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

Proceeding	85930329
Applicant	MMDT Stretch, LLC
Applied for Mark	STRETCH LA
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Serial No. 85930329
Mark: STRETCH LA
Applicant: MMDT Stretch, LLC
Examining Attorney: Sean Crowley

**EX PARTE APPEAL
APPLICANT'S BRIEF**

The Applicant, MMDT Stretch, LA, by counsel, hereby respectfully appeals the Examining Attorney's refusal to register the mark STRETCH LA in standard characters.

DESCRIPTION OF RECORD

A. Prosecution History.

The STRETCH LA Application was initially refused on September 5, 2013 in a non-final office action. Applicant filed a response to the office action on March 4, 2014. A non-final office action was issued by the Examining Attorney on April 4, 2014, in which the Examining Attorney raised a non-final new issue; namely that Applicant provide a written statement explaining whether the services or any aspect thereof will be rendered in, or have any connection with, "LA". Applicant filed a response to this second non-final office action on September 30, 2014. A Final Refusal of Registration for the mark STRETCH LA was issued by the Examining Attorney on October 23, 2014 based on the Examining Attorney's determination that the mark was primarily geographically descriptive under Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2). Applicant's Notice of Appeal and Request for Reconsideration were timely filed on April 23, 2015. On May 19, 2015, the Examining Attorney denied the Request for Reconsideration of the refusal to register based on geographic descriptiveness.

B. Examining Attorney's Evidence.

September 5, 2013 Office Action

The Examining Attorney provided evidence that Los Angeles and Beverly Hills are cities in California. This is beyond dispute.

The Examining Attorney incorrectly provided evidence (as Attachments 7 and 8) to indicate that the services originate in Los Angeles as evidenced by Applicant's website. The Examining Attorney provided a blog that does not belong to Applicant. Applicant intends to provide services nationwide, notwithstanding that it's office is located in Beverly Hills, California.

**May 19, 2015 Examining Attorney Response to Request for Reconsideration
After Final Office Action**

The Examining Attorney provided evidence that LA is a "geographic term in connection with the provision of fitness services." All the Examining Attorney demonstrated was that fitness services are provided in Los Angeles (known as LA), which point is beyond dispute. It is respectfully maintained that he did not demonstrate that "LA" is used as a geographically descriptive term in a trademark context with reference to the provision of fitness services.

C. Applicant's Evidence.

May 4, 2014 Response to Office Action

Applicant provided evidence of the Principal Register registration of LA Fitness. (See Registration No. 2326358.)

September 30, 2014 Response to Office Action

Applicant provided evidence by claiming that it "plans on offering services within and outside of the greater Los Angeles area." Applicant further expressed its intention that the reference to "LA" in the mark "is meant to suggest a level of fitness or healthy lifestyle associated with Los Angeles/Southern California." Applicant stated that "[t]his is believed to be similar to the sense in which 'LA' is used in the LA Fitness mark (Registration Nos. 1806464,

2852260 and 2326358) as well as in its pending registrations (Serial Nos. 86289083 and 86094397)”, each of which were attached with Applicant’s response.

ARGUMENT

A. Legal Standard.

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 a generally known geographic location (see TMEP §§1210.02-1210.02(b)(iv);

(2) the goods or services originate in the place identified in the mark (see TMEP §1210.03); and

(3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (see TMEP §§1210.04-1210.04(d)).”

It is respectfully maintained that the Examining Attorney failed to satisfy the first and second prongs of this test (the “Geographic Descriptiveness Test”) and that refusal to register must be denied accordingly.

B. Analysis.

i. The primary significance of the mark “STRETCH LA” is not a generally known geographic location.

Concerning the first prong of the 3-part test set forth in A. above, “the significance of a mark is primarily geographic if it identifies a real and significant geographic location and primary meaning of the mark is the geographic meaning.” (See TMEP §1210.02.) Applicant

concedes that “LA” identifies a real and significant geographic location, but contends that the primary meaning of the mark is not the geographic meaning.

“To support a refusal to register geographic matter, the Trademark Act requires that the mark be *primarily* geographic, that is, that its primary significance to the relevant consumers in the United States be that of a geographic location. 15 U.S.C. §§1052(e)(2) and (3). *See, e.g., In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445 (Fed. Cir. 2015) (finding evidence insufficient to establish that Newbridge, Ireland is a place known generally to the relevant American public); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK held to have primarily geographic significance; Court was not persuaded by assertions that the composite NEW YORK WAYS GALLERY evokes a gallery that features New York “ways” or “styles”). *See, in particular, In re Roy J. Mankovitz*, 90 USPQ2d 1246 (T.T.A.B. 2009), finding that THE MONTECITO DIET was not primarily descriptive even though applicant’s address was in Montecito, California.

