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Subject: U.S. TRADEMARK APPLICATION NO. 85930329 - STRETCH LA - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85930329

MARK: STRETCH LA



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: MMDT Stretch, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, MMDT Stretch, LLC, appeals the examining attorney's refusal to register on the Principal Register the mark STRETCH LA for "Therapeutic Stretching Services." Registration was refused under Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the ground that the mark is primarily geographically descriptive.

## FACTS

On May 13, 2013, applicant filed an intent to use based application for registration on the Principal Register of the mark STRETCH LA for use in conjunction with “Therapeutic Stretching Services” in International Class 044.

The examining attorney refused registration on September 5, 2013 under Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the ground that the mark is primarily geographically descriptive.

Applicant filed a response on March 4, 2014 wherein applicant provided arguments against the refusal to register the mark.

On April 4, 2014, the examining attorney issued a non-final Office action maintaining and continuing the Section 2(e)(2) refusal and issuing a non-final requirement for more information about where the services will be provided.

Applicant filed a response on September 30, 2014 wherein applicant responded to the information requirement.

A final Office Action was issued on October 23, 2014 making final the refusal under Trademark Act Section 2(e)(2) on the ground that the mark is primarily geographically descriptive. The information requirement was satisfied by applicant’s September 30, 2014 response and was therefore withdrawn.

Applicant filed a request for reconsideration on April 23, 2015 in conjunction with a Notice of Appeal to the Board. The examining attorney denied reconsideration on May 19, 2015.

**ARGUMENT: THE PROPOSED MARK IS PRIMARILY GEOGRAPHICALLY DESCRIPTIVE OF APPLICANT'S IDENTIFIED SERVICES.**

A mark is primarily geographically descriptive when the following is demonstrated:

(1) The primary significance of the mark is a generally known geographic place or location;

(2) The services for which applicant seeks registration originate in the geographic place identified in the mark; and

(3) Purchasers would be likely to make a goods-place or services-place association; that is, purchasers would be likely to believe that the services originate in the geographic place identified in the mark.

TMEP §1210.01(a); see *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014).

- I. The Primary Significance of the Mark is the Generally Known Geographic Place or Location of Los Angeles

With respect to the first prong of the test, the evidence submitted by the examining attorney shows that the primary significance of “LA” is as a geographic location, namely, a county in California. The September 5, 2013 Office action contained evidence from the Macmillan Dictionary demonstrating that the wording “L.A.” is a common abbreviation for Los Angeles. The May 19, 2015 Office action provided evidence from lafitness.com, timeout.com and touchstoneclimbing.com demonstrating that “LA” (without periods) is also a commonly accepted alternate abbreviation for Los Angeles. Evidence from the September 5, 2013 Office action from the Columbia Gazetteer shows that Los Angeles is county in the state of California.

While the evidence of record shows that “LA” is a nickname for Los Angeles, commonly used nicknames for geographic locations are generally treated as equivalent to the proper geographic name of the place identified. TMEP §1210.02(a); *see, e.g., In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive of retail clothing store services where evidence showed that “Carolina” is used to indicate either the state of North Carolina or South Carolina). Additionally, applicant concedes the point in its March 4, 2014 Response stating, in part, “‘LA’ connotes Los Angeles.” *See* Response to Office Action, March 4, 2014. Because the evidence of record demonstrates that “LA” is a commonly used nickname for Los Angeles, it should therefore be treated as the equivalent of “Los Angeles” and the primary significance of the wording “LA” in the mark is therefore as a geographic location or place.

While the applied-for mark also contains the wording “stretch,” this wording does not diminish the primary geographic descriptiveness of “LA” because this wording simply describes that applicant provides stretching services. The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term’s primary geographic significance. TMEP §1210.02(c)(ii).

