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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ON APPEAL



Applicant: Los Verdes III, L.L.C.  
Trademark: CHERRY CREEK COUNTRY CLUB  
Serial No.: 78/043560  
Filing Date: January 17, 2001

12-04-2002  
U.S. Patent & TMO/TM Mail Rcpt Dt. #76

**APPLICANT'S APPEAL BRIEF**

Los Verdes III, L.L.C. ("Applicant") respectfully submits this Appeal Brief. Applicant apologizes for the delay in submission. There was confusion as to whether Applicant's Notice of Appeal had been received by the Trademark Office. Applicant's counsel was informed by a representative at the Trademark Office that this Appeal Brief was due 60 days following receipt by the Trademark Office of the Notice of Appeal pursuant to the T.T.A.B. Manual of Procedure, Section 1200-16. The Notice of Appeal was received by the Trademark Office on November 5, 2002, after Applicant's counsel faxed a copy of the Notice of Appeal and check to the Trademark Examiner. Enclosed herewith is a new check in the amount of \$400 for the appeal fee.

A later conversation between Applicant's counsel and the Trademark Office revealed that the Appeal Brief was in fact due 60 days from the date on the Certificate of Mailing attached to the Notice of Appeal, which was September 18, 2002, rather than 60 days from the date of receipt at the Trademark Office. Applicant's counsel was informed that, because of the confusion, this Appeal Brief could be submitted at a later date. Applicant appreciates the Board's consideration of the following arguments.

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## I. ARGUMENT

### A. Applicant's mark, **CHERRY CREEK COUNTRY CLUB**, is not geographically descriptive.

The Trademark Examiner refused registration of the mark CHERRY CREEK COUNTRY CLUB because the mark is geographically descriptive. Applicant respectfully disagrees.

The Cherry Creek Country Club is a golf course development with a clubhouse and other recreational amenities, as well as multi-million dollar custom homes. It is located in unincorporated Arapahoe County, Colorado, which is essentially a suburb of Denver. The Cherry Creek is a creek that runs from central Denver to a reservoir southeast of the city and is not indicative of any particular location in Denver. Cherry Creek is also a neighborhood in Denver, which is known for its expensive real estate, restaurants and shopping boutiques. It is viewed as a luxurious neighborhood inhabited by the wealthiest residents.

In Colorado and surrounding states, the term "Cherry Creek" has come to symbolize the quality and luxury, such as can be found in the Cherry Creek neighborhood. An example is the popular advertisement for the Cherry Creek Shopping Center, which says "Do you speak Cherry Creek?" See attached Exhibit A depicting this ad. The ad lists the names of various jewelry stores and department stores, which are best known for their expensive, high-quality merchandise.

As such, the term "Cherry Creek" within the mark CHERRY CREEK COUNTRY CLUB does not *primarily* denote a geographical place to reasonable consumers in Colorado. Registration of a mark can be refused for this reason only if the mark, when used on or in connection with the goods of the applicant, is *primarily* geographically descriptive of them. 15 U.S.C. 1052(e)(2). The courts have created a two-part test for determining whether a mark is

primarily geographically descriptive: a) whether the term sought to be registered primarily denotes a geographical place to reasonable purchasers, and b) if so, whether customers would associate the goods and/or services with the geographic place named. In re International Taste, Inc., 53 U.S.P.Q. 2d (BNA) 1604 (T.T.A.B. 2000). In making this determination, the Fifth Circuit Court of Appeals ruled:

[T]he wording of the statute makes it plain that not all terms which are geographically suggestive are unregistrable. . . . Indeed, the statutory language declares nonregistrable only those words which are "primarily geographically descriptive." The word "primarily" should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote, or unconnected with the goods.

World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F. 2d 482, 486 (5<sup>th</sup> Cir. 1971). Applicant's mark is not "primarily" geographically descriptive, and registration must be allowed.

