

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
Nov. 29, 2006

Mailed:  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Robert M. Pirnie

Serial No. 76555048

Theodore A. Breiner of Breiner & Breiner, L.L.C. for  
Robert M. Pirnie.

Toni Y. Hickey, Trademark Examining Attorney, Law Office  
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Grendel and Zervas, Administrative Trademark  
Judges.

Opinion by Grendel, Administrative Trademark Judge:

On October 29, 2003, applicant filed the above-  
captioned application, by which he seeks registration on  
the Principal Register of the mark **CONFERENCE AMERICA** (in  
standard character form) for services recited in the  
application (as amended) as:

promoting the use of telecommunication services  
through the administration of an incentive award

program; managing a secure telecommunications network for others, in Class 35;

telecommunications services, namely audio, video and data teleconferencing; streaming of audio and video material on the Internet, in Class 38; and

design and implementation of a secure telecommunications network for others and support services therefor, in Class 42.

The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and June 8, 1992 is alleged in the application to be the date of first use anywhere and the date of first use in commerce as to all three classes of services. In the application, applicant has claimed ownership of a prior registration, Reg. No. 1780600. Pursuant to the Trademark Examining Attorney's requirement, applicant has disclaimed the exclusive right to use CONFERENCE apart from the mark as shown.

At issue in this appeal are the Trademark Examining Attorney's final refusals to register applicant's mark on two grounds. First, she contends that applicant's mark is primarily geographically descriptive of applicant's services, and that it therefore is unregistrable under Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2), as to all three classes of services recited in the application. Second, she contends that the wording included in the Class 35 recitation of services which reads "managing a secure

telecommunications network for others" is unacceptable as indefinite, and that applicant has failed to comply with her requirement to satisfactorily amend such recitation of services. Trademark Act Section 1(a)(2), 15 U.S.C. §1051(a)(2); Trademark Rule 2.32(a)(6), 37 C.F.R. §2.32(a)(6).

The appeal is fully briefed, and an oral hearing was held at which applicant's attorney and the Trademark Examining Attorney presented arguments. After careful consideration of the evidence of record and the arguments of counsel, and for the reasons discussed below, we affirm both of the refusals at issue on appeal.

The evidence of record on appeal<sup>1</sup> consists of the file of the application, including applicant's specimen of use; various dictionary definitions of AMERICA; various dictionary definitions of CONFERENCE; numerous third-party registrations of marks containing the word AMERICA (submitted by both the Trademark Examining Attorney and by applicant); TESS printouts of three prior registrations

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<sup>1</sup> Applicant attached several items of evidence to its appeal brief which had not been made of record prior to appeal. Ordinarily, we would not consider this untimely evidence. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). However, because the Trademark Examining Attorney, in her appeal brief, has not objected to this evidence and indeed has presented arguments pertaining thereto, we shall consider the evidence despite its untimeliness. See *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999); TBMP §1207.03 (2d ed. rev. 2004).

owned by applicant;<sup>2</sup> printouts from applicant's website; and a printout of the results of a search of the Office's "Trademark Acceptable Identification of Goods & Services" Manual (hereinafter ID Manual) for the word "managing."

We turn first to the Trademark Examining Attorney's refusal to register applicant's mark on the ground that it is primarily geographically descriptive of applicant's services, and thus is unregistrable under Trademark Act Section 2(e)(2).

The test for determining whether a mark is primarily geographically descriptive is whether (1) the mark (or a portion thereof) is the name of a place known generally to the public, and (2) the public would make a goods/place or services/place association, that is, believe that the goods or services identified in the application originate in that place. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006); and *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001). If the goods do in fact originate from the place named in the mark, the requisite goods/place or services/place

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<sup>2</sup> Reg. Nos. 1780600, 3006875 and 3096912. The third of these registrations issued subsequent to the prosecution and briefing of this case. Applicant previously had submitted a printout of the then-pending application. We take judicial notice that the application has matured into the registration.

association can be presumed. See *In re Joint-Stock Co. "Baik"*, *supra*; *In re JT Tobacconists*, *supra*; *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1998); and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

We find, first, that the word AMERICA in applicant's mark is the name of a place known generally to the American public, i.e., the United States of America. The entry for "America" in The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000), made of record by the Trademark Examining Attorney, identifies "The United States" as the first or primary definition of "America." We note as well that in thirteen third-party registrations made of record by the Trademark Examining Attorney, all of which are of marks with the format "\_\_\_\_\_ AMERICA" and which cover telecommunications services or services related thereto, the word AMERICA has been disclaimed. Similarly, three of the third-party registrations submitted by applicant, which likewise have the format "\_\_\_\_\_ AMERICA," include disclaimers of AMERICA.

