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U.S. Application Serial No. 79236843

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EXAMINING ATTORNEY'S APPEAL BRIEF

International Registration No. 1413432

INTRODUCTION

Applicant, Altona Diagnostics GmbH, appeals the trademark examining attorney's final refusal to register the proposed mark, ALTONA, on the ground that it is primarily geographically descriptive within the meaning of §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2). It is respectfully requested that this refusal be affirmed.

PROCEDURAL HISTORY

Applicant applied to register the standard character mark ALTONA on the Principal Register under a Section 66(a) filing basis on July 19, 2018, in connection with goods in International Classes 1, 5, and 9 and services in International Class 42.

In the July 26, 2018, Office action, the Examining Attorney refused registration of the applied-for mark under Trademark Act Section 2(e)(2) on the ground that it is primarily geographically descriptive of the origin of applicant's goods and services. Applicant was advised that it may overcome the Section 2(e)(2) refusal if it established acquired distinctiveness under Section 2(f).

Applicant was also required to clarify the nature of the entity applying and to clarify the identification of goods and services slightly. Applicant subsequently satisfied both of these requirements.

In its February 11, 2019, response, Applicant argued against the Section 2(e)(2) refusal. Applicant made no claim of acquired distinctiveness under Section 2(f). The Section 2(e)(2) refusal was made final on February 28, 2019.

In its August 28, 2019, Request for Reconsideration, Applicant again argued against the Section 2(e)(2) refusal. Finding Applicant's arguments unpersuasive, the Examining Attorney denied Applicant's Request for Reconsideration. Applicant appeals the Examining Attorney's Section 2(e)(2) refusal. The Examining Attorney requests that the refusal be affirmed.

ARGUMENTS

Mark is primarily geographically descriptive under Section 2(e)(2)

The Section 2(e)(2) refusal should be affirmed because the applied-for mark is primarily geographically descriptive of the origin of applicant's goods and services. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); see TMEP §§1210, 1210.01(a).

A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods and services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place or services-place association; that is, purchasers would be likely to believe that the goods and services originate in the geographic place identified in the mark.

TMEP §1210.01(a); see *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014). Each of the three prongs are discussed, below.

The primary significance of the mark is a generally known geographic place

"Altona" is a municipality in the German city state of Hamburg with a population of approximately a quarter million people. Office action, July 26, 2018, TSDR 5; Denial of Request for Reconsideration, September 16, 2019, TSDR 42, 48, 90. Altona is a "major rail junction" and a "major port." Denial of

Request for Reconsideration, September 16, 2019, TSDR 2, 11. It has “a popular shopping district with plenty of restaurants” and “popular residential neighbourhoods.” *Id.* at 6. Altona has numerous accommodations, restaurants, museums, and other tourist attractions. *Id.* at 37-39, 53-89. Altona has a “host of well-functioning public transportation systems” and “can be an explorer’s paradise” for visitors. *Id.* at 37. Altona hosts the “bustling” 17-day “Altonale” street festival that is “the largest culture and street festival in Hamburg” and includes “international ... musicians.” *Id.* at 38, 97-98. Altona also hosts a cycling event that “attracts participants from across the world.” *Id.* at 38, 102-106. Due to its large number of tourist-friendly accommodations, attractions, restaurants, and events, combined with its extensive network of tourist-friendly modes of transportation, Altona identifies a large generally known geographic location with international appeal, including from the American public. *Id.* In light of the evidence of record, the primary significance of “Altona” is a known geographic location. *Id.*

The services originate in the geographic place identified in the mark

Applicant’s address of record is located in Altona, Germany. Specifically, Applicant’s address of record has the postal code of 22767. Application, July 19, 2018, TSDR 1. This postal code falls within Altona, Germany’s borders. Denial of Request for Reconsideration, September 16, 2019, TSDR 90. The map of applicant’s headquarters confirms that applicant is located in Altona, Germany. Office action, July 26, 2018, TSDR 12-13. Further, Applicant has never disputed that the goods and services originate in Altona.¹ Therefore, the goods and services for which applicant seeks registration originate in the geographic location identified in the mark.

¹ Applicant has, however, argued that the goods and services do not *solely* originate in Altona. Applicant’s Appeal Brief, November 18, 2019, TSDR 16. For an explanation why this argument is without merit, see the section entitled “Applicant’s arguments against the Section 2(e)(2) refusal are unpersuasive” below.

Purchasers would likely make the services-place association

When, as is the case here, there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, a public association of the goods and services with the place is presumed if an applicant's goods and services originate in the place named in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (holding DENVER WESTERNS primarily geographically descriptive of western-style shirts originating in Denver).

