

6/11/02

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 19  
TJQ

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re The Hermitage Group, Inc.

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Serial No. 75/533,136

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Anthony S. Zummer of Palmatier & Zummer for applicant.

Lynn A. Luthey, Trademark Examining Attorney, Law Office  
102 (Thomas Shaw, Managing Attorney).

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Before Quinn, Holtzman and Drost, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed to register the mark  
HERMITAGE in typed form for "printed art reproductions."<sup>1</sup>

The Trademark Examining Attorney has refused  
registration under Section 2(a) of the Trademark Act on the  
ground that applicant's mark falsely suggests a connection  
with an institution, namely the Hermitage Museum in Russia.

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<sup>1</sup> Application Serial No. 75/533,136, filed August 10, 1998,  
setting forth dates of first use as 1926.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have submitted briefs.<sup>2</sup> An oral hearing was not requested.

The Board, in a final decision dated January 15, 2002, affirmed the same Section 2(a) refusal (false suggestion of a connection) in applicant's co-pending application Serial No. 75/533,137. In that case, applicant sought to register the mark shown below



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<sup>2</sup> Applicant's request for an extension of time to file its reply brief is granted, and the reply brief is considered timely filed. In its reply brief, applicant has objected to "Appendix C" and "Appendix D" attached to the Examining Attorney's brief as not being of record. The Board takes judicial notice of the dictionary definition of the word "Cyrillic" (Appendix D). There is a problem, however, with two of the four pages retrieved from the Website of the Heritage Museum forming "Appendix C." Applicant's objection grounded on the untimely submission of these pages is well taken. Inasmuch as these two pages relating to the "Museum Stores" were not properly introduced in the record, this evidence and the Examining Attorney's arguments based thereon ("art museums often reproduce their own works of art for sale and offer for sale the art on collateral goods featuring works of art from the museum's collection" and it is "commonplace for museums to operate retail gift shops and on-line retail stores featuring works from the museum's collection") have not been considered in reaching our decision. We would also add that, given the Board's identical treatment of this evidence in the earlier decision, of which the Examining Attorney was aware when she filed her appeal brief, we are somewhat surprised that the same mistake was repeated in the present case.

for the same goods as those involved herein, namely, "printed art reproductions." The Board denied applicant's request for reconsideration on March 12, 2002. At the time of the Board's decision, the Board was unaware of the present application. The cases are essentially identical in terms of the evidentiary record and arguments, with the only significant distinction being that one mark is presented in special form while the present mark is in typed form.

Applicant, in urging that the refusal be reversed, asserts that the name of the museum in St. Petersburg, Russia comprises Russian words in the Cyrillic alphabet, and that "Hermitage" is merely an "Americanization" of the Russian name. Further, applicant contends that the word "hermitage" does not uniquely and unmistakably identify the museum, but rather identifies many places and things. In support of its position, applicant submitted listings of the word "hermitage" from ten dictionaries, none of which refer to the museum. Applicant points out that these "scholarly" dictionaries, some of which are multi-volume, define "hermitage" as, firstly, a hermit's place and, secondly, a wine district. The absence of any reference in these dictionaries to the museum demonstrates, according to applicant, that the term "hermitage" is not universally

identified as the name of the museum in Russia. Applicant also submitted an Internet search print-out of 100 websites dealing with a variety of places and things named "Hermitage," including towns, hotels, businesses, an appellation of wine and the home of President Andrew Jackson. Also of record are labels from a bottle of French wine showing "HERMITAGE Appellation Hermitage Contrôlée."

The Examining Attorney maintains that the mark sought to be registered falsely suggests a connection with the Hermitage Museum in Russia, a place listed in the one dictionary definition relied upon by her. The Examining Attorney asserts that "[t]he Hermitage is a fine art museum in St. Petersburg (formerly known as Leningrad), Russia"<sup>3</sup> and that "[t]he world-renowned museum features works of art and is known as the state museum of Russia." (brief, p. 4) The mark's association with the museum is not dispelled by the other meanings of "hermitage" because, according to the Examining Attorney, these meanings have little or nothing to do with the goods identified in the application, namely printed art reproductions. In addition to the one dictionary definition, the Examining Attorney relied upon

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<sup>3</sup> St. Petersburg, Russia has been renamed three times since its founding. In June, 1991, the city's name reverted back to "St. Petersburg" from "Leningrad."

ten excerpts retrieved from the NEXIS database showing references to the Hermitage Museum in Russia, and two pages from the museum's website.

