

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: April 4, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ralph Whitworth

Serial No. 78816327

Thomas D. Foster, Esq. for Ralph Whitworth.

Thomas M. Manor, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Walters, Grendel and Mermelstein, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Ralph Whitworth has filed an application to register on the Principal Register the standard character mark AMERICA'S CAR COLLECTION for "printed matter, namely, bookmarks, bumper stickers, calendars, decals, envelopes and stationery, pencils, pens, atlases, geographical maps, art prints, magazines featuring motor sports; postcards and posters; printed instructional, educational, and teaching materials in the field of motor sports," in International Class 16, and "museum services; namely, arranging and

conducting a museum featuring automobiles and other memorabilia relating thereto; providing entertainment services in the nature of museum events, charity events, or events to showcase racing and motor sports memorabilia; publishing and issuing of books, journals and magazines," in International Class 41.¹

The examining attorney has issued a final refusal to register. With respect to some of the goods identified in International Class 16, i.e., "art prints; magazines featuring motor sports; postcards and posters; printed instructional, educational, and teaching materials in the field of motor sports,"² the examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with these goods.

With respect to the services identified in International Class 41, the examining attorney has refused registration under Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), on the ground that applicant's mark is

¹ Serial No. 78816327, filed February 16, 2006, based on an allegation of a bona fide intention to use the mark in commerce. Although filed in only one class, the application also included goods and services properly classified in International Classes 25, 28, 41 and 43. These classes were added to the application, but Classes 25, 28 and 43 were not subject to a refusal to register and were divided out of this application, becoming application serial no. 78978257.

² Throughout both his office actions and his brief, the examining attorney inconsistently includes or omits "art prints" in his Section 2(e)(1) refusal. His reasoning for the refusal does not apply to "art prints" and, therefore, we do not consider these goods to be included in the Section 2(e)(1) refusal.

primarily geographically descriptive in connection with these services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.³

As a preliminary matter, we note that applicant has submitted exhibits with its brief on appeal and the Examining Attorney has objected thereto. Inasmuch as the evidentiary record in an application must be complete prior to the filing of the notice of appeal, we sustain the objection to the extent that we have not considered any exhibits attached to the brief that were not previously submitted. *See, 37 CFR 2.142(d); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).* However, it appears that most if not all of this evidence was previously submitted in connection with a response prior to appeal or with the request for reconsideration. Such evidence is timely and has been considered.

Both applicant and the examining attorney submitted evidence in support of their respective positions.

Applicant submitted the following evidence:

- Copies of 29 third-party registrations for a wide variety of goods and services for marks including

³ Consistent with the Board's order of November 10, 2007, applicant's late-filed reply brief has not been considered.

AMERICA'S along with additional wording. None of these registrations includes a disclaimer of AMERICA'S.

- One third-party registration for the mark AMERICA'S FINEST for paints, registered under Section 2(f).⁴
- The results of a "Yahoo People Search" for "Car" listing 152 businesses that include the word "car" and individuals whose surname is "Car."
- Entries from *Roget's New Millennium Thesaurus* listing for each of the words in applicant's Class 16 identification of goods.⁵

The examining attorney submitted the following evidence:

- Copies of 29 third-party registrations for a wide variety of goods and services for marks including AMERICA'S along with additional wording. Each of these registrations includes a disclaimer of AMERICA'S.
- The following dictionary definitions from *The American Heritage[®] Dictionary of the English Language, 4th ed.*, 2000:

America: 1. The United States. 2. also the A·mer·i·cas, The land masses and islands of North America, Central America, and South America.

⁴ We note that, while submitted by applicant, this registration would appear to support the examining attorney's contention that AMERICA'S is merely descriptive or primarily geographically descriptive.

⁵ Applicant submitted this evidence in support of its contention that COLLECTION is not merely descriptive of a publication because it does not appear as a synonym for "publication." Suffice it to say that this argument is inapposite and we have not relied thereon in making our determination.

Car: 1. An automobile.

Collection: 1. The act or process of collecting. 2. A group of objects or works to be seen, studied, or kept together.

The question before us is whether the mark AMERICA'S CAR COLLECTION is merely descriptive in connection with the specified goods in International Class 16 and/or primarily geographically descriptive in connection with the services in International Class 41.

The examining attorney contends that AMERICA'S CAR COLLECTION is merely descriptive of the subject matter of applicant's publications featuring motor sports and, inexplicably, he cites several Board and court decisions involving entirely different marks, for magazines, that were found to be merely descriptive. Based on the definitions of the individual terms in the mark, the examining attorney argues that AMERICA'S CAR COLLECTION "means a collection of American cars, and/or a collection of cars in America, either of which is descriptive." (Brief, unnumbered p. 9.)

