

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: June 25, 2002

Paper No. 16
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American International Group, Inc.

Serial No. 75/278,430

Mark J. Liss, Anne E. Naffziger and Elizabeth C. Diskin of
Leydig, Voit & Mayer, Ltd. for American International
Group, Inc.

Chrisie Brightmire King, Trademark Examining Attorney, Law
Office 109 (Ron S. Sussman, Managing Attorney).

Before Cissel, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

American International Group, Inc. has appealed from
the final refusal of the Trademark Examining Attorney to
register GRANITE STATE INSURANCE COMPANY, with the words
INSURANCE COMPANY disclaimed, for the following services:

financial guarantee and surety;
insurance underwriting in the fields of
property, casualty, specialty workers'

compensation, healthcare and automobile insurance to domestic and foreign markets.”¹

Registration has been refused pursuant to Section 2(e)(3) of the Trademark Act, 15 U.S.C. 1052(e)(3), on the ground that applicant’s mark is primarily geographically deceptive misdescriptive of applicant’s identified services. Specifically, the Examining Attorney contends that GRANITE STATE INSURANCE COMPANY is a primarily geographic term because GRANITE STATE is a nickname for the state of New Hampshire; that applicant’s services do not come from the state of New Hampshire; and that insurance services are offered by businesses in that state, such that consumers will mistakenly associate applicant’s services with New Hampshire.

The appeal has been fully briefed.² An oral hearing was not requested.

We affirm the refusal of registration.

We note at the outset that in the first Office action, the Examining Attorney refused registration under Section

¹ Application Serial No. 75/278,430, filed April 21, 1997, and asserting first use and first use in commerce as early as January 1, 1996.

² The Examining Attorney has objected to third-party registrations which applicant attached to its appeal brief as being untimely filed. However, as applicant points out in its reply brief, these registrations were previously properly made of record with applicant’s request for reconsideration. Accordingly, they have been considered.

2(3)(2) on the ground that the mark was primarily geographically descriptive if applicant's services came from the state of New Hampshire, and alternatively under Section 2(e)(3), on the basis that the mark was primarily deceptively misdescriptive if applicant's services did not originate from that state. In response to this action, applicant stated that it "does not have a GRANITE STATE INSURANCE COMPANY office in the state of New Hampshire" and that "the services are offered from offices in New York, Massachusetts, Connecticut, Pennsylvania and New Jersey. Additionally, the Granite State Insurance Company itself is a Pennsylvania company, not a New Hampshire company."

(Although applicant did not mention this in its response, its application identifies itself as a Delaware corporation.) On the basis of this response, the Examining Attorney withdrew the refusal based on geographic descriptiveness, and made a final refusal of registration on the ground that the mark is primarily geographically deceptively misdescriptive.

In its brief on appeal, applicant for the first time mentioned that its "assets are wholly owned by a New Hampshire-based company." The Examining Attorney commented in her brief that this fact would not cause the mark to be found geographically descriptive, rather than deceptively

misdescriptive, and therefore there is no need to remand the application to her to consider this information.

However, we must comment on applicant's lack of candor in its response to the first Office action, particularly because its statements were directed to overcoming the refusal on the ground of geographic descriptiveness.

This brings us to the question of whether GRANITE STATE INSURANCE COMPANY is primarily geographically deceptively misdescriptive of applicant's identified services.

Whether a mark is primarily geographically deceptively misdescriptive is determined according to a two-part test: (1) is the mark's primary significance a generally known geographic location; and (2) would consumers reasonably believe the applicant's goods are connected with the geographic location in the mark, when in fact they are not. **In re Save Venice New York Inc.**, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) **In re Wada**, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); **Institut National des Appellations d'Origine v. Vintners Int'l Co.**, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992).

The first question is whether the primary meaning of GRANITE STATE INSURANCE COMPANY is geographic. The Examining Attorney has asserted, and applicant does not

argue this point, that the additional words INSURANCE COMPANY in the mark do not remove whatever geographic connotation GRANITE STATE may have. We agree. The words INSURANCE COMPANY, which have been disclaimed by applicant, are highly descriptive, if not generic, for the services. See **In re Save Venice New York Inc.**, supra (it is not erroneous to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole). It is clearly the term GRANITE STATE which is the dominant part of applicant's mark, and it is the significance of this term which determines the significance of the mark.³

In support of her position that the primary significance of GRANITE STATE, and therefore GRANITE STATE INSURANCE COMPANY, is geographic, the Examining Attorney has submitted a dictionary definition showing that the nickname of New Hampshire is "Granite State,"⁴ and the following articles which refer to New Hampshire as the Granite State:

Begun in July 1993, BlueChoice provides health insurance for about 100,000 Granite State residents.

