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THIS DISPOSITION IS NOT
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OF THE TTAB

Paper No. 13
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re British-American Tobacco (Holdings) Limited

Serial No. 75/559,558

Kathleen E. McCarthy, Maren Coburn and Charles P. Guarino
of Morgan & Finnegan, LLP for British-American Tobacco
(Holdings) Limited.

Tina L. Snapp, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Hanak, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

British-American Tobacco (Holdings) Limited seeks
registration on the Principal Register of this mark:



**BRITISH AMERICAN
TOBACCO**

for goods in five classes, identified as "sunglasses" in
International Class 9; "sports timing devices, namely,

watches and stop watches," in International Class 14; "cloth flags" in International Class 24; "ornamental novelty pins and badges," in International Class 26; and "scale model vehicles for collectors, model drivers' helmets for collectors," in International Class 28.¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the ground that applicant has failed to comply with the requirement for a disclaimer of the phrase "BRITISH AMERICAN." Applicant has volunteered to disclaim separately the word "BRITISH" and the word "AMERICAN," arguing that the record fails to show that "'British American' is a unitary geographically descriptive phrase in the context of the mark and goods at issue here." (Applicant's reply brief, p. 1).

The Trademark Examining Attorney takes the position that even if there is no such place as "British America," the term BRITISH AMERICAN is geographically descriptive matter and therefore it must be disclaimed as a unitary term prior to the issuance of a federal trademark registration.

¹ Application Ser. No. 75/559,558, filed on September 25, 1998, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Applicant makes a number of arguments supporting the conclusion that it should not have to comply with the Trademark Examining Attorney's required format for a disclaimer. Applicant argues that the evidence in the file does not support the Trademark Examining Attorney's basic premise that the term "British American" is primarily geographically descriptive. However, in an earlier case having analogous facts, the Board dealt with a similar issue:

[T]he basis for applicant's position is that when combined in the phrase LONDON & EDINBURGH, the individual geographic terms become nongeographic because London & Edinburgh is not the name of a particular geographic place. We disagree. When the mark LONDON & EDINBURGH INSURANCE is viewed as a whole, the geographic significance of the words is not lost. Consumers will still regard the mark as referring to the cities of London and Edinburgh, rather than to some mythical place called "London & Edinburgh." Nor can London & Edinburgh be considered such an odd or incongruous combination of geographic place names that consumers will view it as an arbitrary combination without a geographic significance to the whole"

In re London & Edinburgh Insurance Group Ltd., 36 USPQ2d 1367 (TTAB 1995)

Applicant argues that consumers who see its British American Tobacco (and design) mark on the listed goods will not assume that "British America" is a geographical place. However, our decision does not turn on the existence of a

mythical place called "British America." Rather, we conclude that consumers will regard this combination of words contained within applicant's mark as having primarily geographical significance. The LEXIS/NEXIS evidence supports the conclusion that this is a combination that consumers are quite accustomed to seeing as it is used in the media and elsewhere. Furthermore, this geographical significance is not lost with the addition of the word "TOBACCO" to "BRITISH AMERICAN, or because the word "tobacco" is arbitrary for these listed goods. That this entire composite also happens to be part of applicant's logo, contains its trade name and constitutes a critical component of its corporate identity is largely irrelevant to this portion of our inquiry.

Applicant also argues that this composite will cause people to assume that the goods come from applicant's group of affiliated companies. However, this argument as to "secondary source" (viz. TMEP 1202.04(c)) does not obviate the basic refusal pertaining to the geographical designation. Rather, it means that while the term "British American" is still primarily geographically descriptive, the tie-in to applicant's house mark may support a factual showing of acquired distinctiveness as to the term "British American Tobacco" (or maybe even the two word term here at

issue, "British American") as to the racing souvenir items listed in the instant application. However, such a showing is not contained within the record before us herein.

We acknowledge that many of the third-party registrations for marks containing "_____-AMERICAN" placed in the record by the Trademark Examining Attorney tend to point to enterprises and service organizations identified with defined racial and ethnic groups that have settled in this country. In that respect, we agree with applicant they are not totally analogous and hence are of limited value in reaching our decision herein.

Additionally, we agree with applicant that its earlier decision to disclaim the term "BRITISH AMERICAN" in a registration for tobacco is not binding on the applicant in the instant applicant for totally different goods. However, irrespective of the goods involved, it does support the contention of the Trademark Examining Attorney that in the past, the Office has considered the designation "BRITISH AMERICAN," like other "_____-AMERICAN" terms, to be primarily geographical - a determination totally apart from whether the current record supports a finding of geographical descriptiveness for particular goods.

Finally, we turn to the few reported cases where the exact formulation of the disclaimer has been discussed.

Petitioner's request for entering two separate disclaimers of "glass" and "technology" in the uniform wording is inappropriate. To allow two separate disclaimers of the individual words in the standard printing format would effectively permit piecemeal disclaimers of a unitary, descriptive term. Disclaimers of individual components of complete descriptive phrases are improper. *In re Surelock Mgf Co.*, 125 USPQ 23 (TTAB 1960). Unitary expressions should be disclaimed as a composite. *America Speech-Language-Hearing Assn. v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984). "Glass Technology" is a unitary phrase which is descriptive of the automobile windshield repair kits. Therefore, the wording must be disclaimed in the composite. Separate disclaimer of the individual words, "glass" and "technology," in the standard printing format is improper.

In re Wanstrath, 7 USPQ2d 1412 (PTO Comm'r 1987).

Consistent with these reported decisions, long-standing Office practice has required that unitary phrases should be disclaimed in their entirety. Accordingly, the Trademark Examining Attorney was correct in this instance to require a disclaimer of the unitary phrase, BRITISH AMERICAN.

Decision: The requirement, under Section 6 of the Trademark Act, for a disclaimer of BRITISH AMERICAN is affirmed.

In accordance with Trademark Rule 2.142(g), this decision will be set aside and this application will be returned to the Trademark Examining Attorney to place in

condition for publication for opposition if applicant, no more than thirty days from the mailing date of this decision, submits an appropriate disclaimer of BRITISH AMERICAN.