

This Opinion is Not a
Precedent of the TTAB

Mailed: August 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Robert J. Olejar
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Serial No. 86302887
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Robert J. Olejar, *pro se*.

Elissa Garber Kon, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Seeherman, Hightower, and Heasley,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Robert J. Olejar (“Applicant”) seeks registration on the Principal Register of the
mark AMERICAN BARRISTER (in standard characters) for the following services in

International Class 45:

Alternative dispute resolution services; Arbitration services;
Attorney services; Expert witness services in legal matters in
the field of fraud, forensic accounting, money laundering,
financial accounting, and legal damages; Legal consultation
services; Legal document preparation services; Legal
research; Legal services; Litigation consultancy; Litigation
services; Litigation support services; Mediation; News
reporting and expert legal commentary services in the field of
legal news; On-site legal services; Online news reporting and
expert legal commentary services in the field of legal news;

Providing information relating to legal affairs; Providing information, news and commentary in the field of law; Providing on-line information and news in the field of law.¹

The Examining Attorney has refused registration of Applicant's proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of the identified services, and under Section 2(e)(2) of the Act, 15 U.S.C. § 1052(e)(2), on the ground that it is primarily geographically descriptive of Applicant's services.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal as to both grounds.

I. Dual Grounds for Refusal

At the outset, we note that the refusal was not made on the two different grounds in the alternative. Section 2(e)(2) of the Trademark Act states that refusal is appropriate under that subsection only when a term is *primarily* geographically descriptive. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448 (Fed. Cir. 2015) ("*Newbridge*") ("Under the statute, it is clear that refusal to register extends under both subsections (e)(2) and (e)(3) only to those marks for which the geographical meaning is perceived by the relevant public as the *primary* meaning . . ."). If the primary significance of a proposed mark is a location describing the geographic origin of an applicant's goods or services, it is highly unlikely that it

¹ Application Serial No. 86302887 was filed on June 6, 2014, based on Applicant's claim of first use anywhere since August 24, 2013, and use in commerce since April 1, 2014. Applicant is an individual from New Jersey.

simultaneously would be merely descriptive of those goods or services themselves under Section 2(e)(1).

Section 1210.02(b)(iii) of the Trademark Manual of Examining Procedure (TMPEP) (April 2016) instructs that: “In rare circumstances, it may be unclear whether the primary significance of the term is geographic or merely descriptive or deceptively misdescriptive. In such cases, the examining attorney may refuse registration on both grounds, in the alternative.” We agree that it is preferable that such refusals are made in the alternative, and proceed to analyze each basis for refusal as though it had been made in the alternative.

II. Whether AMERICAN BARRISTER Is Merely Descriptive of Applicant’s Identified Services

A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *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, 1009 (Fed. Cir. 1987). A suggestive mark, on the other hand, requires imagination, thought and perception to reach a conclusion as to the nature of the goods or services. *StonCor Group, Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014); *see also In re Tennis in the Round*, 199 USPQ 496, 498 (TTAB 1978) (“[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.”).

Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). Rather, descriptiveness determinations are made in relation to an applicant's identified goods or services, the context in which the proposed mark is being used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use. *Chamber of Commerce*, 102 USPQ2d at 1219.

Applicant seeks to register AMERICAN BARRISTER for various services in the legal field. In dictionary evidence of record, definitions of "American" include "Of or relating to the United States of America or its people, language, or culture."² "Barrister," in turn, is defined as "a lawyer in England or Wales who is allowed to speak in the higher law courts."³ There is no record evidence that the term "barrister" has a descriptive meaning in association with legal services rendered in the United States; to the contrary, according to the evidence of record, by definition such services are provided by a barrister only in England and Wales.

Because there is no evidence that legal services are rendered by "barristers" in the United States, we find that the phrase AMERICAN BARRISTER, considered as a whole, presents an incongruity that renders the mark suggestive. At least some imagination, thought, or perception is required to deduce what service characteristics the term indicates: that Applicant is an American lawyer offering legal services in

² April 24, 2015 Final Office Action at 99-100, THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2014) (ahdictionary.com).

³ September 19, 2014 Office Action at 23-24, American English definition from the online English dictionary from Macmillan Publishers Ltd. (2014) (macmillandictionary.com).

the United States who also is qualified as a barrister in Great Britain.⁴ *See, e.g., In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983) (holding SNO-RAKE not merely descriptive for a snow removal tool, and stating: “The concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and 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’.”).

Considering the record as a whole, we find that Applicant’s mark is not merely descriptive of the services recited in the application under Trademark Act Section 2(e)(1).

