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

Proceeding	91162078
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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THE UNITED STATES PLAYING  
CARD COMPANY,

Opposer,

v.

HARBRO, LLC,

Applicant.

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Opposition No.: 91162078

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OPPOSER'S BRIEF IN REPLY TO APPLICANT HARBRO'S TRIAL BRIEF

April 27, 2006

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## **I. Preliminary Statement**

USPC has opposed registration of the mark Vegas based on the fact that it is deceptive under Section 2(a) of the Trademark Act or primarily geographically misdescriptive or descriptive within the meaning of Section 2(e). 15 U.S.C. §1052. Applicant's argument in favor of registration is essentially 1) Vegas has a popular significance separate from its geographical meaning and therefore, is not primarily geographical; 2) playing cards are not manufactured and therefore do not originate in Las Vegas; and 3) origination of playing cards in Las Vegas is not material to a consumer's decision to purchase playing cards. The evidence submitted, however, does not support Applicant's argument. First, the dictionary definitions of "Vegas" and "Las Vegas" prove that Vegas is a geographical location. Second, playing cards are ubiquitous in Las Vegas, a city famous for its gambling and casinos, and are, therefore, connected and related to the city. Third, the fact that the public buys cancelled casino cards shows the materiality of the Las Vegas connection to playing cards. Vegas for playing cards is much closer to Venice for decorative products, Havana for rum, Rodeo Drive for perfume and New York for fashion accessories, than Hollywood for fries.

Vegas is the "literal equivalent" of the well known tourist destination Las Vegas, Nevada, and it is home to several well-known casinos including the MGM Grand, the Bellagio, the Luxor, the Venetian, Binion's Horseshoe, Mandalay Bay, the Rio, the Flamingo and many others which use playing cards. Because card playing is prevalent throughout Las Vegas and is one of the reasons the public visits Las Vegas, the city is associated with card games like poker and playing cards themselves. There is a market in retail stores and on the internet for cancelled cards from Las Vegas casinos. Thus,

playing cards are intimately associated with Las Vegas, and consumers value playing cards that are connected with Vegas.

## II. **Argument**

### A. **The *primary* significance of Vegas is a geographic location.**

The test is not whether the only significance of a term is a geographic location but whether it is its *primary* significance--Courts and the Board have found that a term's primary significance is a geographic location despite the fact that a term also refers to a style or aura. Las Vegas, Nevada's primary significance is that it is one of the country's best known geographical locations. The public recognizes Vegas and Las Vegas as synonymous. The Las Vegas Convention and Visitors Authority (the "LVCVA") uses brochures and taglines that refer to their city as "Vegas" such as the "Only Vegas" logo to attract more than 37 million tourists from across the country and the world annually to Las Vegas, Nevada. (Bagger at 7, 10-11).

*Miriam-Webster's Geographic Dictionary* also recognizes that Las Vegas and Vegas are synonymous. The Dictionary's entry for Las Vegas, Nevada, starts "Las Vegas [...] 1. often shortened to Vegas." Notice of Reliance Index 1. Further, numerous newspaper articles that demonstrate how Vegas is commonly used to refer to the City of Las Vegas, Nevada. (Index 17, 26, 28, 33, 36, 37, 44, 50, 61, 63, 73, 82, 83, 87, 91). Applicant complains that Opposer's evidence in this regard is limited to a small scope of time; however, the scope of time was restricted to May 2005 in order to limit the documents presented to the Board to some reasonable number. In May 2005, hundreds of articles used "Vegas" as a synonym for Las Vegas, Nevada, showing that use of Vegas to refer to the geographic location is widespread and common.

Applicant argues that Vegas does not refer primarily to a geographic location because there is a Las Vegas, New Mexico, and "vegas" is Spanish for "meadows." The evidence overwhelmingly demonstrates that the primary use of Vegas refers to the City of Las Vegas, Nevada. Kevin Bagger, an employee of the LVCVA, testified that the travel and tourism agency uses the word Vegas to promote their city; (Bagger at 13) newspaper articles also show that Vegas has become commonplace for the city. (Index 5-642)

The existence of Las Vegas, New Mexico, does not undercut Vegas's primary significance as a synonym for the geographical location of Las Vegas, Nevada. In fact, Applicant has offered no evidence about Las Vegas, New Mexico, and there is no likelihood that Las Vegas, New Mexico would be associated with playing cards. See generally, In re Loew's Theater, Inc., 226 USPQ 865 (Fed. Cir. 1985). Under the California Innovations test, the Board looks at the **primary** significance of the mark, not the fact that possible alternate lesser-known geographic locations exist. In re California Innovations, Inc., 66 USPQ2d 1853 (Fed. Cir. 2003).

