

Flag Day Greetings

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For this Flag Day we call your attention to a precedential case involving the word AMERICAN (but not the flag) in which a servicemark was held to be registrable for “retail furniture stores” despite the fact that AMERICAN FURNITURE WAREHOUSE was found to be merely geographically descriptive of applicant’s retail furniture stores located in the United States.



The examining attorney refused to register this mark absent a disclaimer of the exclusive right to use the wording AMERICAN FURNITURE WAREHOUSE as being primarily geographically descriptive of the location of the stores, and of the words FURNITURE WAREHOUSE as being generic for the nature of the stores.

The applicant already owned previous Principal Register registrations of (a) AMERICAN FURNITURE WAREHOUSE (in standard characters) with a claim of acquired distinctiveness of the entire mark, (b) AMERICAN FURNITURE WAREHOUSE (stylized) with a claim of acquired distinctiveness-in-part as to the wording, and (c) AMERICAN LIFESTYLE FURNITURE (stylized) with a claim of acquired distinctiveness-in-part as to AMERICAN and FURNITURE.

As to the disclaimer requirements for this mark, the applicant appealed to the Trademark Trial and Appeal Board. The applicant argued against the AMERICAN FURNITURE WAREHOUSE disclaimer requirement because it said that the “bare possibility” that the services could emanate from an American company did not establish a services-place relationship. It also argued that FURNITURE WAREHOUSE did not describe “retail furniture stores” but merely suggested its large stock and lower prices one would expect from a wholesale shop. The TTAB rejected both arguments, largely based on statements made in the applicant’s own advertising materials as to its location in the United States and its large size.

The applicant further argued that this mark was unitary in nature and therefore would be viewed as a whole. But the TTAB pointed out that this was belied by the earlier claims of acquired distinctiveness-in-part as to separate elements included in this mark.

The applicant had maintained, in the alternative, a claim of acquired distinctiveness-in-part for AMERICAN FURNITURE WAREHOUSE. The TTAB reversed the examining attorney's rejection of this distinctiveness claim to be consistent with the claims contained in the prior registrations. However, the TTAB also required a disclaimer of FURNITURE WAREHOUSE and FURNITURE as being generic portions of this mark.

Author's Note: This case exemplifies that "AMERICAN," like other merely descriptive words, can become a trademark exclusively signifying a single source for specific goods or services located in the United States if that term is used and advertised sufficiently to acquire distinctiveness in the mind of the public as the source for those goods and services. That is the American way.

[*In re American Furniture Warehouse CO*](#), Serial No. 86407531 (April 23, 2018).

The entry of a disclaimer of FURNITURE WAREHOUSE and FURNITURE was held [satisfied](#) when the disclaimer was timely submitted.

Thereafter, the [certificate of registration](#), Registration No 5,558,129, was issued.