The record also shows (and applicant argues) that "America" may refer to North America or South America (which collectively are also known as "The Americas"). However, we find that the primary significance of AMERICA

to the American purchasing public, i.e., to Americans, is that of a shorthand way of referring to The United States of America. AMERICA is neither obscure nor remote.

Next, we find that the word CONFERENCE in applicant's mark is highly descriptive of (if not generic for) applicant's recited services in all three classes. First, we note that in the present application applicant has disclaimed the word CONFERENCE apart from the mark as shown, and that applicant likewise disclaimed CONFERENCE in its prior registration of the mark CONFERENCE AMERICA for "telephone communication services; namely, connecting telephone conferences for others" in Class 38.<sup>3</sup> Moreover, applicant's use of the word "conference" in the recitation of services in its prior registration is further evidence of the highly descriptive nature of the term.

Second, in applicant's specimen of use (which appears to be a printout of applicant's website's home page) applicant refers to itself as "Your **Conference** Calling Company," and includes the statement "Conference America is proudly celebrating 11 years of excellence in the **conferencing** industry." (Emphasis added.) Likewise, applicant's website (a printout of which was made of record

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<sup>3</sup> Registration No. 1780600, issued on July 6, 1993. (Exhibit 4 to applicant's main brief.)

by the Trademark Examining Attorney) is replete with descriptive uses of the word CONFERENCE (or forms thereof) in connection with applicant's services. Under the heading "Operator Assisted **Conferencing**," (emphasis added), the following text appears (emphasis added):

On our Operator Assisted dial out **conferences**, we will call the leader and all the participants for the **conference**. The leader can be placed into the **conference** first or last. If you would rather have everyone dial into the **conference**, we will assign a dial in number and passcode and have everyone greeted by an operator, identified and placed into their call.

Later on, the following text appears (emphasis added):

Whenever you are ready to have a **conference**, just dial your personal toll-free number, enter your passcode and start your call. ... We can even do notification calls reminding your participants of the upcoming **conference**. ... At the conclusion of the presentation, our operator opens the **conference** to all parties for questions or responses. ... Our Back Door Line service provides direct communication with the call operator without interfering with the meeting. You stay informed as to what is happening in the **conference**. ... Your **conference** call can be digitally saved and accessed afterwards for your review or for anyone you want to listen to it. Echo Replay **conferences** are available 24 hours a day, 7 days a week. ... We will remind your participants of an upcoming **conference** either by fax, email or voice. ... Provide us a list of your pre-assigned questions, and we will conduct a polling session during your **conference**. ... Let us help you manage your **conference**. ... At the conclusion of the presentation our operator opens the **conference** to all parties for a one-at-a-time

question and answer session. ... Let us pre-register your participants for your **conference** call. ... Ask for a recording of your **conference** when you schedule it and we will provide it to you in the format that you need... Need to have a translator on your **conference** call? Our Worldnet Voice provides translation for 148 different languages during the **conference**. ... Conference America has combined the power of the web with audio **conferencing** to let you see and hear your meeting. Web Echo delivers visual presentations over the web in combination with a standard **conference** call... The **conference** timer lets you start and stop at the best times to get your message out. ... How about having an audio broadcast of your **conference** over the web? ... Never before could you manage your **conferencing** costs as they occur...you can set up multiple levels of Secure passcode access to your **conferencing** bills. ... How would you like to be rewarded for running **conference** calls! Inquire today to learn more about Conference Club and how you can earn Conference Rewards.™

This evidence of applicant's own highly descriptive usage of CONFERENCE in connection with its services is strong evidence that the term is highly descriptive. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Third, the entry for "conference" in the New World Dictionary of the American Language (Second College Edition), made of record by applicant, includes the following pertinent definition of the word: "a formal meeting of a number of people for discussion or consultation." This definition of "conference" directly



applies to applicant's services, as is apparent from applicant's own usage of the word "conference" on its website, as quoted above, and in its recitation of services in its prior Registration No. 1780600. It is immaterial that there may be dictionary entries for "conference" which show other meanings of the word. Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

For these reasons, we find that CONFERENCE is highly descriptive of, if not generic for, applicant's recited services.

We next turn to the question of whether applicant's composite mark CONFERENCE AMERICA is primarily geographically descriptive.

Under the first prong of the test - whether the mark's primary significance is a generally known geographic location - a composite mark such as applicant's proposed mark must be evaluated as a whole. ... It is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.

