

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: NCL Corporation Ltd.)	Trademark Examining Attorney:
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Serial No. 88/275,242)	Wendell S. Phillips III
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Filing Date: January 24, 2019)	Law Office 110
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Mark: NORWEGIAN ENCORE SPEEDWAY)	
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OFFICE ACTION RESPONSE

This filing is in Response to the Examining Attorney's Office Action dated April 9, 2019. The Trademark Examining Attorney issued an Office Action concerning the subject application for registration of NORWEGIAN ENCORE SPEEDWAY (“Applicant’s Mark”), requesting a disclaimer of “NORWEGIAN,” a disclaimer of “SPEEDWAY,” and a requirement for an amendment to the identification of services.

For the reasons set forth below, Applicant maintains that “NORWEGIAN” is not descriptive of the services. Indeed, Applicant was not required to disclaim “NORWEGIAN” in its other NORWEGIAN formative marks for various services related to, or rendered upon, its cruise ships. The additional issues have also been addressed below. Hence, Applicant respectfully requests that the application be approved for publication.

I. The Element “NORWEGIAN” Is Not Primarily Geographically Descriptive

The Trademark Examining Attorney has indicated in the subject Office Action that “NORWEGIAN” is primarily geographically descriptive of the origin of Applicant’s services and that Applicant’s services include cruises to Norway, and that the applied-for services are rendered on cruise ships, so the services originate in Norway. Applicant respectfully disagrees that “NORWEGIAN” is primarily geographically descriptive of Applicant’s intended services.


To establish that a mark is primarily geographically descriptive, the Examining Attorney must show that: (1) the primary significance of the mark is a generally known geographic location; (2) the goods or services originate in the place identified in the mark; and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark. *See TMEP* § 1210.01(a). In this instance, the above test has not been met.

Applicant's Mark is not primarily geographically descriptive because: (1) the primary significance of "NORWEGIAN" for providing go-kart track facilities and organizing go-kart racing aboard cruise ships is to indicate that such services originate from Applicant rather than the country of Norway; (2) Applicant's intended services do not originate from Norway; and (3) consumers are not likely to believe that Applicant's services originate from Norway. Rather, given that Applicant is the owner of the famous NORWEGIAN CRUISE LINE mark, as well as a family of NORWEGIAN marks, and Applicant's intended services are to be offered aboard one of Applicant's cruise ships, the obvious meaning of NORWEGIAN to consumers is to denote Applicant, rather than the country of Norway, as the origin of Applicant's services.

A. The Primary Significance of the Mark is To Suggest That the Intended Services Originate From Applicant and Not From the Country of Norway.

In order to support a refusal to register geographic matter, the Trademark Act requires that the primary significance of the mark be that of a geographic location. *See TMEP* § 1210.02(b) (citing 15 U.S.C. § 1052(e)(2)). "[I]f the most prominent meaning or significance of the mark is not geographic, or ***if the mark creates a separate readily understood meaning that is not geographic, registration must not be refused under § 2(e)(2)....[emphasis added]***" *TMEP* § 1210.02(b)(i) (citing *Hyde Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (holding that the primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about such product's geographic origin); *In re Int'l Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000) (finding doubt as to the primary significance of HOLLYWOOD because of other prominent,

significant meaning of HOLLYWOOD as referring to the entertainment industry in general); *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999) (finding the primary significance of SYDNEY 2000 for advertising, business, and communication services is as a reference to the Olympic Games, not to the name of a place). Here, it is plain that Applicant's Mark creates a primary and readily understood meaning that is not geographic. Applicant is the owner of the famous trademark NORWEGIAN CRUISE LINE for cruise services and has used "NORWEGIAN" in connection with rendering cruise-related services for over 50 years. Applicant owns the following registrations and allowed application for marks incorporating NORWEGIAN:

Mark and Reg. No.	Services
NORWEGIAN BLISS RN: 5520994 SN: 87540894	(Int'l Class: 39) cruise ship services; arranging of cruises; organization of travel; providing transport for excursions; arranging of excursions, namely, providing bookings and reservations for transport for travel excursions
NORWEGIAN BREAKAWAY RN: 4361834 SN: 85339731	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN CRUISE LINE RN: 1548650 SN: 73710895 Disclaimer: "CRUISE LINE"	(Int'l Class: 39) arranging and conducting transportation for ocean cruises
NORWEGIAN CRUISE LINE NCL and Design  RN: 4816395 SN: 86420918 Disclaimer: "CRUISE LINE"	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN DAWN RN: 2622217 SN: 76261039	(Int'l Class: 39) arranging and conducting transportation for ocean cruises

Mark and Reg. No.	Services
NORWEGIAN ENCORE SN: 87776146	(Int'l Class: 39) cruise ship services; organisation of travel; arranging of cruises; providing transport for excursions; transportation of passengers by cruise ship
NORWEGIAN EPIC RN: 3861538 SN: 77650362	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN ESCAPE RN: 4871173 SN: 86079425	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN FIGHT KLUB RN: 4696459 SN: 85842299 Disclaimer: "FIGHT CLUB"	(Int'l Class: 41) conducting fitness classes aboard cruise ships
NORWEGIAN GEM RN: 3469520 SN: 78803046	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN GETAWAY RN: 4522357 SN: 85421111 Disclaimer: "GETAWAY"	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN ICONCIERGE RN: 4291686 SN: 85656567 Disclaimer: "ICONCIERGE"	(Int'l Class: 09) downloadable software in the nature of a mobile application for allowing cruise passengers to browse and book shore excursions, make dinner, entertainment and spa appointments onboard the ship, and receive cruise-related information
NORWEGIAN JADE RN: 3528431 SN: 77208614	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement

Mark and Reg. No.	Services
NORWEGIAN JEWEL RN: 3180959 SN: 78813934	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN JOY RN: 5297281 SN: 86920156	(Int'l Class: 39) cruise ship services; arranging of cruises; providing transport for excursions
NORWEGIAN NEXT RN: 4621307 SN: 86290876	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN PEARL RN: 3270213 SN: 78803020	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN SKY RN: 2558684 SN: 76262188	(Int'l Class: 39) arranging and conducting transportation for ocean cruises
NORWEGIAN SPIRIT RN: 3180960 SN: 78813952	(Int'l Class: 39) arranging of cruises; cruise ship services; travel, excursion and cruise arrangement
NORWEGIAN STAR RN: 2591379 SN: 76295673	(Int'l Class: 39) arranging and conducting transportation for ocean cruises
NORWEGIAN SUN RN: 2558675 SN: 76261040	(Int'l Class: 39) arranging and conducting transportation for ocean cruises
THE NORWEGIAN EDGE RN: 5182716 SN: 86864598	(Int'l Class: 39) cruise ship services rendered pursuant to a refurbishment and renewal upgrade program
NORWEGIAN CRUISE LINE POKER CHALLENGE RN: 4607459 SN: 86080824 Disclaimer: "POKER"	(Int'l Class: 41) organizing, conducting and operating poker tournaments

Copies of these USPTO records are attached as **Exhibit A**.

Applicant has used the term “NORWEGIAN” in connection with its cruise line services since at least as early as December 5, 1969 and has used that term in commerce since at least as early as January 1, 1988. *See* Registration No. 1548650. As a result of Applicant’s long-standing, substantially exclusive and continuous use of “NORWEGIAN”, as well as Applicant’s numerous registrations for marks containing that term in connection with cruise ship services and services rendered onboard cruise ship services, there is no question that the term “NORWEGIAN” has become distinctive of Applicant’s services. There is no question that the primary and readily-understood significance to consumers of the term “NORWEGIAN” when applied to go-kart tracks and go-kart racing aboard cruise ships is to suggest that such services originate with Applicant, rather than the country of Norway.

Accordingly, the primary significance of “NORWEGIAN” is not geographic.

