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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Lankshear

Serial No. 85239139

Matthew H. Swyers of The Trademark Company, PLLC for John Lankshear.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Kuhlke, Shaw, and Adlin, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, John Lankshear, filed an application to register on the Principal Register the mark,



for goods identified as: "Pants; Women's clothing, namely, shirts, dresses, skirts, blouses; Women's shoes; Women's underwear," in International Class 25.¹

¹ Application Serial No. 85239139, filed on February 10, 2011 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce.

The examining attorney has refused registration under Sections 2(a) and 2(e)(3) of the Trademark Act, 15 U.S.C. §§ 1052(a) and 1052(e)(3), on the grounds that applicant's mark is geographically deceptive and geographically deceptively misdescriptive, respectively.

After the refusal was made final, applicant appealed. The case is fully briefed. For the reasons discussed below, we reverse the refusal to register.

Preliminary Issues

We must first address an issue involving the statutory grounds for refusal. The Board has previously advised, based on the guidance of our primary reviewing court, that the appropriate refusal under circumstances such as those presented herein is that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3), not Section 2(a). *In re South Park Cigar Inc.*, 82 USPQ2d 1507, 1509 (TTAB 2007), citing to *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 and 1858 (Fed. Cir. 2003) ("NAFTA and its implementing legislation obliterated the distinction between geographically deceptive marks and primarily geographically deceptively misdescriptive marks," and, therefore, "this court anticipates that the PTO will usually address geographically deceptive marks under subsection (e)(3) of the amended Lanham Act rather than subsection (a).").² *See also, In re Spirits Int'l N.V.*, 86 USPQ2d 1078, 1080 n.3 (TTAB 2008), *reversed*

² In the *South Park Cigar* decision, the Board posited that there remains the possibility that Section 2(a) will be the basis for refusal in the limited situation where applicant seeks registration on the principal register based on a claim that the mark had acquired distinctiveness prior to December 8, 1993. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1853 n.32 (TTAB 2012). However, the involved application in this proceeding is based on an intent to use the mark in commerce.

and remanded on other grounds, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009). Thus, we deem the appropriate refusal in this case involving an allegedly geographically deceptive mark to be only the Section 2(e)(3) “primarily geographically deceptively misdescriptive” refusal, and not the Section 2(a) deceptiveness refusal. *South Park Cigar*, 82 USPQ2d at 1509.

Analysis

Regardless of the actual statutory basis being asserted for refusing registration in this appeal, there is no dispute regarding the applicable legal standard. The examining attorney and applicant both agree that the same elements must be present for a mark to be refused as either geographically deceptive or primarily geographically deceptively misdescriptive. They are:

- 1) The primary significance of the mark is a generally known geographic place;
- 2) Purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark;
- 3) The goods or services do not originate in the place identified in the mark; and
- 4) The misrepresentation would be a material factor for a substantial portion of relevant consumers in deciding whether to buy the goods or use the services.

Spirits Int’l, 90 USPQ2d at 1490-95; *In re California Innovations*, 66 USPQ2d at 1858. *See also*, *In re Miracle Tuesday LLC*, 695 F.3d 1339, 104 USPQ2d 1330 (Fed. Cir. 2012).

We begin with the primary significance of the mark. To support a finding under Section 2(e)(3), it must first be shown that the place named in the mark is a

place that is or would be generally known to the relevant purchasers, and not a place that is remote or obscure. *See In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, 1821; *In re Joint- Stock Co. "Baik"*, 80 USPQ2d 1305, 1309. That is, it must be shown that relevant purchasers would readily recognize that the allegedly geographical designation at issue (be it the mark as a whole or the relevant portion thereof) is in fact the name of a geographical place, and would not view it instead merely as an arbitrary term which is being used as a trademark.

The examining attorney argues that "the designation SW3 is recognized as being synonymous with the Chelsea District of London . . . famous for its shopping and designer clothing boutiques" and that "[c]onsumers seeing the designation UK on the applicant's clothing items would assume the goods come from England."³ The examining attorney has put into the record a variety of excerpts from internet sources to show that SW3 identifies the postal code of the Chelsea District of London and UK refers to the United Kingdom:

- **[http://en.wikipedia.org/wiki/Chelsea, London](http://en.wikipedia.org/wiki/Chelsea,_London)** – A Wikipedia entry providing information about the district of Chelsea, London. The term SW3 appears in a section describing the boundaries of Chelsea:

Chelsea consists of two main postcodes (SW3 and SW10) but also includes small sections of SW1. All of Chelsea is, by definition, in the Royal Borough of Kensington and Chelsea (RBKC). On the eastern side RBKC meets the equally expensive borough of the City of Westminster (COW), this meets at Chelsea Bridge Road where the postcode is SW1W, with one side of the road being in COW and the other in RBKC. The vast majority of Chelsea is SW3. The far west of Chelsea is SW10 and SW5. . . . The most desirable part of Chelsea is around Sloane Square and Knightsbridge tube. Around here,

³ Examining attorney's Br. at 4.

