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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Biomimetics Corporation

Serial No. 74/528,628

Stuart E. Beck for applicant.

James A. Rauen, Trademark Examining Attorney, Law Office 103
(Kathryn D. Erskine, Managing Attorney).

Before Seeherman, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by American Biomimetics Corporation to register the mark AMERICAN BIOMIMETICS CORPORATION for "financial services in the field of materials, namely, raising capital, organizing ventures, and providing financial management in connection with searching for and creating new materials, development of techniques for their manufacture in commercial quantities, and research and engineering in connection with their commercial utilization" (International Class 36); and "consulting and research services for others in the field of materials,

namely, searching for and creating new materials, development of techniques for their manufacture in commercial quantities, and research and engineering in connection with their commercial utilization" (International Class 42).¹

The Trademark Examining Attorney has refused registration under Section 2(e)(2) of the Act on the ground that applicant's applied-for mark, if used in connection with applicant's services, would be primarily geographically descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs, and both were present at an oral hearing before the Board.

Applicant contends that the Examining Attorney has improperly dissected applicant's mark in considering registrability, and that "while its components are ordinary words in the English language, the mark is not." (brief, p. 2) Applicant further argues that "AMERICAN is not being used to signify that applicant's services are being provided for or by Americans or in America or according to an American system or technique. Rather, AMERICAN is simply being used to suggest that applicant's services are of high quality and are to be desired." (brief, pp. 5-6) Applicant

¹ Application Serial No. 74/528,628, filed May 24, 1994, based on a bona fide intention to use the mark in commerce. The word "Corporation" is disclaimed apart from the mark.

concludes that its applied-for mark, when considered in its entirety, creates "a unique commercial impression" that is not primarily geographically descriptive.

The Examining Attorney argues that the primary significance of the term "American" is geographic and that applicant's services come from the geographical place named in the mark. The Examining Attorney goes on to assert that the term "biomimetics" is highly descriptive of the services and that the term "corporation" is an entity designation without trademark significance. According to the Examining Attorney, the addition of these terms to the geographic term does not diminish the primarily geographic significance of the mark as a whole. In support of the refusal to register, the Examining Attorney submitted dictionary listings for "bio-", "mimetic" and "biomimetic chemistry."² The Examining Attorney also submitted twenty-five excerpts retrieved from the NEXIS database which, according to the Examining Attorney, show descriptive uses of the term "biomimetics."

In order for registration to be properly refused under Section 2(e)(2), it is necessary to show that (i) the mark

² This last listing accompanied the Examining Attorney's appeal brief. Pursuant to the Examining Attorney's request, we have taken judicial notice of this dictionary definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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/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 or services with the place may ordinarily be presumed from the fact that the applicant's own goods or services come from the geographical place named in the mark. In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982).

It hardly needs to be said that "America" is universally known as a geographic name for the United States of America.³ We find, therefore, that the geographic significance of "America" (or, in this case, "American") is its primary significance⁴ and that America is neither obscure or remote.

³We take judicial notice of the listing for "America" in Webster's Third New International Dictionary (1976). The word is defined, in relevant part, as "of or from the U.S."

⁴ In saying this, we recognize that the term "American" may also suggest that the involved services are of high quality or are to be desired. We reiterate, however, that the primary significance is geographic.

Having found that the term "American" is a primarily geographic term, the question becomes whether the composite mark AMERICAN BIOMIMETICS CORPORATION is primarily geographically descriptive as contemplated by the statute.

The mere addition to AMERICAN of the descriptive term BIOMIMETICS and the entity designation CORPORATION does not change the geographic significance of AMERICAN. The dictionary listings of record indicate that "biomimetics" is a term referring to a mimicry or imitation of natural processes in living systems. In this connection, the NEXIS excerpts show descriptive uses within the scientific field. One of the articles includes the following statement:

"Their efforts have even spawned a new field, biomimetics, whose premise is that humanity can create better materials and structures by understanding and imitating the way spiders make their silk. . ." *Discover* (October 1994).

Another article states that "[t]he field of biomimetics, in which scientists emulate nature's own processes for fashioning high-quality compounds, is emerging with force."

Science News (February 12, 1994). Other examples include

"the biomimetic character of the system", "biomimetic materials", "biomimetics project", "biomimetic synthesis", "biomimetic products" and "biomimetic approach." Applicant has failed to offer any persuasive evidence and/or argument to show that the term "biomimetics" is anything but a merely

descriptive term as used in connection with applicant's consulting, research and financial services which are rendered in the field of biomimetics.

Simply put, the addition of the descriptive words "biomimetics" and "corporation" to "American" does not detract from the primary geographic significance of AMERICAN BIOMIMETICS CORPORATION when the mark is considered as a whole. In re Chalk's International Airlines Inc., 21 USPQ2d 1637, 1639 (TTAB 1991) [PARADISE ISLAND AIRLINES for air transportation services is primarily geographically descriptive]. Moreover, as the Board has stated in the past, the determination of registrability under Section 2(e)(1) should not depend on whether the mark is unitary or composite. In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986) [the addition of the descriptive word DIGITAL does not detract from the primary geographic significance of CAMBRIDGE DIGITAL].

We now turn to the second part of the test as set forth above, namely, whether the public would make a services/place association. In the present case, applicant is located in the United States (specifically, in the state of Pennsylvania). Having found that the geographic significance of AMERICAN BIOMIMETICS CORPORATION is its primary significance and that America is neither obscure or remote, we presume, from the fact that applicant's own

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services originate from that place, a public association of the services with the place named in the mark. See: In re BankAmerica Corporation, 231 USPQ 873, 875 (TTAB 1986) and cases cited thereat [BANK OF AMERICA primarily signifies an American bank and, with respect to computerized financial data processing services which emanate from this country, a public association of those services with the place named in the mark (i.e., America) may be presumed]. See also, e.g.: In re Biesseci S.p.A., 12 USPQ2d 1149 (TTAB 1989); and In re Jim Crockett Promotions, 5 USPQ2d 1455 (TTAB 1987).

Decision: The refusal to register is affirmed.

E. J. Seeherman

E. W. Hanak

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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