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Subject: U.S. TRADEMARK APPLICATION NO. 85505335 - GUINEA - 218001 - EXAMINER BRIEF

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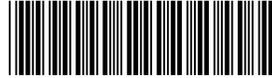
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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85505335

MARK: GUINEA



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** The East India Company Holdings Pte. Ltd

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

218001

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The East India Company Holdings Pte. Ltd., (applicant), a limited company existing under the laws of Singapore, has appealed the examining attorney's final refusal to register the mark GUINEA for use on "collectible coins made of precious metals and their alloys," in pertinent part. Registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the mark merely describes a feature or characteristic of the applicant's goods.

## STATEMENT OF FACTS

On December 29, 2011, the applicant applied to register the mark GUINEA under Sections 1(b) and 44(d) for use on “coins and medals made of precious metals and their alloys; precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; watches; clocks; horological and chronometric instruments.”

On January 10, 2012, the examining attorney refused registration on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because the applied-for mark merely describes a feature of the applicant’s goods. The examining attorney also required additional information about the goods, clarification of the identification of goods, a signed verification, and a copy of the foreign registration from the applicant’s country of origin when it became available.

The applicant responded on July 10, 2012, arguing that the mark is not descriptive, providing the requested information regarding the goods, amending the identification of goods, and providing a signed verification.

The examining attorney found the applicant’s arguments against the refusal unpersuasive, and on August 20, 2012, suspended action on the application pending receipt of a copy of the foreign

registration from the applicant's country of origin when it becomes available and maintaining the Section 2(e)(1) refusal and the requirement for clarification of the identification of goods.<sup>1</sup>

On June 9, 2015, the applicant submitted a copy of the foreign registration, and on July 7, 2015, the examining attorney issued a final refusal pursuant to Section 2(e)(1), limiting the refusal to "collectible coins made of precious metals and their alloys."<sup>2</sup>

On July 7, 2015, the applicant filed a notice of appeal, and on January 4, 2016, filed an appeal brief.

## ARGUMENTS

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d

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<sup>1</sup> The trademark examining attorney accepted the applicant's amended identification of goods filed January 26, 2013, to "collectible coins and medals made of precious metals and their alloys; precious metals and their alloys; precious metals and their alloys and goods in precious metals or coated therewith, namely, jewelry and precious stones, tie pins, tiaras, cufflinks, shirt pins, shirt studs and ear studs; jewellery, precious stones; watches; clocks; horological and chronometric instruments."

<sup>2</sup> In its response filed July 10, 2012, the applicant states, "Applicant's coins are non-monetary collectible coins. The coins are not incorporated into the design of applicant's goods. Applicant does not intend to deal in historical coins or repurpose historical coins as jewelry items [...]."

1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

The term “guinea” refers to a historical British coin. The applicant’s goods are identified as collectible coins, and the screen shot of the applicant’s website (<http://www.eicgold.com/>) attached to the final Office action dated July 7, 2015, clearly establishes that the applicant uses the applied-for mark on a collectible replica of the guinea coin.

#### 2015 One Guinea Gold Proof Coin

#### Product Overview

First minted in 1613, the Guinea is one of the world’s most famous coins, underpinning much of the growth and influence in the Colonies as The Company’s activities expanded. Now, once again the Guinea is at the very heart of The Company as this classically inspired modern interpretation is once again a legendary marque of trade and trust issued each year. This 2015 coin is strictly limited to just 500 pieces.

The evidence on the record consisting of screen shots from the websites of a collectible coin producer, a collectible coin broker and a consumer-to-consumer and business-to-consumer e-commerce

website where collectible coins are bought and sold demonstrates that guinea coins are collectible and of interest to coin collectors. For example, note the following:

- The last guinea was struck in 1813 and we have a selection of historic coins from the guinea family to delight our customers. <http://www.royalmint.com/our-coins/ranges/guinea>. Office action dated July 7, 2015, at 7.
- Consumers have collected coins since Renaissance times for various reasons, including artistic display, bullion value, and historical significance. British Guinea coins, in circulation between 1663 and 1813, provide consumers with all of these in their collecting. When looking to collect British Guinea coins, there are several factors consumers can use to evaluate the worth of the prospective addition to their collection. <http://www.ebay.co.uk/gds/What-to-Look-for-in-British-Guinea-Coins-/10000000178631529/g.html>. Office action dated July 7, 2015, at 12.

The applicant claims that the term “guinea” is an obscure term. Furthermore, the applicant contends that “given its historical obscurity, prospective American purchasers have no reason to associate the term ‘guinea’ with any descriptive meaning.” Applicant’s brief at 3. This argument lacks merit. Determining the descriptiveness of a mark is done in relation to an applicant’s goods, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a

mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

“Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods are, but “whether someone who knows what the goods and[/or] services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

In the context of collectible replicas of guinea coins being offered to the average purchasers of historic collectible coins (i.e., coin collectors), the significance of the term “guinea” is definite and clear. It immediately conveys knowledge that the collectible coin is a guinea coin. There is nothing mysterious or incongruous about the proposed mark in relation to the identified goods. The applied-for mark “GUINEA” merely describes the type of coin.

The applicant maintains that the proposed mark was registered by the European Union. Therefore, “if GUINEA can function as a distinctive trademark in the United Kingdom, it should be considered a distinctive mark in the United States as well.” Applicant’s brief at 4. This argument is unpersuasive. Although Section 44 exempts eligible applicants from the use requirements of Section 1 of the Trademark Act, Section 44 applicants must meet all other requirements for registration set forth

in the Trademark Act and relevant rules. Registration in a foreign country does not automatically ensure eligibility for registration in the United States. *In re Rath*, 402 F.3d 1207, 1214, 74 USPQ2d 1174, 1179 (Fed. Cir. 2005) ("[I]t is impossible to read section 44(e) to require the registration of foreign marks that fail to meet United States requirements for eligibility. Section 44 applications are subject to the section 2 bars to registration . . . ."); *In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *Order Sons of Italy in Am. v. Marofa S.A.*, 38 USPQ2d 1602 (TTAB 1996).

### CONCLUSION

Based on the record evidence and case law, the proposed mark is merely descriptive of a feature or characteristic of the applicant's goods. The examining attorney, therefore, respectfully requests that the Board affirm the refusal to register the mark on the Principal Register.

Respectfully submitted,

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