

This Opinion is not a
Precedent of the TTAB

Mailed: November 9, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Air New Zealand Ltd.

Serial No. 79192386

William J. Seiter of Seiter Legal Studio,
for Air New Zealand Ltd.

Ryan Cianci, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

Before Kuhlke, Shaw and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Air New Zealand Ltd. (“Applicant”), based in Auckland, New Zealand, seeks registration on the Principal Register of the mark **AIR NZ** (in standard characters, with “**AIR**” disclaimed) for airline-related travel services, specifically

Arranging and conducting incentive loyalty rewards programs to promote the sale of airline tickets; Membership privileges programs, namely, membership club services in the nature of providing discounts to members in the field of travel; Sales promotion of travel for others; Consumer loyalty services for commercial, promotional, and/or advertising purposes, namely, administration of frequent flyer programs that allows

members to redeem miles for points and artificial currency in International Class 35;

Airline transportation services; Shipping of goods and freight by air; passenger transport; provision of airport facilities, namely, airport services featuring transit lounge facilities for passenger relaxation; Travel agency services, namely, providing information about tariffs, timetables, and methods of transport for goods and people for travel purposes; Travel ticket reservation services; Travel ticket upgrade reservation services; Planning travel and transport via electronic contact and communication with customers, namely, providing a website for the arrangement and booking of travel; Booking travel and transport via electronic contact and communication with customers, namely, providing a website for the arrangement and booking of travel; Travel ticket reservation services for airline frequent flyer programs in International Class 39; and

Services relating to the provision of accommodation, namely, booking of temporary accommodation; Provision of temporary accommodation services, namely, making bookings and reservation for others for accommodations; Services for the booking and reserving of temporary accommodation, namely, providing online reservations and bookings for temporary accommodation in International Class 43.¹

The Trademark Examining Attorney initially refused registration of Applicant's mark on the ground that **AIR NZ** is primarily geographically descriptive of the identified services under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), stating, "The primary significance of 'NZ' is a generally known geographic location,

¹ Application Serial No. 79192386 was filed on February 18, 2016, seeking an extension of protection of International Registration No. 1310619 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f (Madrid Protocol).

Page references to the application record are to the .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal are to the Board's TTABVUE docket system.

namely, New Zealand. ... The applicant's address is in New Zealand and the applicant offers flights to and from New Zealand."² "Applicant is advised that, if the application is amended to seek registration on the Principal Register under Trademark Act Section 2(f), applicant will be required to disclaim "AIR" because such wording appears to be generic in the context of applicant's services."³ Applicant accordingly amended its application, disclaiming "AIR" and claiming that **AIR NZ** had acquired distinctiveness based on Applicant's ownership of the active prior registered mark **AIR NEW ZEALAND** for the same or related airline-related travel services.⁴ 15 U.S.C. § 1052(f).

The Examining Attorney refused to accept Applicant's prior registration as proof that **AIR NZ** had acquired distinctiveness, stating that, "[a] claim of acquired distinctiveness may be based on an applicant's ownership of one or more active prior registrations of the same mark on the Principal Register. 37 C.F.R. §2.41(a)(1); TMEP §1212.04." However, "[i]n the present case, the applied-for mark and the mark in the

² Sept. 30, 2016 Office Action TSDR p. 2.

³ *Id.* at 3.

⁴ March 6, 2017 Response to Office Action TSDR pp. 4, 9, 12, citing Reg. No. 4148227, issued on May 29, 2012 under Section 2(f), 15 U.S.C. § 1052(f), for "Airline transportation services; transportation and delivery of goods and people by air; storage of goods; providing information and data relating to the transportation of goods and people; tourist agency services, namely, arranging excursions for tourists; providing transportation information about tariffs, timetables and methods of transport for goods and people; arranging of tours and the operation of tourist offices; making reservations and bookings for airline transportation services via television, the Internet and electronic mail; all the aforesaid being in relation to airline services; reservation services for travelers, namely, travel and tour ticket reservation service" in International Class 39 and "Providing temporary accommodation, food and beverages; travel agency services, namely, making reservations for temporary accommodations and meals" in International Class 43. Combined declaration of use and incontestability under Sections 8 and 15 accepted and acknowledged on May 21, 2018.