**a. The term "Cherry Creek" does not primarily denote a geographical place to reasonable purchasers.**

"Cherry Creek" evokes an image of luxury and decadence and is not primarily geographic. In the Applicant's mark CHERRY CREEK COUNTRY CLUB, the term Cherry Creek is intended to connote financial abundance and high quality, and not a geographic location.

This Board has held that the mark HOLLYWOOD was registrable as a mark for french fries and fast food services, despite the fact that Hollywood is a district of Los Angeles. In re International Taste, Inc., 53 U.S.P.Q.2d (BNA) at 1604. The Board explained that the Examining Attorney had not proven that the primary significance of the term "Hollywood" is that of a geographic location in California. The public knows the term "Hollywood" best for its connection to the entertainment industry, and not simply for the particular town in California. Id. The Board further cited Thomas McCarthy, McCarthy on Trademarks and Unfair Competition,

§14:28 (4<sup>th</sup> Ed. 1999), for the proposition that "a mark that has a popular significance apart from its geographical meaning is not, in most cases, 'primarily' geographical."

Just as "Hollywood" is known for the activities within the town, rather than for being a specific geographic location, "Cherry Creek" is known in the Denver area for the wealth and luxury emanating from the residents and businesses within it. Since Cherry Creek has a popular significance apart from its geographical meaning, the Applicant's mark CHERRY CREEK COUNTRY CLUB should not be deemed primarily geographical.

**b. Consumers would not associate the goods and services with the geographic place, Cherry Creek.**

The patrons and residents of the Cherry Creek Country Club would not associate the goods and services with the actual Cherry Creek, or the neighborhood, which is several miles from the development. Neither the creek nor the neighborhood is known for golf courses. Additionally the term "Cherry Creek" connotes luxury and quality in this region. As such, there is a genuine issue whether the geographical significance of the term Cherry Creek is its primary significance; therefore, a public association of the goods and services with a particular place should not be presumed. *See In re JT Tobacconists*, 59 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. 2001) (Where there is no genuine issue, public association is presumed).

In *In re Gale Hayman, Inc.*, 15 U.S.P.Q.2D (BNA) 1478 (T.T.A.B. 1990), the applicant sought to register the mark SUNSET BOULEVARD for cosmetics and appealed to this Board when the application was rejected on the grounds that the mark was geographically descriptive. The Board reversed the refusal to register the mark, holding that the public was not likely to make a goods/place association, stating that "the mere fact that applicant's principal offices are in Century City, close to Sunset Boulevard, does not mandate a finding that a goods/place association should be presumed." *Id.*

The Hayman court further explained that Sunset itself would have to be associated with the products in such a way that the consuming public would be likely to assume that Sunset Boulevard was the place in which the perfume and cologne originated, when in fact there was no indication that any perfume or cologne was manufactured on Sunset Boulevard. Id.

The Hayman case is analogous to the present matter. The Examining Attorney has provided no evidence that the term "Cherry Creek" is associated with golf course communities or that the public would make such an association. As in Hayman, the mere fact of the location of the Cherry Creek Country Club does not automatically imply that the public would make a goods/place association regarding golf and the term Cherry Creek. In fact, there is no golf course in the area known as Cherry Creek.

Accordingly, the CHERRY CREEK COUNTRY CLUB mark should not be deemed geographically descriptive because the term Cherry Creek is not *primarily* geographically descriptive nor is there evidence that the term evokes a goods/place association in the minds of consumers. This Board has indicated that to the extent there is any doubt as to the primary significance of a mark, such doubt should be resolved in favor of the applicant. In re International Taste, Inc., 53 U.S.P.Q.2D (BNA) at 1611.

**c. Rejection of the mark CHERRY CREEK COUNTRY CLUB is inconsistent with decisions made by the Trademark Office to register similar marks.**

As indicated in Applicant's response to Office Action No. 1, the PTO has granted many registrations for "ROCKY MOUNTAIN" marks to companies located in the Rocky Mountain Region without requiring a disclaimer of the obviously geographic designation. Likewise, the PTO has granted a number of "BEAR CREEK" registrations to applicants located near the Bear Creek in Medford Oregon, Birmingham, Alabama, and Woodinville, Washington. See Exhibit

A attached hereto. There is no difference between those registered marks and the present application.