Applicant responds that the mark is, at most, suggestive and that any doubt in this regard should be resolved in his favor. Applicant states that "while each of the terms in applicant's mark taken individually perhaps may not require imagination to reach a conclusion, all of the words together, AMERICA'S CAR COLLECTION, require the consumer to stop and think. It is not at all clear or

apparent what the public can expect to encounter"; and that "AMERICA'S as a geographically descriptive term encompasses three enormous geographically and culturally diverse continents, and AMERICA'S CAR is by no means a clear description of anything" (brief, p. 10). Applicant concludes that AMERICA'S is too vague to have any descriptive or geographic significance.

Regarding the connotation of his mark, applicant states that "AMERICA'S CAR COLLECTION is NOT intended to denote a place of origin, rather it is intended to appeal to a sense of national identity" and "It takes an imaginative leap when one hears the mark ... to conjure up what exactly one might encounter while experiencing the 'museum services' or 'publishing services' advertised in connection with the mark. The primary significance of the term AMERICA'S in this mark is not for the origin of the services, but to hearken to a 'GREAT AMERICAN' love affair with automobiles and the open road, as one refers to baseball and apple pie ... [and that] AMERICA'S suggests something of desirable quality, pride, excellence, or a national unity rather than the geographic origin of the museum services." (Brief, p. 5.)

Both applicant and the examining attorney have cited cases in support their respective positions as to the significance of AMERICA'S in the mark. Regarding these

cases with seemingly contradictory results and the case before us, we remind applicant and the examining attorney that each case must be decided on its own facts and we must determine the connotation of AMERICA'S in the specific mark AMERICA'S CAR COLLECTION and in connection with the goods and services herein. See *In re Nett Designs Inc.*, 236 F3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).⁶

The test for determining whether a mark or a portion thereof is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark or a portion thereof is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of

⁶ While the cited case involved the issue of likelihood of confusion, the principle is equally applicable herein.

guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We begin our analysis by noting that in connection with both grounds for refusal, the examining attorney contends that the phrase CAR COLLECTION is merely descriptive.⁷ Implicit in the examining attorney's Section 2(e)(1) refusal of AMERICA'S CAR COLLECTION vis-à-vis the identified publication, is the contention that the individual words, separately and together, are merely descriptive in connection with the magazine. With respect to the museum services identified in International Class 41, while the basis for refusal is under Section 2(e)(2), the examining attorney contends that "the addition of a generic or highly descriptive term [CAR COLLECTION] to a geographic term [AMERICA'S] does not obviate a determination of geographic descriptiveness" (brief, unnumbered p. 13 of 16).

We agree with the examining attorney that the phrase CAR COLLECTION is merely descriptive of a magazine featuring

⁷ During examination, the examining attorney's refusals and disclaimer requirements vary among the classes and among the goods within the classes. The examining attorney offers little explanation for these different positions and his reasoning remains a mystery to us. However, this inconsistency does not detract from his consistent position that CAR COLLECTION is merely descriptive in connection with the goods and services herein.

motor sports and museum services featuring automobiles. The phrase CAR COLLECTION merely describes a significant aspect of the goods and services, namely, that the subject matter of the magazine is cars and that the museum features a collection of cars.

However, as the Board stated in *In re Wisconsin Tissue Mills*, 173 USPQ 319, 320 (TTAB 1972):

It does not follow as a matter of law that because component words of a mark may be descriptive, the composite is unregistrable. The established rule is that a composite must be considered in its entirety and the question then is whether the entirety is merely descriptive. (citation omitted)

Further, the Office bears the burden of setting forth a prima facie case in support of a descriptiveness or a geographic descriptiveness refusal. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (When the Examining Attorney sets forth a prima facie case, the applicant cannot simply criticize the absence of additional evidence supporting the refusal and must come forward with evidence supporting its argument for registration).

Neither applicant nor the examining attorney dispute that "America" is defined as either the territory comprising the Western Hemisphere or the United States of America. But, as this word appears in the mark AMERICA'S CAR COLLECTION, the connotation of AMERICA'S and of AMERICA'S CAR COLLECTION is not so clear. We find that the possessive

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form of the word AMERICA in combination with the phrase CAR COLLECTION renders the mark as a whole somewhat vague and, therefore, suggestive at most. Therefore, in its entirety, the mark is neither merely descriptive in connection with the specified goods in International Class 16 nor primarily geographically descriptive in connection with the identified services in International Class 41.

However, in view of the merely descriptive nature of the phrase CAR COLLECTION, we affirm the refusal to register under Section 2(e)(1) in the absence of a disclaimer of CAR COLLECTION apart from the mark as a whole in connection with the goods and services identified in International Classes 16 and 41.

Decision: The refusal under Section 2(e)(2) of the Act is reversed. The refusal under Section 2(e)(1) of the Act is affirmed in the absence of a disclaimer of the merely descriptive phrase CAR COLLECTION. This affirmance of the Section 2(e)(1) refusal will be set aside and the mark forwarded for publication for opposition if applicant, no later than thirty days from the mailing date of this decision, submits an appropriate disclaimer of CAR COLLECTION. See, 15 U.S.C. §1056 and Trademark Rule 2.142(g), 37 C.F.R. 2.142(g).