

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rollyn H. Samp

Serial No. 75/631,602

Hugh D. Jaeger, Esq. for Rollyn H. Samp

Katherine Waters-Perez, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Hanak and Walters, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Rollyn H. Samp (applicant) seeks to register SOUTH
DAKOTA DYNASTY TRUST and design in the form shown below for
"legal services; technical support services for clients and
potential clients establishing a trust in South Dakota,
namely, assisting clients and potential clients in
establishing a trust in South Dakota via telephone, via E-
mail, and in person." The intent-to-use application was
filed on February 1, 1999. In the application, applicant's
mailing address was identified as 101 East 38th Street,
Sioux Falls, SD 57101.

The Examining Attorney has refused registration on two grounds. First, citing Section 2(e)(2) of the Trademark Act, the Examining Attorney contends that applicant's mark is primarily geographically descriptive of applicant's services. Second, citing Section 2(d) of the Trademark Act, the Examining Attorney contends that applicant's mark, when used in connection with applicant's services, is likely to cause confusion with the mark DYNASTY TRUST, previously registered in typed drawing form for "services in the area of estate planning, namely, the design and implementation of a highly specialized trust to minimize or eliminate estate taxes and generation skipping transfer taxes for several generations." Registration No. 2,086,015. This registration contains a disclaimer of the word TRUST apart from the mark as shown.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining

Attorney filed briefs. Applicant initially requested an oral hearing, but later withdrew the request.

We will decide first whether applicant's mark taken as a whole is primarily geographically descriptive of applicant's services. At the outset, we note that at page 9 of her brief the Examining Attorney has characterized the DYNASTY TRUST portion of applicant's mark as being "generic or highly descriptive." In this regard, the Examining Attorney has made of record over 40 articles from various publications wherein the term "dynasty trust" appears. For example, the July 19, 1999 edition of the New Jersey Law Journal contains the following sentences: "The new law, which applies to property interests created after July 8, removes all time limits on how long trusts can last, enabling people to create what are being called 'dynasty trusts.'... In recent years, there has been a trend toward allowing dynasty trusts, with Alaska, Arizona, Delaware, Idaho, Maryland, Illinois, South Dakota and Wisconsin repealing their rules against perpetuities." (Emphasis added). A story appearing in the April 23, 1999 edition of The Columbus Dispatch explains the advantages of a dynasty trust as follows: "Sound too good to be true? Until recently it was. But a change in law by the state legislature now allows some wonderful benefits by creating

a new Ohio dynasty trust ... For many years, you could use a trust to skip estate tax not only for you, but also for the next generation. But you couldn't go further than one generation, until now. With the Ohio dynasty trust, you can create a fund for your bloodline that will be free of federal estate taxes forever." Based upon these and many other articles, we find that the term "dynasty trust" is the name of a type of trust that can last in perpetuity.

There can be no dispute that Section 2(e)(2) of the Trademark Act "provides that a term which is primarily geographically descriptive is initially unregistrable." In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889, 896 (CCPA 1982). Such a term can only be registered pursuant to Section 2(f) of the Trademark Act upon proof by the applicant that the term has become distinctive of applicant's goods or services. In this case, applicant has made no Section 2(f) showing.

In light of the Court's decision in Nantucket, this Board shortly thereafter set forth a test for determining whether a word or term is primarily geographically descriptive. That test is as follows: "Where, on the other hand, 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 naming the mark." In re Handler Fenton Westerns, Inc., 214 USPQ 848, 850 (TTAB 1982).

Obviously, South Dakota is a well known place. The addition of the term "dynasty trust" to South Dakota does not change the fact that the primary significance of the mark is geographically descriptive. As noted earlier, the term "dynasty trust" is the name of a type of trust that can last in perpetuity. This primary geographic significance is only enhanced by the fact that the mark also includes an outline of the state of South Dakota. In addition, applicant's services originate in South Dakota. Moreover, we note that at page 1 of his brief, applicant even concedes that its mark "is geographically descriptive."

Accordingly, we find that the Examining Attorney's refusal to register applicant's mark pursuant to Section 2(e)(2) of the Trademark Act on the basis that the mark is primarily geographically descriptive of applicant's services is well taken.

Having found applicant's mark to be primarily geographically descriptive, we elect not to consider the refusal pursuant to Section 2(d).

Decision: The refusal to register on the basis that applicant's mark is primarily geographically descriptive of applicant's services is affirmed.