

This Opinion is Not a  
Precedent of the TTAB

Mailed: January 11, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

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*In re American Airlines, Inc.*

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Serial No. 88298380

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Eric J. Maiers and Michael R. Friedman of Greenberg Traurig, LLP  
for American Airlines, Inc.

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Before Adlin, Goodman and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant American Airlines, Inc. seeks a Principal Register registration of RENOAIR, in standard characters, for “air transport of passengers, cargo and freight.”<sup>1</sup> Applicant alleges that the proposed mark has acquired distinctiveness under Section 2(f) of the Trademark Act based on Applicant’s prior Registration No. 2677849 for the same mark for “toys, namely model airplanes” (the “Prior Registration”).

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<sup>1</sup> Application Serial No. 88298380, filed February 12, 2019 under Sections 1(b) and 2(f) of the Trademark Act, based on an alleged intent to use the proposed mark in commerce.

The Examining Attorney refused registration under Section 2(e)(2) of the Act, 15 U.S.C. § 1052(e)(2), on the ground that the proposed mark is primarily geographically descriptive of Applicant's services, finding that the Prior Registration does not establish that the mark has acquired distinctiveness for air transport. After the refusal became final, Applicant appealed and filed a request for reconsideration which was denied. The appeal is fully briefed.

### **I. Geographic Descriptiveness**

Applicant claimed in its original application that its mark has acquired distinctiveness under Section 2(f). The claim was not made in the alternative. This was therefore a concession that the term RENOAIR is not distinctive, as a matter of law. In fact, "an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive." *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). Accordingly, there is no issue with respect to geographic descriptiveness.<sup>2</sup>

Even if geographic descriptiveness was at issue, which it is not, the record leaves no doubt that the term is not distinctive, because: (1) the primary significance of the term is the name of a place known generally to the public; (2) the public would make a services/place association, i.e. believe that the services for which Applicant seeks registration originate in that place; and (3) the source of the services is the geographic

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<sup>2</sup> Applicant's Appeal Brief and May 22, 2020 Office Action response address only Applicant's Section 2(f) claim, ignoring geographic descriptiveness. Applicant argued that its mark is not primarily geographically descriptive in its Appeal Reply Brief and October 30, 2019 Office Action response, however.

region named in the proposed mark. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015) (quoting *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987) and *In re Jacques Bernier, Inc.*, 894 F.2d 389, 13 USPQ 1725 (Fed. Cir. 1990)); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1210.01(a) (Oct. 2018).

In fact, the record establishes that the primary significance of RENO is a place generally known to the American public, specifically, a city in Nevada. April 30, 2019 Office Action TSDR 5-14. The addition of AIR to the term RENO is of no consequence with respect to geographic descriptiveness, as it does not change the geographic meaning of Applicant's proposed mark, being merely descriptive of or generic for Applicant's identified "air transport" services. *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988). Furthermore, there is no evidence that combining "Reno" and "air" into a single term without a space between the constituent words results in the proposed mark creating a commercial impression any different from RENO AIR with a space between the constituent words. *See, e.g., In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (FIRSTIER merely descriptive of banking services); *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Cox Enters. Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) ("Applicant's mark THEATL is simply a compressed version of the descriptive term THE ATL without a space between the two words. Without the space, THEATL is equivalent in sound, meaning and impression to THE ATL and is

Serial No. 88298380

equally descriptive of applicant's goods. We disagree with applicant that the single word creates a new meaning or a nonsensical expression or that it changes the commercial impression of the term in any significant way."); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001) ("the compound term RUSSIANART is as merely descriptive as its constituent words, 'Russian Art'"); *In re Gagliardi Bros., Inc.*, 218 USPQ 181, 184 (TTAB 1983) (BEEFLAKES merely descriptive of thinly sliced beef); *In re Orleans Wines, Ltd.* 196 USPQ 516, 517 (TTAB 1977) (BREADSPRED merely descriptive of jellies and jams).

We presume that the public would believe that Applicant's services originate in Reno, because Applicant is one of the airlines which transports passengers (and perhaps cargo and freight) into and out of Reno-Tahoe International Airport. April 30, 2019 Office Action TSDR 7-14. *In re MCO Props. Inc.*, 38 USPQ2d 1154, 1155 (TTAB 1995) ("When it has been demonstrated that the primary significance of the term is geographic, and the services of the applicant are in fact rendered from the place the term names, a public association of the services with the place will be presumed."); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 850 (TTAB 1982). This element of the test is therefore also satisfied.

