

TAB

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

Name of Applicant: Joseph W. Cotchett
Serial Number of Application: 78208591
Filing Date of Application: January 29, 2003
Mark: HALF MOON BAY

NOTICE OF APPEAL

NOTICE OF APPEAL

To: Hon. Commissioner of Patents and Trademarks:

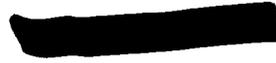
Applicant hereby appeals to the Trademark Trial and Appeal Board from the Continuation of Final Refusal of the Examiner dated October 4, 2004.

The appeal fee of \$100.00 is enclosed herewith.



Paul W. Reidl
Attorney for Applicant

Date: April 4, 2005



04/08/2005 ZCLIFT01 00000004 78208591

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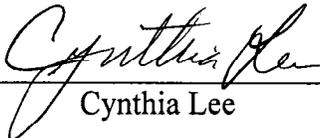
U.S. Patent & TMOrc/TM Mail Rcpt Dt. #32

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Date of Deposit: April 4, 2005

I hereby certify that NOTICE OF APPEAL and APPLICANT'S BRIEF ON APPEALS FROM (1) FINAL REFUSAL AND (2) SECOND OFFICE ACTION CANCELLING NOTICE OF ALLOWANCE, (Serial No. 78/208591), is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 CFR § 1.10 on the date of deposit indicated above and is addressed as follows: "Commissioner for Trademarks, BOX TTAB – FEE, P.O. Box 1451, Alexandria, Virginia, 22313-1451" by Cynthia Lee.



Cynthia Lee

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"Express Mail" mailing label number: ED673962173US

Date of Deposit: April 4, 2005

I hereby certify that NOTICE OF APPEAL and APPLICANT'S BRIEF ON APPEALS FROM (1) FINAL REFUSAL AND (2) SECOND OFFICE ACTION CANCELLING NOTICE OF ALLOWANCE, (Serial No. 78/208591), is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 CFR § 1.10 on the date of deposit indicated above and is addressed as follows: Susan E. Hickey, Esq., Trademark Law Office 112, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia, 22313-1451, on April 4, 2005.


Cynthia Lee

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

Name of Applicant:	Joseph W. Cotchett
Application Serial Numbers:	78208591 and 78208878
Filing Date of Applications:	January 29, 2003 January 30, 2003
Marks:	HALF MOON BAY HALF MOON BAY WINERY (& Design)

**APPLICANT'S BRIEF ON
APPEALS FROM (1) FINAL
REFUSAL AND (2) SECOND
OFFICE ACTION.
CANCELLING NOTICE OF
ALLOWANCE**

INTRODUCTION

Applicant seeks registration of the above-referenced marks on the Principal Register in Class 33 for wine. The Examiner refused registration of the mark HALF MOON BAY, Serial No. 78208591, alleging that the proposed mark is primarily geographically descriptive of Applicants' goods under section 2(e)(2) of the Lanham Act. Applicant's application with respect to the mark HALF MOON BAY WINERY (& Design), Serial No. 78208878, was originally approved for publication, published and allowed, but the Notice of Allowance was almost immediately canceled, on the same ground as the Final Refusal for Serial No. 78208591.¹ As discussed below, Applicant respectfully submits that the Examining Attorneys with respect to both applications have failed to meet their burden of establishing that Applicant's mark is primarily geographically descriptive. *In re*

¹ The Notice of Allowance for Applicant's wine label design HALF MOON BAY WINERY (& Design), Serial No. 78208878, was mailed on August 10, 2004. However, seemingly after learning that Applicant's application for HALF MOON BAY, Serial No. 78208591, had been refused by a different Examining Attorney, the Examining Attorney for Serial No. 78208878 canceled his Notice of Allowance for HALF MOON BAY (& Design) the following day, on August 11, 2004. Thereafter, on January 18, 2005, the Examining Attorney as to Application Serial No. 7820878 issued an Office Action citing geographic descriptiveness, and requiring a disclaimer of the entire mark as a condition of registration. Applicant accordingly files the present appeals with respect to both applications.

