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MARCH 3, 99

Paper No. 8
HRW

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Monograms America, Inc.

Serial No. 75/097,874

Gary L. Bush of Bush, 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 "monogramming store
services."¹

¹ S.N. 75/097,874, filed May 2, 1996, based on a bona fide
intention to use the mark in commerce.

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

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

As a preliminary matter, the Board recently issued a published decision in the companion case to this appeal, *In re Monograms America, Inc.*, ___ USPQ2d ___, S. N. 75/089,735 (TTAB Feb. 12, 1999), involving the same mark for the related services of consultation services for owners of monogramming shops. In that case, we affirmed the refusal of registration, inter alia, on the ground that the mark MONOGRAMS AMERICA was primarily geographically descriptive of the involved services under Section 2(e)(2). While the services here are somewhat different, our analysis is very similar.

As we stated in the companion case, 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.*, 49 USPQ2d 1702 (TTAB 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 does not only indicate that applicant's monogramming store services are offered in America but also implies the excellence or

high quality of these services. As for the term MONOGRAMS, applicant argues that while this word is suggestive that applicant's monogramming services are to be performed in a retail store setting, it is also suggestive that other products with monograms or just the monogram letters are also available at the stores. Thus, applicant contends that its mark, as a whole, is not merely or only descriptive of the fact that applicant's monogramming services are being performed in America but is also suggestive that applicant's monograms 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, and that the latter term does not detract from the geographic significance of the mark as a whole. He argues that the term AMERICA as used by applicant primarily denotes the United States and is not being used in a composite mark in such a way to create an overall non-geographic connotation. As for the term MONOGRAMS, he argues that it is merely descriptive so long as it describes one significant feature of applicant's store services.

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.² We consider AMERICA as used in applicant's mark to similarly signify United States origin and/or geographical scope.

Accordingly, since the primary significance of the term AMERICA is its geographic significance and the place named is far from obscure,³ 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 significant feature of applicant's monogramming store services. As such, we consider the term MONOGRAMS to be incapable of detracting from the primary significance of applicant's mark as being geographically descriptive.

² See also the several cases cited in *BankAmerica*, *supra*, finding the terms "America" or "American" primarily geographically descriptive.

³ See footnote 2 of *BankAmerica*, *supra*, for reference to dictionary definitions of "America" as "the United States of America."

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While applicant may argue that other suggestive connotations exist for the mark as a whole, we find the *primary* significance to be that of being geographically descriptive of applicant's services.

Decision: The refusal to register under Section 2(e)(2) of the Trademark Act is affirmed.

E. J. Seeherman

B. A Chapman

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

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