

**THIS DISPOSITION  
IS NOT CITABLE AS  
PRECEDENT**

Paper No. 12  
Bottorff

8/17/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **American Sporting Goods Corporation**

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Serial No. 75/302,487

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**Michael A. Painter** of **Isaacman, Kaufman & Painter** for  
**American Sporting Goods Corporation**

**Sue Carruthers**, Trademark Examining Attorney, Law Office  
108 (**David Shallant**, Managing Attorney)

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Before **Chapman, Wendel and Bottorff**, Administrative  
Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant has filed an intent-to-use application by which it seeks registration on the Principal Register of the mark AMERICAN SPORT for goods identified in the application as "athletic shoes."<sup>1</sup> The Trademark Examining Attorney has refused registration of applicant's mark under Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2), on

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<sup>1</sup> Serial No. 75/302,487, filed June 3, 1997. During prosecution of the application, applicant voluntarily disclaimed the exclusive right to use AMERICAN apart from the mark as shown.

the ground that applicant's mark is primarily geographically descriptive of the identified goods.

When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney filed main briefs, but applicant did not file a reply brief and did not request an oral hearing. We affirm the refusal to register.

Under Trademark Act Section 2(e)(2), a mark must be refused registration if it is primarily geographically descriptive of the applicant's goods as identified in the application. In order for registration to be properly refused on this basis, the Trademark Examining Attorney must show that the mark sought to be registered is the name of a place known generally to the public, and that the public would make a goods/place association, i.e., believe that the goods for which the mark is sought to be registered originate in that 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 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 with the place may ordinarily be presumed from

the fact that the applicant's own goods come from the geographical place named in the mark. See *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982). Applying these principles to the present case, we find that applicant's mark AMERICAN SPORT is primarily geographically descriptive of applicant's "athletic shoes."

The primary connotation of the term AMERICAN, as it is used in applicant's mark AMERICAN SPORT, is that of the goods' geographical origin in the United States of America, a place which is neither obscure nor remote. We take judicial notice that AMERICAN is an adjective defined as "of or relating to America." Webster's Ninth New Collegiate Dictionary (1990) at 78.<sup>2</sup> Furthermore, it often has been held that AMERICA or AMERICAN, when used in a way that primarily denotes the United States origin or the scope of the goods or services, is primarily geographically descriptive. See, e.g., *American Diabetes Association, Inc. v. National Diabetes Association*, 533 F.Supp. 16, 214 USPQ 231 (E.D.Pa. 1981)(AMERICAN DIABETES ASSOCIATION held primarily geographically descriptive); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986)(BANK OF AMERICA held

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<sup>2</sup> The Board may take judicial notice of dictionary definitions. See Fed. R. Evid. 201(b); *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).

primarily geographically descriptive); *Finance Co. of America v. BankAmerica Corp.*, 205 USPQ 1016 (TTAB 1979, amended 1980)(THE FINANCE COMPANY OF AMERICA held primarily geographically descriptive); and *American Paper & Plastic Products, Inc. v. American Automatic Vending Corp.*, 152 USPQ 117 (TTAB 1966)(AMERICAN AUTOMATIC VENDING held primarily geographically descriptive).

We are not persuaded by applicant's contention that AMERICAN is not primarily geographically descriptive because it does not denote a place name per se. As is apparent from the cases cited above, adjectival forms of place names, such as AMERICAN, clearly may be found to be primarily geographically descriptive under Section 2(e)(2). Moreover, we note that applicant has voluntarily disclaimed the term AMERICAN.

Where a mark consists only of a primarily geographically descriptive term combined with a merely descriptive or generic term, and where the resulting composite does not create a new, unitary commercial impression which is not primarily geographically descriptive, the entire mark is deemed to be primarily geographically descriptive and unregistrable. See, e.g., *In re California Pizza Kitchen Inc.*, supra; and *In re Handler Fenton Westerns, Inc.*, supra. In this case, we

find that the primarily geographic significance of AMERICAN in applicant's mark is not eliminated by applicant's addition thereto of the merely descriptive or generic word SPORT.

The evidence submitted by the Trademark Examining Attorney, i.e., the dictionary definitions of "athletic" and "sport" and the numerous third-party registrations covering footwear wherein SPORT has been disclaimed apart from the registered marks as shown, convinces us that SPORT is a merely descriptive and possibly even a generic term as applied to "athletic shoes." Applicant has submitted no contrary or rebutting evidence to support its contention that SPORT is suggestive rather than merely descriptive as applied to applicant's goods.

Instead, applicant argues that because SPORT might be suggestive of other types of goods, it cannot be merely descriptive of "athletic shoes." However, the mere descriptiveness of a term must be determined in relation to the applicant's identified goods, not in the abstract. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Applicant also argues that SPORT is not merely descriptive of applicant's goods because it "is included as a segment of the subject mark only for its

relationship to Appellant's corporate name [American Sporting Goods Corporation]." (Brief at 7.) Applicant cites no authority to support this argument, and we find it to be without legal merit.

Thus, as used on or in connection with applicant's goods, AMERICAN is a primarily geographically descriptive term and SPORT is a merely descriptive or generic term. Neither of the terms, individually, is registrable.

We likewise find that the composite designation AMERICAN SPORT is unregistrable. The combination of the two words does not result in any new unitary or incongruous composite designation which is not primarily geographically descriptive. Compare, e.g., *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U.S. 251 (1916) (THE AMERICAN GIRL held not primarily geographically descriptive for shoes); *National Lead Co. v. Wolfe*, 223 F.2d 195, 105 USPQ 462 (9<sup>th</sup> Cir. 1955), cert. denied, 350 U.S. 883, 107 USPQ 362 (1955) (DUTCH BOY held not primarily geographically descriptive for paint); and *Wilco Co. v. Automatic Radio Mfg. Co., Inc.*, 255 F.Supp. 625, 151 USPQ 24 (D.Mass. 1966) (ALL AMERICAN held not primarily geographically descriptive of radio receivers). As applied to applicant's "athletic shoes," the composite AMERICAN SPORT creates the same commercial impression as that created by the

descriptive words AMERICAN and SPORT considered separately, i.e., that the goods are sport or athletic shoes of American origin. The composite is as lacking in inherent distinctiveness as the two words are when they are considered separately.

We also find that, for purposes of Trademark Act Section 2(e)(2), applicant's goods originate from the geographic place named in the mark, i.e., America. Applicant's application is based on intent-to-use, and applicant apparently has not yet begun producing the goods. However, applicant is a Delaware corporation located in California, which, obviously, is in the United States of America. Because applicant is headquartered in America, applicant's goods may be deemed to originate from America. See *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144, 1146 (TTAB 1993).

For the reasons discussed above, we find that there is no genuine issue that, as applied to applicant's goods, the primary significance of the applicant's mark AMERICAN SPORT is its geographical significance, and that the term denotes a geographical place which is generally known to the purchasing public and which is neither obscure nor remote. In view thereof, and because applicant's goods are deemed to be of American origin due to the fact that applicant is

headquartered in America, we find that the requisite goods/place association between applicant's goods and the place named in the mark has been established. See *In re Handler Fenton Westerns, Inc.*, *supra*. We accordingly conclude from the evidence of record that applicant's mark is primarily geographically descriptive of applicant's goods, and that registration of applicant's mark is barred under Trademark Act Section 2(e)(2).

Decision: The refusal to register is affirmed.

B. A. Chapman

H. R. Wendel

C. M. Bottorff

Administrative Trademark Judges  
Trademark Trial and Appeal Board