*In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (internal citations omitted). In this regard, it is well settled that "the presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole." *In re JT Tobacconists, supra*, 59 USPQ2d at 1082; *See also In re Bacardi & Co. Ltd.*, 49 USPQ2d 1031 (TTAB 1997).

For the reasons discussed above, we find that the word AMERICA in applicant's mark is the name of a well known geographic place, and that the word CONFERENCE is highly descriptive of (if not generic for) applicant's services. In accordance with the authorities cited above, we further find that the presence of the highly descriptive word CONFERENCE in applicant's mark does not detract from the primary geographical significance of the mark as a whole.

Applicant contends that the primary significance of its mark is not that of a geographical place because the mark creates a double meaning or double entendre. Specifically, applicant contends that "the mark could be taken as a command for 'America' to 'conference.'" (Applicant's brief at 11.) We find this purported second

meaning of CONFERENCE AMERICA to be so nebulous and tenuous that it cannot be said to detract from the primarily geographic significance of the mark (assuming arguendo that it would be perceived or recognized by purchasers at all). Applicant's "double meaning" argument therefore is wholly unpersuasive.

In sum, we find under the first prong of the Section 2(e)(2) test that the primary significance of applicant's mark is that of a well known geographic place, i.e., America. We turn next to the second prong of the test, i.e., whether purchasers would make a services/place association between applicant's services and the place named in the mark.

Applicant's address of record is in Montgomery, Alabama. We take judicial notice that Montgomery, Alabama is located within and is part of the United States of America, also known as "America." Because applicant's services originate from the place named in the mark, we may presume that purchasers would make a services/place association between applicant's services and "America," a geographic location which is neither obscure nor remote. *See in re JT Tobacconists, supra; In re Chalk's International Airlines Inc., 21 USPQ2d 1637 (TTAB 1991); In re California Pizza Kitchen Inc., supra.*

Applicant has not presented evidence which suffices to rebut the presumption of a services/place association which arises from the fact that applicant is located in, and its services originate from, the place named in the mark. Applicant's arguments in support of its contention that purchasers would not make a services/place association are wholly unpersuasive.

For the reasons discussed above, we find that applicant's mark CONFERENCE AMERICA identifies a well known geographic location, and that purchasers would make a services/place association between applicant's services and the place named in the mark. Because both elements of the Section 2(e)(2) refusal have been established, we find that the Trademark Examining Attorney has established, prima facie, that applicant's mark is primarily geographically descriptive of applicant's services. Applicant's arguments to the contrary are not persuasive.

We also find that applicant has failed to rebut the Trademark Examining Attorney's prima facie case. Applicant relies on the fact that the Office, in 1993, issued a registration (Reg. No. 1780600) to applicant for the same mark, CONFERENCE AMERICA (CONFERENCE disclaimed), for related services, i.e., "telephone communication services; namely, connecting telephone conference calls for others."

As applicant acknowledges, however, we are not bound by the Office's previous decision to allow this mark to be registered. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). Nor do we regard the fact of the issuance of the prior registration to applicant to be evidence which suffices to rebut the clear evidence presented by the Trademark Examining Attorney in this case that the mark is primarily geographically descriptive.

We likewise find that the evidence in the record of third-party registrations involving AMERICA marks does not raise doubts or persuade us that applicant's mark is not primarily geographically descriptive. First, as noted above, the Office's issuance of these registrations is not binding upon us in this case. *In re Nett Designs Inc.*, *supra*. Second, we find that the third-party registrations in the record in fact support, rather than detract from, a finding that applicant's mark is unregistrable.

These third-party marks include: TELEDIAL AMERICA; TOUCH AMERICA; AIRTOUCH AMERICA; LATATEL DE AMERICA; IIJ AMERICA; MVP AMERICA; CLOSECALL AMERICA; CLOSE AMERICA; AZTECA AMERICA; LONG DISTANCE AMERICA (and design); TALK AMERICA; FAIRCALL AMERICA; BLANKET AMERICA; CROPLIFE

AMERICA; ROAD AMERICA; PARTY AMERICA and RESERVE AMERICA.

As noted above, most of these third-party registrations involving "\_\_\_\_\_ AMERICA" marks include disclaimers of AMERICA.