prior registration are not the same mark, and thus are not legal equivalents, because while the acronym ‘NZ’ commonly refers to ‘New Zealand,’ it can also reference other terms.”⁵ Applicant pointed out the incongruity in stating that the primary significance of ‘NZ’ is New Zealand, but that **AIR NZ** does not convey the same commercial impression to the consuming public as **AIR NEW ZEALAND**.⁶ “[I]t is inconceivable that a consumer who comes across the Applicant’s mark ‘**AIR NZ**’ is going to think of any other airline besides ‘Air New Zealand’ or any other airline company besides the Applicant,” it stated.⁷

The Examining Attorney nonetheless maintained and made final the refusal to register on the ground that **AIR NZ** is primarily geographically descriptive of the identified services and has not acquired distinctiveness. When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. Primarily Geographically Descriptive

The Trademark Act provides that “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it-- ... [c]onsists of a mark which ... when used on or in connection with the goods of the applicant is primarily

⁵ March 28, 2017 Office Action TSDR p. 2.

⁶ July 17, 2017 Response to Office Action TSDR pp. 9-10.

⁷ *Id.* at 9.

geographically descriptive of them....” 15 U.S.C. § 1052(e)(2). Section three of the Act, 15 U.S.C. § 1053, extends this provision to service marks. *In re London & Edinburgh Ins. Grp. Ltd.*, 36 USPQ2d 1367, 1368 (TTAB 1995).

The test for determining whether a term is primarily geographically descriptive is whether (1) the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public, (2) the public would make an association between the goods or services and the place named in the mark, that is, believe that the goods or services for which the mark is sought to be registered originate in that place, and (3) the source of the goods or services is the geographic region named in the mark. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015) (citing *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987)). “The second prong, or services-place association, can be presumed when the services do in fact emanate from the place named in the mark.” *In re American Furniture Warehouse Co.*, 126 USPQ2d 1400, 1403 (TTAB 2018) (citing *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (“[W]here there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named by the term 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 goods or services come from the geographical place named in the mark.”)).

Here, it is clear that, absent acquired distinctiveness, **AIR NZ** is primarily geographically descriptive of Applicant’s airline/travel services. As the Examining

Attorney has established, the primary significance of ‘NZ’ is a generally known geographic location, namely, New Zealand.⁸ *See In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 246 (TTAB 1975) (“Nicknames and even maps and geographical abbreviations used as trademarks, have, over the years, been treated under the common law and statutory interpretation in the same manner as ordinary geographical marks.”). The second prong, of services-place association, can be presumed because Applicant’s address is in New Zealand and it offers flights to and from New Zealand.⁹ *See In re Chalk’s Int’l Airlines Inc.*, 21 USPQ2d 1637, 1639 (TTAB 1991) (“[I]t is not a coincidence that applicant selected ‘PARADISE ISLAND AIRLINES’ to identify its air transportation services to and from Paradise Island.”).

Applicant does not dispute these facts: “Regarding the term NZ, what the Examining Attorney said about it in his first office action was true: ‘The primary significance of “NZ” is a generally known geographic location, namely, New Zealand.’ He proffered very credible evidence from multiple sources in support of this fact.”¹⁰ Applicant’s addition of the disclaimed generic or highly descriptive term “AIR” for its airline-related services does not detract from the primary geographical significance

⁸ In support of this point, the Examining Attorney adduces evidence from the Acronym Finder, www.AcronymFinder.com/NZ 9/28/2016, showing that the first two meanings of “NZ” are New Zealand and Applicant’s airline code; Columbia Gazetteer of the World, www.ColumbiaGazetteer.org 9/28/2016, the Oxford Dictionary, www.OxfordDictionaries.com 9/28/3016, and Wikipedia, www.en.Wikipedia.org 9/28/2016, in which “NZ” redirects to the article on New Zealand. Sept. 30, 2016 Office Action TSDR pp. 11-15. *See also* Aug. 7, 2017 Office Action TSDR p. 3.

