

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

Mailed: February 9, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Geskes

Serial No. 77911173

Mark B. Harrison and Michael E. Hall of Venable LLP for
Christoph Geskes.

Andrea R. Hack,¹ Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Kuhlke, Taylor and Wellington, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Christoph Geskes ("applicant") has filed an
application to register on the Principal Register the mark
THE MUNICH and design, shown below

THE MUNICH 

for goods ultimately identified as:

"Advertising; business management services; business
administration; office functions; forestry management

¹ A different examining attorney initially was responsible for
the application.

services; forestry management consultation" in International Class 35;

"Insurance and reinsurance agencies; insurance underwriting services for all types of insurance; reinsurance underwriting; insurance and reinsurance consultancy; insurance and reinsurance information; insurance and reinsurance subrogation; insurance and reinsurance brokerage; insurance and reinsurance actuarial services; insurance and reinsurance administration; insurance and reinsurance claims processing; consultation in the fields of insurance, reinsurance, insurance underwriting and reinsurance underwriting; consultation services in the fields of property insurance, casualty insurance, reinsurance, legal expenses insurance, liability insurance, life insurance, fire insurance, accident insurance, and health insurance as well as in the field of administration of insurance and reinsurance claims; financial affairs, namely, financial information, management and analysis services; financial advice; financial consultation; financial forecasting; financing services; financial research; consultation in the field of financial risk management; financial services, namely, consultation in finance management and planning; monetary exchange; acquisition and transfer of monetary claims; monetary strategy consultation and research; real estate consultation; real estate agencies; real estate appraisal; real estate brokerage; real estate listing; real estate financing services; real estate investment services" in International Class 36 and

"Medical and veterinary services; hygienic and beauty care for human beings; agricultural advice; forest habitat restoration" in International Class 44.²

² Application Serial No. 77911173 filed January 13, 2010, based on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), with a claim of priority under Section 44(d) of the of the Act, 15 U.S.C. § 44(d), based on a German application [and registration] number 302009058764, and an allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The application includes the following statements: "The mark consists of the wording 'THE MUNICH' to the left of three concentric semicircles, the innermost of which begins and ends on a horizontal axis, the next on a vertical

The examining attorney issued a final requirement that applicant disclaim the exclusive right to use the term "MUNICH" because it is geographically descriptive of the identified services.

Applicant appealed and the appeal is fully briefed. As discussed below, we affirm the refusal to register for applicant's failure to disclaim "MUNICH."

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act, 15 U.S.C. § 1056. Primarily geographically descriptive terms are unregistrable under Trademark Act Section 2(e)(2) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

A mark is considered to be primarily geographically descriptive if (1) it is the name of a place and this place is generally known to the public, and (2) the public would make a goods/place association, that is, believe that the

axis, and the outmost on a diagonal axis." "Color is not claimed as a feature of the mark."

Ser No. 77911173

goods or services for which the mark is sought to be registered originate in that place. See *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988). Where there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure or remote, a public association of the goods or service with the place may ordinarily be presumed from the fact that the applicant's own goods or services come from the geographical place named in the mark. *In re Harvey & Sons Ltd.*, 32 USPQ2d 1451 (TTAB 1994); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

It is the examining attorney's position that MUNICH is primarily geographically descriptive of applicant's identified services because "it is a generally known city in Germany, because applicant's services will originate in Munich, and because consumers will be likely to make a service-place association between the mark and the city." Br. unnumbered p. 6.

In support of the refusal, the examining attorney made of record a definition of Munich from YourDictionary.com (citing *The American Heritage*[®] *Dictionary of the English*

Language (4th ed. 2010)), of which we take judicial notice,³ and an excerpt from Wikipedia,⁴ showing that Munich is a well known city in Germany. The examining attorney also points to the prosecution history of the application where applicant "advises that the services will originate from Munich."⁵

The examining attorney also has made of record several definitions of "the," of which we additionally take judicial notice.

Based on the definition and Wikipedia excerpt of Munich of record, we find that the primary significance of MUNICH is geographic, and that the city of Munich is neither obscure nor remote. Further, as indicated, applicant's services originate from Munich. Accordingly, we presume a public association of applicant's services with Munich. Applicant notably does not dispute this.