Stephen Dossick, M.D., 2003 TTAB LEXIS 421, 13 (T.T.A.B. 2003). Accordingly, publication of HALF MOON BAY should be allowed and a Notice of Allowance as to HALF MOON BAY WINERY (& Design) should be reissued.

Where a proposed mark includes the name of the geographic origin of goods or services, the test to determine whether it is primarily geographically descriptive is (1) whether the term sought to be registered primarily denotes a geographical place to reasonable purchasers, and (2) 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, 4 (T.T.A.B. 2000).² Because the Examiners failed to make the requisite showing with regard to either prong of this test, their Final Refusal to allow the mark HALF MOON BAY, Serial No. 78208591, to proceed to publication, and their cancellation of the Notice of Allowance with respect to Applicant's mark HALF MOON BAY WINERY (& Design), Serial No. 78208878, must be reversed.

ARGUMENT

I. The primary significance of Applicant's proposed marks is not geographic.

The significance of a trademark must be determined from the viewpoint of the relevant purchasing public. *In re Northland Aluminum Products*, 777 F.2d 1556, 1559 (Fed. Cir. 1983). *See also Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8, 11 (9th Cir. 1970) (“[W]e are required to consider standards of meaning not our own, but prevalent among prospective purchasers of the article.”) In this case, the relevant purchasing public is wine drinkers throughout the United States.

² The Trademark Manual of Examining Procedure provides that to establish a prima facie case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show that: (1) the primary significance of the mark is geographic; (2) purchasers would be likely to make a goods/place or services/place association, *i.e.*, to think that the goods or services originate in the geographic place identified in the mark; and (3) the mark identifies the geographic origin of the goods or services. TMEP §1210.01(a).

Contrary to the examiner's view, when the typical American wine drinker hears the words "Half Moon Bay" or sees these words on a wine label, the consumer does not automatically think of Half Moon Bay, California. There is no basis in the present record to conclude that this is the primary connection made by the mark. To wine consumers across the United States, most of them unfamiliar with Northern California geography, the far more likely association is with two things: a half moon and a sheltered body of water. A "half moon," of course, refers to the phase of the moon in which only half of the moon is visible. Applicant's proposed marks conjure up, in the minds of wine drinkers, the image of enjoying Applicant's product in the moonlight by the water. Such circumstances are the perfect occasion for a fine glass of wine. That the proposed marks share the HALF MOON BAY name with a place is purely incidental.

While the proposed marks do have geographic significance, since applicant's winery is located in Half Moon Bay, California, they are not *primarily* geographically significant as required for a section 2(e)(2) refusal. In a frequently quoted decision, the Fifth Circuit explained:

"[T]he wording of the statute makes it plain that not all terms which are geographically suggestive are unregistrable. There are certain words, which while containing the germ of geographic significance, cannot be identified with any specific geographic unit or are not used in a descriptive sense and hence do not fall within the ambit of proscribed trademarks. Indeed, the statutory language declares nonregistrable only those words which are 'primarily geographically descriptive.' The word 'primarily' should not be overlooked...." *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 486 (5th Cir. 1971).

Accordingly, the Board has repeatedly held registrable marks that happen to share the name of the place where the corresponding product originates.

For example, the Board held that a company whose principal place of business was Birmingham, Alabama, could register the mark DIXIE for insurance. *In re Dixie Insurance Company*, 223 U.S.P.Q. (BNA) 514 (1984). In that case, the applicant conceded that that the

proposed mark identifies the "Old South," *i.e.*, the portion of the United States south of the Mason-Dixon Line. *Id.*, at 2. The Board noted that "some marks may quite properly be held not primarily geographically descriptive even where a goods/place association exists," and it concluded that the Examining Attorney failed to show that the admitted geographical significance of DIXIE was its primary significance to purchasers. *Id.*, at 4. Accordingly, it reversed the Examiner's refusal. Similarly, the Board held that a company located in Waldron, Arkansas could register the mark WALDRON for furniture, as this mark was not primarily geographically descriptive within the meaning of Section 2(e)(2). *In re Waldron Furniture Manufacturing Corporation*, 149 U.S.P.Q. (BNA) 460 (T.T.A.B. 1966). The Board noted that in addition to being the location of the applicant's business, Waldron was also a surname, and "there is no way of knowing what the impact on the purchasing public is likely to be upon seeing 'WALDRON' furniture, or with what, if anything, purchasers are likely to associate the mark." *Id.* See also *In re Application of Brauerei Aying Franz Inselkammer KG*, 217 U.S.P.Q. 73 (T.T.A.B. 1983)(holding AYINGER BEER not primarily geographically descriptive even though the applicant's goods came from Ayer, Germany).