⁹ *See* Applicant’s listing of flight departures from cities in New Zealand, including Auckland, Christchurch, Dunedin, Queenstown, and Wellington. www.AirNewZealand.com 9/28/2016, Sept. 30, 2016 Office Action TSDR p. 16.

¹⁰ Applicant’s reply brief, 10 TTABVUE 5.

of the mark as a whole. *See In re Chalk's Int'l Airlines*, 21 USPQ2d at 1639 (“The addition of the generic and disclaimed word ‘AIRLINES’ to applicant’s mark cannot avoid the refusal.”) *cited in* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1210.02(c)(ii) (Oct. 2018). Moreover, because Applicant has made an unconditional claim of acquired distinctiveness under Section 2(f), it has effectively conceded that the proposed mark is primarily geographically descriptive. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of distinctiveness as an established fact.”); *see also Grand Canyon W. Ranch, LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1504 (TTAB 2008); TMPEP § 1212.02(b).

We find, then, that Applicant’s mark is primarily geographically descriptive of its services under Section 2(e)(2), and thus not registrable on the Principal Register absent proof of acquired distinctiveness.

II. Acquired Distinctiveness

A. Proving Acquired Distinctiveness

Section 2(f) of the Lanham Act provides, in part, that “nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f) *quoted in Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012). “Even though geographic terms are generally considered not to be inherently distinctive, they are capable of acquiring distinctiveness. *See, e.g., Boston Beer Co. v.*

Slesar Bros. Brewing Co., 9 F.3d 175, 28 USPQ2d 1778, 1783 (1st Cir. 1993) (“secondary meaning has been established in a geographically descriptive mark where the mark no longer causes the public to associate the goods [or services] with a particular place, but to associate the goods [or services] with a particular source.”)....”

In re Society of Health and Physical Educators, 127 USPQ2d 1584, 1588-89 (TTAB 2018) (collecting cases where primarily geographically descriptive terms acquired distinctiveness).

The burden of establishing that a mark has acquired distinctiveness is on the Applicant. See *Yamaha v. Hoshino Gakki Co.*, 6 USPQ2d at 1006; *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1199 (TTAB 2016). This burden increases with the degree of descriptiveness: the greater the degree of descriptiveness, the greater the burden. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, ___ F.3d ___, 128 USPQ2d 1370, 1378 (Fed. Cir. 2018); *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). This is because “[h]ighly descriptive terms ... are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source-indicators.” *Alcatraz Media, Inc. v. Watermark Cruises*, 107 USPQ2d 1750, 1767 (TTAB 2013) (quoting *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010)).

The issue of acquired distinctiveness is a question of fact. *In re Compagnie Generale Mar.*, 993 F.2d 841, 26 USPQ2d 1652, 1655 (Fed. Cir. 1993). The statute is

silent as to the evidence required under Section 2(f), except for suggesting that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence of acquired distinctiveness. 15 U.S.C. § 1052(f); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985). Trademark Rule 2.41 fills in this gap for trademarks and service marks, stating in relevant part that “[i]n appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.” 37 C.F.R. § 2.41(a)(1), *quoted in In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); *In re Olin Corp.*, 124 USPQ2d 1327, 1334 (TTAB 2017); TMEP § 1212.04.

B. The Applicant’s and Examining Attorney’s Arguments

As indicated, Applicant relies on this provision, claiming that **AIR NZ** has acquired distinctiveness based on Applicant’s ownership of active prior Registration No. 4148227 for the mark **AIR NEW ZEALAND**, essentially for airline services. That registration issued on May 29, 2012 based on acquired distinctiveness under Section 2(f); Applicant’s combined declaration of use and incontestability under Sections 8 and 15 was accepted and acknowledged in May 2018.¹¹ Applicant maintains that **AIR NEW ZEALAND** is the legal equivalent of **AIR NZ**.¹² “For purposes of Trademark

¹¹ See n. 4 supra.