Even without this presumption, the evidence of record demonstrates that Americans would associate applicant's goods and services with Altona, Germany. Altona is known as an "industrial town" and is associated with chemical manufacturing, fish-processing, fisheries, and the machine-tool industry. Final refusal, February 28, 2019, TSDR 2-4. Applicant's goods and services specifically include "chemicals for use in industry" and "pharmaceutical and veterinary preparations" and "scientific apparatus and instruments for laboratory use" and related goods and services. Application, July 19, 2018, TSDR 1. Therefore, American consumers of these types of goods and services would associate applicant's chemical industrial manufacturing goods and services and related goods and services with Altona, Germany.

Because all three prongs have been met, the registration of the proposed mark was properly refused under Section 2(e)(2).

The procedural history of applicant's prior registration also supports the Section 2(e)(2) refusal

Applicant's prior registration for ALTONA DIAGNOSTICS [with design], U.S. Registration No. 5139471, also supports the Section 2(e)(2) refusal. Response to Office action, February 11, 2019, TSDR 1; Denial of Request for Reconsideration, September 16, 2019, TSDR 93-94. In applicant's prior registration, the wording "ALTONA DIAGNOSTICS" was disclaimed as primarily geographically descriptive. *Id.* The goods and services in applicant's prior registration are essentially identical to the *original* applied-for goods and services in applicant's current application, before applicant amended the identification slightly in accordance with the requirements set forth in the initial Office action. This is probative evidence that "ALTONA" is geographically descriptive in the current application. "The disclaimer of a term pursuant to a requirement by the Examining Attorney is a concession that the term is at best merely descriptive." *In re Contentment Found.*, 2019 TTAB LEXIS 244, *8 (Trademark Trial & App. Bd. July 2, 2019) citing *In re Pollio Dairy Prods. Corp.* 8 USPQ2d 2012, 2014 n.4 (TTAB 1988); *See also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (quoting *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992)); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006).

Applicant's arguments against the Section 2(e)(2) refusal are unpersuasive

Applicant argues that ALTONA is not primarily geographically descriptive, alleging that the word “Altona” does not have a dictionary definition” and that the evidence does not show that Altona is a generally known geographic location. Applicant’s Appeal Brief, November 18, 2019, TSDR 6, 10.

Applicant’s statement that “Altona” does not have a dictionary definition is belied by the numerous dictionary definitions attached to the record, including from Dictionary.com, Wikipedia.com, Britannica.com, Columbiagazetteer.org, Credoreference.com, Geonames.nga.mil, Getty Thesaurus of Geographic Names Online, and Worldatlas.com. Office action, July 26, 2018, TSDR 2, 5-10; Final refusal, February 28, 2019, TSDR 2-8; Denial of Request for Reconsideration, September 16, 2019, TSDR 2, 47-48. The evidence of record makes clear that Altona is a generally known geographic location in Germany.

Applicant further argues that because “the term ‘altona’ or ‘altoona’ is associated with [other] locations” and that “850 Altona is a minor planet in the Solar System,” it cannot be primarily merely geographic under Section 2(e)(2). Applicant’s Brief, November 18, 2019, TSDR 13-14.

The only evidence in the record in support of Applicant’s claim that “Altona” and “Altoona” has other meanings in other contexts is a series of Wikipedia entries. Applicant’s Request for Reconsideration, August 28, 2019, TSDR 9-45. However, there are “inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries.” TMEP 710.01(b). “As recommended by the editors of Wikipedia, the information in a particular article should be corroborated.” *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). Applicant has provided no corroborating evidence.

But even assuming for the sake of argument that the uncorroborated Wikipedia evidence is reliable, Applicant's evidence does not support its argument. At the outset, Applicant has not explained how the existence of "Altoona, Pennsylvania" bears on the geographical significance of ALTONA, given that these are different words with different commercial impressions. Applicant's Request for Reconsideration, August 28, 2019, TSDR 11. Additionally, the Wikipedia evidence does not refute the fact that the primary significance of the mark is a generally known geographic place in Hamburg, Germany. Indeed, the Wikipedia entries for "850 Altona" and "Altona, New York" and "Altona, Victoria" each explain that these places were in fact all named after Altona, Hamburg in Germany. The article on "850 Altona" states: "It is named after Altona, Hamburg, the location of the Altona Observatory"; the article on "Altona, New York" states: "The town was named after the Altona, Hamburg, district of Germany"; and the article on "Altona, Victoria" states that it "takes its name from the then independent German city of Altona." Applicant's Request for Reconsideration, August 28, 2019, TSDR 9, 30, and 33. Moreover, Altona, New York – the only U.S. location for which applicant included a Wikipedia entry – is a small, relatively unknown town having fewer than 3000 people. Request for Reconsideration, August 28, 2019, TSDR 30. This Wikipedia evidence does not obviate the fact that the primary significance of the mark is a generally known geographic location in Germany.