³ Applicant has made the argument that GRANITE is the dominant part of the mark because the word STATE is used in various third-party registrations. We disagree. Because of the use of GRANITE STATE as a nickname for the state of New Hampshire, as discussed herein, it is the term GRANITE STATE which is dominant.

⁴ Webster's New Geographical Dictionary.

"The Union Leader" (Manchester, NH),
January 20, 2000

Medical insurance reform—what to do
about the exodus of health insurance
providers from the Granite State.
"The Union Leader," December 26, 2000

Now, the governor says her goal is to
ensure every child in the Granite State
has health insurance.
"American Health Line," November 8,
2000

...according to a separate Progressive
study of premium variance in New
Hampshire, the cost for an identical
auto insurance policy for Granite State
motorists varies an average of \$332
every six months.
"New Hampshire Business Review,"
September 22, 2000

Applicant argues that GRANITE STATE will not be
recognized by consumers as a geographic location because
the "Granite State" is not widely known as a nickname for
New Hampshire. Applicant points out that of the above four
articles submitted by the Examining Attorney, three were
from New Hampshire publications, and the article from the
national publication, "American Health Line," was a multi-
state update and the Granite State reference was under the
subheading for New Hampshire.⁵ Applicant also notes that

⁵ In support of this point, applicant submitted with its brief a
copy of the entire article from "American Health Line." Although
it was not made of record during the examination of the
application, because the Examining Attorney had previously made
of record a portion of the article, we do not consider the
submission to be untimely under Trademark Rule 2.142(d), and have

the articles refer to "the Granite State" or "Granite State residents," rather than "Granite State" per se.

Applicant has also submitted the results of a search for "granite" which it did in the on-line Merriam-Webster's Collegiate Dictionary.⁶ This search did not retrieve a listing for "granite state." From this fact, applicant contends that it is "highly likely that the nickname 'Granite State' is so scarcely known as to render it not even worthy of retrieval in an online dictionary that searches for a word or words in any related string of term." Brief, p. 5. It is not clear to us that the online dictionary will retrieve a word wherever it may be in the database, including words which may appear anywhere within a definition. The three "granites" which were retrieved by applicant's search all appear to be from the actual listing of words which are defined, and we find it hard to believe that in an entire dictionary the word "granite" would not be used as part of a definition. In any event, we take judicial notice of a listing for "Granite State as a separately defined term in the abridged The American

considered the entire article. See **In re Bed & Breakfast Registry**, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986).

⁶ This was submitted as an exhibit to applicant's appeal brief, but we have considered it because the Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Heritage Dictionary of the English Language, © 1970

("Granite State. A nickname for New Hampshire").

Nor are we persuaded by applicant's other arguments. The fact that the articles do not include a phrase that literally equates Granite State with New Hampshire, such as "Granite State, a nickname for New Hampshire," does not mean that "Granite State" is not readily recognized as a nickname for New Hampshire. Indeed, the fact that the articles refer to "the Granite State" or "Granite State residents" or "Granite State motorists" shows that readers of the articles are assumed to know that "Granite State" is another way of referring to the state of New Hampshire. Even if we accept that only people living in New Hampshire would know their state's nickname, these residents are among the consumers of applicant's insurance services.⁷ The population of New Hampshire is large enough that "Granite State" cannot be considered an obscure place name. See **In re Loew's Theatres, Inc.**, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (Durango is not an obscure place name to the Mexican population of this country nor to reasonably informed non-Mexicans).

⁷ Whether or not applicant currently offers its services to residents of New Hampshire, its identification is not restricted, and we must therefore presume that such residents are among its customers.

Thus, the present situation is distinguishable from **Rockland Mortgage Corp. v. Shareholders Funding, Inc.**, 835 F.Supp. 182, 30 USPQ2d 1270 (D. Del. 1993) upon which applicant relies. In Rockland, the Court held that Rockland is "an obscure geographic location in Northern Delaware" because, although the it is the name of a neighborhood in Delaware, it includes only one business (as well as residential condominiums, several estates, and a post office which does not deliver mail). GRANITE STATE, the nickname of a state of the United States with a significantly larger population than a "neighborhood," is not an obscure geographic place.

Moreover, it seems unlikely to us that only residents of New Hampshire would be aware of the state's nickname. Certainly people living in neighboring states such as Vermont, Maine and Massachusetts, because of their proximity to New Hampshire, are likely to know of the nickname. More importantly, as applicant has stated, "American Health Line" is a national publication, and its writer and editors must have considered the nickname to be well enough known nationally to have used it in the article which is of record.