It is true that Trademark Examiners must evaluate each mark individually; however, the Trademark Office strives to be consistent. In re International Taste, Inc., 53 U.S.P.Q.2D (BNA) at 1611. Refusal to register the mark CHERRY CREEK COUNTRY CLUB is inconsistent with the numerous other registrations of similarly composed marks, such as those mentioned above.

**B. CHERRY CREEK COUNTRY CLUB is not confusingly similar to the mark CHERRY CREEK and design.**

Registration of the mark in class 025 was refused because the Examiner believed the mark so resembles the stylized mark CHERRY CREEK (Registration No. 2176521) as to be likely to cause confusion. Applicant respectfully disagrees, because the manner in which the mark is used, as well as the likely channels of commerce for each mark, make it unlikely that the public will be confused or deceived by the existence and use of both marks.

In considering what factors are relevant to a determination of likelihood of confusion, the examiners look at those factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The Court of Customs and Patent Appeals discussed likelihood of confusion and the decisional process involved, as follows:

In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.

7. The nature and extent of any actual confusion.
8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
10. The market interface between applicant and the owner of a prior mark:
  - a. a mere "consent" to register or use.
  - b. agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
  - c. assignment of mark, application, registration and goodwill of the related business.
  - d. laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, i.e., whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.

The evidentiary elements are not listed above in order of merit. Each may from case to case play a dominant role.

*duPont*, 476 F.2d at 1360-62, 177 USPQ at 566-67.

The Court of Appeals for the Federal Circuit has ruled that one cannot dissect a mark in making this determination:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted).

*In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

A review of each of the factors in this case supports Applicant's contention that the marks, as used, will not cause confusion or deception.

1. *The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.*

The points of comparison for a word mark are appearance, sound, and meaning or connotation. Similarity of the marks in one respect – sight, sound or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. *TMEP* § 1207.01(b)(i). Considering the total context of the mark, the words CHERRY CREEK COUNTRY CLUB on clothing items in Class 025 connote souvenir items from this particular golf course and country club. The registered mark CHERRY CREEK (Reg. No. 2176521) is a stylized mark depicting red and green cherries and is used as the name of a clothing line, rather than to connote a golf course or country club.

2. *The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.*

The goods offered are totally dissimilar. A telephone conversation with a representative at Lawrence Stevens Fashions, the owner of the CHERRY CREEK mark, revealed that the clothing label is for plus-size women only. Further, the majority of clothing items included in the line are skirts, blouses and dresses made of colorful and predominantly patterned fabrics that are soft and flowing. The company's mantra, stated prominently on its website, is "We are About Prints." By contrast, the Class 025 items on which the CHERRY CREEK COUNTRY CLUB mark will be used, will consist almost entirely of golf shirts, hats, t-shirts, sweatshirts and other items used primarily by men, women and children who play golf, tennis or some other sport at the Country Club. Further these sports-related items will not be made in patterned, flowing fabrics.

Moreover, the Class 025 registration by Lawrence Stevens Fashions, Ltd. for its mark CHERRY CREEK is overbroad, as the mark is not used for clothing of all of the types for which it is registered.

3. *The similarity or dissimilarity of established, likely-to-continue trade channels.*

The markets served by the companies and the corporate strategies are substantially different. The items sold at the Cherry Creek Country Club gift shops will be for men, women and children in standard sizes, not plus sizes in particular. The merchandise sold at the Country Club will not be made of printed, flowing materials as used by Lawrence Stevens Fashions, Ltd.

Given the nature of the clothing, it is unlikely a woman would do the same type of shopping at the Country Club gift shop as she would at a store carrying clothes labeled with the CHERRY CREEK mark. People purchasing items from the Country Club's gift shop are generally shopping for souvenirs and specifically desire a commemorative imprinted logo on the outside of the garment they purchase that is reminiscent of the Country Club, or they are in search of items to be used while playing sports. According to the website for Lawrence Stevens Fashions, Ltd., ([www.lsfcm.com](http://www.lsfcm.com)), clothes labeled with the CHERRY CREEK mark are sold directly to retail stores. Ostensibly, such a retail store is one that sells clothing lines for plus-sized women. The customer of such a store is likely shopping for everyday clothing, not souvenir items.