Further, Applicant's assertion that "850 Altona" is a "minor planet in the solar system" bears little relevance here; if the most prominent meaning or significance of a mark is geographic for the goods and services in the application, the fact that the mark may have other meanings in other contexts does not alter its geographic significance in the context of the application. *See In re Opryland USA Inc.*, 1 USPQ2d 1409, 1412-13 (TTAB 1986) (holding the mark THE NASHVILLE NETWORK primarily geographically descriptive of television program production and distribution services where finding that the primary

significance of the term referred to Nashville, Tennessee and not that of a style of music); TMEP §1210.02(b)(i).

Applicant next argues that, in accordance with *In re California Innovations*, 329 F.3d 1334 (Fed. Cir. 2003), Applicant's mark is not geographically descriptive because there is no showing that the "goods-place (service-place) association made by the consumer is material to the consumer's decision to purchase those goods." Applicant's Appeal Brief, November 18, 2019, TSDR 14-17. The *California Innovations* case, however, dealt with a refusal under Section 2(e)(3) – that is, a refusal based on the mark being primarily geographically deceptively misdescriptive. The present application was refused under Section 2(e)(2) – that is, a refusal based on the mark being primarily geographically descriptive. The prima facie case for establishing that a mark is primarily geographically descriptive under Section 2(e)(2) is different from the prima facie case for establishing that a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) precisely because a Section 2(e)(2) refusal requires no showing of materiality. *Id.* Applicant's reliance on *California Innovations* is therefore inapt.

Applicant repeatedly argues that the U.S. consuming public would not make a goods-place or services-place association between Altona, Germany and the particular applied-for goods and services Applicant provides. In support of this argument, Applicant cites *In re Newbridge Cutlery Co.*, 776 F.3d 854 USPQ2d 1445 (Fed. Cir. 2015), in which the court found the evidence insufficient to establish that Newbridge, Ireland is a place known generally to the relevant American public. *Newbridge* is distinguishable, however. Newbridge, Ireland is a small town of fewer than 20,000 people. *Id.* at 862. Altona, Germany, on the other hand, has approximately 250,000 people. Office action, July 26, 2018, TSDR 5; Denial of Request for Reconsideration, September 16, 2019, TSDR 42, 48, 90. Newbridge, Ireland is small enough

that it went unlisted in certain maps and atlases of record. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 863. In contrast, there is no evidence of Altona being unlisted on any maps or atlases; indeed, the evidence of record makes clear that Altona, Germany is a well-known geographic location. Office action, July 26, 2018, TSDR 5; Denial of Request for Reconsideration, September 16, 2019, TSDR 2, 6, 11, 28, 37-39, 42, 48, 53-90, 97-98, 102-106. Applicant in *Newbridge* also provided evidence that “Newbridge” has “other meanings, both geographical and non-geographical” making it less likely that Newbridge is a generally known geographic location. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 863. In contrast, as explained above, the only evidence suggesting that “Altona” has any meaning beyond that of a geographic location in Germany is a series of not only uncorroborated but also unpersuasive Wikipedia articles. Further, whereas the relied-upon evidence in *Newbridge* was sparse, the current evidence of record is varied and ample. *In re Newbridge Cutlery Co.*, 776 F.3d at 863. *Newbridge* is therefore readily distinguishable. Because the primary significance of Altona is geographic, and Altona, Germany is “neither obscure nor remote,” and because applicant’s goods and services originate from Altona, Germany, a public association of the goods and services is presumed. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988).

Applicant also argues that the refusal is not warranted because applicant’s goods and services “do not originate solely from a single location in Germany.” Applicant’s Appeal Brief, November 18, 2019, TSDR 9-13. However, when the goods or services may be said to originate both in the geographic place named in the mark and outside that place, registration will normally be refused on the ground that the mark is primarily geographically descriptive under Section 2(e)(2). *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 n.2 (TTAB 1988). There is no requirement that applicant’s goods and services originate “solely” from Altona, Germany for the mark to be geographically descriptive. *Id.*

Lastly, applicant argues that any doubt should be resolved in favor of applicant. Applicant's Appeal Brief, November 18, 2019, TSDR 18. Here, however, the evidence of record leaves no doubt that the mark is primarily geographically descriptive.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of §2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), for the reason that the mark is primarily geographically descriptive, should be affirmed.

Respectfully submitted,

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