

This Opinion is Not a
Precedent of the TTAB

Mailed: June 16, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Grade-A-Global LLC
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Serial No. 88003141
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Thomas W. Galvani of Thomas W. Galvani PC,
for Grade-A-Global LLC.

Daniel F. Capshaw, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

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Before Cataldo Ritchie and Johnson,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Grade-A-Global LLC, seeks registration on the Principal Register of the mark KOTA JAPAN (in standard characters) identifying “hand-operated sharpening tools and instruments; whetstones,” in Class 8.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), on the ground that

¹ Application Serial No. 88003141 was filed on June 15, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as November 2017. The application originally identified additional goods in Class 21. These subsequently were deleted by Applicant.

the mark KOTA JAPAN is primarily geographically deceptively misdescriptive. According to the Examining Attorney, Japan is a country known, inter alia, for sharpening instruments and whetstones, and because Applicant's goods do not originate from Japan, the mark is primarily geographically deceptively misdescriptive. When the refusal was made final, Applicant appealed. We affirm the refusal to register.

The elements of whether a mark is primarily geographically deceptively misdescriptive are set forth in *In re Miracle Tuesday LLC*, 695 F.3d 1339, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012). *See also In re Cal. Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003):

1. Is “the primary significance of the mark ... a generally known geographic location?”

2. Is “the consuming public ... likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place?” and

3. Would “the misrepresentation [be] a material factor in the consumer's decision” to purchase the goods?

Id. at 1332 (quoting *In re Cal. Innovations, Inc.*, 66 USPQ2d at 1856); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1746 (TTAB 2014).

I. Is the primary significance of KOTA JAPAN a generally known geographic location?

There is no record evidence that the term KOTA has any meaning. The Examining Attorney further states in his brief that “KOTA is distinctive matter with no clear

meaning.”² The Examining Attorney submitted the following evidence to show that “Japan” is a generally known geographic location:

- American Heritage Dictionary of the English Language Fifth Ed. (2018) (ahdictionary.com), identifies Japan as “a country consisting of an archipelago off the eastern coast of Asia.”³
- The Columbia Gazetteer of the World lists Japan as a republic with a population of over 127 million with the highest per capita income of all Asian countries.⁴
- The website for the U.S. Department of State (state.gov) provides the following information: “Japan is one of the world’s most successful democracies and largest economies. The U.S. – Japan Alliance is the cornerstone of U.S. security interests in Asia and is fundamental to regional stability and prosperity.”⁵ and
- The website for the Office of the United States Trade Representative (ustr.gov) provides the following information: “Japan is currently our 4th largest goods trading partner with \$217.6 billion in total (two way) goods trade during 2018.”⁶

² Examining Attorney’s brief; 6 TTABVue 6. The Examining Attorney’s speculative argument (*Id.* n.3) that the term KOTA in the involved mark is evocative of the Japanese city of Kyoto is unsupported by evidence that consumers would make such an association.

³ October 5, 2018 first Office Action at TSDR 59.

⁴ April 26, 2019 final Office Action at TSDR 244-254.

⁵ *Id.* at 204-207.

⁶ *Id.* at TSDR 208-210.

As discussed above, the term KOTA has no known meaning on this record and it is unclear what, if any, significance consumers will ascribe to the term. On the other hand, the record evidence shows that JAPAN is hardly an obscure place to reasonably informed consumers in the United States, but rather denotes a well-known geographic location. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) (finding that Durango, Mexico is not an obscure place to reasonably informed non-Mexicans). *Cf. In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1844 (TTAB 2012) (“A mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods.”). Indeed, the evidence shows JAPAN is a modern, populous democracy with one of the world’s largest economies, and also is a key ally in Asia and a leading trading partner to the United States.

Applicant argues:

The Examining Attorney focuses heavily on the word JAPAN, arguing that the addition of the term KOTA “does nothing to create a non-geographic meaning.” Applicant respectfully submits that the Examining Attorney’s analysis is misplaced and is more proper in an analysis pursuant to Section 2(a). Under Section 2(a), the focus is on the deceptive matter within the mark, rather than the mark itself. ... However, under Section 2(e)(3), the focus is on the entire mark. To base a Section 2(e)(3) analysis on a single element in the mark, imbue meaning into the whole mark from that element, and then analyze the remaining elements in light of that meaning is “to ignore the distinction drawn in the statute between the focus of Sections 2(a) (“[c]onsists of or comprises . . . deceptive . . . matter”) and 2(e)(3) (“[c]onsists of a mark”). *Morinaga*. Thus, to preserve a distinction between Sections 2(a) and 2(e)(3) and not render 2(a) superfluous, the analysis must focus on the mark as a whole.

