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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re U.S. Education Finance Management Corporation

Serial No. 76/040,862

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L.L.P. for U.S. Education Finance Management Corporation.

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Before Cissel, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 4, 2000, U.S. Education Finance Management Corporation (applicant), a corporation organized under the laws of Florida and located in Miami, Florida, filed an intent-to-use application to register the mark "U.S. PRESTAMOS DE EDUCACION" (in typed form) on the Principal Register for services eventually identified as "education loan services; brokering education loans" in International Class 36. The application has been amended to indicate

that the term "prestamos de education" is translated from Spanish as "education loans."

The examining attorney¹ refused to register applicant's mark on the ground that the mark is primarily geographically descriptive of applicant's services under Section 2(e)(2) of the Trademark Act. 15 U.S.C. § 1052(2)(e)(2). After the examining attorney made the refusal final, applicant filed an appeal.

The examining attorney's position is that "the public certainly would understand the designation 'U.S.' as the dominant portion" of the mark and that the other wording "prestamos de educacion" is generic for applicant's services. Examining Attorney's Brief at 4. The examining attorney determined that: the primary significance of the mark is geographical; customers would make a goods/place association; and the mark would identify the geographic origin of the services. Therefore, the examining attorney refused to register the mark under Section 2(e)(2) of the Trademark Act.

Applicant, on the other hand, argues that its mark is composed "of the English term 'U.S.' and the Spanish phrase 'PRESTAMOS DE EDUCACION,' which translates to 'EDUCATION

¹ The current examining attorney was not the original examining attorney in this case.

LOANS.'" Applicant's brief at 2. "The incongruity presented by the juxtaposition of the English term "U.S." with the Spanish phrase 'PRESTAMOS DE EDUCACION' certainly would cause the average consumer of Applicant's services to pause and reflect upon the meaning of Applicant's mark since the first term encountered is the English term 'U.S.,' which is immediately followed by a Spanish phrase. Thus, the consumer would have to 'pause,' in order to 'shift gears' mentally from thinking in English to thinking in Spanish." Reply Brief at 4.

The Board has set out the following test to use in determining whether a mark is primarily geographically descriptive:

[T]he Trademark Examining attorney would need to submit evidence to establish a public association of the goods with that place if, for example, a genuine issue is raised that (1) the place named in the mark may be so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied or (2) an admitted well-recognized term may have other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. 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 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.

In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849-50 (TTAB 1982).

We start by taking judicial notice² of the fact that "U.S." is an abbreviation of the of "United States." See Webster's II New Riverside University Dictionary (1984), p. 1353. Because applicant's address is in Florida, applicant is located in the United States and we can presume the services would originate in the United States. In re Compagnie Generale Maritime, 993 F.2d 841, 26 USPQ2d 1652, 1655 (Fed. Cir. 1993) ("Certainly, all of the goods and services would either originate in France or should be considered as if they did because they are sold by a French company"). Furthermore, the United States is not a remote or obscure geographic location, nor does applicant argue that it is. In re U.S. Cargo Inc., 49 USPQ2d 1702, 1703 (TTAB 1998) ("[W]e may take judicial notice of the fact that "U.S." means the United States, and that the United States is a geographic area with defined boundaries. Indeed, we believe the exclusive significance of "U.S." to most purchasers would be the geographic area")(footnote omitted).

² University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

As in U.S. Cargo, here the significance of the term "U.S." in the United States to most purchasers would be a reference to the United States of America. In addition, the term "education loans" and its Spanish translation, "prestamos de educacion," are generic for education loan services and brokering education loan services.

Combining the geographical term "U.S." with the generic term "prestamos de educacion" does not convert the mark into a non-geographically descriptive term. In re Monograms America Inc., 51 USPQ2d 1317, 1319 (TTAB 1999) (MONOGRAMS AMERICA for consultation services for owners of monogramming shops held primarily geographically descriptive as it simply signifies United States origin and/or geographical scope. "Moreover, the addition of highly descriptive matter to a geographic term does not detract from the mark's primary significance as being geographically descriptive"). See also, U.S. Cargo, 49 USPQ2d at 1704 (U.S. CARGO held primarily geographically descriptive for towable trailers for carrying cargo and vehicles for commercial purposes); In re Chalk's International Airlines Inc., 21 USPQ2d 1637, 1639 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of transporting passengers and goods by air); and In re Cambridge Digital Systems, 1

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USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL held primarily geographically descriptive of computer systems). Similarly here, the addition of the generic wording "prestamos de educacion" or "education loans" does not change the primarily geographic impression of applicant's mark.

Applicant's main argument, however, is that its mark is a combination of the "English term 'U.S.' and the Spanish phrase 'PRESTAMOS DE EDUCACION.'" Numerous cases have held that when words in English and other languages are combined, the resulting mark is registrable and non-descriptive." Applicant's Brief at 2. Applicant cites several cases to support its argument. See In re Universal Packaging, 222 USPQ 344 (TTAB 1984) (LE CASE not descriptive for jewelry boxes); In re Johanna Farms, 8 USPQ2d 1408 (TTAB 1986) (LA YOGURT not descriptive for yogurt); In re Sweet Victory, Inc., 228 USPQ 959 (TTAB 1988)(GLACE LITE not descriptive for frozen desserts). Indeed, one court has held that "the doctrine [of foreign equivalents] does not apply when a mark is a combination of foreign and english words." French Transit Ltd. v. Modern Coupon Systems Inc., 818 F. Supp. 635, 29 USPQ2d 1626, 1626 (S.D.N.Y. 1993).

We are not persuaded by applicant's argument. First, we start by observing that the mere allegation that a mark contains an English word and a foreign word does not automatically lead to a conclusion that the mark as a whole is not merely descriptive or primarily geographically descriptive. Second, we note that the "English word" in applicant's mark, "U.S.," is an abbreviation, not a word. Abbreviations of a geographic place are much less likely to appear incongruous when used with foreign words. For example, the abbreviation "US\$" would likely have the same meaning in English and Spanish. It would appear no more incongruous in a Spanish publication in the United States than in an English language publication. Third, we take judicial notice of two dictionary definitions that demonstrate that the full abbreviation "USA" means the same in Spanish as it does in English. *Collins Spanish Dictionary*, 6th Ed.; *Oxford Spanish Dictionary* (1997).³ Because applicant's mark incorporates an even shorter abbreviation, it is just as likely to be recognized in both English and Spanish as standing for the United States. Inasmuch as we are only dealing with the perception of the

³ We are aware that the traditional Spanish abbreviations for "Estados Unidos de America - U.S.A." are "E.U.A. or EE.UU. or E.U." *Cassell's Spanish Dictionary* (1959), p. 1456.

mark in the U.S., there is no reason to believe that English or Spanish speaking people in the U.S. would have any reason to pause over the use of the abbreviation "U.S." Therefore, the argument that prospective purchasers would find the mark incongruous is not viable. If the mark "U.S. PRESTAMOS DE EDUCACION" were used in association with education loan services and brokering education loan services from an entity located in the United States, the mark would be primarily geographically descriptive of those services.

Decision: The refusal to register applicant's mark under Section 2(e)(2) of the Trademark Act on the ground that the mark is primarily geographically descriptive is affirmed.