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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lafayette Street Partners, LLC

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Serial No. 78678314

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Susan Upton Douglas and Vanessa Hwang Lui of Fross Zelnick Lehrman & Zissu, P.C. for Lafayette Street Partners, LLC.

Steven Foster, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

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Before Kuhlke, Walsh and Mermelstein, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Lafayette Street Partners, LLC (applicant) has applied to register the mark shown here for "restaurant services."

Applicant has disclaimed "BRASSERIE."[1]

The Examining Attorney finally refused registration on the grounds that the mark is primarily geographically deceptively misdescriptive of the identified services under Trademark Act Section 2(e)(3), 15 U.S.C. § 1052(e)(3). Applicant appealed. Both applicant and the Examining Attorney have filed briefs. We reverse.

Before addressing the refusal, we must attend to one evidentiary objection. The Examining Attorney has objected to consideration of Exhibit E, attached to applicant's main brief, consisting of copies of pages from *ZAGATSURVEY 2007 NEW YORK CITY RESTAURANTS* on the grounds that the exhibit was submitted for the first time with the brief. Applicant has not responded to the objection in its reply brief. The objection is well taken; the record must be complete at the time the appeal is filed. *See* 37 C.F.R. § 2.142(d). Accordingly, we sustain the objection, and we have not considered this evidence.

Turning to the refusal, to determine whether the mark is primarily geographically deceptively misdescriptive we must consider whether:

> … (1) the primary significance of the mark is a generally known geographic location, (2)

[1] Application Serial No. 78678314, filed July 26, 2005, alleging first use anywhere and first use in commerce on June 1, 2006.

> [whether] the consuming public is likely to believe the place identified by the mark indicates the origin of the goods [or services] bearing the mark, when in fact the goods [or services] do not come from that place, and (3) [whether] the misrepresentation was a material factor in the consumer's decision.

In re California Innovations Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003). *See also In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003); *United States Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537 (TTAB 2006).

In *Les Halles*, the Federal Circuit discussed the application of the *California Innovations* test to services, in particular, to restaurant services:

> In the case of a services-place association, however, a mere showing that the geographic location in the mark is known for performing the service is not sufficient. Rather the second prong of the test requires some additional reason for the consumer to associate the services with the geographic location invoked by the mark. *See In re Municipal Capital Markets, Corp.*, 51 USPQ2d 1369, 1370-71 (TTAB 1999) ("Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location."). Thus, a services-place association in a case dealing with restaurant services, such as the present case, requires a showing that the patrons of the restaurant are likely to believe the restaurant services have their origin in the location indicated by the mark. In other words, to refuse registration under section 2(e)(3), the PTO must show that patrons will likely be misled to make some meaningful connection between the restaurant (the service) and the relevant place.

In re Les Halles De Paris J.V., 67 USPQ2d at 1541 ("… the record does not show that a diner at the restaurant in question in New York City would identify the region in Paris [LE MARAIS, the mark] as a source of those restaurant services.").

The Board later applied *Les Halles* and determined that the mark COLORADO STEAKHOUSE was primarily geographically deceptively misdescriptive for restaurant services. *In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921 (TTAB 2004). The Board found that the evidence in the case established that Colorado was known for steaks and "… that 'Colorado steaks' are featured food items in restaurants not only within the state of Colorado but outside the state as well." *Id.* at 1927. The Board stated, "Therefore, consumers will believe, mistakenly, that the steaks served at applicant's steakhouse restaurants come from Colorado, when they do not." *Id.* at 1927-28. The Board explained further, "The Examining Attorney's evidence shows that steaks from Colorado are served in other locations, such that out-of-state consumers would reasonably believe a 'Colorado Steakhouse' served Colorado beef, regardless of the restaurant's location." *Id.* at 1928. Thus, the Board found that the Examining Attorney had established the

necessary "meaningful connection" and "heightened association" required by *Les Halles*.

In the case before us, the Examining Attorney argues that CHINATOWN is a defined neighborhood in New York City, that applicant is not located in CHINATOWN but about ½ mile north of CHINATOWN, that CHINATOWN is known for its restaurants and Chinese cuisine, and that the location of a restaurant in Chinatown would be material to a consumer's choice of the restaurant.