When a geographic term is combined with additional matter (e.g., wording and/or a design element), the examining attorney must determine the primary significance of the composite. (See TMEP §§1210.02(c)-1210.02(c)(iii).)

In its correspondences with the Examining Attorney, Applicant has declared, under penalty of perjury, that the primary significance of “LA” is to denote a healthy lifestyle that Applicant believes consumers would associate with Los Angeles. In its response to Office Action dated March 4, 2014, Applicant states that the “Stretch” component is the primary element in the pending mark. Moreover, while “LA” connotes Los Angeles, it is also associated with fitness, as the inhabitants of Los Angeles are generally thought to be in better physical shape than those that reside elsewhere in the United States.”

As such, Applicant has taken the position, and reasonably so, that “LA” is suggesting a level of fitness, rather than being primarily geographic. This is similar to a reference in a mark for “HOLLYWOOD” to suggest the entertainment industry, rather than a location, or the term “HYDE PARK” to suggest a superior quality of men’s fashion, rather than a location in London, England. (See *In re Int’l Taste Inc.*, 53 USPQ2d 1604, 1605–06 (TTAB 2000) (finding doubt as to the primary significance of HOLLYWOOD because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, with the doubt resolved in favor of the applicant); *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951) (holding that the primary significance of HYDE PARK for men’s suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin), *aff’d*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953).)

In sum, there are significant non-geographic characteristics of the services, notwithstanding the reference to “LA,” which characteristics identify health and fitness, rather than “Los Angeles,” it being further noted that the services are meant to be offered throughout the United States, rather than solely in the greater Los Angeles area.

Applicant has provided evidence of the registrations for “LA FITNESS” (Registration Nos. 1806464, 2852260 and 2326358), which mark uses “LA” to connote fitness and good health, in all likelihood. “STRETCH LA” makes a stronger use of the term “LA” as it is not associated with the term “fitness” and hence, is used in a more arbitrary sense than the use of “LA” in the “LA FITNESS” mark.

Geographic terms may be used a components in marks without indicating geographic origin (e.g., “Boston baked bean”, “Swiss cheese” per TMEP §1210.02(b)(iii)). (See *Forschner Grp. Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 356, 31 USPQ2d 1614, 1619 (2d Cir. 1994),

aff'd, 124 F.3d 402, 43 USPQ2d 1942 (2d Cir. 1997) (finding that SWISS ARMY KNIFE refers to a knife used by the Swiss Army, not an Army Knife from Switzerland); *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin.)

Per TMEP §1210.02(b)(iii), “[w]hen geographic terms are used in circumstances in which it is clear that they are meant to convey some meaning other than geographic origin, registration must not be refused on the basis of geographical descriptiveness”

ii. The Services Do Not Originate In the Place Identified in the Mark.

The second prong of the Geographic Descriptiveness Test requires the Examining Attorney to establish that the services originate in “LA”. (See TMEP §1210.03.) It is respectfully submitted that he has not satisfied this requirement.

Whether a term is primarily geographically descriptive under §2(e)(2) depends on whether the mark identifies the place from which the goods or services originate.” (See TMEP §1210.03.) “When the goods or services may be said to originate both in the geographic place named in the mark and outside that place, registration will normally be refused on the ground that the mark is primarily geographically descriptive under §2(e)(2) of the Trademark Act. *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 n.2 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN for restaurant services held primarily geographically descriptive, where the services were rendered both in California and elsewhere).

In the case of the instant mark, there is nothing for customers in Portland, for instance, to believe that the services originate in Los Angeles, They will be provided at a local location and there will be no nexus to “LA.” This is similar to a customer sitting in a restaurant in New York that claims to be a French bistro.

“Application of the second prong of this test – the services-place association – requires some consideration. A customer typically receives services, particularly in the restaurant business, at the location of the business. Having chosen to come to that place for the services, the customer is well aware of the geographic location of the service. This choice necessarily implies that the customer is less likely to associate the services with the geographic location invoked by the mark rather than the geographic location of the service, such as a restaurant. In this case, the customer is less likely to identify the services with a region of Paris when sitting in a restaurant in New York.” (TMEP §1210.04(b).)

It is respectfully submitted that while the services are intended to be provided at locations within and without the greater Los Angeles area, a customer receiving the services will not be confused as to their origin. This would similarly be the case of an LA Fitness customer receiving personal trainer services at a location in Chicago, Illinois, for example.

It is respectfully submitted that the Examining Attorney has failed to satisfy the second prong of the Geographic Descriptiveness Test based on the above argument.

CONCLUSION

The Examining Attorney has failed to satisfy the first and second prongs of the Geographic Descriptiveness Test, for reasons set forth above. In light of the above,

Applicant respectfully requests that the Board grant this Ex Parte Appeal and allow for the registration of the ‘STRETCH LA’ mark.

Dated this 18th day of July, 2015

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