¹² *Id.*

Rule 2.41(a)(1), the term ‘same mark’ does not mean identical mark,” Applicant contends. “A proposed mark is the ‘same mark’ as a previously registered mark if it is the ‘legal equivalent’ of such mark,” that is, “if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark.”¹³

In support of this claimed equivalence, Applicant alludes to evidence it adduced in its responses to Office Actions, and attaches copies of this previously-submitted evidence as exhibits to its main brief on appeal.¹⁴ The Board discourages the practice of attaching copies of evidence submitted during examination to appeal briefs. *See, e.g., In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015); TBMP § 1203.01 (June 2018). Nonetheless, the Examining Attorney does not object to these exhibits, and refers to them in his brief, so we shall give them due consideration. The exhibits consist of:

- A. Google® search engine summary of results indicating that a search for “NZ” yields the result “New Zealand.”¹⁵ For example:

¹³ Applicant’s brief, 7 TTABVUE 10, quoting *In re Dial-A-Mattress*, 57 USPQ2d at 1812.

¹⁴ 7 TTABVUE 20-135.

¹⁵ 7 TTABVUE 20-77.

nz - Google Search

The screenshot shows a Google search for 'nz'. The search bar contains 'nz' and the search button is visible. Below the search bar, there are tabs for 'All', 'Maps', 'News', 'Images', 'Videos', and 'More'. The search results show 'About 626,000,000 results (0.97 seconds)'. Under 'Top stories', there are three articles: 'Simon Wilson: Something has changed at Waitangi', 'New dawn at Waitangi', and 'Search resumes for teen swimmer missing off Christchurch beach'. To the right, there is a map of New Zealand with the New Zealand flag. Below the map, the title 'New Zealand' is followed by 'Country in Oceania'. A detailed description of New Zealand is provided, including its location, capital (Wellington), prime minister (Jacinda Ardern), population (4.693 million in 2016), and continent (Oceania). There is also a 'Plan a trip' section with a 'New Zealand travel guide' and a '12 h 50 min flight' duration. At the bottom, there are 'Points of interest' with images of Milford, Abel, Fiordland, and Tongariro.

nz

All Maps News Images Videos More

Settings Tools About 626,000,000 results (0.97 seconds)

Top stories

Simon Wilson: Something has changed at Waitangi

New dawn at Waitangi

Search resumes for teen swimmer missing off Christchurch beach

NZ Herald 6 hours ago

NZ Herald 6 hours ago

Stuff.co.nz 1 hour ago

More for nz

New Zealand - Wikipedia

https://en.wikipedia.org/wiki/New_Zealand

New Zealand is an island country in the southwestern Pacific Ocean. The country geographically comprises two main landmasses—the North Island and the South Island (or Te Waipounamu)—and around 600 smaller islands. New Zealand is situated some 1,500 kilometres (900 mi) east of Australia across the Tasman Sea ...

Jacinda Ardern · Auckland · Wellington · Patsy Reddy

Welcome to New Zealand | Official site for Tourism New Zealand | New ...

<https://www.newzealand.com/us/>

Welcome to New Zealand. Get official travel information, maps, itineraries, activities & accommodation to help you plan your next holiday to New Zealand.

New Zealand travel - Lonely Planet

<https://www.lonelyplanet.com/new-zealand>

Explore New Zealand holidays and discover the best time and places to visit. | Get ready for mammoth national parks, dynamic Māori culture, and world-class surfing and skiing. New Zealand can be mellow or action-packed, but it's always epic.

New Zealand

Country in Oceania

New Zealand is a country in the southwestern Pacific Ocean consisting of 2 main islands, both marked by volcanoes and glaciation. Capital Wellington, on the North Island, is home to Te Papa Tongarewa, the expansive national museum. Wellington's dramatic Mt. Victoria, along with the South Island's Fiordland and Southern Lakes, stood in for mythical Middle Earth in Peter Jackson's "Lord of the Rings" films.