The courts have also recognized that even where a mark may be understood, among other meanings, to denote a place, its primary significance is not necessarily geographic. For example, in *Rockland Mortgage Corp. v. Shareholders Funding*, 835 F. Supp. 182 (D. Del. 1993), the court held that plaintiff's mark ROCKLAND for mortgage services was inherently distinctive even though Rockland is the name of one of the cities in Delaware where plaintiff provided mortgage services. Plaintiff was incorporated in Delaware and its business was limited to a few counties in Delaware and Pennsylvania. Plaintiff contended that ROCKLAND was a suggestive mark "because its components suggest the qualities of plaintiff's business," namely strength and the fact that it deals

with real estate. *Id.*, at 189. The court pointed out that the mark should be viewed from “the minds of potential retail mortgage purchasers” and therefore concluded that it was in fact arbitrary: “Potential purchasers may just as easily take the ‘ROCKLAND’ portion of the mark to signify ‘stony terrain’ as ‘a stable business pertaining to real estate.’” *Id.* Rejecting defendant’s contention that the mark was primarily geographically descriptive, the court stated that “it stretches credulity to find plaintiff had an intention of hitching its fortunes to what is truly an ‘obscure geographic location in Northern Delaware.’” *Id.*, at 190. *See also In re Societe Generale Des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 960 (Fed. Cir. 1987)(holding that the mark VITTEL was not primarily geographically descriptive even though the applicant’s business was located in the town of Vittel, France); *American Plan Corp. v. State Loan & Finance Corp.*, 365 F.2d 635, 638 (3d. Cir. 1966), *cert. denied*, 385 U.S. 1011 (1967)(holding that the mark AMERICAN PLAN CORPORATION was not primarily geographically descriptive even though appellant was located in and provided services throughout the United States).

Even assuming *arguendo* that purchasers primarily associate HALF MOON BAY with a particular location, the proposed marks are still registrable because the place name itself has taken on a separate meaning. “A mark that has a popular significance apart from its geographical meaning is not, in most cases, ‘primarily’ geographical.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §14:28, at 14-57 (2004). The purchasing public, inasmuch as it is familiar with Half Moon Bay, California, recognizes this place as a seaside resort and weekend getaway.³ To the typical consumer, then, HALF MOON BAY connotes a meaning of care-free relaxation and

³ According to the Half Moon Bay Coastside Chamber of Commerce & Visitors Bureau, “This quaint Ocean community boasts numerous Bed and Breakfasts, several motels and some world-renowned hotels.” http://www.halfmoonbaychamber.org/community_info/index.html.

pleasure. These are associations, one assumes, that Applicant hopes consumers will make with its products. Applicant's use of the proposed marks is equivalent to using the mark WALL STREET to connote wealth and power, or the mark CITY OF PARIS to connote high fashion and style. Such terms are closer to being arbitrary⁴ than they are to being descriptive. "Whether the mark is 100 percent fanciful or arbitrary or whether the mark merely suggests some quality, is irrelevant. In either instance secondary meaning is unnecessary." McCarthy, *supra*, §14:7, at 14-15.

In re International Taste, Inc., *supra*, 53 U.S.P.Q.2D (BNA) 1604, provides a good illustration of this principle. In that case, a company located in Culver City, California applied for registration of the mark HOLLYWOOD FRIES (and design) for french fries and refused to disclaim the word "Hollywood." The Examiner concluded that this mark was primarily geographically descriptive of applicant's goods (emphasizing Culver City's "close proximity to Hollywood, California"⁵) and refused registration. *Id.*, at 2. The Board reversed. It acknowledged that Hollywood is the name of an area in California (as well as a town in Florida), but it found that "in view of the other prominent, significant meaning of the term 'Hollywood' as referring to the entertainment industry in general, we find that the Examining Attorney has not established that the *primary* significance of the term 'Hollywood' is that of a geographic location in California. *Id.*, at 5.