While applicant has acknowledged that the wording “LA” in the mark may be used to refer to Los Angeles, applicant contends that the use of the geographic term in this instance would not be perceived as referring to the geographic location of Los Angeles but instead to a concept of healthy living or a level of fitness. Applicant’s Brief at 5. However, applicant has provided no evidence whatsoever to support a conclusion about how consumers would perceive the term “LA.” Applicant’s argument instead relies on the presence of a third party registration for the mark LA FITNESS, Registration No. 2326358, for use in connection with health club services on the Principal Register. Registration No. 2326358 proceeded to registration with only disclaimer of “fitness” and no 2(f) claim of acquired distinctiveness and based on this applicant opines that “in all likelihood” that “mark uses ‘LA’ to connote fitness and good health.” Applicant’s Brief at 6.

Applicant’s April 23, 2015 Request for Reconsideration provided the prosecution history for Registration No. 2326358, as well as the prosecution history for that registrant’s prior registration of L. A. FITNESS, Registration No. 1806464, also for use in connection with health club services, which was registered with a disclaimer of “fitness” and a claim of distinctiveness under Trademark Section 2(f). The prosecution history for these registrations makes no reference to any alternative meanings or consumer impressions of any kind that would bolster applicant’s claim that “LA” identifies a level of fitness or healthy living. This history simply indicates that the Office previously allowed two trademark applications to proceed to registration with the same owner where “LA” appeared in the mark in connection with health club services and that the senior registration was registered with a 2(f) claim and disclaimer while the junior registration only registered with a disclaimer. Furthermore, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is

decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Applicant also argues that the Office's allowance of pending third-party Application Nos. 86094397 (LA | FITNESS, plus design, for exercise related goods) and 86289083 (LA FITNESS, for clothing) further demonstrates that the primary significance of LA is as a concept of healthy living or a level of fitness and not as a geographic place. However, these are pending applications and not registrations and should therefore be entitled to little weight. Nevertheless, Application No. 86094397 contains a 2(f) statement in part as to "LA fitness" which suggests that the Office, in that case, viewed the term "LA" as primarily geographically descriptive.

Furthermore, applicant's reliance on these registrations and applications as evidence of applicant's intended meaning of the mark is misplaced; it is the meaning that consumers will attribute to the mark that must be considered and not the meaning that applicant hopes they will form. TMEP §1210.02(b)(1). Applicant has provided no evidence that consumers will attribute this alternate meaning to the mark and no evidence to refute the examiner's evidence from the Macmillan Dictionary, lafitness.com, timeout.com, touchstoneclimbing.com and the Columbia Gazetteer demonstrating that LA primarily refers to a county in California.

## II. The Services Will Originate in Los Angeles

Regarding the second prong of the test, for services to originate in a geographic place, the record must show that they are, or will be, rendered at least in part in the geographic place. *See In re Chalk's Int'l Airline Inc.*, 21 USPQ2d 1637 (TTAB 1991); TMEP §1210.03. Here, applicant stated for the

record in its September 30, 2014 response and again in its April 23, 2015 Request for Reconsideration that “[t]he applicant plans on offering services within and outside of the greater Los Angeles area.” Applicant’s Brief at Page 8 further states that “the services are intended to be provided at locations within and without the greater Los Angeles area.” These admissions clearly establish that the services will be rendered at least in part in Los Angeles, the geographic place named in the mark.

### III. Purchasers Would be Likely to Make a Services-Place Association

With respect to the third prong of the test, when, as here, there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, a public association of the services with the place is presumed if an applicant’s services will originate in the place named in the mark. TMEP §1210.04. As discussed above, the mark clearly points to the geographic location of Los Angeles and applicant has explicitly stated numerous times for the record that the services will originate in Los Angeles. Because of this, it should therefore be presumed that consumers will be likely to believe that the mark simply identifies the place from which the services originate.

### **CONCLUSION**

For the reasons noted above, the examining attorney respectfully submits that the applied-for mark STRETCH LA is primarily geographically descriptive when used in connection with therapeutic stretching services. Accordingly, registration is properly refused under Section 2(e)(2) of the Trademark Act.

Respectfully submitted,

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