Capital: Wellington

Prime minister: Jacinda Ardern

Population: 4.693 million (2016) World Bank

Continent: Oceania

Plan a trip

New Zealand travel guide

12 h 50 min flight

Points of interest View 15+ more

Milford Abel Fiordland Tongariro

<http://www.google.com/search?q=nz&oeq=nz&aq=chrome.6957985.13151098&sourceid=chrome&ie=UTF-8> [2/5/2018 2:37:31 PM]

B. Dictionary entries from seven online dictionaries, offered to show that the only definition of “NZ” is “New Zealand.” For example:

- Merriam-Webster “Definition of NZ “ New Zealand;
- Oxford Advanced American Dictionary: “NZ abbreviation – New Zealand”;
- Webster’s New World College Dictionary: “NZ in American or N Zeal – New Zealand”;
- Macmillan Dictionary: “N.Z. ... New Zealand”;

- Dictionary.com: “N.Z. or N. Zeal 1. New Zealand” (citing Random House Dictionary);¹⁷

Applicant likens this dictionary evidence to similar evidence adduced in *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712 (TTAB 2011) (finding “NKJV” substantially synonymous with the term “New King James Version” of the Bible).¹⁸

C. An Airline and Airport code search issued by the International Air Transport Association (IATA), the trade association for the world’s airlines, indicating that “NZ” is the airline code for Applicant “Air New Zealand Limited.”¹⁹

D-F. Webpages from Acronym.com indicating that “NZ” is the country code for the New Zealand Internet top level domain.²⁰

G. Country abbreviations issued by SustainableSources.com indicating that “NZ” denotes “New Zealand.”²¹

The Examining Attorney argues that the two marks, **AIR NZ** and **AIR NEW ZEALAND**, are not legal equivalents. Although he adduced evidence during the course of examination showing that “[t]he primary significance of ‘NZ’ is a generally known geographic location, namely, New Zealand,”²² that same evidence, he later stated, shows that “NZ” can have other meanings in other contexts:

¹⁷ 7 TTABVUE 80 -111.

¹⁸ 7 TTABVUE 14-15.

¹⁹ 7 TTABVUE 114-120.

²⁰ 7 TTABVUE 122-129.

²¹ 7 TTABVUE 134-135.

²² Aug. 7, 2017 Office Action TSDR p. 3.

[w]hile the acronym NZ commonly refers to New Zealand, it can also reference other terms and creates a different commercial impression. See attached evidence from the March 28th Office Action. Additionally, third-parties use NZ not to reference to New Zealand. An algebra book shows NZ means “not zero,” The Neutral Zone is an online store and uses NZ to reference its website, and Sporting Charts shows NZ is used to explain neutral zone starts.²³

The evidence the Examining Attorney submitted from AcronymFinder.com/NZ is as follows:

The screenshot shows the AcronymFinder website interface. At the top, there is a search bar with the text "What does NZ stand for?" and a subtext "Your abbreviation search returned 12 meanings". Below the search bar, there is a banner for ASUS ZenBook with the text "Your ZenBook. Your Moment. Windows multi-tasking: start fast and finish first." and a "Explore Now" button. Below the banner, there is a navigation bar with "G+1 0" and "Link/Page Citation". The main content area shows a list of results for "NZ" with columns for "Rank", "Abbr.", and "Meaning". The results are sorted alphabetically. The first result is "New Zealand" with a rank of 1 and 5 stars. Other results include "Air New Zealand Limited (IATA airline code)", "Neutral Zone", "Net Zero (internet service provider)", "Not Zero", "Neo-Zeon (gaming, Gundam World)", "Nachtzug (German :night train)", "NukeZone (game)", "National-Zeitung", and "Non-Infarcted Zone (also seen as NIZ)". At the bottom of the screenshot, there is a URL "http://www.acronymfinder.com/NZ.html" and a timestamp "2:45:36 PM 9/28/2016".