Finally, Reno is the source of Applicant's air transport services, as revealed by the evidence establishing that Applicant serves passengers (and perhaps carries cargo and freight) traveling to and from Reno. April 30, 2019 Office Action TSDR 7-14. Thus, all 3 elements of the test are satisfied and there is no doubt that RENOAIR is primarily geographically descriptive.

## II. Acquired Distinctiveness

“A claim of distinctiveness under Section 2(f) normally is not raised in a Section 1(b) application before the applicant files an amendment to allege use or a statement of use because a claim of acquired distinctiveness, by definition, requires prior use.” *In re Olin Corp.*, 124 USPQ2d 1327, 1333 (TTAB 2017). However, “an applicant can establish a prima facie case of acquired distinctiveness in the mark in an intent-to-use application where it can show that same mark *acquired distinctiveness for sufficiently similar or related goods*, and that this *acquired distinctiveness will transfer* to the goods specified in the application when that mark is used in connection with them.” *Id.* (emphasis added) (citing, *inter alia*, *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). To establish that any acquired distinctiveness will transfer, the relationship between the goods or services must be close enough “that the *purchasing public will perceive that the mark’s primary significance is to identify Applicant as the source of the new goods.*” *Id.* 1333-34 (emphasis added). Applicant faces a “heavy burden” in attempting to establish that distinctiveness will transfer; in fact, “the required showing for acquired distinctiveness to ‘transfer’ to new products is a rigorous one.” *Id.* at 1335. *See also In re Dial-A-Mattress*, 57 USPQ2d at 1812-13; *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009); *In re Rogers*, 53 USPQ2d 1741, 1744 (TTAB 1999).

Thus, Applicant is required to do more than establish merely that there is some type of relationship between the goods and services. It “must show *the extent to which the goods and/or services in the intent-to-use application are related to the goods and/or services in connection with which the mark is distinctive*, and that there is a

*strong likelihood that the mark's established trademark function will transfer to the related goods and/or services when use in commerce occurs.*" *In re Binion*, 93 USPQ2d at 1538 (emphasis added) (citing *In re Rogers*, 53 USPQ2d at 1745)). Even in cases where the mark is famous (and there is no evidence of fame here), "[t]he owner of a famous mark must still establish a strong likelihood of transference." *In re Rogers*, 53 USPQ2d at 1745-46.

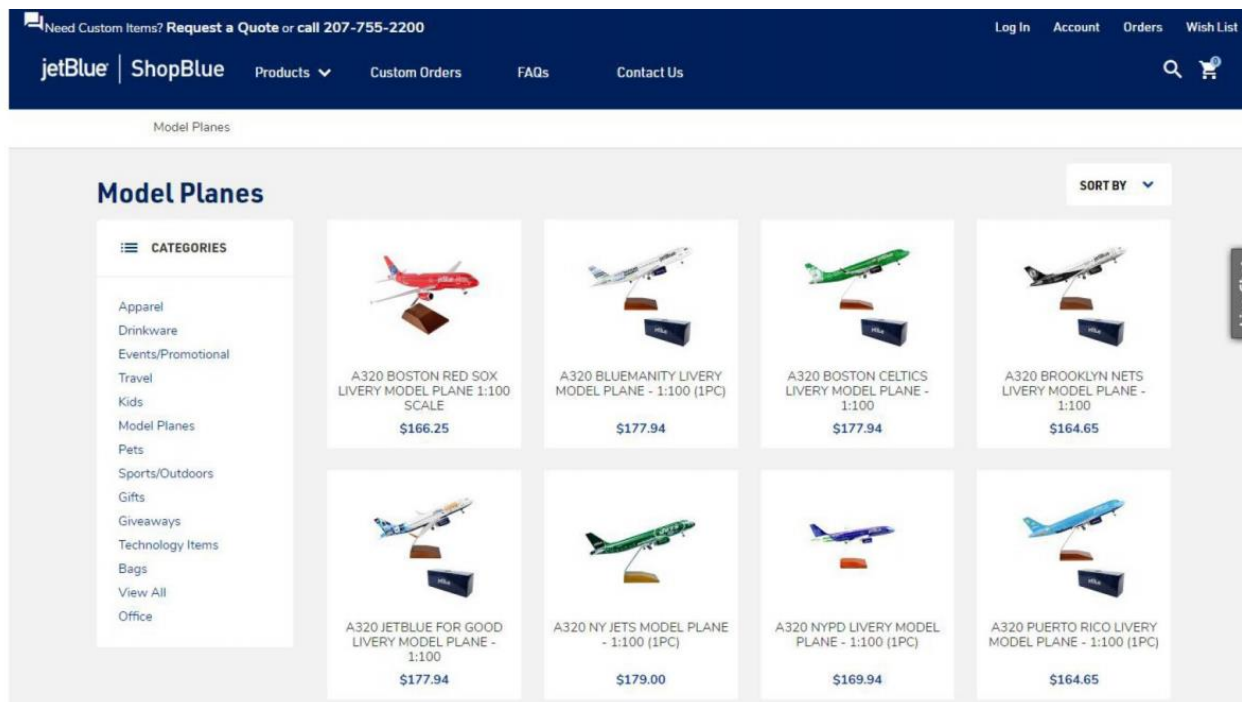
Under Trademark Rule 2.41(a)(1)-(3), there are three ways to establish that the mark in an intent to use application has acquired distinctiveness. *See* TMEP § 1212.09(a). Here, Applicant bases its claim of acquired distinctiveness on just one of them: ownership of a prior Principal Register registration for the same mark for what it alleges are "sufficiently similar" goods and services. Trademark Rule 2.41(a)(1). Specifically, Applicant relies on its Prior Registration (Registration No. 2677849 for the same mark RENOAIR for "toys, namely model airplanes").