The Federal Circuit was not troubled in the Save Venice case that secondary geographic locations existed such as Venice Beach in Venice, California, to say nothing of cities named Venice in Illinois, New York, Florida and Louisiana. The court upheld the examining Attorney's determination that the mark THE VENICE COLLECTION primarily signified Venice, Italy, just as the mark Vegas primarily signifies Las Vegas, Nevada here. In re Save Venice New York, Inc., 59 USPQ2d 1778, 259 F.3d 1346, 1353 (Fed. Cir. 2001).

Opposer's evidence including major news publications, and testimony from an employee of the LVCVA, demonstrate that Vegas is widely used to refer to Las Vegas, Nevada. Applicant's suggestion that Vegas has other meanings does not contradict Vegas's primary significance as that of a geographic location.

**B. The word mark Vegas used on playing cards is not the same as the Hollywood and design mark as used on french fries.**

Applicant relies heavily upon the Board's decision in In re International Taste, Inc., 53 USPQ2d 1604 (TTAB 2000), where the Board found that HOLLYWOOD FRIES, a design mark incorporating a star and an approximation of the famous Hollywood Sign, was entitled to registration in Class 29 for "french fries" and class 42 for "fast food restaurants." The present case is distinguishable from International Taste for three reasons. First, Applicant's mark is not a design mark that includes elements of the "aura" symbolized in a word such as Hollywood. Second, the goods and services offered under HOLLYWOOD FRIES were totally different and easily distinguishable from any aura associated with the geographic place, thus, consumers could easily distinguish the primary significance from the secondary significance. Finally, Applicant's argument that Vegas, like Hollywood, refers to a "style" or "aura" does not overcome Vegas' *primary* geographical significance.

The mark at issue in International Taste is a design mark that incorporates the iconic Hollywood Sign with a star design. The mark is depicted below:



Both the Hollywood Sign and the star are images that relate to, and are famous within, the movie industry. The design element of the HOLLYWOOD FRIES mark itself leads consumers to believe that the reference to Hollywood in the mark does not relate to a town in California, but rather to the film industry. Applicant's mark, on the other hand, does not contain a design element. The mark is simply the word VEGAS. There are no accompanying images that would relay the message that the product relates to a "Vegas-style." In International Taste, the Board stated clearly that "the star design feature which forms part of applicant's mark increases the commercial impression of the term as connoting the entertainment industry and decreases the connection to the town of Hollywood, California." Id. at 1605.

This case also differs from International Taste in that the goods here are directly related to the geographic location. The Board in International Taste relied on the Fifth Circuit's decision in World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482 (5th Cir. 1971). The word "primary" in the test of geographical significance should not be overlooked: "for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote or *unconnected with the goods*." Id. at 1605, quoting, World Carpets, (emphasis added). Thus, in part, the Board reached its decision in International Taste because Hollywood is not known for its french fries. Noting that each case must be decided on its own facts and record, the Board stated that it must take into account the relation between the goods and the location to determine whether it would be significant to consumers because of the fame of a certain geographic place and its notoriety for certain goods. Id. at 1606.

Vegas is famous for many things, not the least of which is cards and gambling. Testimony shows that large casinos in Las Vegas, Nevada, are a major part of tourism. (Bagger at 9-11). Playing cards are an integral part of gambling services, because games such as blackjack, Let it Ride, Pai Gow Poker and regular poker require playing cards. (Bagger at 10, Espenscheid at 11-12). Unlike the lack of connection between Hollywood, CA, and french fries in International Taste, there is a demonstrated connection between Vegas and playing cards.

Furthermore, even if Vegas conveys an "aura," such an aura would be related to the lifestyle surrounding gambling. The aura would also be connected to and derived from activities for which the geographic location is well known. Thus, the aura of a Vegas-style is intimately associated with the geographic location.

In International Taste, Applicant relied on a dictionary definition of Hollywood as "the U.S. motion picture industry or the atmosphere attributed to *it*." Id. at 1605 (emphasis in original). Applicant in this case has produced no evidence that a secondary meaning exists for the term Vegas unrelated to the geographic meaning itself. Applicant has produced no additional evidence which would contradict the weight of Opposer's evidence supporting use of Vegas as a geographic location. The Board has held that a failure of the applicant to bring evidence in support of additional meanings of the geographical mark can be fatal to an argument which asserts such an additional meaning. In re Hiromichi Wada, 52 USPQ2d 1539, 194 F.3d 1297, 1300 (Fed. Cir. 1999).

