

THIS DISPOSITION IS CITABLE AS
PRECEDENT OF THE TTAB

FEB. 12, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Monograms America, Inc.

Serial No. 75/089,735

Gary L. Bush of Bush, Moseley, Riddle & Jackson, L.L.P.
for applicant.

John Tingley, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Seeherman, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Monograms America, Inc. has filed an application to
register the mark MONOGRAMS AMERICA for "consultation
services for owners of monogramming shops."¹

Registration has been finally refused under Section
2(e)(2) on the ground that the mark is primarily
geographically descriptive of the services involved. The

¹ S.N. 75/089,735, filed April 17, 1996, claiming first use
dates of April 5, 1996.

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requirement that acceptable specimens showing use of the mark for consultation services be submitted has also been made final.

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

THE SPECIMENS

We consider first the requirement that acceptable specimens be submitted. The specimens originally filed with the application consist of a letterhead showing use of the mark as follows:

There is no body to the letter or any further evidence of record as to the nature of the services provided under this mark. Thus, the Examining Attorney has requested specimens which support use of the mark in connection with consultation services.

Applicant argues that the present specimens, which consist of stationery with the mark thereon and which are used to send letters to store owners and others advertising

applicant's services, suffice as evidence of actual use of the mark in connection with the recited services.

Applicant points to the statement on the letterhead as indicating that the mark is associated with "a nationwide network of embroidery stores." Applicant further states that the consulting services "are not limited to monogramming per se." Instead, according to applicant, its consulting services include such features as providing management and advertising assistance for the monogramming stores.

Service mark use is defined under Section 45 of the Trademark Act as occurring when a mark "is used or displayed in the sale or advertising of services...". In view of the inherent intangible nature of services, specimens which evidence service mark use cannot be labels or tags as are used for trademarks, but rather are often advertising materials. There must be, however, a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. See *In re Advertising and Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); *In re Johnson Controls Inc.*, 33 USPQ2d 1318 (TTAB 1994); *In re Duratech Industries Inc.*, 13 USPQ2d 2052

(TTAB 1989); In re Metrotech, 33 USPQ2d 1049 (Comm'r Pats. 1993). Letterhead stationery in itself may be acceptable evidence of service mark use, *if* it includes a reference to the service. In re Metriplex Inc., 23 USPQ2d 1315 (TTAB 1992).²

Here the letterhead displays the mark sought to be registered, the notations "A Nationwide Network of Embroidery Stores" and "Formerly Sew Smart Owners Association, Inc.", and the addresses of two directors. While these notations might be interpreted as an indication that this is an association or "network" of "embroidery stores", there is no indication as to the purpose or activities of this association. There is no reference whatsoever to any type of consultation service, even in the area of monogramming per se, much less in the management of, or advertising for, the stores offering this monogramming. Thus, there is nothing in the specimens which would create an association between the mark MONOGRAMS AMERICA and the consultation services set forth in the application. If a specific letter to a store owner

² As was the case in Metriplex, there are situations in which the specimens do not contain a reference to the services, but yet are acceptable, since they show direct use of the mark in connection with the rendering of the services. Here we have no evidence of the rendering of the consultation services.

describing applicant's services had been submitted, the situation might be entirely different. But in the absence of any supplemental evidence, we find the specimens insufficient to support the present recitation of services. The Examining Attorney's requirement that acceptable specimens be submitted is affirmed.

THE SECTION 2(e)(2) REFUSAL

In order for registration to be refused under Section 2(e)(2) of the Trademark Act, on the ground that the mark is primarily geographically descriptive of the goods or services, it must be established that

- (1) the mark sought to be registered is the name of a place known generally to the public, and
- (2) the public would make a goods/place (or in this case, services/place) association, i.e., would believe that the services originate from this place.

