMS TITANIC, and that as a result of its activities with respect to the salvage operations the public has come to recognize opposer's association with the wreck, the name TITANIC, merchandise associated with the wreck and artifacts removed from the wreck. Opposer then alleged that applicant's use of its marks is likely to cause confusion, but did not specify the specific goods or services in which opposer has prior rights, and with which applicant's use of its mark is likely to cause confusion.

In its brief opposer has argued that it has been using the marks TITANIC and RMS TITANIC in connection with its research and recovery services since 1987. Although opposer may have undertaken research (and this is not clear from the record) and recovery activities, these activities do not constitute services as contemplated under trademark law. That is, opposer's recovery activities were not services provided to others, but were merely activities undertaken on its own behalf. As for the services provided as part of its museum exhibitions, the record is clear that opposer did not

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provide such services in the United States until 1996, a date long after the filing of applicant's applications.

Opposer also argues that as of 1987 it "sold and distributed clothing, including T-shirts and caps, bearing the marks TITANIC and RMS TITANIC, and offered those items for sale in the United States." Brief, p. 25. Opposer bases this assertion on the testimony of George Tulloch, who had been president of one of the partners of opposer's predecessor-in-interest. However, after reviewing Mr. Tulloch's testimony, and in particular the pages specified by opposer in support of its assertion, we find the testimony in this regard to be very vague. Specifically, in response to the question "were these things actually offered for sale, the caps and hats," Mr. Tulloch stated:

They were offered for sale to people who would have been entitled to be considered rightful to. Some you would give away. I can recall the police in San Pierre [France] where the shops went out were very helpful, the customs officials, et cetera. We sent free pieces to those people and to other people, I've mentioned other institutions.

But to other people we would sell them. They wanted them and we sold them to them, not on a large scale, because we were not ready with an exhibition, but we were building towards what we were intending to do, but, yes, some were sold.

Q.: Were these to individuals, the ones that were sold to individuals, in the United States?

A.: Yes, people that would be related—I mean, the jackets, a lot of this material—it just was not our business to give away merchandise and they would want a jacket or a hat or whatnot, and they would have to pay, and, you know, that's in New York and Connecticut and Georgia and California, wherever certain people wanted them.

Tulloch testimony, pp. 15-16

Later in his testimony, again at the pages particularly pointed to by opposer, Mr. Tulloch stated:

...this might have been for interested parties who said, wonderful expedition, can I buy some pieces and I can't really swear which invoice this represents, but we did have people who wanted jackets and hats and whatnot, and we had to - just as you saw, as you noted in that December letter where we gave the police in San Pierre, four hats, four patches, we needed to buy these things for people who either graciously earned them or who wanted to buy them.

Tulloch testimony, p. 136.

This testimony is not sufficient to establish that opposer was making public sales of clothing sufficient to establish trademark rights in the United States in TITANIC or any mark containing this term.<sup>6</sup> On the contrary, it appears to us that clothing bearing the word TITANIC was not

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<sup>6</sup> It appears from Mr. Tulloch's testimony, which we reiterate is rather vague, that any reference to TITANIC which would have appeared on clothing in 1987 was as part of a circular logo in which the words EXPEDITION TITANIC 1987 appear in the top portion of a band encircling the globe on which a large design of an ocean liner appears. Other wording is also in this band.

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sold to the public at large, but was given or sold only to those who had a relationship to the expedition.

Subsequent to the 1987 expedition and prior to the filing of applicant's applications on September 30, 1993, opposer's sales of TITANIC related merchandise were limited to Europe, where exhibitions of artifacts recovered from the wreck had been mounted. Any such sales abroad did not establish opposer's trademark rights in the United States.

Accordingly, we find that opposer has not proven that it has prior rights in the trademark TITANIC, and its Section 2(d) ground for opposition must accordingly fall.<sup>7</sup>

This brings us to opposer's primary ground for opposition. Although opposer has characterized this ground as both that applicant's marks are merely descriptive and that they are ornamental, it appears to us that the gravamen of opposer's opposition is that applicant's marks are ornamental and therefore fail to function as trademarks indicating the source of applicant's goods.