The Examining Attorney posits that a tourist, "unfamiliar with the nuances of where the borders of various New York neighborhoods fall," encountering the CHINATOWN BRASSERIE mark may be deceived into thinking that the restaurant is in Chinatown. Examining Attorney's Brief at unnumbered page 13.

Applicant argues that, "… the primary meaning and significance of the term CHINATOWN is not geographic," but that it "… now only suggests a style of Chinese cuisine, not a neighborhood." Applicant's Brief at 4. Applicant discounts the importance of the fact that a number of Chinese restaurants are located in Chinatown.

We first consider whether the primary significance of CHINATOWN, in the context of the CHINATOWN BRASSERIE mark, is that of a generally known geographic location. We note

the Examining Attorney's observation that applicant's restaurant is within ½ mile of the neighborhood in the borough of Manhattan referred to as CHINATOWN, a fact which applicant does not dispute.

Applicant has made of record historical information related to this neighborhood indicating that the CHINATOWN neighborhood in Manhattan started on Mott Street, Park, Pell and Doyer Streets. *Wikipedia* entry attached to Applicant's Response of July 17, 2006. The Chinese population of the area was about 200 in 1870, 2000 in 1882, and 7,000 in 1900. Up until the 1970s, the "accepted" borders of CHINATOWN were generally Canal Street to the North, The Bowery to the East, Worth Street to the South and Baxter Street to the West. *Id.*

Beginning in 1965 the Chinese population in the neighborhood "exploded" with geographical expansion mainly to the north. In the process CHINATOWN supplanted most of Little Italy. In the 1990s the Chinese population expanded further and also supplanted the Jewish and Hispanic populations in adjacent neighborhoods in the Lower East Side. *Id.* Consequently, the borders of Chinatown have evolved and expanded. The parties refer to Delancey Street as the generally accepted border of CHINATOWN to the North

at present. The estimates of the current population within the neighborhood vary widely from 150,000 to 350,000.

"CHINATOWNS" have also emerged in other New York City boroughs, for example, in Flushing, Queens and Sunset Park, Brooklyn, and even in the New York City suburbs. *Id.*

We have also consulted a number of dictionaries and other reference works to determine the significance of CHINATOWN.[2] The definition for "Chinatown" in the *Columbia Gazetteer of the World* (1998) refers to the neighborhood in Lower Manhattan known as CHINATOWN and states, "… Once an 8-block area S of Canal St., it now stretches to include over 65 blocks." The definition also refers to the "Two other Chinatowns" in Queens and Brooklyn. *The American Heritage Dictionary of the English Language* (4th ed. 2006) defines "Chinatown" as "a neighborhood or section of a city that is inhabited chiefly by Chinese people." In like manner, The *New Oxford American Dictionary* (2nd ed. 2005) defines "Chinatown" as "a district of any non-Chinese town, esp. a city or seaport, in which the population is predominantly of Chinese origin." Thus, there are "CHINATOWNS" in many cities.

[2] The Board may take judicial notice of dictionaries and similar references. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

On this record we conclude that the primary significance of CHINATOWN, as used in the CHINATOWN BRASSERIE mark, is not that of a generally known geographic location – at least not in the sense intended by the Trademark Act. The record indicates that "CHINATOWN" is used generally to refer to neighborhoods with a predominantly Chinese population. The record indicates further that, in the case of New York City, the city where applicant's restaurant is located, there is more than one CHINATOWN. Also, the "CHINATOWN" which is only ½ mile from applicant's restaurant, is a consistently-expanding neighborhood.

Furthermore, contrary to the Examining Attorney's argument, this is not like those cases where there is more than one place known by the same name. *Cf. In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). This is not a case where there is more than one city named "Durango" or "Paris" and the goods are associated with one, in particular. Any CHINATOWN, by definition, would have Chinese businesses, including restaurants. The point is that the Chinese restaurants located in the CHINATOWN in Manhattan, and for that matter in any other CHINATOWN, are not associated with a particular food, like steaks, or a style or quality of

cuisine that would distinguish them from Chinese restaurants in places not identified as CHINATOWN.