The Record

Applicant has relied upon listings of the term "hermitage" from the following ten dictionaries: *The Oxford English Dictionary, Webster's Third New International Dictionary of the English Language, The Century Dictionary and Cyclopedia, Funk & Wagnalls New Standard Dictionary of the English Language, Funk & Wagnalls New Comprehensive International Dictionary of the English Language, The Concise Oxford Dictionary of Current English, Random House Webster's College Dictionary, The Oxford Desk Dictionary, The Oxford Modern English Dictionary, and Merriam-Webster's Collegiate Dictionary.* The listings are quite consistent in their definitions of the term "hermitage," and the following one, taken from *Webster's Third International Dictionary* is representative: "the habitation of a hermit; a secluded residence or retreat; a house of various monastic orders; a chiefly red Rhone Valley wine made from grapes grown above the commune of Tain-l'Ermitage." As pointed out by applicant, not a single definition refers to the museum in Russia.

The dictionary definition of "hermitage" relied upon by the Examining Attorney reads as follows: "the habitation of a hermit; any secluded place of residence or habitation; retreat; hideaway; (*cap.*) a palace in Leningrad built by Catherine II and now used as an art museum." *Random House Unabridged Dictionary* (2d ed. 1993).

Aside from the dictionary definitions, applicant's evidence includes a print out of the first 100 websites shown by way of an Internet search of "hermitage"; five of the sites concern the Hermitage Museum. The evidence of record shows that the term "Hermitage" names two towns (in Arkansas and Pennsylvania), a street (in Chicago), five hotels, two monasteries, President Andrew Jackson's home (in Tennessee), an animal shelter, a squash club, condominiums and an insurance business. Applicant's evidence also shows that "Hermitage" identifies an appellation of origin of a particular wine of Rhone, France ("Appellation Hermitage Contrôlée").

The ten NEXIS articles submitted by the Examining Attorney make various references to the "Hermitage Museum," with one reference to the museum as "Hermitage" per se.

Also of record is the excerpt retrieved from the museum's website ([www.hermitage.ru](http://www.hermitage.ru)) indicating that the museum is "[s]ituated in the center of St. Petersburg" and

that "the State Hermitage Museum is housed in five magnificent buildings created by celebrated architects of the 18<sup>th</sup> to 19<sup>th</sup> century." The website also states "[p]ut together throughout two centuries and a half, the Hermitage collections of works of art (over 3,000,000 items) present the development of the world culture and art from the Stone Age to the 20<sup>th</sup> century."

In addition to the evidence of record, we take judicial notice of the following encyclopedia excerpts<sup>4</sup> that shed more light on the Hermitage Museum:

Hermitage: in full STATE HERMITAGE, Russian GOSUDARSTVENNY ERMITAZH, art museum in Leningrad (formerly St. Petersburg) founded in 1764 by Catherine the Great as a court museum. It adjoined the Winter Palace and served as a private gallery for the art amassed by the Empress. Under Nicholas I the Hermitage was reconstructed (1840-52), and it was opened to the public in 1852. Following the October Revolution of 1917, the imperial collections became public property.

Masterpieces of western European painting since the Middle Ages, as well as Russian art, are represented. The Hermitage also has extensive holdings of Oriental art, especially noteworthy being its collection of the art of Central Asia.

5 *The New Encyclopaedia Britannica* (Micropaedia)(15<sup>th</sup> ed. 1988)

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<sup>4</sup> Such evidence, as a standard reference work, is proper subject matter for judicial notice. See: *The B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); and *In re Mahony*, 421 F.2d 742, 164 USPQ 572, 575 (CCPA 1970).

Leningrad: ...Between the square and the river rises the huge and massive rectangle of the Winter Palace, the former principal residence of the tsars...The whole complex, now called the Hermitage, or State Hermitage Museum, is a treasure-house of fine art of worldwide significance that originated in 1764 as the private collection of the tsarina Catherine II.  
22 *The New Encyclopaedia Britannica* (Macropaedia)(15<sup>th</sup> ed. 1988)

Union of Soviet Socialist Republics--  
Museums and Galleries: Museum attendance in the Soviet Union is high...Famous museums include (in Moscow) the Central Lenin Museum...Leningrad has the Hermitage...  
28 *The New Encyclopaedia Britannica* (Macropaedia)(15<sup>th</sup> ed. 1988)

### The Law

Section 2(a) of the Act prohibits, *inter alia*, the registration of a mark if it "consists of or comprises...matter which may...falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols."