Likewise, the Board held that an American company could register the mark THE GREAT AMERICAN BASH for professional wrestling matches. *In re Jim Crockett Promotions, Inc.*, 5 U.S.P.Q.2D (BNA) 1455 (T.T.A.B. 1987). In that case, the Examiner had refused registration after

⁴ Courts consistently hold that when a geographical term is arbitrarily applied to a product, it can be the subject of a valid trademark. See, e.g., *La Touraine Coffee Co. v. Lorraine Coffee Co.*, 157 F.2d 115, 116 (1946).

⁵ Culver City is less than 10 miles from Hollywood.

concluding that the primary significance of the word “American” was geographic⁶, but the Board reversed. The Board explained: “The mere fact that a mark contains a geographical term, even one which is well known and which names the geographical area from which the goods or services originate, does not automatically render the mark unregistrable under Section 2(e)(2). As always, a mark must be considered in the context of its use and the meaning it would have for the relevant public when so used.” *Id.*, at 4. The Board concluded that the mark considered in its entirety suggested “something of desirable quality or excellence”—rather than the origin of goods—and it therefore was not primarily geographically descriptive. *Id.*, at 5.

II. Purchasers are not likely to associate Applicant’s goods with any particular place.

Where a proposed mark’s primary significance is not geographic, there is “no need to decide or even consider whether purchasers would associate the goods or services with that place as a place of their geographic source.” *Dixie Insurance, supra*, 223 U.S.P.Q. (BNA) 514 at 4 (holding that “this case is disposed of by determination of the threshold question whether the term sought to be registered is primarily a geographical term”); *In re International Taste, Inc.*, *supra*, 53 U.S.P.Q.2D (BNA) 1604 at 7 (“In view of our finding that the term ‘Hollywood’ is not primarily a geographical term, we need not reach the question of whether the Examining Attorney has established a goods and services/place association between the term and the applied-for goods and services.”). Thus, because the proposed marks are not primarily geographically significant, the Board can end its inquiry.

⁶ The Examiner emphasized this word because it found that “the” is an article without trademark significance; “great” is a laudatorily descriptive term; and the applicant disclaimed “bash” because it is descriptive of an important sports contest. *Crockett, supra*, 5 U.S.P.Q.2d (BNA) 1455 at 2-3.

Nonetheless, Applicant respectfully contends that purchasers are not likely to make a goods/place association as required for a section 2(e) (2) refusal.⁷

As discussed above, Applicant's proposed marks serve to convey a particular image in the minds of consumers independent of the origin of the Applicant's goods. Furthermore, the multitude of places known as "Half Moon Bay" throughout the world ensures that consumers will not automatically and exclusively make a connection between Applicant's geographic location and the proposed mark. Many bays that have no connection whatsoever to either Applicant or its goods are named "Half Moon Bay." Among several other places, the term refers to five bays in Australia, see <http://www.ga.gov.au/bin/gazm01?placename=half+moon+bay&placetype=C&state=0>; a bay in St. Kitts, see <http://www.halfmoonbayvillas.com/>; a bay in Antigua, see <http://www.caribbeanavenue.com/treetops/dview2.html>; and a bay in New Zealand, see http://www.traveljournals.net/explore/new_zealand/map/m2154605/halfmoon_bay.html. Moreover, "Half Moon Bay" refers to two cities in Australia—a region widely known for its wine. See <http://www.halfmoonbay.localguide.com.au/>.