We note as well that with perhaps one or two exceptions, the first words appearing respectively in these third-party marks, unlike the word CONFERENCE in applicant's mark, are at best suggestive, and certainly not highly descriptive or even merely descriptive, of the goods or services identified in the respective registrations. In this regard, we note that applicant argues specifically that its CONFERENCE AMERICA mark is identical in structure to the above-listed registered TALK AMERICA mark,<sup>4</sup> and that if the latter mark was deemed to be registrable, it makes no sense to refuse registration of applicant's similarly-constructed mark. This argument is not persuasive. The word TALK in the TALK AMERICA mark is suggestive at most, not descriptive or generic like the word CONFERENCE in applicant's mark. We find, rather, that the registered third-party mark of record which is most similar to applicant's mark and thus most apposite in this case is the

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<sup>4</sup> Registration No. 2812827, of the mark TALK AMERICA (AMERICA disclaimed), for "telecommunications services, namely, telephone communication services, telecommunications services, namely, telephone communication services offered via a global communications network."

LONG DISTANCE AMERICA (and design) mark,<sup>5</sup> which combines a generic or highly descriptive term (LONG DISTANCE) with the word AMERICA, and in which all of the wording LONG DISTANCE AMERICA has been disclaimed.

Applicant argues that any doubts as to whether applicant's mark is primarily geographically descriptive must be resolved in applicant's favor, and that the Office's issuance of applicant's prior CONFERENCE AMERICA registration, as well as its issuance of some of the third-party registrations discussed above, suffice to raise doubts as to the registrability of applicant's mark. We do not agree. Based on the evidence submitted by the Trademark Examining Attorney and by applicant, and for the reasons discussed above, we conclude without any doubts that applicant's mark is primarily geographically descriptive and thus unregistrable.

Accordingly, we affirm the Trademark Examining Attorney's Section 2(e)(2) refusal.<sup>6</sup>

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<sup>5</sup> Registration No. 2690452, of the mark LONG DISTANCE AMERICA (and design; LONG DISTANCE AMERICA disclaimed) for various telecommunications services.

<sup>6</sup> At pages 8-9 of its reply brief, applicant states: "If the Board does not agree with applicant in this appeal, applicant may request remand of the application for amendment of the application under Section 2(f) of the Trademark Act." Such a request would be beyond the Board's jurisdiction, and is unlikely to be successful in any event. See TMEP §1501.06.

Finally, we turn to the second ground for refusal asserted by the Trademark Examining Attorney, i.e., the acceptability of applicant's Class 35 recitation of services insofar as they include "managing a secure telecommunications network for others." Trademark Act Section 1(a)(2), 15 U.S.C. §1051(a)(2), requires that the application for registration of a mark include "a specification of ... the goods in connection with which the mark is used..." Trademark Rule 2.32(a)(6), 37 C.F.R. §2.32(a)(6) requires that the application include "a list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark."

The Trademark Examining Attorney contends that the wording "managing a secure telecommunications network for others" in applicant's Class 35 recitation of services is unacceptably indefinite, and has refused registration in view of applicant's failure to submit an acceptable amended recitation.

Applicant, for its part, argues that this wording is identical to the wording "design and implementation of a secure telecommunications network for others" which appears in its Class 42 recitation of services in the present application and in two of opposer's three prior registrations (see *supra*), but for the substitution of the



word "managing" for the words "design and implementation of." Applicant contends that since "secure telecommunications network" apparently is acceptable to the Office, the purported unacceptability of its current recitation of services must reside in the word "managing." Applicant has submitted a printout from the Office's ID Manual which shows eleven instances in which the word "managing" appears in acceptable identifications of goods or services. Applicant argues that the word "managing" therefore should be deemed to be acceptable in its current recitation of services as well.

We have reviewed the printout from the Office's identification of goods and services manual submitted by applicant. We note that although the word "managing" appears in various contexts in connection with goods and services which are markedly different from applicant's services, the listing which is closest to applicant's services and thus the most apposite in this case is the listing for Class 35 "managing telecommunications networks for others, namely, managing telephone service for other carriers." This listing clearly suggests that "managing telecommunications networks for others," which is identical to the wording in question in applicant's recitation of services but for applicant's addition of the word "secure,"

is deemed to be unacceptable absent a further elucidation of what it is that applicant is "managing," preceded by the word "namely."

On this basis, we find that applicant's Class 35 recitation of services, insofar as it includes the wording "managing secure telecommunications networks for others," fails to identify the services with the degree of specificity and particularity required by Trademark Act Section 1(a)(2) and Trademark Rule 2.32(a)(6). We therefore agree with the Trademark Examining Attorney's contention that the recitation of services is unacceptably indefinite.

Decision: The refusal to register under Trademark Act Section 2(e)(2) as to all three classes of services recited in the application is **affirmed**. The refusal to register as to Class 35 based on applicant's failure to submit an acceptable recitation of services in that class is **affirmed**.