Rank	Abbr.	Meaning
1	NZ	New Zealand
2	NZ	Air New Zealand Limited (IATA airline code)
3	NZ	Neutral Zone
4	NZ	Net Zero (internet service provider)
5	NZ	Not Zero
6	NZ	Neo-Zeon (gaming, Gundam World)
7	NZ	Nachtzug (German :night train)
8	NZ	NukeZone (game)
9	NZ	National-Zeitung
10	NZ	Non-Infarcted Zone (also seen as NIZ)

²³ *Id.* at TSDR p. 4.

²⁴ Sept. 30, 2016 Office Action TSDR p. 11.

In his brief, though, the Examining Attorney focuses not on the evidence he submitted during the course of examination, but on minimizing the probative value of Applicant's evidence. Applicant's Google® search summary of results have minimal probative value, he contends, because they do not show the websites, which would show the term "NZ" in context.²⁵ See *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n. 4 (TTAB 2013). The IATA airline codes are irrelevant, he contends, because there is no proof that the code is displayed to airline travelers, and it is speculative to presume that these travelers would know that the IATA code for New Zealand is NZ.²⁶ Applicant has provided dictionary and acronym-defining evidence, as in *In re Nelson*, the Examining Attorney admits; but the applicant in *Nelson*, in addition to dictionary and acronym-defining evidence, provided declarations from corporate officers, retailers, and end consumers attesting that "NKJV" was substantially synonymous with the term "New King James Version." Here, the Examining Attorney argues, Applicant has provided no corollary evidence showing that consumers will interpret "NZ" as "NEW ZEALAND" when used in connection with airline services.²⁷ In the crowded airline industry, he asserts, it is common for service marks to feature similar terms that have the same connotation but are not legal equivalents, such as Air China and China Airlines, or Air Japan and Japan Airlines, or US Air and American Airlines. And Applicant's exhibit G, a screenshot showing a list of country

²⁵ Examining Attorney's brief, 9 TTABVUE 9.

²⁶ *Id.*, 9 TTABVUE 11.

²⁷ *Id.* 9 TTABVUE 11-12.

abbreviations from a webpage about green, environmentally sustainable building information, does not show how consumers will interpret “NZ” in connection with airline services.²⁸ Without evidence showing consumers will interpret “AIR NZ” as the equivalent of “AIR NEW ZEALAND” in connection with airline services, he concludes, it would be inappropriate to grant Applicant’s claim of acquired distinctiveness based on its prior registration.²⁹

In reply, Applicant notes: The Examining Attorney’s evidence adduced during the course of examination was so “skimpy, trivial and lacking in relevance” that he scarcely refers to it in his brief.³⁰ The Examining Attorney does not dispute that the services identified in the subject application are the same as or are related to those in its prior registration.³¹ The evidence the Examining Attorney submitted from AcronymFinder.com/NZ primarily defined “NZ” as New Zealand; and the remaining definitions were irrelevant to U.S. airline passengers.³² Applicant’s Google® search engine summaries have probative value, it contends, because they constitute evidence of public exposure. *See* TMEP § 1208.03.³³ The IATA airline code document states that “IATA codes are an integral part of the travel industry, and essential for the identification of an airline, its destinations and its traffic documents. They are also

²⁸ *Id.* 9 TTABVUE 11.

²⁹ *Id.*, 9 TTABVUE 12-13.

³⁰ Applicant’s reply brief, 10 TTABVUE 7.

³¹ *Id.*, 10 TTABVUE 9.

³² *Id.*, 10 TTABVUE 7-8.