The existence of a secondary meaning of a geographic term does not necessarily alter its primary geographical significance. In California Innovations, the

Federal Circuit held that California's primary significance was that of a geographic location, contrary to Applicant's argument that a "style" or "aura" was the primary meaning. "Although the mark may also convey the idea of a creative, laid-back lifestyle or mindset, the Board properly recognized that such an association does not contradict the primary geographic significance of the mark." 66 USPQ2d 1853, 1858 (Fed. Cir. 2003).

Other Board decisions have similarly recognized the primacy of a mark's geographic meaning. For instance, the Board held that RODEO DRIVE is primarily a geographic location associated with the sale of perfume, which was the subject of the trademark application, even though RODEO DRIVE arguably has an "aura" of sophistication and high society. See, Fred Hayman Beverly Hills v. Jacques Bernier, Inc., 38 USPQ2d 1691 (TTAB 1986).

The Board also rejected a claim by an Applicant that HAVANA evoked a "historic or stylish image" or suggested a desirable free-wheeling lifestyle. Instead, the Board reasoned that the geographic significance of HAVANA was of primary significance, and the particular lifestyle the Applicant was trying to portray did not contradict the primary geographic significance of the term. In re Bacardi & Co., Ltd., 48 USPQ2d 1031 (TTAB 1998).

When the Applicant in In re Opryland USA Inc., 1 USPQ2d 1409 (TTAB 1986), argued that NASHVILLE as part of THE NASHVILLE NETWORK conveyed something other than a geographic location, the Board disagreed. "Applicant's argument that the term 'Nashville' is not primarily geographical because it has other imagery other than the city of Nashville, e.g., education, i.e., the "Athens of the South"; country music;

Printer's Alley; a particular musical sound, i.e., "the Nashville sound" etc., is not persuasive. Because a term may have other meanings does not necessarily alter the primacy of its geographical significance." Id. at 1413 (internal citations omitted).

Applicants' reliance on International Taste is misplaced because Applicant's mark is not stylized. Further Applicant has not presented any evidence to demonstrate that any "lifestyle" or "aura" exists, and even if it did, that it alters the geographical significance of the term. Finally, playing cards are associated with Las Vegas, as opposed to a lack of any association of with Hollywood the goods and services in International Taste: "french fries and restaurant services." Thus consumers were more likely to understand the use of Hollywood in the HOLLYWOOD FRIES mark to relate to the aura rather than the geographic location. This is not the case with Vegas and playing cards.

**C. There is an association between Las Vegas and playing cards.**

Contrary to Applicant's assertion that Opposer has "failed to even attempt to prove" that an association exists between playing cards and Las Vegas, the evidence demonstrates that there is a strong relationship between the use of playing cards and related items and the city of Las Vegas, Nevada. Applicant argues that manufacture of similar items in the geographic location is the end-all of the analysis under California Innovations, but this Board has held that a goods' "relation to" the location is sufficient to meet the second prong of the California Innovation test. Opposer has shown that there is a strong relation between Las Vegas and playing cards including evidence of use of playing cards in Las Vegas casinos.

According to language in California Innovations the **belief** of the consumer is what is significant. Consumers are likely to believe playing cards originate from or have some relation to Las Vegas because of the use of playing cards in Las Vegas casinos. The Federal Circuit in In re Save Venice, a case cited approvingly in California Innovations, held that whether a mark is primarily geographically deceptively misdescriptive is determined by whether consumers would reasonably *believe* the Applicant's goods are connected with the geographic location in the mark. Specifically, the Federal Circuit held that even absent a direct goods/place association, goods that reflect products that consumers would "associate" with the location meet the second prong of the test. In re Save Venice, 59 USPQ2d 1778, 1784, 259 F.3d 1346, 1355 (Fed. Cir. 2001) (emphasis added).

Likewise, The TTAB has held that a showing that goods "relate to" a geographic location is sufficient to satisfy the second prong of California Innovations. In In re Broyhill Furniture Industries, Inc., the Board concluded that a consumer's mistaken belief that furniture originated in Tuscany was sufficient to demonstrate a goods place association between Tuscany and furniture even though "Tuscany is not famous or otherwise noted for its furniture." 60 USPQ2d 1511, 1518 (TTAB 2001). According to the record in that case, "Tuscany is an important industrial center and, especially in the case of pieces of handcrafted furniture (which are products encompassed by the goods identified in applicant's application,) such items plainly would be considered by consumers to be a *natural expansion* of Tuscan's longstanding handicraft industries, particularly those in wood and metal." Id. (emphasis added). The playing card industry is a natural expansion of the gaming industry, a service for which the record in this case

indicates Vegas is famous. In fact, the *American Heritage Illustrated Encyclopedia Dictionary* defines Las Vegas in terms of its popularity for gambling. "Las Vegas. City in southern Nevada. Set in remote ranching and mining region, it is the leading gambling city in the country and site of many famous nightclubs."<sup>1</sup>

