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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Globe Amerada Glass Company

Serial No. 75/067,615

Edward D. Gilhooly, Ltd. for applicant.

Matthew C. Kline, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Hanak and Quinn, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Globe Amerada Glass Company to register the mark AUTO GLASS OF AMERICA for "installation of automobile and truck glass."[1]

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[1] Application Serial No. 75/067,615, filed March 5, 1996, alleging a bona fide intention to use the mark in commerce. The recitation of services was amended to read as set forth above in a response filed on March 3, 1997. Applicant refers, in its brief, to the recitation of services as "replacement of automobile and truck glass." This reference is in error, and we have considered the merits of the appeal based on the recitation of services set forth above.

The Trademark Attorney has refused registration on two separate grounds. First, registration has been refused under Section 2(d) of the Trademark Act on the ground that applicant's mark, if used in connection with applicant's services, would be likely to cause confusion with the following previously registered marks, both owned by the same entity: U.S. AUTO GLASS for "auto glass repair and replacement and commercial glazing services[2];" and

for "glass replacement and repair services."[3] Second, registration has been refused under Section 2(e)(2) of the Act on the ground that the mark, if used in connection with applicant's services, would be primarily geographically descriptive of them.

When the refusals were made final, applicant appealed.[4]

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[2] Registration No. 1,948,197, issued January 16, 1996, pursuant to the provisions of Section 2(f) of the Act.

[3] Registration No. 1,906,776, issued July 18, 1995. The word "Glass" and the representation of the map of the United States are disclaimed apart from the mark.

[4] The Examining Attorney further refused registration under Section 2(d) based on Registration No. 1,040,791, issued June 1, 1976, also owned by the same registrant. The registration was not renewed, and the Office held it expired on March 10, 1997.

Thus, the Board need not consider the refusal based on the now-expired registration.

Applicant and the Examining Attorney filed briefs.[5]

Before we turn to the merits of the appeal, we direct our attention to a procedural matter. With respect to the Section 2(e)(2) refusal, applicant states as follows (brief, p. 3):

> Applicant is willing to convert its application to one on the Supplemental Register, but has not submitted evidence of use in light of the adverse holding of the Trademark Attorney as to the refusal to register on Section 2(d). If this Board determines that the refusal to register under Section 2(d) is erroneous, then Applicant will submit evidence of use and convert the application to the Supplemental Register.

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[5] Applicant's brief is accompanied by exhibits A and B which are printouts from a computerized trademark search report (specifically, according to applicant, from Thompson and Thompson's Trademarkscan database). The Examining Attorney, in his appeal brief, objected to this evidence as untimely filed. Applicant then filed a remand request to allow the Examining Attorney to consider the search report. The Board, on April 8, 1998, denied the request. The Board reiterates that exhibits A and B attached to the brief do not form part of the record here, and this evidence has not been considered in reaching our determination. Trademark Rule 2.142(d) and TBMP § 1207.02. See also: In re Classic Beverage Inc., 6 USPQ2d 1383 (TTAB 1988)[private trademark search report insufficient to make third-party registrations of record; copies of the registrations themselves are required for that purpose]. We hasten to add, however, that even if considered, the evidence is not persuasive of a different result in this case. See: Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973).
In its brief, applicant also specifically refers to two third-party registrations. However, as pointed out by the Examining Attorney, these registrations likewise were never properly made of record. See: In re Duofold Inc., 184 USPQ 638 (TTAB 1974). Accordingly, they have not been considered.

Applicant concludes its brief by requesting “that the refusal of the Examiner be reversed on the issue of the refusal on Section 2(d) and the application be remanded to the Examining Attorney to allow Applicant an opportunity to convert the application to one on the Supplemental Register in a manner provided by the rules.”

The procedure suggested by applicant cannot be entertained. A review of the prosecution history of this case shows that applicant responded, albeit in a cursory fashion, to the merits of the geographical descriptiveness refusal, contending that the matter sought to be registered is fanciful and did not “suggest a particular geographical significance other than as being an expression.” At no time, however, did applicant file or even suggest, either directly or in the alternative, an amendment to the Supplemental Register. In this regard, we do not understand applicant’s decision to not previously submit evidence of use in the form of an amendment to allege use, the filing of which would have permitted an amendment to the Supplemental Register. Applicant appears to base its decision on the pendency of the Section 2(d) refusal. We fail to see the connection between the two.

The proper procedure would have been for applicant to file, prior to final decision, evidence of use, together

with an amendment to the Supplemental Register, either directly or alternatively. TMEP § 1115. See also: TMEP § 1212.02(c). This avenue was not taken earlier, and there is no option at this manifestly late juncture to consider such an amendment. Moreover, inasmuch as we have decided the Section 2(e)(2) issue on the merits, infra, the prosecution of the application cannot be reopened to consider an amendment to the Supplemental Register. Trademark Rule 2.142(g); TMEP § 1115.05 and TBMP § 1218 and cases cited therein.

Section 2(d)

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.

