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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Argent Media Group, LLC

Serial No. 88780676

Timothy J. Zarley of Zarley Law Firm, P.L.C.,
for Argent Media Group, LLC.

James Hill, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Wolfson, Larkin, and Johnson,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Argent Media Group, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark MALIBU SUPPER CLUB (“SUPPER CLUB” disclaimed) for “Restaurant and bar services” in International Class 43.¹

¹ Application Serial No. 88780676, filed on January 31, 2020, based on Applicant’s allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the ground that the mark is primarily geographically descriptive of the identified services.

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal was resumed. For the reasons explained below, we affirm the refusal to register.²

I. Applicable Law

In order for registration to be refused under Section 2(e)(2) of the Trademark Act on the ground that the mark is primarily geographically descriptive of the goods or services, it must be established that:

1. The primary significance of the term in the mark sought to be registered is the name of a place generally known to the public;
2. The services originate in the place named in the mark; and
3. The public would make an association between the goods or services and the place named in the mark by believing that the goods or services originate in that place.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448 (Fed. Cir. 2015); *see also In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); *Spiritline Cruises LLC v. Tour Mgmt.*

² All citations in this opinion to the appeal record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. Citations to the prosecution history of the application are to pages from the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

Servs., Inc., 2020 USPQ2d 48324, *5 (TTAB 2020). The third inquiry, the services-place association, can be presumed when the services do in fact originate in the place named in the mark. *Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014). Finally, “the presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole.” *Id.* at 1853-54 (quoting *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars from Minnesota)).

II. Evidence and Arguments

In support of the Section 2(e)(2) refusal, the Examining Attorney submitted the following evidence:

A. Dictionary definitions

- Columbia Gazetteer of the World - Malibu is a “city in Los Angeles county.” February 12, 2020, Office Action, TSDR 2;
- Lexico - Malibu is “a resort on the Pacific Ocean coast of southern California, west of Los Angeles.” *Id.*, TSDR 3;
- American Heritage Dictionary of the English Language – Malibu is “a district of Los Angeles, California, on Santa Monica Bay. It is a fashionable resort and residential area.” September 29, 2020, Denial of Request for Reconsideration, TSDR 3;
- Merriam-Webster – Malibu is a “seaside city west of Los Angeles population 12,965.” *Id.* at TSDR 4;
- Your Dictionary – Malibu is a “city in SW Calif., on the Pacific . . . a district of Los Angeles, California, on Santa Monica Bay. It is a fashionable resort and residential area.” *Id.* at TSDR 5.

B. Screenshots from third-party websites referring to “Malibu” as a dining destination, attached to the March 27, 2020, Office Action. Examples include:

- Eater Los Angeles: “Malibu’s Top 15 Restaurants, Summer 2018 –

Where to eat near the beach in Malibu, Santa Monica, and Pacific Palisades.” At <https://la.eater.com>, TSDR 2;

- Culture Trip: “The 8 Best Restaurants in Malibu.” At <https://theculturetrip.com>, TSDR 4;
- The Travel: “20 Go-To Restaurants In Malibu (That Are Actually Affordable) – From seafood and pizza on the coast to fine dining in the Santa Monica Hills, this list will help you navigate the dining experiences of scenic Malibu.” At <https://www.thetravel.com>, TSDR 5.

C. Screenshots from third-party websites showing that “supper club” is commonly used to refer to restaurants, eateries, and bars, attached to the March 27, 2020, Office Action. Examples include:

- Arthur Henry’s Supper Club & Ruby Room – “An evening Bar and Restaurant Lounge hotspot unlike any other . . . in Sacramento.” At <http://arthurhenrys.net>, TSDR 9;
- Feinstein’s at Vitello’s – “. . . one of Los Angeles’s premier supper-clubs.” At <https://www.feinsteinsatvitellos.com>, TSDR 12;
- Bernie’s Lounge and Supper Club – “Re-live the atmosphere of what dining used to be. Stop by for martinis, supper and a swingin’ lounge act.” At <https://www.visitgreaterpalmsprings.com>, TSDR 20.

D. Eleven third-party registrations including “MALIBU” registered under Trademark Act Section 2(f) or with the term “Malibu” disclaimed. March 27, 2020, Denial of Request for Reconsideration, TSDR 21-50.

Based on the above, the Examining Attorney argues that MALIBU is “a clear reference to the resort city on the Pacific Ocean coast of southern California, west of Los Angeles in Los Angeles County, California” and that “this term is routinely used in the restaurant and bar industry . . . to refer to such services originating in the geographic location in question.” Examining Attorney Brief, 8 TTABVUE 4. The Examining Attorney further argues that the record shows “that applicant’s restaurant and bar services will be provided at a SUPPER CLUB in MALIBU, i.e., a MALIBU SUPPER CLUB,” and the services-place association is “appropriately presumed.” 8

TTABVUE 6-7. “Thus, because MALIBU is primarily geographically descriptive of the origin of the services, and the additional wording in the mark, SUPPER CLUB, is merely descriptive of the services and does not overcome the geographic descriptiveness of the mark, the entire mark is primarily geographically descriptive of the services” 8 TTABVUE 10.