III. Whether AMERICAN BARRISTER Is Primarily Geographically Descriptive

Turning to the second ground for refusal, the test for determining whether a term is primarily geographically descriptive is whether:

- 1) the mark sought to be registered (or a portion thereof) is the name of a place generally known to the public,
- 2) the public would make an association between the goods or services and the place named in the mark, that is, believe that the goods or services for which the mark is sought to be registered originate in that place, and
- 3) the source of the goods or services is the geographic region named in the mark.

⁴ *See* Applicant’s specimens of use and November 9, 2015 Reconsideration Letter at 68-69, 74-75 (printouts of pages from Applicant’s website americanbarrister.net), which indicate that Applicant is both a barrister and an attorney at law.

Newbridge, 113 USPQ2d at 1448-49; *see also In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). The relevant public is the purchasing public in the United States of the types of goods or services identified in the application. *Newbridge*, 113 USPQ2d at 1449.

TMEP § 1210.02(b)(iv) points out that marks incorporating the word AMERICAN, such as the mark before us, may present a special challenge:

When terms such as “AMERICA,” “AMERICAN,” and “USA” appear in marks, determining whether the term or the entire mark should be considered geographic can be particularly difficult. There is no simple or mechanical answer to the question of how to treat “AMERICA” or “AMERICAN” in a mark. The examining attorney must evaluate each mark on a case-by-case basis. The examining attorney must consider the entire context, the type of goods or services at issue, the geographic origin of the goods or services and, most importantly, the overall commercial impression engendered by the mark at issue. . . . The introduction of a nuance, even a subtle one, may remove a mark from the primarily geographically descriptive category.

If the term is used in a way that primarily denotes the United States as the origin of the goods or services, then it is primarily geographically descriptive. *See American Diabetes Ass’n, Inc. v. Nat’l Diabetes Ass’n*, 533 F. Supp. 16, 214 USPQ 231, 233 (E.D. Pa. 1981), *aff’d*, 681 F.2d 804 (3d Cir. 1982); *In re Monograms America Inc.*, 51 USPQ2d 1317 (TTAB 1999) (MONOGRAMS AMERICA for embroidery stores). Conversely, if a composite mark does not primarily convey geographic significance overall, or if AMERICA or AMERICAN is used in a nebulous or suggestive manner, then it is not primarily geographically descriptive. *See, e.g., In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (holding THE GREAT AMERICAN BASH not primarily geographically descriptive for professional wrestling matches

because the phrase GREAT AMERICAN suggests something of desirable quality or excellence); *cf. Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251 (1916) (holding THE AMERICAN GIRL not primarily geographically descriptive for shoes).

Here, there is no question that the third prong of the test for geographic descriptiveness is satisfied. Applicant, an attorney from New Jersey, is applying to register the mark AMERICAN BARRISTER for legal services that are rendered in the United States. Thus, the source of the services is the geographic region identified in the mark. Nonetheless:

The mere fact that a mark contains a geographical term, even one which is well known and which names the geographical area from which the goods or services originate, does not automatically render the mark unregistrable under Section 2(e)(2). As always, a mark must be considered in the context of its use and the meaning it would have for the relevant public when so used.

In re Jim Crockett Promotions Inc., 5 USPQ2d at 1456.

As part of Applicant's mark, consumers likely will perceive "American" to refer primarily to a personal characteristic rather than to the geographic location per se. Moreover, barristers have no role in the American legal system. Thus, when we consider the incongruity of the overall commercial impression engendered by the composite mark as a whole in this context, we are not persuaded that the public is likely to make an association between the services and the place named in the mark, that is, believe that legal services offered under the mark AMERICAN BARRISTER originate in the United States. *Cf. In re Sharky's Drygoods Co.*, 23 USPQ2d 1061, 1062 (TTAB 1992) (reversing deceptiveness refusal of PARIS BEACH CLUB for T-shirts and sweatshirts because the juxtaposition of PARIS with BEACH CLUB

results in an incongruous phrase such that the word PARIS in the mark signifies a facetious rather than geographic reference). For these reasons, the mark does not primarily convey the geographic origin of Applicant's services.

The Examining Attorney made of record a number of third-party registrations for legal and other services in which AMERICAN is disclaimed, or the registration is on the Supplemental Register or issued pursuant to a claim of acquired distinctiveness under Trademark Act Section 2(f). None of those registrations, however, presents the special circumstance we have here, in which AMERICAN is combined with a term denoting services that by definition are unavailable in the United States. In any event, we note once again that each case must be decided on its own facts, particularly for marks comprising the terms AMERICA or AMERICAN.

We find that AMERICAN BARRISTER is not primarily geographically descriptive for Applicant's identified services under Trademark Act Section 2(e)(2).

Decision: The refusal to register Applicant's mark AMERICAN BARRISTER is reversed on both alternative grounds.