Applicant is correct that our analysis of geographic deception under Section 2(e)(3) must focus on the entire mark.⁷ However, it is not necessary for every component of a mark to be geographically deceptive in order to satisfy the first part of the test under Section 2(e)(3) articulated in *Cal. Innovations*. See, e.g., *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark, for various goods, held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY, with a disclaimer of NEW YORK, held primarily geographically deceptively misdescriptive of backpacks, handbags, purses, and similar items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HABANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER primarily geographically deceptively misdescriptive of rum); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design, with a disclaimer of NEW YORK, held deceptive for various items of clothing that originate in North Carolina, and have no connection with New York, because of the renown of New York in the apparel industry).

Applicant further argues:

Inclusion of a distinctive term in combination with a geographic term will operate to prevent the mark from having a primary significance that

⁷ The Federal Circuit in *Cal. Innovations* held that geographic deception is “specifically dealt with in subsection (e)(3), while deception in general continues to be addressed under subsection (a). Consequently, 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).” *Id.*

is geographic. See *Morinaga*, 120 USPQ2d at 17[4]8. Here, not only is the term distinctive, but it is fanciful. The inclusion of the dominant, fanciful, undefined term KOTA, together with the non-dominant geographic term JAPAN, renders the mark, as a whole, fanciful and without meaning. A fanciful mark by definition has no meaning, and so the mark's primary significance is one of no meaning.

The facts in *Morinaga* are distinguishable from those of the present application.



In *Morinaga*, the Board found that the term SEATTLE in the mark

“plays a relatively minor role visually, but more importantly, it is part of the phrase THE MOUNTAIN OF SEATTLE, which appears at the base of a mountain, all of which is underneath the large and dominant wording MT. RANIER.” *Morinaga*, 120 USPQ2d at 1748. The term SEATTLE was embedded within a larger phrase and less prominent in size than the wording MT. RANIER and ESPRESSO & MILK or the design. Thus, while the record reflected that SEATTLE identifies a known geographic location, “as it is used in the context of Applicant’s mark,” *Id.* the Board found that the relevant public would be unlikely to consider it to indicate the origin of the goods. In the case before us, Applicant’s KOTA JAPAN mark consists of only two terms in standard characters that may be displayed in any size relative to each other. Further, the Board in *Morinaga* stated: “This is not to say that a geographic term in a compound mark cannot dominate the commercial impression of the mark in a way that renders the primary significance of the entire mark geographic.” *Id.*

Applicant does not dispute that JAPAN is a generally well-known place. Further, there is nothing in the record to suggest that KOTA detracts from its geographic significance. *See In re Consol. Specialty Rests., Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (“Neither the addition of the generic word ‘steakhouse’ nor the addition of the design feature (including a mountain) detracts from the primary geographical significance of the mark [including the word COLORADO].”). Nor does KOTA modify JAPAN in such a manner that consumers will fail to recognize JAPAN as a geographic location. We find, as a result, that the primary significance of KOTA JAPAN is a generally known geographic place.

II. Is the consuming public likely to believe KOTA JAPAN indicates the geographic origin of the goods, when in fact the goods do not come from JAPAN?

“[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product.” *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (citing *Loew’s Theatres*, 226 USPQ at 868 (“the PTO’s burden is simply to establish that there is a reasonable predicate for its conclusion that the public would be likely to make the particular goods/place association on which it relies.”) and *California Innovations*, 66 USPQ2d at 1855 (affirming the “reasonable predicate” standard)). To establish a goods/place association, the Examining Attorney may provide excerpts from telephone directories, gazetteers, encyclopedias, geographic dictionaries, the LexisNexis® database, or the results of an Internet search. *See Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1847. Thus, to make a goods-place association,

the case law permits an inference that the consumer associates the product with the geographic location in the mark because that place is known for producing the product. *Les Halles De Paris J.V.*, 67 USPQ2d at 1541.