³³ *Id.*, 10 TTABVUE 6.

fundamental to the smooth running of hundreds of electronic applications which have been built around these coding systems for passenger and cargo traffic purposes.”³⁴ Furthermore, Applicant’s dictionary and acronym-defining evidence establish that “NZ” has only one definition, “New Zealand,” in American English. Although this evidence was not as voluminous as that presented in *Nelson*, Applicant maintains that it has, on the whole, presented “extensive evidence” that the initialism means the country name.³⁵ The Examining Attorney’s assertion that similar airline names, such as “Air China and China Airlines,” are common in the airline industry is not supported by any evidence in his brief or his Office Actions, Applicant notes; and unlike the Examining Attorney’s examples, **AIR NZ** has the same structure as **AIR NEW ZEALAND**, with AIR preceding the country designation.³⁶ For these reasons, Applicant concludes, **AIR NZ** has acquired distinctiveness by virtue of its legal equivalence with *AIR NEW ZEALAND*, its prior active registration.

C. Analysis

As discussed above, Trademark Rule 2.41(a)(1), 37 C.F.R. § 2.41(a)(1), provides that the examining attorney may accept, as prima facie evidence of acquired distinctiveness, ownership by the applicant of one or more active prior registrations of the same mark on the Principal Register or under the Act of 1905. A proposed mark is the “same mark” as a previously registered mark for the purpose of 37 C.F.R. §

³⁴ *Id.*, 10 TTABVUE 12, quoting from 7 TTABVUE 118.

³⁵ *Id.*, 10 TTABVUE 10.

³⁶ *Id.*, 10 TTABVUE 4.

2.41(a)(1) if it is the “legal equivalent” of that mark. *In re Dial-A-Mattress*, 57 USPQ2d at 1812. “A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark.” *Id.*; see also *In re Society of Health and Physical Educators*, 127 USPQ2d at 1588. The goods or services identified in a prior registration must be “sufficiently similar” to those in an application to be accepted as prima facie evidence of distinctiveness. *In re Olin*, 124 USPQ2d at 1333-34.

Here, there is no dispute that the two marks are, or were, highly descriptive of those services—airline services emanating from New Zealand. So the burden of establishing acquired distinctiveness is commensurately high for Applicant. See *Grand Canyon W. Ranch v. Hualapai Tribe*, 88 USPQ2d at 1507 (finding that “GRAND CANYON WEST is highly descriptive of the identified services. Consequently, applicant faces a heavy burden in establishing acquired distinctiveness for the mark.”). Even so, Applicant’s prior registered mark, **AIR NEW ZEALAND**, registered six years ago under Section 2(f), based on acquired distinctiveness.³⁷

There is also no dispute that Applicant’s prior registration and current application recite essentially the same airline services, i.e., are “sufficiently similar.” The issue, then, is whether consumers of those same airline services would view **AIR NZ** as conveying the same, continuing commercial impression. We find that they would. “[N]icknames and even abbreviations and maps of geographical areas and the name

³⁷ Reg. No. 4148227, issued under Section 2(f), 15 U.S.C. § 1052(f),

of the geographical area that they identify are, for purposes of registration, **identical**, and ... the same criteria for registration must necessarily apply thereto.” *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 246 (TTAB 1975) (emphasis added); *see also In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1617 (TTAB 2007) (“It is well settled that a recognized nickname or other informal name for a geographic location is considered the **equivalent** of the official or formal name for purposes of determining registrability of the geographic term.”) (emphasis added).

The evidence adduced by both the Examining Attorney and Applicant establishes that “NZ,” as used in connection with Applicant’s services, means New Zealand. While the Examining Attorney’s evidence from AcronymFinder indicates other meanings in other contexts (such as “neutral zone” for hockey games or “non-infarcted zone” in medical settings)³⁸ the connotation of an abbreviation is determined in the context of its goods or services. *See, e.g., In re Nelson*, 97 USPQ2d at 1716. Here, Applicant’s applied-for mark would be viewed by consumers in the context of airline services—for example, airline advertisements, airline ticket counters, and airline baggage claim areas—not in the other contexts cited by the Examining Attorney. “That a term may have other meanings in different contexts is not controlling.” *In re Franklin County Historical Society*, 104 USPQ2d 1085, 1087 (TTAB 2012). Applicant’s evidence about the IATA NZ code designation does not, standing alone, show that NZ is displayed to airline customers, but it does show that the use of NZ as an airline code is exclusive to Applicant in the airline service industry. Applicant also submits seven definitions