Chelsea meets Knightsbridge. . . . Much of Chelsea is now viewed as a "Global Ultra Prime Residential Area". Much of Chelsea (SW3) and Knightsbridge (SW1X) is still owned by Earl Cadogan, through the Cadogan Estates.

The Wikipedia entry further describes Chelsea as “The borough of artists” and “Swinging Chelsea”:

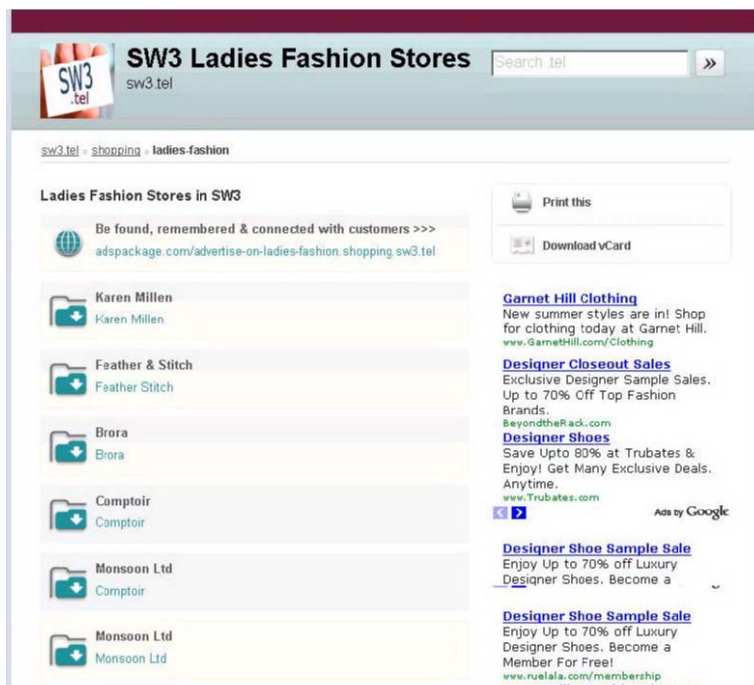
Chelsea once had a reputation as London's bohemian quarter, the haunt of artists, radicals, painters and poets. Little of this seems to survive now – the comfortable squares off King's Road are homes to, amongst others, investment bankers and film stars. . . .

Chelsea shone again, brightly but briefly, in the 1960s Swinging London period and the early 1970s. The Swinging Sixties was defined on King's Road, which runs the length of the area. . . .

Chelsea at this time was home to both the Beatles, and Rolling Stones members Brian Jones, Mick Jagger, and Keith Richards. . . .

King's Road remains the major artery through Chelsea and a very busy road, despite its continuing reputation as a shopping mecca, it is now home to many of the same shops found on any other British high streets, such as Gap, and McDonald's. Sloane Street and Knightsbridge are overtaking Bond Street as one of London's premier shopping destinations, housing a variety of high-end fashion or jewellery boutiques such as Cartier, Gucci, and Graff.

- <http://fashion-wear.shopping.sw3.tel> and <http://ladies-fashion.shopping.sw3.tel> – A listing of “fashion wear stores” and “ladies fashion stores” from an online directory of information. The listings provide the name of the store with no further information about the goods sold or the significance of SW3. A sample appears below.

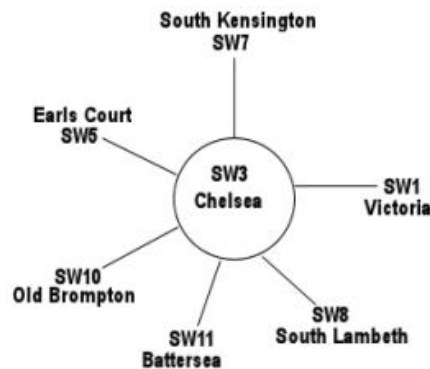


- <http://www.n-jobs.co.uk> – Two online employment advertisements, one for a “fashion designer” and the other for a “general manager – Italian luxury menswear”, both in the SW3 postal code area.
- <http://www.milesfaster.co.uk/hotels/london/sw3/knightsbridge/the-levin-hotel.htm> – A British hotel information website billing itself as “The London Hotel Specialists!” and providing a review of the “Levin” hotel in Knightsbridge. The term SW3 appears in the web page address, above, and in the hotel’s physical address given as *28 Basil Street, Knightsbridge, London, England, UK, SW3 1AS*. At the bottom of the page there are internet links to other hotels in “adjacent areas” and a diagram showing “surrounding postcodes:”

