

This Opinion is not a
Precedent of the TTAB

Mailed: August 10, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re The East India Company Holdings Pte. Ltd.
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Serial No. 85505335
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Douglas N. Masters and Melaina D. Jobs of Loeb & Loeb LLC
for The East India Company Holdings Pte. Ltd.

Maria-Victoria Suarez, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Kuhlke, Masiello, and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

The East India Company Holdings Pte. Ltd. (“Applicant”) seeks registration on
the Principal Register of the mark GUINEA in standard characters for, as amended:

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, in International Class 14.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that Applicant's mark is merely descriptive. In the Office Action dated July 7, 2015, the refusal was restricted to "collectible coins made of precious metals & their alloys." When the refusal was made final, Applicant appealed. We affirm the refusal to register.

I. Discussion.

A mark is merely descriptive of goods within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the mark is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, we evaluate whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). A mark need not immediately convey an idea of

¹ Application Serial No. 85505335 was filed on December 29, 2011, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Sections 1(b) and 44(d) of the Trademark Act.

each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). The determination that a mark is merely descriptive is a finding of fact and must be based upon substantial evidence. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

It is the Examining Attorney's burden to show, *prima facie*, that a mark is merely descriptive of an applicant's goods or services. *In re Gyulay*, 3 USPQ2d at 1010; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012).

Applicant's goods are "collectible coins," in connection with which Applicant intends to use the mark "GUINEA." A "guinea" is defined as "a gold coin issued in England from 1663 to 1813 and worth one pound and one shilling."² As discussed more fully below, the Examining Attorney has shown that one of Applicant's products is a collectible replica of the historic guinea. Applicant's webpage located at: www.eicgold.com/goldcollection/2015-one-guinea-gold-proof/coin/, Office Action dated July 7, 2015 at p.25. While acknowledging the meaning of the term, Applicant argues that the Examining Attorney has not made her case because "the term 'guinea' is an obscure foreign term and therefore not descriptive of Applicant's goods." Appeal Brief, 4 TTABVUE 4. We disagree.

² Definition from Yahoo! Education (<http://education.yahoo.com/reference/dictionary/entry/guinea>), Exhibit to Office Action dated January 10, 2012.

Applicant argues that it “has been over 200 years since [guineas] circulated in England and the guinea coinage was never circulated in the United States.” *Id.* Applicant buttresses its argument by asserting that “the Examiner relies almost exclusively on foreign websites rather than U.S. websites to explain what the term ‘guinea’ means.”³ *Id.* at 6. For that reason Applicant concludes that “the term is obscure and not relevant to American consumers.” *Id.* Applicant’s argument is not persuasive, particularly since the relevant American consumers of “collectible coins” are coin collectors, not the general public.

Further, while the guinea may not have been issued after 1813, the Examining Attorney has established that

[e]ven after the coin ceased to circulate, the name *guinea* was long used to indicate the amount of 21 shillings (£1.05 in decimalised currency). The guinea had an aristocratic overtone; professional fees and payment for land, horses, art, bespoke tailoring, furniture and other luxury items were often quoted in guineas until a couple of years after decimalisation in 1971. It was similarly used in Australia until that country went to decimal currency in 1966.⁴

³ The evidence introduced by the Examining Attorney includes webpages from four websites. While relevant, we have not relied on two of the sites that are clearly United Kingdom sites with .UK URLs. We have, however, relied on Applicant’s own website, located at www.eicgold.com/goldcollection/2015-one-guinea-gold-proof/coin and on an article appearing in Wikipedia, located at [https://en.wikipedia.org/wiki/Guinea_\(British_coin\)](https://en.wikipedia.org/wiki/Guinea_(British_coin)). Both are exhibits to the Office Action dated July 7, 2015 and are discussed below.

⁴ Wikipedia article, “*Guinea (British coin)*”, which discusses the history of the British guinea; [https://en.wikipedia.org/wiki/Guinea_\(British_coin\)](https://en.wikipedia.org/wiki/Guinea_(British_coin)), *id.*, at TSDR p.7.

Moreover, in the product overview for its “2015 One Guinea Gold Proof Coin”, set forth below,⁵ Applicant admits that “the Guinea is one of the world’s most famous coins:”

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

Specification

Shipping

Applicant’s website, in and of itself, is sufficient to establish that the term “guinea” would immediately convey to the relevant purchasers, coin collectors, that the type of collectible coin being offered by Applicant is a guinea or replica thereof. Accordingly, we find Applicant’s mark to be merely descriptive of its “collectible coins made of precious metals & their alloys.”

Applicant’s ownership of a European Union registration does not affect our finding. While Applicant’s European Union registration provided Applicant with a statutory basis for filing its application in the United States, once filed, the application must meet the eligibility requirements for registration. *See In re Rath*, 403 F3d 1207, 74 USPQ2d 1175 (Fed. Cir. 2005) (The legislative history of Section 44

⁵ Applicant’s webpage located at: www.eicgold.com/goldcollection/2015-one-guinea-gold-proof/coin/, *id.* at p.25.

of the Trademark Act “confirms that [while registration on] the principal register was available to foreign registrants and United States citizens on equal terms—both had to meet the eligibility requirements of United States law.”)

Decision: The refusal to register Applicant’s mark GUINEA is affirmed as to “collectible coins made of precious metals & their alloys” and the application will proceed with the remaining goods.