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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SF Investments, Inc.

Serial No. 78645616
Serial No. 78645618[1]

Carl H. Pierce of Reed Smith LLP for SF Investments, Inc.

Pamela Y. Willis, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Seeherman, Quinn, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

SF Investments, Inc. filed use-based applications for the mark THE SMITHFIELD COLLECTION, in standard character form (Serial No. 78645616), and THE SMITHFIELD COLLECTION and design (Serial No. 78645618), shown below, both for the following services:

> Mail order catalog services featuring meat, seafood, and poultry; sauces and marinades; peanuts; soups; cheese; pet treats; cookbooks; candy and desserts;

[1] Because the same applicant filed both applications, the same Examining Attorney reviewed both applications, and both applications involve common issues of fact and law, we have consolidated the appeals.

> gift baskets; nuts; and grilling accessories; and computerized on-line retail store services in the fields of meat, seafood, and poultry; sauces and marinades; peanuts; soups; cheese; pet treats; cookbooks; candy and desserts; gift baskets; nuts; and grilling accessories, in Class 35.

Applicant claimed ownership of Registration No. 2624764 for the mark SMITHFIELD for the products listed below:

> Meat, excluding hams, processed, treated, smoked, aged, and cured by the long-cure, dry salt method of cure and aged for a minimum of six months when such six-month period commences when the green pork cut is first introduced to dry salt and all such salting, processing, treating and aging is done within the corporate limits of the town of Smithfield, Virginia, in Class 29.

The SMITHFIELD mark was registered under the provisions of Section 2(f) of the Trademark Act of 1946, 15 U.S.C. §1052(f).

During the prosecution of both applications, applicant disclaimed the exclusive right to use "Collection."

In application Serial No. 78645616, the examining attorney refused registration under Section 2(e)(2) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(2), on the ground

that the mark THE SMITHFIELD COLLECTION, when applied to applicant's mail order and retail online store services, is primarily geographically descriptive. With respect to application Serial No. 78645618, the Examining Attorney made a final requirement that applicant disclaim the exclusive right to use "Smithfield" on the ground that "Smithfield" is primarily geographically descriptive. The examining attorney contends that "Smithfield" is primarily geographically descriptive because "Smithfield" is a geographic place and applicant's services originate from Smithfield thereby creating a services-place association.

In response to the refusals, applicant argues that the examining attorney failed to make a *prima facie* case that "Smithfield" is primarily geographically descriptive for the following reasons:

1. The primary significance of "Smithfield" is Smithfield Foods, applicant, not a geographic location; and,
2. There is no services-place association because "Smithfield, Virginia is a small, remote town," and that consumers will not perceive it as a

geographic location associated with applicant's services.[2]

The following evidence has been made of record:[3]

1. A dictionary definition of "Smithfield" indicating that "Smithfield" is the name of 9 cities in the United States, including Smithfield, Virginia;[4]

2. An excerpt from applicant's website identifying applicant as the "world's largest pork processor and hog producer" and stating that it is located in Smithfield, Virginia;[5]

3. An excerpt from applicant's website referencing information from its latest annual report with the following information:

A. Applicant has $5.7 billion in assets;

B. Applicant has $11.4 billion in sales;

C. Applicant has net income of $296 million;

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[2] Applicant's Brief, pp. 6-7.

[3] Applicant filed exhibits with its brief and reply brief. "The record in an application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or the examiner after the appeal is filed." Trademark Rule 2.142(d). To the extent that the evidence attached to applicant's brief was not submitted prior to the filing of the appeal (or request for reconsideration), it has not been given any consideration.

[4] *Ultralingua web: The Language Site* (www.ultralingua.net).

[5] www.smithfieldfoods.com.

D. Applicant is the fifth largest beef producer in the United States;

E. Applicant is the world's largest pork processor and hog producer; and,

F. Applicant has a 6% market share;

4. Copies of the following "Smithfield" registrations owned by applicant in which the exclusive right to use "Smithfield" is disclaimed:

Mark	**Reg. No.**	**Goods**
SMITHFIELD BY LUTER	1104410	Fresh meats, hams, bacon, sausage, franks, and lard
OLDE SMITHFIELD	1140468	Fresh sausage, bacon, and ham
OLDE SMITHFIELD	1441351	Frankfurters
SMITHFIELD PREMIUM	2292349	Meat

5. Copies of the following "Smithfield" registrations owned by applicant in which the mark is registered under the provisions of Section 2(f) of the Trademark Act of 1946:

Mark	**Reg. No.**	**Goods**
SMITHFIELD	2624764	Meat
SMITHFIELD	2989997	A house mark for a full line of meat
SMITHFIELD PREFERRED STOCK	3059618	Meat

6. A printout from a YAHOO! People Search displaying 10 out of 27 listings for people with the surname Smithfield;

7. An excerpt from applicant's website with a copyright notice indicating that applicant is located in Portsmouth, Virginia;[6]

8. The homepage from the website of Smithfield, Virginia which identifies itself as "The Ham Capital of the World";[7]

9. The Wikipedia entry for Smithfield, Virginia.[8] The entry provides the following information:

> The town originally founded in the 17th century as a seaport, is most famous for the curing and production of ham. The Virginia General Assembly passed a statute defining Smithfield ham by law in 1926. [9]