Hotels in the Adjacent Areas

>>>MORE HOTELS IN CHELSEA SW3

surrounding postcodes: SW11 SW8 SW1 SW7 SW5 SW10



The web page provides the following additional information about the neighborhood surrounding the hotel:

The Levin hotel occupies a location next to one of London's most iconic landmarks, namely the famous Harrods department store, where the rich and famous do their shopping. This area is known as Knightsbridge and is surrounded some of most upmarket and chic shopping anywhere in the capital. Bounded by Brompton Road to the east and Sloane Street on the west side there is no end of restaurants, bars, boutiques and major stores to choose from. Perhaps best known for its fashion with designer shops along Sloane Street Just under half a mile to the south is the Kings Road, Chelsea. This long stretch of road is popular both by day and night. During the day shoppers flock to the trend setting boutiques and the many restaurants while at night the wine bars and pubs make for a great evening venue.

- http://www.fashionsources.co.uk/fashion/designers_London.html - A web site providing fashion information including a listing of twenty-nine prominent London fashion designers, including descriptions of three that are located in the SW3 postcode district as described below:

Amanda Wakeley

Launched in 1990, the brand has garnered a reputation for creating a confident,

polished look. Her signatures are attention to detail, perfection of cut and the finest fabrics. Store in Fulham Road, London SW3.

Bruce Oldfield

Renowned for his red carpet gowns worn by Hollywood actresses and celebrities. The couture, bridal and ready-to-wear collections can be found at his shop in Beauchamp Place, London SW3.

Margaret Howell

Launched in the late 1980's, her finely-tailored collections have a relaxed off duty, androgynous almost masculine look. Flagship showrooms in Wigmore Street, W1, Fulham Road, SW3 and Richmond.

- **<http://londontown.com>** – An excerpt titled “Shopping in SW3” from “LONDONTOWN,” a travel and information website about the city of London. The excerpt provides brief information about thirty retail stores in the SW3 postal code area, including food and drink shops, florists, perfume and cosmetics stores, department stores, and jewelry stores. Only three of the thirty listings refer to “ladies fashion” or “clothing” generally.
- **[www.elegant-lifestyle.com/london shopping](http://www.elegant-lifestyle.com/london_shopping)** - A listing of thirty-seven retail stores in London, including department stores, shoe stores, menswear stores, interior designs stores, auction houses and bookstores. Five of the thirty-seven listed stores sell clothing and are in the SW3 postal code area. The term SW3 appears in the address of the five stores in the manner shown in the example below.

Rigby & Peller; Shopping: Clothing; Most elegant but erotic lingerie, also made-to-measure available (Princess Diana used to be a client); Tel: +44-20-7491 2200; Fax: +44-20-7491 4209; 22 Conduit Street (main store); Mayfair, London W1R 9TB; or: other store: 2 Hans Road, Knightsbridge, London SW3; Open: Mon-Sat 9.30am-5.30pm; Tube: Bond Street (other: Knightsbridge); website: www.rigbyandpeller.com



- An excerpt from the **MSN Encarta** and **yahoo.com** online dictionaries defining U.K. and the United Kingdom as “a country of western Europe comprising England, Scotland, Wales, and Northern Ireland.” The capital of the United Kingdom is London.

Applicant argues that the mark is not geographically descriptive because, “as a whole, it creates separate meaning.”⁴ Moreover, while applicant admits that SW3 is a London postal code for the Chelsea district, applicant argues that “to the

⁴ Applicant’s Br. at 5.

general purchasing public, this is *not* a well-known or generally known fact.”⁵

Finally, applicant argues that the USPTO has registered a number of marks comprising zip codes or postal codes similar to applicant’s mark. Applicant has made of record the following seven⁶ registrations:

Mark	Registration No.	Goods/Services
SW3	3991099	Class 11: Electric Lighting Fixtures
SW4	3956876	Class 33: Spirits
SW2	3679180	Class 35: Arranging personal appearances by persons working in the field of film, music, television, entertainment or sport; Employment services in the nature of talent casting in the fields of music, video, and films; Providing consumer information services and making referrals in the field of entertainment services for products, services, events, activities, facilities and locations; Class 41: Arranging and conducting nightclub entertainment events; Entertainment and recreational services, namely, organizing and conducting a knitting/crocheting event the proceeds of which are donated to charity
BEVERLY HILLS 90210 and design	3027594	Class 41: Entertainment services in the nature of a dramatic television series.
BEVERLY HILLS 90210 and design	3596450	Class 3: Perfume; Cologne; Eau de toilette
DR. 90210	3041139	Class 41: Entertainment services; namely an ongoing reality television series featuring doctors and their patients, and information related to such series disseminated through global computer networks
33139	3446685	Class 25: Hats, head wear, caps, visors, sun visors, shirts, t-shirts, tank-tops