³⁸ Sept. 30, 2016 Office Action TSDR p. 11.

from American English dictionaries indicating that “NZ” has only one definition: New Zealand. The Examining Attorney questions the strength of this evidence, compared with that in *Nelson*, but does not controvert Applicant’s dictionary evidence. Also as in *Nelson*, the Examining Attorney questions the probative value of Applicant’s citation to Google® search summaries for “NZ.” It is true that the use of search summaries has less probative value than full web pages, which would show more context, *In re Thomas Nelson*, 97 USPQ2d at 1715, but Applicant’s search summaries, such as the one displayed above,³⁹ display some content, and may be accorded limited probative value, to the extent that they show that “NZ” means “New Zealand.”

Furthermore, the consuming public would perceive both of Applicant’s marks, **AIR NEW ZEALAND** and **AIR NZ**, as a whole, in the context of airline services. “The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety” *In re Dial-A-Mattress*, 57 USPQ2d at 1811 (quoting *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920)). Taken as a whole, **AIR NZ** retains the same structure as **AIR NEW ZEALAND**, a structure consumers would tend to recognize and associate with Applicant. *Cf. Christian Broadcasting Network, Inc. v. ABS-CBN Int’l*, 84 USPQ2d 1560, 1566 (TTAB 2007) (same structure of initials recognizable). The Examining Attorney and Applicant dispute whether the term “AIR” in Applicant’s proposed mark is generic or

³⁹ 7 TTABVUE 20.

descriptive of airline services.⁴⁰ For our present purposes, however, the distinction makes no difference, “because even generic and descriptive matter may contribute to the commercial impression of a mark in certain circumstances.” *See In re Society of Health and Physical Educators*, 127 USPQ2d at 1587. And a “generic term may be included in the claim of acquired distinctiveness as long as an accompanying disclaimer of the generic term is provided.” *In re American Furniture Warehouse*, 126 USPQ2d at 1407. “AIR” is disclaimed in Applicant’s current application, just as it was in Applicant’s prior registration, but the consuming public is unaware of that disclaimer. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018). And given the consuming public’s penchant for shortening place names, *see In re South Park Cigar Inc.*, 82 USPQ2d 1507, 1512 (TTAB 2007), Applicant’s contraction of the country name NEW ZEALAND into the initialism NZ neither adds nor subtracts anything to or from the origin-indicating significance of AIR NEW ZEALAND. The relevant public would tend to view AIR NZ as a shorthand version of the original mark. *See In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) (finding applicant entitled to rely on six year old registered mark in support of claim of acquired distinctiveness; “It seems inescapable that persons exposed to applicant’s registered mark since 1966 would, upon encountering the instant mark when first used in 1972, be likely to accept it as the same mark or as an inconsequential modification or modernization thereof. In other words, the marks are, in effect, and would be recognized as one and the same mark.”).

⁴⁰ Examining Attorney’s brief, 9 TTABVUE 7, Applicant’s brief, 7 TTABVUE 3.

For these reasons, upon consideration of all of the relevant evidence and arguments, including those we have not mentioned, we find that **AIR NZ** is the legal equivalent of **AIR NEW ZEALAND**, and has acquired distinctiveness by virtue of Applicant's prior active registration of that mark. Because it has acquired distinctiveness, the mark **AIR NZ** no longer causes the public to associate the services with a particular place, but to associate them with a particular source: Applicant. *See In re Society of Health and Physical Educators*, 127 USPQ2d at 1588-89.

Decision: The refusal to register Applicant's mark **AIR NZ** under Section 2(e)(2) of the Trademark Act on the ground that the mark is primarily geographically descriptive is affirmed; the refusal on the ground that it has not acquired distinctiveness under Section 2(f) is reversed. The application will be published for opposition in due course.