Opposer has demonstrated that a connection between playing cards and Las Vegas is prevalent in numerous media sources. For example, the Chicago Daily Herald referred to playing cards from casinos in Las Vegas such as the Dunes Hotel and Country Club available for sale as "Las Vegas playing cards." (Index 631, Chicago Daily Herald, Here's a Taste of What You Missed at Maxwell Street Saturday, May 27, 2005, C1). Playing cards are so intertwined with the iconography of Las Vegas that state officials sought approval from the U.S. Mint to include images of playing cards on the state quarter. (Index 625, 628; Argus Leader, South Dakota's Entry in the State Quarter Line Up, January 13, 2005, page 1A). Obviously, goods which function as a symbol of the geographic place are likely to be believed as originating from that place.

Furthermore, trial testimony shows that there is a connection between playing cards and Las Vegas, Nevada. Kevin Bagger of the LVCVA testified that Vegas is known for its gaming, which includes use of playing cards in legal games of chance. (Bagger at 9). Dan Espenscheid also testified to the casino's need to use playing cards for games like poker and blackjack among others. These used cards from casinos are cancelled and resold. (Espenscheid at 13). In fact, testimony from Applicant's witness,

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<sup>1</sup> *American Heritage Illustrated Encyclopedia Dictionary*, First Edition, 1987. (Exhibit A). The Board may take judicial notice of dictionary entries at any stage of the proceeding, (Fed. R. Evid. 201), including at the time of decision on appeal. BVD Licensing Corp. v. Body Action Design, Inc., 6 USPQ 2d 1719 (Fed. Cir. 1988) (allowing judicial notice at appellate court level); The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982) (confirming Board may take judicial notice of dictionaries).

Karl Ondersma, who bought cancelled casino playing cards, confirms that a market exists for playing cards from Las Vegas. (Ondersma at 21). Thus, consumers are likely to believe that playing cards, especially cards sold under the mark VEGAS , originate from Las Vegas even if in fact they do not.

Even though Vegas may not be the site of actual manufacture of playing cards it certainly is famous for the industry related to its widespread use, namely, gambling, and there is a connection between Vegas and cancelled casino playing cards. Therefore, as acknowledged in Broyhill Furniture, consumers would make the connection between the related industries. Presented with a box of playing cards labeled VEGAS, consumers would mistakenly believe that the cards originated from or had some connection to the named geographic place.

**D. The association between Las Vegas and playing cards is material to a consumer's decision.**

Opposer presented evidence which demonstrates that the relation between playing cards and Vegas is a material factor in a consumer's purchase decision. The market for cancelled casino cards that were in play in Vegas casinos demonstrates that consumers find playing cards that come from Las Vegas desirable. Thus, Opposer has shown that a relationship to Vegas can materially affect the consumer's purchase decision. Furthermore, the Board has held that it may presume a purchase-making decision is materially affected when a heightened goods-place association exists. In re Consolidated Specialty Restaurants, 71 USPQ2d 1921 (TTAB 2004). Contrary to Applicant's argument, this presumption has not been limited to services.

The evidence presented relating to the market for cancelled casino cards demonstrates that consumers want playing cards that were used in casinos in Las

Vegas. Cancelled playing cards are those that were used in a casino, such as those in Las Vegas, and are cancelled by performing some physical alteration to the card. (Bagger at 20). Cancelled cards are available for sale at casino gift shops or at the Gambler's General Store. (Bagger at 19-20, Espenscheid at 39). The cards are also available for sale online at sites like the Gambler's General Store website and oldvegaschips.com. (Przywara at 11-13). Applicant argues that consumers will know if a deck has been cancelled by spotting a seal placed on the deck or by the clipped corners and hole punches in the cards themselves. Applicant's argument overlooks the sale of decks of cards on the internet,<sup>2</sup> where a consumer would not be able to tell that the deck comes without a seal. Applicant's argument also overlooks the fact that consumers, whether purchasing the cards in person or over the internet, cannot inspect the cards themselves until after opening the packages.