See *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988). Where there is no question but that the geographic significance of a term is its primary significance, and the place named is neither obscure nor remote, a public association of the goods (or services) with the place may be presumed if, in fact, the goods (or services) originate

from the geographic place named in the mark. See In re California Pizza Kitchen Inc., *supra*; In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982). Moreover, the addition of highly descriptive matter to a geographic term does not detract from the mark's primary significance as being geographically descriptive. See In re U.S. Cargo, Inc., ___USPQ2d___, S.N. 74/663,449, (TTAB Nov. 6, 1998); In re Cambridge Digital Systems, 1 USPQ2d 1659 (TTAB 1986)

Applicant argues that its composite mark, MONOGRAMS AMERICA, must be considered in its entirety in determining whether it is primarily geographically descriptive. As such, applicant maintains that the term AMERICA not only indicates that applicant's consulting services are offered in America but also implies the excellence or high quality of these services. As for the term MONOGRAMS, applicant argues that it is only suggestive, rather than merely descriptive, of its consulting services to retail monogramming stores. Thus, applicant contends that its mark, as a whole, is at best suggestive that its consulting services with respect to monogram stores are of the high quality typical of American providers.

The Examining Attorney, on the other hand, maintains that applicant's mark is no more than the combination of the primarily geographic term AMERICA with the highly

descriptive or generic term MONOGRAMS. He argues that there is no other meaning which may be attributed to the mark as a whole nor would it project any other significance to the public. Instead, the public would view the mark as indicating that applicant's consulting services with respect to monogramming are offered across America.

The word AMERICA is obviously well known to the United States public as the name of a geographic location. The question is whether the primary significance of the term AMERICA as used in applicant's mark would be this geographic location or whether the term would possess some other, at least equally significant connotation. As support for its arguments that the latter is true, applicant has referred to cases in which another meaning has been found to predominate for terms which applicant considers in the same class as AMERICA. For example, in *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) the Board found the term "Great American" to be suggestive, in the same way that the term "All-American" had previously been found suggestive, of high quality or excellence, rather than a mere descriptor of the geographic origin of the involved services.

But applicant has produced no evidence of other potential connotations for the term AMERICA standing alone.

Thus, we have no reasonable basis for holding that AMERICA, as opposed to "Great American" or "All-American," is capable of any other interpretation. Applicant has submitted no evidence of use by others of the term "America," without more, as a designation of high quality or excellence. Instead we find the situation here to be similar to that in *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986), where we held BANK OF AMERICA to primarily signify that the applicant's financial services originated from an American bank or from a bank in the United States.³ We consider MONOGRAMS AMERICA to similarly signify United States origin and/or geographical scope. If there were any question as to the intended significance of the term AMERICA in applicant's mark, we believe that applicant's own letterhead, which touts applicant as "a nationwide network," as well as applicant's statement that "applicant offers consulting services to a network of monogram shops across America" (Applicant's brief p.3) is conclusive as to the intended geographic connotation of the term AMERICA. We see no basis for prospective purchasers of the services to view the term AMERICA in any other way.

³ See also the several cases cited in *BankAmerica*, *supra*, finding the terms "America" or "American" primarily geographically descriptive.

Accordingly, since the primary significance of the term AMERICA is its geographic significance and the place named is far from obscure,⁴ and since applicant's services originate in America, a services/place association on the part of the public may be presumed. See *In re Handler Fenton Westerns, Inc.*, *supra*. Although the mark includes the additional term MONOGRAMS, we have no reason to believe that this term serves any purpose other than to describe a feature of the consulting services which applicant offers to the owners of monogramming shops. Applicant's statement that its consulting services are "not limited to monogramming per se" is ample basis for us to presume that monogramming is at least one of the topics covered in the consultations provided by applicant. As such, we find the term MONOGRAMS to be highly descriptive of the subject matter of applicant's consultation services and incapable of detracting from the primary significance of applicant's mark as being geographically descriptive.

⁴ See footnote 2 of *BankAmerica*, *supra*, for reference to dictionary definitions of "America" as "the United States of America."

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Decision: The refusals to register on the ground that applicant has failed to submit acceptable specimens showing use of the mark for consultation services and on the ground that the mark is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act are affirmed.

E. J. Seeherman

B. A Chapman

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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