Applicant acknowledges that its goods do not originate in JAPAN, that is, the geographic place identified in its involved mark.⁸

The Examining Attorney submitted evidence, excerpted below, to show that consumers identify Japan as a source of high quality knives and knife sharpening stones:

- JW Web Magazine, (jw-webmagazine.com) in an article entitled The Guide to Best Japanese Knives, states “If you are a chef or into cooking, you may already know that Japanese knives have top-notch quality.”⁹ “No wonder that the country of Samurai swords produces the best cooking knives in the world.”¹⁰ “When you buy a fine Japanese knife, make sure to look after it after use. Knives are very sensitive so maintenance is a key. ... Purchasing a whetstone with your knife is a must. Ask shops’ craftsmen for the best whetstone [that] suits your knife!”¹¹
- Chef’s Armoury (chefsarmoury.com) in an article entitled About Japanese Knives, reports that “For centuries, Japanese craftsmen have been

⁸ Applicant’s April 5, 2019 response to the October 5, 2018 first Office Action at TSDR 16.

⁹ October 5, 2018 first Office action, TSDR 61-68.

¹⁰ *Id.* at TSDR 62.

¹¹ *Id.* at TSDR 67.

tinkering with steel. The Japanese are famous for making the very best chisels, wood planes, saws, swords and knives throughout the ages.”¹²

- The Knives and Tools website (knivesandtools.com) in an article entitled Japanese Whetstones: traditionally speaking the sharpest choice, states “Sharpening knives has become a true art form in the Japanese culture. For this reason they know exactly what type of tools you need to end up with razor-sharp knives. It is therefore not surprising that the best sharpening stones come from Japan.”¹³
- The MTC Kitchen website (mtckitchen.com) in an article entitled About Japanese Knives, discusses the craftsmanship required to create very high quality Japanese chef’s knives and sharpening stones therefor, many of which are also made in Japan. “Tsukiji Masamoto is one of Japan’s premier knife makers. ... Also, Tsukiji Masamoto offers knife sharpening services for professional cooks at their store in Tokyo’s famed Tsukiji Market so you know you can trust the quality of their whetstones.”¹⁴
- The Town Cutler website (towncutler.com) offers Japanese natural whetstones with the following description: “Japanese natural stones have become rare and highly sought after. The stones we carry have been mined

¹² *Id.* at TSDR 69-72.

¹³ April 26, 2019 final Office Action at TSDR 11-19. We note that the prices for products offered for sale on this website are listed in Euros (€) and it is not clear from the record the extent to which these goods are available in the United States. We note nonetheless, that the article is written in English and the website appears to be accessible by any user.

¹⁴ *Id.* at 20-23, 42-44.

in the area around Kyoto, Japan and have been sourced for us by mastersmith Shosui Takeda.”¹⁵

- The Fendrihan website (fendrihan.com) offers Oozuku Japanese natural whetstones with the following description: “Named for the site of its origin, the Oozuku Japanese Natural Whetstone is a product of its homeland’s finest honing practices. ... Oozuku is one of the Higashi-mono, referring to a collection of five quarries famous since ancient times for their sharpening stones.”¹⁶
 - The Amazon.com website (amazon.com) offers numerous Japanese whetstones and sharpening stones that consistently receive high ratings from purchasers.¹⁷
 - The Chef Knives To Go website (chefknivestogo.com) primarily offers Japanese sharpening stones: “Most of the stones you see here are Japanese water stones, both synthetic and natural. ... These stones are mined in the Narutaki District near Kyoto and are well regarded by professionals.”¹⁸
 - The sharpeningsupplies.com website states “Naniwa has been manufacturing quality waterstones for over 60 years in Osaka, Japan.”¹⁹
- and

¹⁵ *Id.* at 45-50.

¹⁶ *Id.* at 77-90.

¹⁷ *Id.* at 102-118.

¹⁸ *Id.* at 119-129.

¹⁹ *Id.* at 130-138.

- The Knife Planet website (knifeplanet.net) in an article on the subject of whetstones and sharpening stones, states “Japanese whetstones use water for lubrication and thus, they are commonly known as Japanese Water Stones because this type of stone is very porous. ... I own a sharpening business and I do all, very single knife, thousands a year by hand on Japanese Water Stones so I need to have confidence in the stones I use.”²⁰

We find the above-noted evidence sufficient to establish a goods/place association (i.e., a reasonable predicate that the public will make the goods/place association). As noted above, JAPAN is a widely known geographic location, famous for centuries of producing, inter alia, high-quality, sought-after knives, knife sharpeners and whetstones, particularly water stones.