It should also be noted that courts and this Board have, in the past, found state nicknames to be recognized

geographic terms. In **In re Charles S. Loeb Pipes, Inc.**, 190 USPQ 238, (TTAB 1975), a case remarkably similar to the case at hand, in that the applicant therein argued that OLD DOMINION would not be recognized as a nickname for the Commonwealth of Virginia, the Board stated, at 245:

It is clear from the documents made of record by the Examiner that this term is the accepted nickname for the State of Virginia. Obviously, not all people throughout the country are aware of this significance of "OLD DOMINION", and manifestly it is doubtful that many know the nicknames for all or even a portion of the fifty states. But, this is of no moment in a proceeding of this character for it is sufficient for our purposes that it is an accepted nickname for a state and would be recognized as such by a segment of the purchasing public.

Accordingly, we find that the Office has met its burden of proving that the first part of the test, namely that the primary significance of GRANITE STATE, and of GRANITE STATE INSURANCE COMPANY, is a that of a generally known geographic location.

The second prong of the test is whether consumers are likely to make a goods/place (or in this case, services/place) association between the identified services and New Hampshire, the place named in the mark. The Examining Attorney has made of record the following article

from the NEXIS database which mentions three large New Hampshire-based insurance companies:⁸

In the mid-1980s, 3 large New Hampshire-based insurance companies, Matthew Thornton, Health-source, and NH Blue Cross, dominated the New Hampshire health insurance market. By the mid-1990s, 2 Massachusetts HMOs expanded into New Hampshire.
"Patient Care," January 15, 2001

The Examining Attorney has also submitted material taken from various websites for insurance companies which are located in New Hampshire and which advertise their insurance services.. They include FIS Financial Insurance Services Inc. (www.fisins.com); Cronin & Gervino Insurance (www.cronin-gervino.com); Cullity Insurance (www.cullityinsurance.com); Hometown Insurance Agency (www.hometownins.com); and The Sadler Insurance Agency (www.sadler.com).

This evidence shows that insurance services do originate in the state of New Hampshire. In addition, applicant acknowledges that "there are insurance companies

⁸ Several of the articles submitted by the Examining Attorney refer to the regulation of insurance activities, including Story 31 mentioned by the Examining Attorney at p. 7 of her brief, and articles referring to the New Hampshire Insurance Commissioner. They are not evidence that insurance services originate in New Hampshire. Other stories are taken from wire service reports, and because we cannot determine whether these reports were actually published, we cannot say that they have received any public exposure. We have not given these types of articles any consideration.

in every state in America." Brief, p. 8. This evidence is sufficient to establish the requisite goods/place association between insurance services and the state of New Hampshire. Applicant asserts, however, that this evidence is not sufficient to show that New Hampshire is known for insurance, in the same way that, as applicant puts it, North Carolina has a reputation for furniture, California for wine, the Southwest for silver jewelry, New York for bagels, and Maryland for crab. "The Examiner has cited no evidence that New Hampshire has a reputation or association with insurance greater than any other state in America. Moreover, there is no reason to believe that consumers would be more interested in purchasing Applicant's goods and services if they believed that the service did, in fact, emanate from New Hampshire." Brief, p. 9

The test applicant has posited is incorrect. As our primary reviewing Court reiterated in **In re Loew's Theatres, Inc.**, supra at 867-68, while [**In re Nantucket**, 677 F.2d 95, 213 USPQ 889 (CCPA 1982)] "requires a goods/place association to support a refusal to register under §2(e)(2),⁹ it does not follow that such association

⁹ This case was decided prior to the amendment of the Lanham Act, when the provisions of current sections 2(e)(2) and 2(e)(3) were combined as Section 2(e)(2).

embraces only instances where the place is well-known or noted for the goods, a position which the *Nantucket* applicant, as well as [applicant herein], have urged. The court, in *Nantucket*, did not adopt that position. Rather, our precedent continues to hold that to establish a "primarily geographically deceptively misdescriptive" bar, the PTO must show only a reasonable basis for concluding that the public is likely to believe the mark identifies the place from which the goods originate and that the goods do not come from there."

As for applicant's comment that there is no evidence that consumers would be more interested in purchasing applicant's services if they believed they emanated from New Hampshire, the materiality of the misrepresentation to the purchasing decision goes to the question of whether the mark is geographically deceptive under Section 2(a) of the Act, not whether it is primarily geographically deceptively misdescriptive under Section 2(e)(3).

In conclusion, we find that that the Office has established that the primary significance of GRANITE STATE INSURANCE COMPANY is geographic, and has further established that consumers would reasonably believe applicant's services are connected with the geographic location in the mark, when in fact they are not.

Ser No. 75/278,430

Accordingly, we hold that the mark is primarily geographically deceptively misdescriptive of applicant's services, and is prohibited from registration by Section 2(e)(3) of the Act.

Decision: The refusal of registration is affirmed.