B. The Services for Which Applicant Seeks Registration Do Not Originate in Norway.

To meet the second element of the test for primarily geographically descriptive marks, the Examining Attorney attempts to show that Applicant’s intended services originate from Norway by relying on pages from Applicant’s website showing cruises by Applicant to Norway. First, Applicant notes that these webpages fail to show where Applicant’s intended services originate because the webpages relate to Applicant’s cruise ship services – not Applicant’s intended services of providing go-kart racing aboard cruise ships, which are the relevant services. Second, none of the webpages cited by the Trademark Examiner show Applicant’s intended services being rendered in Norway. The evidence of record shows the intended services and specifically states that Applicant’s go-kart racing are on a “two-level race track in the middle of the ocean” – not Norway. Accordingly, the record fails to demonstrate that the go-kart racing services for which the Applicant seeks registration will originate from Norway.

In addition, the record is devoid of any evidence that the ship on which the NORWEGIAN ENCORE SPEEDWAY services will be rendered, namely, the NORWEGIAN ENCORE vessel, even

travels to Norway. Accordingly, there is no support for the argument that the Applicant's services rendered in connection with the subject mark originate in Norway, because they do not.

C. Purchasers Are Not Likely to Believe That Applicant's Intended Services Originate From Norway.

To meet the third element of the test for primarily geographically descriptive marks, the Examining Attorney relies solely on the rebuttable presumption that "Norwegian" is the adjectival form of Norway, a generally known geographic place or location (*TMEP* §1210.02) and that the evidence cited by the Examining Attorney from Applicant's website shows that Applicant's services include cruises to Norway therefore because the applied-for services are rendered on cruise ships the services must originate in the place named (Norway). However, the presumption does not apply here because, as set forth above, the significance of NORWEGIAN ENCORE SPEEDWAY is not primarily geographic and Applicant's services do not originate from Norway. Aside from relying on this rebuttable presumption, the Examining Attorney does not offer any evidence of record to show that the public is likely to associate Applicant's services with Norway.

Additionally, consumers are not likely to associate Applicant's intended services with Norway. There is nothing in the record that suggests that Norway is particularly well-known for go-kart facilities/tracks or go-kart racing, such that consumers would believe that Applicant's NORWEGIAN ENCORE SPEEDWAY services originate from Norway. *See In re Harvey & Sons Ltd.*, 32 U.S.P.Q.2d (BNA) 1451 (T.T.A.B. Sept. 16, 1994) ("there is nothing in the record that indicates, or even suggests, that American purchasers would believe that Bristol, England was or is now the place of production of applicant's cakes flavored with sherry wine").

Consumers also are not likely to associate Applicant's intended services with Norway, when such services are to be offered on Applicant's NORWEGIAN CRUISE LINE-branded cruise ships. Under such circumstances, it is highly unlikely that consumers will believe that the Applicant's intended services originate from Norway. Rather, it is readily obvious that consumers will associate Applicant's intended services with Applicant's famous NORWEGIAN CRUISE LINE-branded cruise services. In particular,

consumers are very familiar with Applicant's "NORWEGIAN ENCORE" cruise ship which has been in service for over two years and will correctly assume that NORWEGIAN ENCORE SPEEDWAY, is a speedway on Applicant's NORWEGIAN ENCORE ship.

To establish that Applicant's applied-for mark is primarily geographically descriptive, all three elements of the test must be met. Here, none of the elements of the test for primarily geographic descriptiveness apply to Applicant's Mark. Applicant requests that the Examining Attorney withdraw the "NORWEGIAN" disclaimer requirement.

II. A Disclaimer of "SPEEDWAY" Has Been Entered By Applicant.

The Trademark Examining Attorney stated Applicant must submit a disclaimer of "SPEEDWAY" because the term merely describes a characteristic, function, or feature of Applicant's services.

To address this issue, Applicant disclaims "SPEEDWAY" in connection with Applicant's Mark. This change has been incorporated into the response and amended accordingly as part of Applicant's submission.

III. The Identification of Services Has Been Amended

The Trademark Examining Attorney indicated the identification of services is indefinite and must be clarified because Applicant does not specify how the services relate to such facilities and racing.

Applicant accepts and adopts the Examining Attorney's suggested identification of services amendment as follows:

Entertainment and recreational services, namely, providing go-kart track facilities and organizing go-kart racing

These changes have been included in Applicant's submission.

IV. Conclusion

Applicant respectfully requests that the Examiner withdraw the disclaimer requirement and allow Applicant's Mark to register.

Respectfully submitted,

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