Applicant provided the following evidence:

A. Excerpt from Dictionary.com describing MALIBU as “an exclusive and ritzy community,” a “glitzy beach town,” and stating that “Malibu more generally evokes luxury and relaxation, whether achieved with Malibu liqueur, driving a Chevy Malibu, or cruising down the beaches of Malibu, CA.” At [dictionary.com/e/pop-culture/malibu/](https://www.dictionary.com/e/pop-culture/malibu/); September 28, 2020, Request for Reconsideration, TSDR 2.

B. Excerpt from Wikipedia about “Malibu, California.” At <https://en.wikipedia.org/>; March 23, 2020, Response to Office Action, TSDR 2-10.

C. Eleven third-party registrations for marks comprising MALIBU.³ March 23, 2020, Response to Office Action, TSDR 17-29.⁴

In challenging the refusals, Applicant maintains that “in popular culture, the term is not primarily a geographic location, but rather a term that indicates luxury and relaxation.” 6 TTABVUE 3. Although Applicant agrees that the third-party restaurants “are located in the city of Malibu,” Applicant argues that the evidence submitted does not compel the conclusion that the term MALIBU is being used to

³ Printouts for 12 registrations were included but one has been cancelled. Cancelled or expired third-party registrations have no probative value other than as evidence that the registrations were issued. *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989).

⁴ Applicant also included a printout of a third-party application. Third-party applications, whether active or abandoned, are evidence only that the applications were filed and have no probative value with regard to the issue of geographic descriptiveness. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *see also In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009).

describe the location of the business as opposed to describing “luxury and relaxation.” *Id.* Finally, Applicant argues it is improper to presume that purchasers would be likely to make a services-place association, because “there is a genuine issue as to whether the primary significance of the mark is geographical, and therefore, reliance upon the presumption is improper.” *Id.*

III. Analysis

Geographic descriptiveness, like descriptiveness generally, “must be evaluated in relation to the particular goods [or services] for which registration is sought, the context in which [the mark] is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use.” *In re Chamber of Commerce of the U.S.A.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citation omitted); *In re Hollywood Lawyers Online*, 110 USPQ2d at 1857 (holding HOLLYWOOD LAWYERS ONLINE primarily geographically descriptive of attorney referrals, online business information, and an online business directory).

Here, the evidence of record clearly establishes the following: (1) the term MALIBU in the applied-for mark is a generally known geographic location; (2) the phrase “supper club” is commonly used by restaurants and bars to identify a type of restaurant; (3) Applicant’s services will originate in Malibu;⁵ and (4) relevant consumers will immediately make a connection between the place located in the

⁵ On February 12, 2020, Applicant’s counsel confirmed by email that “[Applicant] will be located in Malibu.” See March 27, 2020 Office Action, TSDR 8.

mark, i.e., Malibu, California, and the services offered by Applicant, namely, restaurant and bar services.

Applicant argues that the term “Malibu” will be seen by consumers not primarily as a place, but rather as a general reference to luxury and relaxation – a “[glitzy] area that Hollywood movie stars flock to.” 6 TTABVue 3. Applicant’s reliance on the “Pop Culture Dictionary” excerpt from Dictionary.com for this proposition is misplaced. A fuller reference to the passage shows that the primary significance of “Malibu,” even in pop culture, is to the geographic location. The excerpt begins: “*Malibu* variously refers to a wealthy beach city near Los Angeles, a coconut-flavored liqueur made with rum, and a sedan made by Chevrolet.” It explains: “This is not meant to be a formal definition of Malibu like most terms we define on Dictionary.com, but is rather an informal word summary that hopefully touches upon the key aspects of the meaning and usage of Malibu that will help our users expand their word mastery.” Denial of Request for Reconsideration, TSDR 2.

In the context in which it is being used by Applicant, that is, as a modifier of the descriptive wording “supper club,” the average purchaser of restaurant and bar services will immediately perceive MALIBU as designating the location of Applicant’s establishment. In fact, the additional wording, SUPPER CLUB, reinforces this immediate perception, as it describes the applied-for services as being rendered at a specific location. Where, as here, the most prominent meaning or significance of a mark is geographic for the services in the application, the fact that the mark may have other meanings in other contexts does not alter its geographic significance in

the context of the application. *See, e.g., In re Opryland USA Inc.*, 1 USPQ2d 1409, 1412-13 (TTAB 1986) (holding the mark THE NASHVILLE NETWORK primarily geographically descriptive of television program production and distribution services when finding that the primary significance of the term referred to Nashville, Tennessee and not that of a style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (noting that where MANHATTAN refers to a type of cocktail and to a geographic location, having an alternative meaning does not alter the mark's primary geographic significance in the context of the goods in the application); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (noting that where NEAPOLITAN refers to a type of ice cream and also means "pertaining to Naples, Italy," having an alternative meaning does not alter the mark's primary geographic significance in the context of the goods in the application).