This case is similar to *In re Consolidated Foods Corporation*, 218 U.S.P.Q. 184 (T.T.A.B. 1983), where the Board held that the term LAUDERDALE was not primarily geographically descriptive as used in LAUDERDALE FARMS for meats and poultry from Lauderdale County,

⁷ The Board has stated that where a proposed mark is primarily geographically descriptive and where the geographical place is neither obscure nor remote, a goods/place association may "ordinarily" be presumed where the applicant's goods come from the geographical place named in the mark. *In re Application of Handler Fenton Westerns, Inc.*, 214 U.S.P.Q. (BNA) 848, 5 (T.T.A.B. 1982). But this presumption is rebuttable, and the Board often avoids applying it at all. See *In re Gale Hayman, Inc.*, 15 U.S.P.Q.2D (BNA) 1478, 4 (T.T.A.B. 1990)(holding presumption inapplicable to the mark SUNSET BOULEVARD even though applicant's goods originate in Century City, California, close to Sunset Boulevard); *Dixie, supra*, 223 U.S.P.Q. (BNA) 514 at 4 (holding presumption inapplicable to the mark DIXIE even though applicants' goods originate in Alabama).

Alabama. The Board observed that the term “Lauderdale” “is a part of other geographic terms such as Lauderdale, Scotland, Lauderdale, Minnesota, Lauderdale-by-the-Sea, Florida, Lauderdale County, Mississippi and Lauderdale County, Tennessee. We have no evidence before us suggesting that the public is likely to associate the term ‘Lauderdale’ in applicant's mark with Lauderdale County, Alabama, rather than any of these other place names....” *Id.* at 9.

III. Third-party registrations confirm that Applicant’s proposed mark is not primarily geographically descriptive.

The wine industry commonly uses geographic place names as trademarks. Numerous other applicants have registered marks under these circumstances. For example, the E. & J. Gallo Winery, which owns and operates a winery in Livingston, California, has registered the mark LIVINGSTON CELLARS for wine, Serial No. 1,179,451. See Exhibit A. Likewise, the Robert Mondavi Winery, which operates a winery in Woodbridge, California, has registered the mark WOODBRIDGE for wine, Serial No. 1,495,291. See Exhibit B. Applicant made this assertion in its office action responses, but the Examiner was unmoved because she found that “the registrations have not been properly made of record.” The Examiner explained that “[i]n order to make third-party registrations properly of record in a proceeding such as this, applicant should submit copies of the registrations themselves, or the electronic equivalent thereof, namely, printouts from the electronic records of the Patent and Trademark Office’s Trademark Automated Search System....” Copies of such printouts are attached.

CONCLUSION

For the reasons stated, Applicant respectfully submits that the Examining Attorney as to the mark HALF MOON BAY, Serial No. 78208591, erred in refusing registration. Because the Office’s

cancellation of its Notice of Allowance as to HALF MOON BAY WINERY (& Design), Serial No. 78208878, was based upon the same erroneous grounds, i.e., that said mark is primarily geographically descriptive, Notice of Allowance as to that mark should be reissued.

The Board must resolve all doubt concerning the primary significance of HALF MOON BAY in favor of Applicant. *In re John Harvey & Sons Limited*, 32 U.S.P.Q.2d 1451, 1455 (T.T.A.B. 1994). Accordingly, the Board should find that Applicant's proposed marks are registrable.

Respectfully submitted,



Paul W. Reidl
Attorney for Applicant



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LIVINGSTON CELLARS

Word Mark	LIVINGSTON CELLARS
Goods and Services	IC 033. US 047. G & S: Wines. FIRST USE: 19800815. FIRST USE IN COMMERCE: 19800815
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	.73278166
Filing Date	September 17, 1980
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	September 1, 1981
Registration Number	1179451
Registration Date	November 24, 1981
Owner	(REGISTRANT) E. & J. Gallo Winery a.k.a. Gallo Livingston Cellars CORPORATION CALIFORNIA 600 Yosemite Blvd. Modesto CALIFORNIA 95353
Prior Registrations	0854802
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20011231.
Renewal	1ST RENEWAL 20011231
Live/Dead Indicator	LIVE



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Typed Drawing

Word Mark	WOODBIDGE
Goods and Services	IC 033. US 047. G & S: WINE. FIRST USE: 19731115. FIRST USE IN COMMERCE: 19731115
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73634251
Filing Date	December 8, 1986
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	April 21, 1987
Registration Number	1495291
Registration Date	July 5, 1988
Owner	(REGISTRANT) ROBERT MONDAVI WINERY CORPORATION CALIFORNIA 841 Latour Court Napa CALIFORNIA 94558
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	JOHN K. UILKEMA
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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