Rather, in urging reversal of the disclaimer requirement and refusal to register based thereon,

³ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁴ First Office Action, issued April 15, 2010.

⁵ Applicant's August 17, 2010 response at p. 3.

applicant argues that a disclaimer is unwarranted in this case because the combination of THE and MUNICH results in an incongruity.

Specifically, applicant contends:

THE MUNICH is incongruous because in common usage the word *the* is a definite article that is not used before the names of cities. And, of course, "incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark." *In re Shutts*, 217 U.S.P.Q. 363, 364-65 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive).⁶

We take, in response to applicant's request, judicial notice of the definition of "incongruous," taken from the online version of the Encarta® World English Dictionary [North America Edition 2009]:⁷

1. **unsuitable or odd:** unsuitable or out of place in a specific setting.

⁶ Applicant's br. p. 3.

⁷ Found at <http://encarta.msn.com...>, and retrieved on March 31, 2011.

We also take judicial notice, as requested, of the definitions, taken from Webster's New World College Dictionary, pp. 186, 639 and 948, respectively, (4th ed. 1999), of: "Bronx" ("northern-most borough of New York City ... commonly called the Bronx"); "Hague" ("**The** city in W Netherlands..."); and "Munich" ("city in SE Germany"), which applicant made of record to traverse the examining attorney's argument regarding the placement of the article "the" before geographic locales. The examining attorney's argument is not well taken for the reasons explained by applicant, i.e., that when included, the definite article "the" is either a part of the actual place name or a common nickname.

As both applicant and the examining attorney aptly observe, if two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMER, the mark is unitary and disclaimer of nondistinctive individual elements is necessary." See TMEP § 1209. In this regard, the Board has noted that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" In re Shutts, *supra*; see also In re Vienna Sausage Mfg. Co., 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although "frank" may be synonymous with "wiener," and "wurst" synonymous with "sausage," the combination of the terms is incongruous and results in a mark that is not more than suggestive of the nature of the goods) and In re John H. Breck, Inc., 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the products).

At bottom, applicant's argument is whether the addition of the definite article "The" before the word

MUNICH in applicant's composite mark THE MUNICH, turns the unregistrable term MUNICH into a trademark. We find it does not. As discussed in a number of cases, the definite article "THE" has no source-indicating capacity when added to an otherwise descriptive term. See e.g., S.S. Kresge Company v. United Factory Outlet, Inc., [fed cite unavailable], 209 USPQ 924, 928 (D. Mass. 1980) ("The Mart" generic for retail stores; "The addition of the prefix 'The' as indicating a possible uniqueness cannot change the basic meaning of the term [Mart]"); The Conde Nast Publications Inc. v. Redbook Publishing Company, 217 USPQ 356, 357 (TTAB 1983) (THE MAGAZINE FOR YOUNG WOMEN generic for magazines; "the fact that the slogan also includes the article 'The' is insignificant. This word cannot service as an indication of origin.").

Here, contrary to applicant's assertion and unlike in the examples discussed above, the mere geographic descriptiveness is not eliminated by the placement of the definite article "THE" before the word MUNICH. That is, THE MUNICH considered as a whole is as primarily geographically descriptive as the term MUNICH when considered alone. As explained, the definite article "THE" simply has no inherent source-indicating significance, and combining it with MUNICH, albeit in a grammatically

incorrect manner, does not create a unique, incongruous or geographically non-descriptive term whose meaning would require some measure of imagination and "mental pause." We accordingly conclude that a disclaimer of "MUNICH" is necessary.

Decision: The refusal to register based on the requirement for a disclaimer of MUNICH is affirmed. However, if applicant submits the required disclaimer of MUNICH to the Board within thirty days of the mailing date of this decision, the decision will be set aside as to the affirmance of the disclaimer requirement.⁸ See Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g).

⁸ The standard printing format for the required disclaimer text is as follows: "No claim is made to the exclusive right to use MUNICH apart from the mark as shown." TMEP § 1213.08(a)(i) (8th ed. 2011).