

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

Hearing: February 2, 2012

Mailed: August 21, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MDF Italia SPA

Serial No. 79063250

Dean R. Karau for MDF Italia SPA.

Timothy J. Finnegan, Trademark Examining Attorney, Law
Office 104 (Chris Doninger, Managing Attorney).

Before Seeherman, Zervas and Greenbaum, Administrative
Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

MFD Italia SPA filed an application to register, on
the Principal Register, the mark MDF IT (stylized) shown
below



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for a variety of goods in International Classes 6, 16 and 21.¹

The description of the mark entered by applicant reads as follows:

The trademark consists of an almost quadrangular print having a red background, where the wording "MDF" is written in white, with the letter "M" forming a part of the border itself; on the lower right-hand side of the mark appears the wording "IT" in white, in small, fancy characters.

Applicant claims the colors red and white as a feature of the mark. In addition, applicant disclaimed MDF apart from the mark as shown.

The examining attorney refused registration under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), because the mark is primarily geographically descriptive of applicant's goods.

When the refusal was made final, applicant concurrently filed a request for reconsideration, which the examining attorney denied, and an appeal of the final refusal. The appeal is fully briefed, and an oral hearing was held. We reverse.

¹ The application is based upon a request for extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), and International Registration No. 0987876, issued August 5, 2008.

Section 2(e)(2) of the Trademark Act prohibits the registration of a mark which, when used on or in connection with the goods or services of an applicant, is primarily geographically descriptive of them. In order to establish that a mark is primarily geographically descriptive, the examining attorney must show that (1) the primary significance of the mark as it is used is a generally known geographic place; and (2) the relevant public would be likely to make a goods/place association, i.e., believe that the goods for which the mark is sought to be registered originate in that place. See *In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990); *In re Societe General des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1616 (TTAB 2007). If the goods do, in fact, originate from the place named in the mark, the requisite goods/place association can be presumed. *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998).

We turn our attention first to the question of whether the primary significance of the mark is that of a geographic location. In making this determination, we are mindful that a mark generally is not considered "primarily" geographic if it has a well-known meaning independent from

its geographical meaning. See *In re International Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000) (HOLLYWOOD not primarily geographic because of other prominent, significant meaning referring to entertainment industry); and *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455, 1456 (TTAB 1987) (primary significance of THE GREAT AMERICAN BASH suggests desirable quality or excellence, not geographic origin of services).

The examining attorney takes the position that applicant's mark is geographically descriptive because the designation IT in applicant's mark primarily denotes a geographic location, namely, Italy. The examining attorney points out that MDF, which has been disclaimed, is merely an acronym for the descriptive term medium density fiberboard, and would be recognized as such when used in connection with applicant's furniture and related goods.

Although the examining attorney has submitted evidence that IT is a recognized abbreviation for Italy,² the term IT, as used in applicant's mark, also has a significant, non-geographic meaning as the common pronoun "it". This meaning is reinforced by the manner in which IT is depicted in the mark, as lower case script letters. We note that

² See printout from www.acronymfinder.com attached to the January 12, 2009 Office action.

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the examining attorney came to a similar conclusion as to the pronoun meaning of IT when he initially withdrew the Section 2(e)(2) refusal (only to reinstate it following Office review). As the examining attorney stated in his August 3, 2009 note to the file, "the mark, at first impression, can be read as the double entendre 'MDF IT', that is, use medium density fiberboard for the applicant's goods, furniture."

In view of our finding that IT is not primarily a geographical term, we need not reach the question of whether the examining attorney has established a goods/place association between the term and the applied-for goods.

Accordingly, the refusal under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052 (e)(2), is reversed.