Applicant submitted with its April 5, 2019 response to the Examining Attorney’s first Office Action²¹ evidence that “Japan” also identifies a 2008 independent motion picture produced in the United States, a 2002 Mexican motion picture, and a British musical group active from 1974 to 1982. “The issue is not the fame or exclusivity of the place name, but the likelihood that a particular place will be associated with particular goods.” *Loew’s Theatres*, 226 USPQ at 868. Thus, the above-identified evidence establishes the goods/place association.

²⁰ *Id.* at 139-158.

²¹ At TSDR 91-106.

III. Would a substantial portion of the relevant consumers likely be deceived by KOTA JAPAN's misrepresentation of the goods/place association?

The materiality element reflects the deceptiveness requirement of section 2(e)(3). *California Innovations*, 66 USPQ2d 1853. “[T]o establish a prima facie case of materiality there must be some indication that a substantial portion of the relevant consumers would be materially influenced in the decision to purchase the product or services by the geographic meaning of the mark.” *Miracle Tuesday*, 104 USPQ2d at 1334 (quoting *In re Spirits Int’l, N.V.* 563 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009)). In determining “materiality,” the Board looks to evidence regarding the probable reaction of purchasers to a particular geographic term when it is used in connection with the goods. *Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1850. Thus, the materiality element in cases involving goods may be satisfied under the following conditions:

- there is evidence showing that the place named in the mark is well known for the goods;
- the goods are a principal product of the place named in the mark;
- the goods are, or are related to, the traditional products of the place named in the mark; or
- the goods are an expansion of the traditional products of the place named in the mark.

Id. (citing *California Innovations*, 66 USPQ2d at 1857).

In support of the refusal, the Office should submit evidence showing that the association between the goods and the

geographic place would be a material consideration in a consumer's decision to purchase the goods. Searches that combine the place name with the name of the goods and terms such as "famous," "renowned," "well known," "noted for," "principal or traditional" may be useful to establish materiality. The stronger the connection between the geographic place and the goods, the more likely the misrepresentation will be a material one. *In re California Innovations, Inc.*, 66 USPQ2d at 1857 ("[I]f there is evidence that goods like applicant's or goods related to applicant's are a principal product of the geographical area named by the mark, then the deception will most likely be found material and the mark, therefore, deceptive." (quoting *In re House of Windsor*, 221 USPQ 53, 57 (TTAB 1983, recon. denied, 223 USPQ 191 (TTAB 1984))).

Id.

The evidence excerpted above demonstrates that knives and sharpening stones, particularly water stones, have for centuries been perceived by United States consumers as a traditional product of JAPAN and are considered to be among the best products of their kind by professionals, collectors and dedicated amateurs. The evidence demonstrates the consumers are interested in purchasing sharpening stones from JAPAN based upon their quality and that the geographic origin of these goods plays a role in their purchasing decision. Indeed, from the record on appeal we draw an inference that the geographic misrepresentation is a material factor in the purchasing decision, based upon a "heightened" association between the goods and the location. *In re Les Halles De Paris J.V.*, 67 USPQ2d at 1542 (the Patent and Trademark Office may raise an inference of materiality with evidence that the place is famous as a source of the goods at issue). The evidence shows that sharpening stones are considered by United States consumers to be a traditional product of JAPAN, and that JAPAN is famous for producing the highest quality water stones.

Further, the record shows the factors consumers consider when they purchase sharpening stones and that the origin of the sharpening stones plays a role in that decision. *Cf. U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1542 (TTAB 2006) (“The record does not show that a material reason for a tourist’s choice of playing cards is that the cards were made or used in Las Vegas.”). Finally, we note Applicant’s concession that:

The Examining Attorney has presented a great deal of evidence to show that knives are a principal and famous product of Japan, and Applicant does not contest such. Applicant thus presents no argument that, if a goods-place association could be made, then sharpening tools are related to Japanese knives. *See California Innovations*, 329 F.3d at 1341, 66 USPQ2d at 1857 (Materiality may be found where goods are related to traditional products of the location).²²

We find the evidence of record demonstrates that a significant portion of the relevant consumers would be materially influenced in the decision to purchase sharpening stones by the geographic meaning of KOTA JAPAN.

Decision: The refusal to register Applicant’s mark KOTA JAPAN under Trademark Act Section 2(e)(3), is affirmed.

²² 4 TTABVUE 11.