We begin by finding that the relevant purchasing public for the goods at issue, women’s clothing and shoes, consists of average American women’s clothing

⁵ *Id.*

⁶ Registration No. 2598330 has been canceled.

purchasers. *See In re Brouwerij Nacional Balashi NV*, 80 USPQ2d at 1821 (The relevant purchaser of goods is the average American consumer and not the unusually well-traveled tourist.).

Additionally, although we are considering the mark in its entirety, our findings and analysis on this issue (like the applicant's and examining attorney's arguments) will be focused on the primary significance of the words SW3 and UK. We find that the crown design and the disclaimed word BESPOKE have less probative significance in our determination of whether the primary significance of the mark is geographical under Section 2(e)(3).

Where the mark comprises a geographical term but the geographical significance is minor, obscure, remote or unconnected with the goods, the mark is treated as an arbitrary one. *See In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982) (use of a geographic term in a fictitious, arbitrary or fanciful manner is not "primarily" a geographic designation.); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (A term may be considered an arbitrary designation if the geographical significance is "lost on the public because of obscurity.").

There is no dispute that SW3 is a postal code for the district of Chelsea, London. SW3, therefore, connotes a geographical location and applicant has conceded as much. Nevertheless, while SW3 refers to Chelsea, the question is how many people *in the United States* would know the geographical significance of SW3? That is, how many American consumers would know that SW3 identifies the district of Chelsea in particular?

We think the record in this case is inadequate to show that an average American consumer purchasing women's clothing would, upon seeing applicant's mark, conclude that it relates to a neighborhood in London, namely, Chelsea. In many of the internet excerpts submitted by the examining attorney, the term SW3 has only minor significance as part of a store's address. Even in the directory-style listings of stores where the term SW3 appears more prominently, there is nothing in the record to indicate that American consumers would recognize or associate SW3 with Chelsea in particular or that SW3 is ever used as shorthand for Chelsea. That is, even if consumers recognized that SW3 was a British postal code, there is little evidence that they would recognize it as the code for Chelsea. Similarly, the designation UK, which appears in very small letters within the term SW3, does nothing to aid prospective consumers in identifying Chelsea, a section of one city in the UK, as the place signified by SW3. In short, the geographical significance of SW3 to the average American consumer is so minor or obscure that, when used on women's clothing, the term must be treated as an arbitrary designation.

Further, to the extent that potential consumers recognize the meaning of SW3, the record supports applicant's position that it would be indicative of a trendy style, viewed more as evoking an attitude of a place (fast-paced, swinging, trendy, high-end) rather than the place of manufacture of a particular type of product, let alone women's clothing specifically. *See Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 90 USPQ 250 (S.D.N.Y. 1951), *aff'd* 203 F.2d 223, 97 USPQ 246 (2d Cir. 1953).

The third-party registrations submitted by applicant confirm that SW3, and similar terms such as SW2, SW4 and U.S. zip codes, have not been regarded by the Office as primarily geographic and have therefore been registered. *See In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1618 (TTAB 2007) (Third party registrations may indicate whether a particular term “has been regarded by the Office as a geographic term.”). While only one of these registrations is for clothing such as applicant’s, we see no reason to deviate from the practice of registering such marks absent a much stronger showing that applicant’s mark identifies a generally known geographic place.

Finally, while we need not reach the remaining elements of the geographically deceptively misdescriptive test in view of our determination regarding the primary significance of the mark, we note that the evidence is not sufficient to make a definitive goods/place association with the specific neighborhood of Chelsea. The evidence shows that it is an artsy, trendy neighborhood. The fact that it is also a shopping district does not necessarily associate it with the production of clothing. To establish a goods/place association, the place must be “known for *producing* the product.” *In re Miracle Tuesday*, 104 USPQ2d at 1333, quoting *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (emphasis added); *Cf. In re Wada*, 48 USPQ2d 1689 (TTAB 1998) *aff’d* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (record included listings of manufacturers of luggage and handbags located in New York).

We find that the examining attorney has not satisfied the Office's burden to demonstrate that the primary significance of the mark is a generally known geographic place. To the extent that there is any doubt as to the primary significance of the term SW3, we resolve doubt in favor of the applicant. *In re Int'l Taste Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000) citing *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451, 1455 (1994).

Decision: The refusal to register is reversed.