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Paper No. 11
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Security First Title Affiliates, Inc.

Serial No. 75/391,512

Kit M. Stetina and Daren S. Rimer of Stetina Brunda Garred
& Brucker for applicant.

Florentina Blandu, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Simms, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by The Security First
Title Affiliates, Inc. to register the mark TITLE AMERICA
for "title insurance underwriting services."¹

The Trademark Examining Attorney has refused
registration under Section 2(e)(2) of the Trademark Act on
the ground that the mark, if used in connection with

¹ Application Serial No. 75/391,512, filed November 10, 1997,
based on an allegation of a bona fide intention to use the mark
in commerce.

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. An oral hearing was not requested.

Applicant states that "[w]hile [applicant] does not dispute that the term 'AMERICA' signifies the geographic region in which [applicant] conducts its business, [applicant] contends that this fact is immaterial."

(brief, p. 4) Applicant goes on to argue that the primary significance of the term "America" is not geographic and that "although America is not a remote place or location, this does not necessarily mean that consumers will assume that a [services]/place association exists." Id.

Applicant maintains that the term "America" functions "similar to a laudatory term (such as majestic, best, etc.) to indicate a certain grandness of [applicant's] services." Id. Applicant has relied upon a trademark search report, and copies of several third-party registrations retrieved from the Office's database.²

² Applicant submitted two search reports, one for "America" type marks and a second one for "National" type marks. The "National" search report is irrelevant to the issue before us. With respect to the "America" search report, although such submission is not the proper way to introduce third-party registrations, the Examining Attorney has not objected thereto, but rather has considered the evidence as if properly of record. The copies of

The Examining Attorney asserts that applicant offers title services which emanate in America and that, therefore, the mark TITLE AMERICA is primarily geographically descriptive. In response to applicant's contention that the term "America" is laudatory and not primarily geographic, the Examining Attorney points out that the argument is not supported by any evidence of record. In support of the refusal, the Examining Attorney submitted third-party registrations showing disclaimers of the terms "Title" and "America." The Examining Attorney's brief includes a request that the Board take judicial notice of the dictionary definitions of the terms "title" and "America," a request which we hereby grant. See: University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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

certain of the third-party registrations were not submitted until applicant's appeal brief. Although this submission is untimely under Trademark Rule 2.142(d), again the Examining Attorney treated the evidence as if properly introduced. Accordingly, we have considered all of applicant's evidence bearing on the state of the register with respect to "America" type marks.

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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. In *The American Heritage Dictionary of the English Language* (3d ed. 1992), the term is defined as "the United States." We find, therefore, that the geographic significance of "America" is its primary significance and that America is neither obscure nor remote. In making this finding, we recognize that the term "America" may also suggest, as applicant argues, that the involved services are of a high quality or are to be desired. We reiterate, however, that the *primary*

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significance of the term is geographic. Applicant has failed to introduce any evidence to convince us to the contrary. In re Monograms America Inc., 51 USPQ2d 1317, 1320 (TTAB 1999)[MONOGRAMS AMERICA is primarily geographically descriptive as used in connection with consultation services for owners of monogramming shops].

Having found that the term "America" is a primarily geographic term, the question becomes whether the composite mark TITLE AMERICA is primarily geographically descriptive as contemplated by the statute.

The mere addition of the generic term "title" (which names the type of insurance underwriting services rendered by applicant) to "America" does not detract from the primary geographic significance of "America." That is to say, such addition of generic matter does not detract from the primary geographic significance of TITLE AMERICA when the mark is considered as a whole. In re Monograms America Inc., supra, and 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)(2) should not depend on whether the mark is unitary or composite. In re Cambridge Digital Systems, 1 USPQ2d 1659,

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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 incorporated and located in the United States (specifically, in the state of Florida). Having found that the geographic significance of TITLE AMERICA is its primary significance and that America is neither obscure or remote, we presume, from the fact that applicant's own 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 U.S. Cargo Inc., 49 USPQ2d 1702 (TTAB 1998); In re Biessecci S.p.A., 12 USPQ2d 1149 (TTAB 1989); and In re Jim Crockett Promotions, 5 USPQ2d 1455 (TTAB 1987).

The third-party registrations of "AMERICA" or "AMERICAN" type marks submitted by applicant do not compel

a different result here. These registrations, coupled with the ones submitted by the Examining Attorney, indicate that the register is mixed.³ While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether *applicant's mark* is primarily geographically descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records in the files of the cited registrations and, moreover, the determination of registrability of particular marks by the Trademark Examining Groups cannot control the result in another case involving a different mark for different goods and/or services. In re Nett Designs Inc., ___F.3d___, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)[“Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.”].

We conclude that consumers are likely to believe

³ We also note that the prosecution history (applicant's response filed January 11, 1999) includes a reference to a then co-pending application owned by applicant. The application matured into Registration No. 2,359,065, issued on June 20, 2000, of the mark TITLE PARTNERS OF AMERICA for “real property title insurance underwriting services.” Applicant's registration includes a disclaimer of the terms “Title” and “America” apart from the mark.

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that TITLE AMERICA is primarily geographically descriptive of title insurance underwriting services that emanate from America.

Decision: The refusal to register is affirmed.

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