In order to warrant a refusal under this portion of Section 2(a), the Examining Attorney, who has the burden of proof, must show that (i) the mark is the same as, or a close approximation of, the name or identity previously used by the other institution; (ii) the mark would be recognized as such in that it points uniquely and



unmistakably to that institution; (iii) the institution named by the mark is not connected with the activities performed by the applicant under the mark; and (iv) the prior user's name or identity is one of sufficient fame or reputation that a connection with such institution would be presumed when applicant's mark is used on applicant's goods. In re Urbano, 51 USPQ2d 1776 (TTAB 1999); In re North American Free Trade Association, 43 USPQ2d 1282 (TTAB 1997); and In re Kayser-Roth Corp., 29 USPQ2d 1379 (TTAB 1993). The term "institution" as used in Section 2(a) certainly encompasses museums. In re North American Free Trade Association, supra.

#### Analysis

The mark sought to be registered is a close approximation of the name of the museum at issue, namely the Hermitage Museum (or Hermitage) in St. Petersburg, Russia, and the mark would be recognized as such. We are not persuaded by applicant's argument that the name of the museum is as it is written in Russia in the Cyrillic alphabet. As shown by the museum's website in the English language version, the translation of the name from Cyrillic is "The State Hermitage Museum." Inasmuch as the issue herein must be decided based upon the perception of the relevant purchasing public in this country, the English

translation that will be encountered in the United States must control.

As indicated on the museum's website, the museum's collection exceeds 3 million works of art, and the encyclopedia describes the holdings as "extensive." Applicant's evidence of "Web Directory Sites" includes a reference to the website of the museum, reading in part "the five buildings which comprise the Hermitage now house one of the finest art collections in the world." Another website refers to the Hermitage Museum as "one of the world's great museums." Further, the encyclopedia refers to the museum as "famous" and "a treasure-house of fine art of worldwide significance that originated in 1764." The museum has been open to the public since 1852. Given the renown of the museum, consumers of printed art reproductions would recognize the mark HERMITAGE as a close approximation of the name of the museum, namely the Hermitage.

The major thrust of applicant's argument is that the term "Hermitage" does not uniquely and unmistakably point to the Hermitage Museum. We acknowledge applicant's point that there are a variety of meanings of the term other than as the name of the museum in Russia. As shown by applicant, the name identifies a variety of things and

places, including an appellation of origin of wine, towns and the home of a former President of the United States.

There is nothing to suggest, however, that any of these other meanings of the term "hermitage" have anything to do with art; thus, the only "person" or "institution" which the mark HERMITAGE possibly identifies is the Hermitage Museum. See: *The Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 411 (TTAB 1986). The use by applicant appropriates the museum's identity. The mark, by its very nature, falsely suggests a connection with the Hermitage art museum in Russia. See: *The University of Notre Dame v. J. C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983), citing *FBI v. Societe M. Bril & Co.*, 187 USPQ 685, 687 (D.D.C. 1975).

With respect to whether the museum is, in fact, connected with the printed art reproductions sold by applicant under its mark, the record is silent. Thus, we are left to find that applicant's mark falsely suggests that its printed art reproductions are of art displayed in the Hermitage, or are of artists who have some of their works displayed in the museum or are of artists schooled at the Hermitage. *The University of Notre Dame v. J. C.*

Gourmet Food Imports Co. Inc., supra at 509 (Fed. Cir. 1983).

### Conclusion

The evidence of record convinces us that the Hermitage is the name of an art museum of sufficient fame or reputation that a connection with the museum would be presumed when applicant's mark is used on printed art reproductions.<sup>5</sup> Such goods obviously are closely related to art museums; in this case, specifically the Hermitage Museum.<sup>6</sup> We find that the Office has met its burden of proving that applicant's mark HERMITAGE in typed form falsely suggests a connection with the Hermitage Museum.

Decision: The refusal to register is affirmed.

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<sup>5</sup> In connection with a likelihood of confusion refusal that was later withdrawn in the involved application, we note the existence of at least three registrations of marks incorporating the term "Hermitage" for goods in the arts and/or crafts field. Suffice it to say, we are not privy to the records in these registrations and, in any event, the determination of registrability of particular marks by the Office cannot control the result in another case. See: *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

<sup>6</sup> Applicant places heavy reliance on the Federal Circuit's decision in Notre Dame. We agree with the Examining Attorney, however, that the present case is distinguishable because here applicant's goods are for essentially the same goods for which the Hermitage is known, namely art works.