With respect to the services in the present case, “it is conceded by applicant that the services and trade channels involve installation of glass, which are somewhat related to the services described in the cited registrations, and further discussion of [this factor] is

not believed necessary." (brief, p. 4) Applicant would appear to fall short in coming to grips with the fact that the involved services are more than "somewhat related." In comparing the services, we must look to the services as identified in the involved registrations and application. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). In doing so, we find that that the services are, for purposes of the likelihood of confusion determination here, legally identical. As identified, the services are assumed to travel in the same trade channels to the same classes of purchasers.

We now turn to focus our attention, as applicant and the Examining Attorney have done, on the similarity between the marks. When marks are used in connection with identical services, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Although there are differences between the marks, we find that applicant's mark, AUTO GLASS OF AMERICA, and registrant's U.S. AUTO GLASS marks, when viewed in their entireties as applied to identical services, engender similar overall commercial impressions.

Applicant is correct in pointing out that there are differences between the marks in terms of appearance and sound. We find, however, that these differences are outweighed by the virtually identical connotations of the marks. The terms “U.S.” and “America” have the same meaning.[6] The marks in their entireties, when applied to identical services, essentially convey the same meaning, namely, auto glass installation services emanating from the United States of America. The design feature in one of registrant’s marks does not detract from this similarity. Moreover, that the marks are constructed differently does not alter the similar overall commercial impression of the marks. See, e.g.: In re Wine Society of America Inc., 12 USPQ2d 1139 (TTAB 1989); and Bank of America National Trust and Savings Association v. The American National Bank of St. Joseph, 201 USPQ 842 (TTAB 1978) and cases cited therein. In finding that the marks are similar, we have

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[6]We take judicial notice of the dictionary evidence submitted by the Examining Attorney showing that the term “America” is defined, in relevant part, as “often, specifically, the United States of America.” Merriam Webster’s Geographical Dictionary We also take judicial notice of the dictionary listings supplied by applicant which show that the term also refers to North America, South America, and North America, South America and Central America considered together. We finally take judicial notice of the listing for "America" in Webster's Third New International Dictionary (1976). The word is defined, in relevant part, as “of or from the U.S.”

kept in mind the normal fallibility of human memory over time (especially here when the purchase of auto glass is relatively infrequent) and the fact that average consumers retain a general rather than a specific impression of trademarks encountered in the marketplace.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

We conclude that consumers familiar with registrant's installation and replacement of automobile glass services rendered under its U.S. AUTO GLASS marks would be likely to believe, if they were to encounter applicant's mark AUTO GLASS OF AMERICA for the same services, that the services originated with or are somehow associated with or sponsored by the same entity.

Section 2(e)(2)

In order for registration to be properly refused under Section 2(e)(2), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public, and that (ii) the public would

make a goods(services)/place association, that is, believe that the goods/services for which the mark is sought to be registered originate in that place. In re California Pizza Kitchen, Inc., 10 USPQ2d 1704 (TTAB 1988), citing In re Societe Generale des Eaux Minerals de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). 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 nor remote, a public association of the goods or services 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 Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982).

It hardly needs to be said that "America" is universally known as a geographic name for the United States of America.[7] We find, therefore, that the geographic significance of "America" is its primary significance and that America is neither obscure or remote.

Having found that the term "America" is a primarily geographic term, the question becomes whether the composite

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[7] See n. 6, supra.

mark AUTO GLASS OF AMERICA is primarily geographically descriptive as contemplated by the statute.

The mere addition of the generic designation AUTO GLASS OF to AMERICA does not change the primary geographic significance of AMERICA. That is to say, such addition of generic matter does not detract from the primary geographic significance of AUTO GLASS OF AMERICA when the mark is considered as a whole. In re Chalk's International Airlines Inc., 21 USPQ2d 1637, 1639 (TTAB 1991) [PARADISE ISLAND AIRLINES for air transportation services is primarily geographically descriptive]. Moreover, as the Board has stated in the past, the determination of registrability under Section 2(e)(2) should not depend on whether the mark is unitary or composite. In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986) [the addition of the descriptive word DIGITAL does not detract from the primary geographic significance of CAMBRIDGE DIGITAL].

We now turn to the second part of the test as set forth above, namely, whether the public would make a services/place association. In the present case, applicant is located in the United States (specifically, in the state of Illinois). Having found that the geographic significance of AUTO GLASS OF AMERICA is its primary

significance and that America is neither obscure or remote, we presume, from the fact that applicant's own services originate from that place, a public association of the services with the place named in the mark. See: In re BankAmerica Corporation, 231 USPQ 873, 875 (TTAB 1986) and cases cited thereat [BANK OF AMERICA primarily signifies an American bank and, with respect to computerized financial data processing services which emanate from this country, a public association of those services with the place named in the mark (i.e., America) may be presumed]. See also, e.g.: In re U.S. Cargo Inc., 49 USPQ2d 1702 (TTAB 1998); and In re Biesseci S.p.A., 12 USPQ2d 1149 (TTAB 1989).

We conclude that consumers are likely to believe that AUTO GLASS OF AMERICA is primarily geographically descriptive of automobile glass installation services that emanate from America.

Decision: The refusals to register under Sections 2(d) and 2(e)(2) are affirmed.

R. L. Simms

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

E. W. Hanak, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur with the Section 2(e)(2) affirmance and dissent with regard to the Section 2(d) affirmance.

E. W. Hanak
Administrative Trademark
Judge, Trademark Trial
and Appeal Board