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[6] www.smithfieldcollection.com. Applicant's specimen filed with the original application also displays a copyright notice with a Portsmouth, Virginia address. Portsmouth is approximately 20 miles southeast of Smithfield. (The Road Atlas, pp. 106-107 (Rand McNally 2000)). Portsmouth and Smithfield are both in the South Hampton Roads region of Virginia. The Board may take judicial notice of the location of Portsmouth, Virginia vis-à-vis Smithfield, Virginia. *Pinocchio's Pizza v. Sandra Inc.*, 11 USPQ2d 1227, 1229 n.6 (TTAB 1989).

[7] www.smithfieldva.gov.

[8] Applicant submitted the Wikipedia entry.

[9] Section 3.1-867 of the Virginia Code reads as follows:

> Genuine Smithfield hams are hereby defined to be hams processed, treated, smoked, aged, cured by the long-cure, dry salt method of cure and aged for a minimum period of six months; such six-month period to commence when the green pork cut is

> Today, Smithfield Foods, a Fortune 500 Company which owns Smithfield Packing Company and others, is the world's largest pork processor and hog producer. The company, based in Smithfield, processes 20 million hogs and raises 12 million annually.

10. The hit list from a search on the Google search engine for "Smithfield."[10] The first two hits are applicant's website at www.smithfieldfoods.com. The third hit reads as follows:

> **Smithfield**
> Famous for hams from **Smithfield**, Virginia, our site offers recipes using a wide range of pork products and recipe videos with Paula Dean.
> www.smithfield.com/ - 12k – Cached – Similar pages

In addition to the evidence and the arguments of applicant and the Examining Attorney, the Board takes judicial notice of the following gazetteer information:[11]

> Smithfield . . . 6. town . . . Isle of Wright co., SE Va., 11 mi/18km W of

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> first introduced to dry salt, all such salting, processing, treating, smoking, curing and aging to be done within the corporate limits of the town of Smithfield, Virginia.

The Board may take judicial notice of the laws of any jurisdiction. *Quaker Oats Co. v. Acme Feed Mills, Inc.,* 192 USPQ 653, 655 (TTAB 1976).

[10] Applicant submitted the Google search results.

[11] *See The 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); *In re Consolidated Specialty Restaurants Inc.,* 71 USPQ2d 1921, 1927 (TTAB 2004).

> Newport News, . . . Mfg. (meat processing).[12]

Section 2(e)(2) of the Trademark Act of 1946 provides that registration shall not be refused unless a mark is primarily geographically descriptive of applicant's goods or, as made applicable by Section 3, its services. In order for registration to be properly refused on this basis 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 services/place association (*i.e.,* believe that the services listed in the application originate from the place). *In re California Pizza Kitchen, Inc.,* 10 USPQ2d 1704, 1705 (TTAB 1989), *citing In re Societe Generale des Eaux Minerals de Vittel S.A.,* 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987). *See also, In re John Harvey & Sons Ltd.,* 32 USPQ2d 1451, 1453 (TTAB 1994). When the primary significance of the name is geographic, and the services of the applicant are rendered from the named place, a public association of the service with the place will be presumed. *In re California Pizza Kitchen, Inc., supra; In re Handler Fenton Westerns, Inc.,* 214 USPQ 848, 850 (TTAB 1982).

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[12] The Columbia Gazetteer of North America, p. 963 (2000).

First, we note that applicant already owns three registrations for SMITHFIELD that were obtained under the provisions of Section 2(f). By seeking registration under Section 2(f), applicant conceded, with these registrations, that "Smithfield" is primarily geographically descriptive. *See Yamaha International v. Hoshino Gakki,* 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (when a mark is registered under the provisions of Section 2(f), "the *statute* accepts a lack of inherent distinctiveness as an established fact"); *Omnicom Inc. v. Open Systems Inc.*, 19 USPQ2d 1876, 1878 (TTAB 1989) (registrant's claim of secondary meaning pursuant to Section 2(f) is evidence that the mark in question is not inherently distinctive).

In any event, the record shows that "Smithfield" is a generally known name of a town in Virginia where applicant is located, it is referred to as the ham capital of the world, and it is famous for the production and curing of hams. *See Ultralingua web: The Language Site* (www.ultralingua.net); applicant's website (wwww.smithfieldfoods.com); the Smithfield, Virginia website (www.smithfieldva.gov); the Wikipedia entry for Smithfield; and The Columbia Gazetteer of North America. Accordingly, Smithfield, Virginia is a place generally

known to the public. This satisfies the first part of the test.

We have considered applicant's argument that "Smithfield is also a surname and identifies more than one geographic location. However, given the evidence regarding the recognition of Smithfield, Virginia, as detailed above, these other meanings do not affect the perception of consumers and potential consumers that "Smithfield" is primarily the name of a geographic location.[13] On this record, we find the primary geographical significance of SMITHFIELD is not displaced or overcome by the fact that there are some people who have this as a surname or that there are other geographical locations with this name. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985); *In re Opryland USA Inc.*, 1 USPQ2d 1409, 1413 (TTAB 1986); *In re Cambridge Digital Systems,* 1 USPQ2d 1659, 1662 (TTAB 1986).