After reviewing applicant's various uses of TITANIC and RMS TITANIC in connection with its T-shirts, caps and hats, we agree with opposer that these words will not be perceived

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<sup>7</sup> In view of opposer's failure to prove trademark rights in TITANIC for clothing prior to applicant's filing date, we need not engage in a discussion of applicant's claim of rights in certain T-shirt designs featuring the ship Titanic which were originally owned by Patrick and Sandy Szwarc, d/b/a Rising Sun, and which became the property of Kaufman Surplus Inc. (not applicant) in an agreement dated August 28, 1996.

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as an indicator of source of applicant's goods, but merely as a reference to the ship Titanic. As indicated above, applicant uses TITANIC on the front of its T-shirts, and RMS TITANIC on the back, as shown below.

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Since the ship Titanic is famous because it sank on its maiden voyage in 1912, consumers would perceive the term RMS TITANIC as used on the T-shirts as referring only to the ship, and not to the source of the shirts. Similarly, the word TITANIC on the front of the shirt, used in conjunction with WHITE STAR LINE, the company which owned the ship, would be seen as a reference to the ship alone. These T-shirts also bear a tag attached to the neck label, one side of which has the same wording as on the back of the T-shirts (i.e., MAIDEN VOYAGE, R M S TITANIC, 1912), and the other side has the same material as the front of the T-shirt (i.e., WHITE STAR LINE, a flag with a single star, and TITANIC), with just the particular title of CREW, MUSICIAN, etc. omitted. The MAIDEN VOYAGE side of the tag also contains, in very small letters, the legend "Titanic, R.M.S. Titanic, White Star Line and the Pennant Design are Trademarks of R M S Ltd N Y C." The tags are shown below.

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Again, we find that the impression on consumers of the words TITANIC and RMS TITANIC on these neck label tags is merely of a reference to the ill-fated ship Titanic, rather than as an indicator of source of the shirts. We say this despite the legend on the tags asserting TITANIC and RMS TITANIC to be trademarks of applicant's. Merely asserting that a term is one's trademark, or having the intention to claim it as a mark, is not sufficient to show that it does in fact function as a mark. Given the small size of the legend, and the strong impression, from all the material on the fronts and backs of the shirts, as well as the neck tags, that TITANIC and RMS TITANIC are merely references to the ship, consumers are unlikely to note the legend or to ascribe source-indicating significance to the words TITANIC and RMS TITANIC.

As for the use of RMS TITANIC on applicant's caps, applicant has not made of record the original seamen's caps on which it first used the phrase. Judging from the replicas of the turn-of-the-century seamen's caps which feature a band with the words R•M•S TITANIC, consumers would view such phrase as merely a reference to the ship, and the caps as reflecting the kind of cap worn by sailors on the ship, rather than viewing the words as a trademark identifying the source of the caps. This impression is

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heightened by the label, which includes the legend "Property of WHITE STAR LINE R·M S TITANIC.

Because applicant was required to have used TITANIC and RMS TITANIC in a trademark manner as of the time it filed its applications, see the interlocutory decision in **Century 21 Real Estate Corp. v. Century Life of America**, 10 USPQ2d 2034 (TTAB 1989), reversed on other grounds, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), it is not necessary for us to examine applicant's uses of TITANIC and RMS TITANIC which were first made after September 30, 1993. However, we note for the record that none of applicant's uses of these terms function as a trademark. Rather, they would be perceived by consumers as merely referring to the ship Titanic, and thus are ornamental uses.

Decision: The opposition is sustained on the ground that the applied-for terms, as used by applicant, fail to function as trademarks for applicant's goods, and are merely ornamental uses. The opposition is dismissed as to the remaining grounds pleaded in the notices of opposition.

R. L. Simms

E. J. Seeherman

C. E. Walters  
Administrative Trademark Judges  
Trademark Trial and Appeal Board