4. *The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.*

Applicant's customers are less careful or scrutinizing because they either desire souvenirs from the Country Club or need last-minute clothing items in order to engage in sporting events. In either case, the Country Club gift shop is the only source for such purchases. On the other hand, purchasers of clothes with the CHERRY CREEK label have the freedom to be more discriminating. They are most likely in retail stores and/or shopping malls and have the ability to go to another store or select an item of a different brand to satisfy their needs.

5. *The fame of the prior mark (sales, advertising, length of use).*

It appears that the prior mark has no value or renown. Indeed, an Internet search for the terms "Cherry Creek" and "clothing" utilizing the search engine [www.google.com](http://www.google.com) yields no reference to the line of clothing by Lawrence Stevens Fashions.

6. *The number and nature of similar marks in use on similar goods.*

A search of the records of the USPTO showed twelve other marks using CHERRY CREEK, five of which have been abandoned. The remaining seven marks are not on similar goods.

7. *The nature and extent of any actual confusion.*

None has been reported, nor has the owner of CHERRY CREEK contacted Applicant to indicate any confusion or to try to protect its mark.

8. *The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.*

The CHERRY CREEK COUNTRY CLUB mark has been in use in commerce for approximately ten months and no confusion has been reported.

9. *The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).*

CHERRY CREEK is used only for labels on apparel for plus-sized women. CHERRY CREEK COUNTRY CLUB is used as a logo imprint on the outside of souvenir sportswear primarily for golfers and others engaged in athletics at the Country Club.

10. *The market interface between applicant and the owner of a prior mark:*

There has been no interface between Applicant and Lawrence Stevens Fashions, Ltd.

11. *The extent to which applicant has a right to exclude others from use of its mark on its goods.*

Applicant has priority against any parties who use the mark subsequent to Applicant's filing date of January 17, 2001.

12. *The extent of potential confusion.*

There is little possibility of confusion. The companies operate in two different spheres. Lawrence Stevens Fashions, Ltd. sells its CHERRY CREEK label to retailers who presumably carry everyday fashions for plus-sized women; whereas, Applicant will sell its clothing on the premises of the Cherry Creek Country Club to men, women and children as souvenir items.

In the event that this Board deems the mark CHERRY CREEK COUNTRY CLUB to be confusingly similar to the mark CHERRY CREEK, Applicant proposes limiting its registration within Class 025 to golf-related clothing items.

**C. Even if the Board finds the mark similar to the prior "Cherry Creek" mark in Class 025, the mark must be passed to publication in Classes 041, 016, and 022.**

The Examiner has cited no marks that the Examiner believes are confusingly similar to the Mark in Classes 041, 016 and 022. Because Applicant has overcome the objection for geographic similarity, the Mark should be passed for publication in these classifications, even if the Mark is denied registration in Class 025.

**D. In the alternative, the application for registration of CHERRY CREEK COUNTRY CLUB should be amended to the Supplemental Register.**

Applicant believes that its mark is not geographically descriptive, nor is it confusingly similar to the CHERRY CREEK mark. In the event that this Board finds the mark CHERRY CREEK COUNTRY CLUB should not be registered, then in the alternative, Applicant requests that the application be amended to the Supplemental Register for Classes 041 and 025.

Respectfully submitted this 4th day of December, 2002.

Ireland, Stapleton, Pryor & Pascoe, P.C.

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Assistant Commissioner for Trademarks," 2900 Crystal Drive, Arlington, VA 22202-3513, Box TTAB Fee" on December 4, 2002.

Monika McDonald  
Signature

Monika McDonald  
Typed or printed name

**EXHIBIT A**

**Registered "Location" Marks**

**(See attached)**