Before addressing the Prior Registration and what it shows, it is important to keep in mind that prior registrations are not necessarily sufficient to establish the transfer of acquired distinctiveness. Indeed, the applicable rule provides only that prior registrations "*may* be accepted as prima facie evidence of distinctiveness" in "*appropriate cases.*" Trademark Rule 2.41(a)(1) (emphasis added). In other words, a prior registration will not be enough to establish the transfer of acquired distinctiveness in all cases. In this case, the Prior Registration is not enough, even though Applicant alleges that model airplanes and air transport services are related

Serial No. 88298380

based on evidence that a number of airlines offer air transport services and model airplanes under the same mark. May 22, 2020 Office Action response TSDR 59-113.

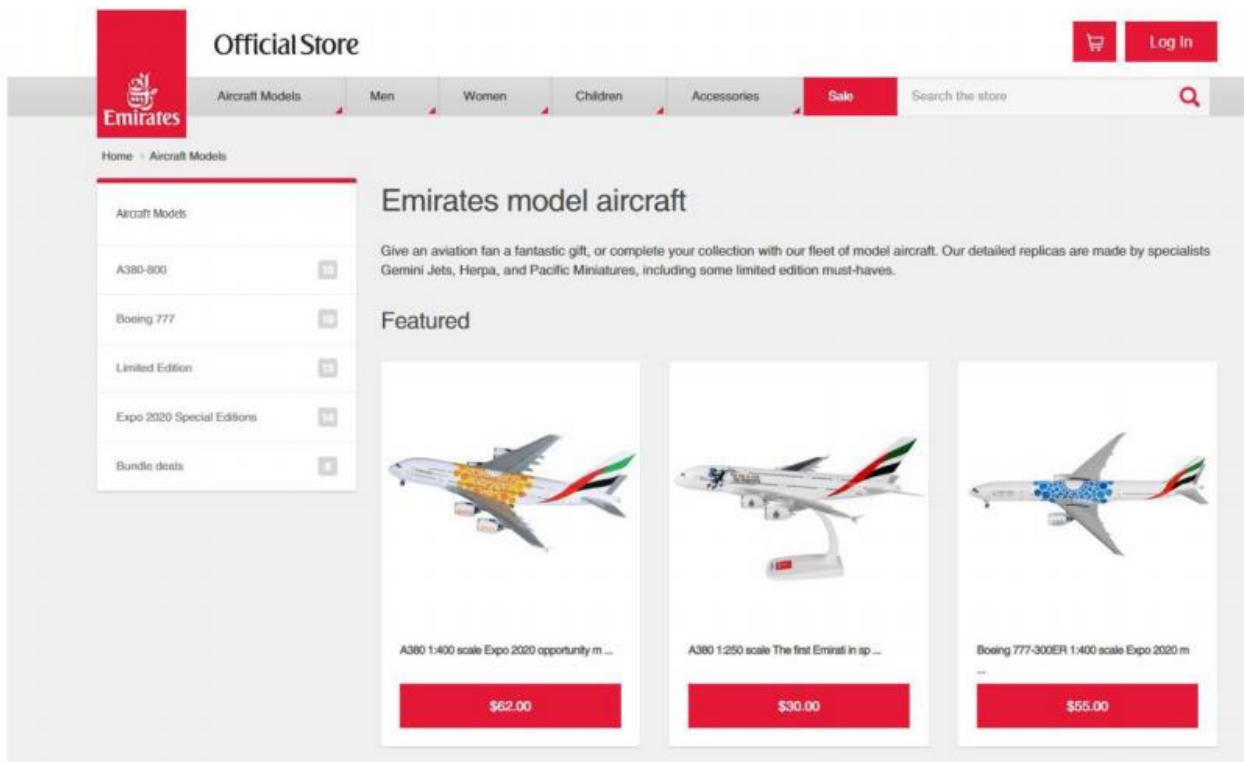
Applicant’s evidence reveals that airlines sell model airplanes as ancillary products, on portions of their websites devoted not to air transport, but to general consumer products bearing the airline’s mark. For example, jetBlue offers model airplanes mounted on stands so that they can sit on, for example, a desk or table; the model airplanes do not fly, by remote control or otherwise, and therefore they do not transport anything. The model airplanes are sold with other general consumer products including “drinkware” and “apparel”:



May 22, 2020 Request for Reconsideration TSDR 99. Delta’s model planes are also not drones; they too are sold on stands and do not fly:

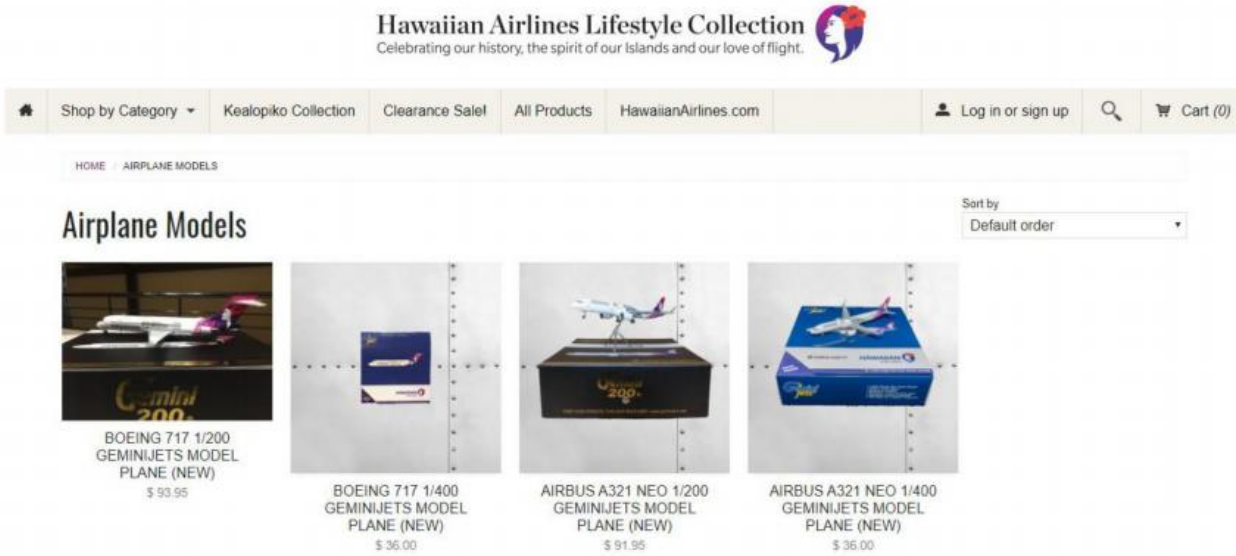


*Id.* at 100. Emirates’s model planes are promoted as a “fantastic gift” for an “aviation fan,” not as a means of transportation:

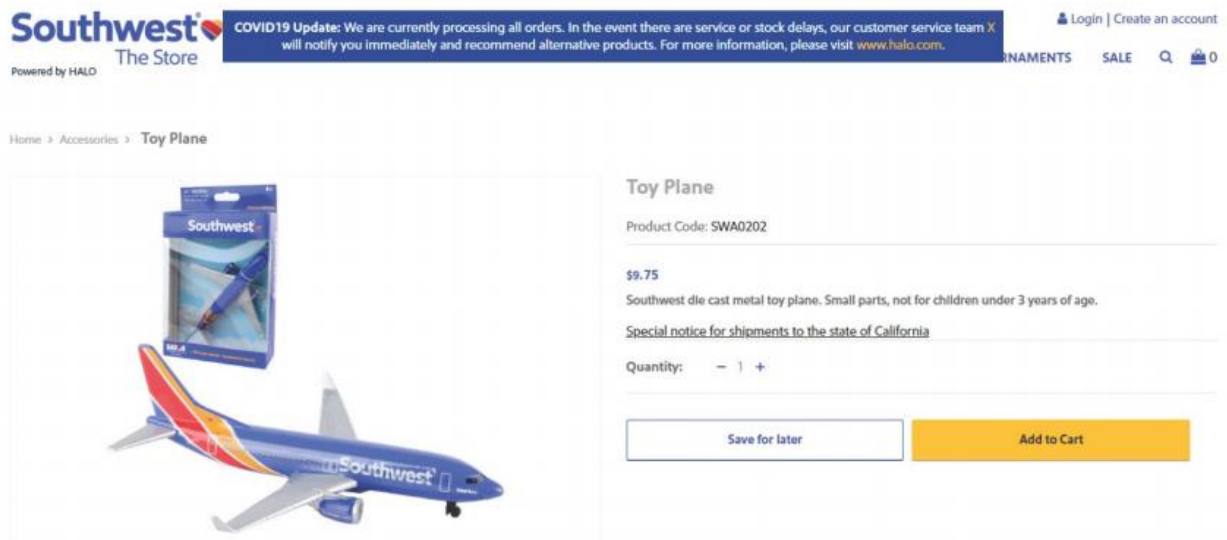


*Id.* at 102. Hawaiian Airlines offers model planes as part of its “Lifestyle Collection”:





*Id.* at 104. Southwest sells its models in the “Accessories” section of its website, referring to them as “toy planes”:



*Id.* at 239.

In short, the only evidence of a relationship between model airplanes and air transport is examples such as those reproduced above, as well as third-party registrations showing that airlines use the same marks for both air transport and model planes. May 22, 2020 Office Action response TSDR 59-113. This is evidence of

some relationship between these goods and services, in the same way that analogous evidence at times shows some relationship between, for example, live musical performances and t-shirts (e.g. ROLLING STONES), or beverages and golf balls (e.g. GATORADE). However, Applicant's showing that there is some relationship between model airplanes and air transport services is far from "rigorous" and is not "sufficient" to meet Applicant's "heavy burden" of establishing that any acquired distinctiveness for model airplanes will transfer to air transport services. *See In re Olin Corp.*, 124 USPQ2d at 1335. *See also In re Binion*, 93 USPQ2d at 1538; *In re Rogers*, 53 USPQ2d at 1744. Indeed, there is no evidence that Applicant's mark has acquired distinctiveness for model airplanes, other than the Prior Registration itself, which did not issue under Section 2(f). While the Prior Registration issued almost 18 years ago, that is not enough without more to show that the mark has acquired distinctiveness for model airplanes, much less that there is a "strong likelihood" that any acquired distinctiveness will transfer.

Applicant attempts to make much of *In re TriStar History and Preservation Inc.*, 2015 BL 304357 (TTAB 2015) ("*TriStar*"), a non-precedential 2015 decision in which we found some relationship between model airplanes and air transport. We do not find *TriStar* persuasive here.

In that case, the applicant sought registration of TWA in stylized and design forms for air transportation of passengers and freight, but was refused based on a likelihood of confusion with the virtually identical mark used for model airplanes. We found in *TriStar* that although at "first glance" there was no relationship between the goods

and services other than relating to aviation “in some manner,” the Examining Attorney had established with evidence similar to that Applicant relies on here that some airlines offer model airplanes. We pointed out in *TriStar* that ordinarily the Examining Attorney’s evidence of this type of relationship “might not be particularly persuasive standing alone,” but that given the “oligopolistic” nature of the airline industry and the “small number of major airlines,” and especially the essentially identical marks, confusion was likely in that case. *Id.* at \* 3-4.

*TriStar* is not controlling here, not only because it is non-precedential, but also, and perhaps more importantly because it answered a different question than we are faced with here. In *TriStar*, we unremarkably found that when virtually identical TWA marks were used for model airplanes on the one hand and air transport on the other, the relationship between the goods and services was close enough that confusion was likely. In this case, by contrast, we are not concerned with confusion at all. The question here is whether Applicant has made a “rigorous” showing that RENOAIR has acquired distinctiveness for model airplanes and that model airplanes are “sufficiently similar or related” to air transport services that the rigorously shown acquired distinctiveness will transfer to air transport services. Thus, the question in this case, whether any acquired distinctiveness will transfer, is much different than the question presented in *TriStar*, whether the relationship between the goods and services sold under virtually identical marks was sufficient to show a likelihood of confusion. *TriStar* is inapposite.

### **III. Conclusion**

Applicant has not met its “heavy burden” to show that any distinctiveness its mark may have acquired for model airplanes will transfer to the air transport services in connection with which Applicant intends to use its proposed mark.

**Decision:** The refusal to register on the ground that Applicant’s proposed mark RENOAIR is primarily geographically descriptive under Section 2(e)(2) and has not acquired distinctiveness for its identified air transport services is affirmed.