The third-party registrations submitted by Applicant do not prove otherwise. Only Reg. No. 4599625 covers services; it is for the mark MALIBU CLOSET for on-line retail store services featuring, inter alia, clothing. Notably, "MALIBU" has been disclaimed, undercutting Applicant's reliance on the registration. Reg. No. 3643203 for MALIBU SHIRTS and design for clothing also includes a disclaimer of "Malibu shirts."

All but one of the remainder of the registrations fall into two groups. The first group is for entirely unrelated goods: Reg. No. 4116906 for MALIBU for "accessories and replacement parts for electric lighting fixtures" and similar goods; Reg. No. 4716613 for MALIBU for "home security systems" and similar goods (both

registrations are owned by the same entity); Reg. No. 5315432 for MALIBU PILL (“pill” disclaimed) for “hormones for medical purposes;” and Reg. No. 5231133 for MALIBU TEETH WHITENING (“teeth whitening” disclaimed) for “Teeth whitening services.” These registrations are not probative of whether MALIBU SUPPER CLUB is primarily geographically descriptive in association with restaurant and bar services.

The second group of marks contain additional distinctive wording, making them not analogous to Applicant’s mark: Reg. No. 5160414 for MALIBU PRINCESS for children’s dresses; Reg. No. 5050002 for MALIBU GIRLS (“girls” disclaimed) for children’s dresses (both owned by the same entity); Reg. No. 4962854 for MALIBU ROAD for clothing and Reg. No. 5125013 for MALIBU BEACH BASICS (“Beach” and “Basics” disclaimed) for, inter alia, handbags.

Finally, Reg. No. 4891172 is for the mark MALIBU for alcoholic and non-alcoholic beverages. To the extent an argument could be made that these goods are related to Applicant’s services, nonetheless, a single registration clearly is insufficient to overcome the other evidence of record. Moreover, our determination of whether MALIBU SUPPER CLUB is primarily geographically descriptive must be based upon the services recited in the application before us. “[T]hat a term may be descriptive of certain types of goods [or services] does not establish that it is likewise descriptive of other types of goods, even if the goods are closely related (e.g. hats and boots).” *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1995).

As none of the marks featured in the above-referenced registrations is analogous

to the applied-for mark, the third-party registrations submitted by Applicant do not change the result in this case. *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant’s marks.”) (citation omitted); *In re The Boulevard Entm’t, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (“The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.”).

We also note that the Examining Attorney submitted eleven third-party registrations including “MALIBU” registered under Trademark Act Section 2(f) or with the term “Malibu” disclaimed. March 27, 2020, Office Action, TSDR 21-50. Several of these are in connection with services identical to those offered by Applicant, for example:

- Reg. No. 3722396 for the mark MALIBU PIER (“Pier” disclaimed), registered with a Section 2(f) statement as to the entire mark for, inter alia, “restaurant services.” *Id.*, TSDR 24.
- Reg. No. 3383412 for the mark CARBON BEACH CLUB MALIBU BEACH INN (“Carbon beach” and “Club” disclaimed), registered with

a Section 2(f) statement as to “Malibu Beach Inn” for “restaurant services.” *Id.*, TSDR 32.

- Reg. No. 4425978 for the mark MALIBU FARM (“Malibu” disclaimed) for “catering and restaurant services.” *Id.*, TSDR 35.
- Reg. No. 5231132 for the mark REEL INN MALIBU (“Malibu” disclaimed) for “restaurant services.” *Id.*, TSDR 40.
- Reg. No. 5387707 for the mark MALIBU MOMENT (“Malibu” disclaimed) for “hotel and restaurant services.” *Id.*, TSDR 46.

Third-party registrations featuring services that are the same as or similar to Applicant’s services are probative evidence on the issue of geographic descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

In light of this evidence, we find that the mark MALIBU SUPPER CLUB is primarily geographically descriptive of Applicant’s services, namely, that Applicant intends to operate a supper club located in Malibu, California.

IV. Conclusion

We have carefully considered all arguments and evidence of record. We find that Applicant’s mark MALIBU SUPPER CLUB identifies a well-known geographic location from where Applicant’s services originate and that purchasers would make a services-place association between Applicant’s services and the place named in the mark. The addition of the descriptive, if not generic, phrase “supper club” in the mark does not detract from the mark’s primary significance as being geographically

descriptive. Because the elements of the Section 2(e)(2) refusal have been established, we find that the Examining Attorney has demonstrated that Applicant's mark is primarily geographically descriptive of Applicant's identified services.

Decision: The refusal to register Applicant's mark MALIBU SUPPER CLUB under Section 2(e)(2) of the Trademark Act is affirmed.