The second part of the test is whether the consuming public would make a services/place association (*i.e.*, whether the relevant public would believe that applicant's services originate in the place named by the mark). The

[13] Applicant was only able to show 27 surname listings from the Yahoo! People Search. The low number of listings indicates that "Smithfield" is such a rare surname that it is unlikely to affect the perception of Smithfield as primarily a geographic location.

record establishes that Smithfield, Virginia is well known for producing ham. The Wikipedia entry for Smithfield provides that Smithfield "is most famous for the curing and production of ham." The third listing in the Google search engine hit list for "Smithfield" reads as follows:

> **Smithfield**
> Famous for hams from **Smithfield**, Virginia . . .

On its homepage, Smithfield, Virginia proclaims itself as "The Ham Capital of the World." Internet based evidence may be probative of how the public perceives a term. *In re Bayer Aktiengesellschaft,* 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re IP Carrier Consulting Group,* 84 USPQ2d 1028, 1032 (TTAB 2007) (Wikipedia evidence is admissible); *In re Total Quality Group, Inc.,* 51 USPQ2d 1474, 1475-1476 (TTAB 1999) (information retrieved from the Internet is probative to the extent that it is information available to the public, and of the way in which a term is used by the public); TMEP §710.01(b) (5th ed. 2007) ("Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which the term is being used by the public"). In addition, on its website, applicant identifies itself as the "world's largest pork processor and hog producer," and that it is based in Smithfield,

Virginia. Finally, Smithfield is noted for meat processing in The Columbia Gazetteer of North America.

Because Smithfield is noted for the curing and production of ham, consumers would naturally believe that mail order and online retail store services featuring other related food products such as meat, seafood, and poultry also emanate from Smithfield. *In re Save Venice New York Inc.,* 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001) ("the registrability of a geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there"); *In re California Pizza Kitchen, supra* at 1706 ("It is the perception of the public as to the geographical significance of the mark which controls whether registration be refused pursuant to Section 2(e)(2), not whether an application also renders the services or manufactures some of the goods outside of the geographical area named in the mark").

Finally, although applicant admits that Smithfield is a town in Virginia, it nevertheless contends that the primary significance of "Smithfield" is applicant, not the town in Virginia. In essence, applicant argues that the evidence demonstrates that the name "Smithfield" has

acquired secondary meaning as a mark, and thus shows that the primary significance of that name is applicant, not a geographic location.[14]

Applicant's arguments regarding the "primary significance," or acquired distinctiveness, of its mark might be relevant if applicant were seeking registration pursuant to Section 2(f) of the Trademark Act of 1946. However, applicant has not claimed the benefits of Section 2(f), and, without a formal claim of distinctiveness under Section 2(f), the evidence of applicant's advertising and promotion, sales success, and substantially exclusive and continuous use of the SMITHFIELD mark for many years cannot serve as the basis for allowing registration of applicant's marks. *Cf In re Industrie Pirelli,* 9 USPQ2d 1564, 1565 (TTAB 1988) (evidence of fame and prior registration cannot serve as the basis for allowing the registration of a name that is primarily merely a surname without a claim of secondary meaning pursuant to Section 2(f); *In re McDonald's Corporation,* 230 USPQ 304, 307 (TTAB 1986) (evidence of secondary meaning in the absence of a claim of secondary meaning pursuant Section 2(f) does not make a mark that is primarily merely a surname registrable).

[14] Applicant's Brief, pp. 3-5; Applicant's Reply Brief, pp. 3-5.

In view of the foregoing, we find that consumers would believe that applicant's mail order and retail online services featuring meat, seafood, and poultry rendered under the mark SMITHFIELD have their origin in Smithfield, Virginia.

Decision: The refusal to register the mark THE SMITHFIELD COLLECTION (Serial No. 78645616) is affirmed.[15]

The refusal to register the mark THE SMITHFIELD COLLECTION and design (Serial No. 78645618) based on applicant's refusal to disclaim the exclusive right to use "Smithfield" is affirmed. However, if applicant submits the required disclaimer of "Smithfield" to the Board within thirty days of the mailing date of this decision, this decision will be set aside as to the affirmance of the disclaimer requirement.[16] *See* Trademark Rule 2.142(g).

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[15] Once an application has been considered and decided by the Board on appeal, an application may not be reopened to amend the application or to submit additional evidence, except to enter a disclaimer or upon order of the Director. Trademark Rule 2.142(g). Applicant should note, however, that in the case *sub judice*, because an amendment to Section 2(f) will require additional examination, a petition to the Director to reopen examination will be denied. *In re Petite Suites Inc.,* 21 USPQ2d 1708 (Comm'r 1991).

[16] The standard printing format for the required disclaimer text in this application is as follows: "No claim is made to the exclusive right to use "The Smithfield Collection," apart from the mark as shown. TMEP §1213.08(a)(i) (5th ed. 2007).