In addition, CHINATOWN is not the only element in the mark. The entire word mark is CHINATOWN BRASSERIE, and there are also design elements in the mark. The Examining Attorney dismisses the significance of BRASSERIE in the mark arguing that it is simply a word meaning "a restaurant serving alcoholic beverages, especially beer, as well as food" and that there is no incongruity in the combination of CHINATOWN and BRASSERIE. Examining Attorney's Brief at 19. On the other hand, applicant argues that BRASSERIE "… evokes European cuisine, and is inherently incongruous with a location in Chinatown." Applicant's Brief at 10.

There is an obvious incongruity in this combination. The *Merriam-Webster's Collegiate Dictionary* (11th ed. 2003) defines "brasserie," in relevant part, as "an informal usu. French restaurant serving simple hearty food."[3] Taken as a whole, the mark suggests a truly "incongruous" combination of Chinese and other non-Chinese cuisine. The menu for applicant's restaurant in the record reflects that same incongruous combination. It is this suggestive meaning, and not that of a geographical location, which the entire

[3] *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ at 596.

mark projects. This lends further support to our conclusion that the primary significance of the mark is not that of a generally known geographic location. *Cf. In re International Taste Inc.*, 53 USPQ2d 1604, 1605 (TTAB 2000); *In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369, 1371 (TTAB 1999); *In re Cotter & Co.*, 228 USPQ 202, 205 (TTAB 1985).

Accordingly, we conclude that CHINATOWN, as used in the CHINATOWN BRASSERIE mark, is not a "geographic location" for purposes of Section 2(e)(3).

We could end our analysis at this point and conclude, based on our conclusion regarding this factor alone, that the mark is not primarily geographically deceptively misdescriptive of the services. However, it is useful in this case, for the sake of completeness, to consider the other factors in the *Les Halles* test; those factors further support our overall conclusion that the CHINATOWN BRASSERIE mark is not primarily geographically deceptively misdescriptive.

Turning to the issue of a possible services-place association, we conclude that there is none here. The *Les Halles* opinion makes the obvious and very practical observation that a customer sitting in a restaurant in New York will not believe that he or she is in Paris. *In re*

Les Halles De Paris J.V., 67 USPQ2d at 1541. Consequently, the Court directs that we find some other "meaningful connection" between the restaurant services and the place named to sustain a refusal under Section 2(e)(3). The Court suggests, "For example, the PTO might find a services-place association if the record shows that patrons, though sitting in New York, would believe the food served by the restaurant was imported from Paris, or that the chefs in New York received specialized training in the region in Paris." *Id.* In the *Colorado Steakhouse* case, as we noted above, the Board found that consumers might make a meaningful connection because they may believe that the steaks served in the restaurant, not located in Colorado, came from Colorado which is known for its steaks. *In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d at 1927.

We find no such connection here. There is no connection such as those discussed in either the *Les Halles* or the *Colorado Steakhouse* cases. The Examining Attorney has provided evidence to show that the CHINATOWN in Lower Manhattan has many Chinese restaurants and that those restaurants are noted for their Chinese cuisine. However, we fail to see how someone dining in a restaurant ½ mile away would connect the services in applicant's restaurant in a meaningful way with the services offered in

restaurants in CHINATOWN, however that is defined. We have no evidence that the CHINATOWN in Lower Manhattan, nor any other one, is associated with a distinct type or style of Chinese cuisine. Neither the quality, nor the authenticity, nor any other feature of the restaurant services offered within the "borders" of CHINATOWN would necessarily differ in a meaningful way from the same services offered ½ mile away at another restaurant featuring Chinese cuisine. While a tourist may be confused about the location of the restaurant and/or the nuances of the neighborhood borders, this is not relevant to any services-place association delineated in *Les Halles*.

Therefore, we conclude, on this record, that there is no services-place association between the services and the mark at issue here. Furthermore, it also logically follows that, since we find no misrepresentation, we also conclude that there is no material effect on the purchasing decision.

For the record, we have given full consideration to all evidence and arguments presented here, including that evidence and those arguments we have not specifically discussed.

In sum, we conclude that the CHINATOWN BRASSERIE mark is not primarily deceptively misdescriptive of restaurant services.

Decision: We reverse the refusal under Section 2(e)(3).