The fact that Opposer manufactures cards in places other than Las Vegas and sells them to casinos throughout the country does not diminish the association between Las Vegas and playing cards. Certainly furniture is manufactured in many places other than the region of Italy known as Tuscany and fashion goods are manufactured in places other than New York. That fact did not preclude the Board from finding that there was a sufficient goods place association between Tuscany and furniture and New York and fashion. See, In re Broyhill Furniture Industries, Inc., 60 USPQ2d 1511, 1518 (TTAB 2001) ; see also, In re Save Venice New York, Inc., 59 USPQ2d 1778, 259 F.3d 1346 (Fed. Cir. 2001); In re Fashion Group S.N.C., Serial No. 76006037, (TTAB Dec. 3, 2004) (not citable as precedent) (Exhibit C). Likewise, the fact that playing cards are

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<sup>2</sup> Applicant has not excluded sales of his cards on the internet in the goods description.

used in casinos in various locales throughout the country does not detract from the reality that they are also used in Las Vegas, and that Vegas is known for such use and affiliation.

Applicant argues that there is a lack of evidence showing that the cards are actually cancelled in Las Vegas, but offers no evidence that it is material to consumers where the cards are cancelled rather than where they are used in casino play. The applicant also argues that the "cache" of cancelled cards decks is not that cards originated from Vegas but that they were used in a casino. Many casinos are located in Vegas and Vegas is famous for its casinos. Since such use also occurs in Vegas the Applicant's distinction is immaterial.

Applicant argues that an inference of materiality can be drawn only where there is a heightened association between a service and a geographic location. The inference was used in both In re Consolidated Specialty Restaurants, Inc., 71 USPQ2d 1921 (TTAB 2004) and In re Les Halles De Paris J.V., 67 USPQ2d 1539, 334 F.3d 1371 (Fed. Cir. 2003). Both cases dealt with restaurant services, but there is no language that expressly limits the Board from inferring the materiality prong when goods rather than services are at issue.

In any event, Opposer has presented more than enough evidence to demonstrate that the association would be material to consumers, and Applicant offered no evidence in response. See, Donya, Ltd. v. Donya Michigan Co., Cancellation No. 92033012 (TTAB Sept. 6, 2005) (Exhibit B). Although non-citable precedent, the case demonstrates the evidence the Board deems sufficient to show materiality: Existence of a market for a product, such as a specialty Russian beer from the Zhiguly region of

Russia was sufficient to show that the goods-place association was material to consumers.

The evidence submitted to the Board with regard to the market for playing cards that were used in play in Las Vegas demonstrate that relation to Vegas is a material factor in a consumer's decision whether or not to purchase playing cards. Furthermore, the heightened association between Vegas and playing cards allows the Board to presume that its geographical relation would be material to a consumer. Based on the foregoing, Applicant's mark is not entitled to registration.

**III. Opposer's evidence is admissible and relevant.**

**A. Applicant has not been prejudiced**

Applicant argues that Opposer improperly filed the documents listed in its Notice of Reliance and the trial testimony by submitting them at the same time Opposer filed its brief with the Board. Applicant also raises several other technical arguments that are petty and unjustified. However, Applicant does not argue that it did not receive notice of Opposer's evidence or that it was prejudiced in any way.

Opposer timely filed its Notice of Reliance with the Board during its testimony period on July 29, 2005 and simultaneously served Applicant with the Notice and copies of each and every document identified in the notice. The Notice of Reliance sets forth a synopsis of the articles and includes references to their relevancy. The documents had previously been produced to Applicant in discovery. Thus, at the latest, Applicant had the Opposer's exhibits four months before Applicant's testimony period ultimately ended.

Opposer also took the depositions of Dan Espenscheid (USPC Casino Sales Manager) and Kevin Bagger (of the Las Vegas Convention and Visitors Bureau) prior to the close of its testimony period on July 31, 2005. Since Applicant's counsel indicated he would be participating in the depositions by telephone, Opposer provided Applicant's counsel with the proposed deposition exhibits in advance for his convenience and arranged for telephone participation of Applicant's counsel. Applicant received copies of the final deposition transcripts and exhibits in advance of the close of its testimony period.

Applicant's testimony period would have closed at the end of September, 2005, except that it sought and obtained two extensions of time to which Opposer consented. The first motion extended Applicant's testimony period until October 29, 2005 and the second motion extended Applicant's testimony period until November 28, 2005. Applicant sought no additional extensions of time; nor did it indicate additional extensions were necessary. Thus, the gist of Applicant's objections to the Opposer's first Notice of Reliance and Opposer's trial testimony is not that Applicant did not have the information, but simply that the documents and transcripts themselves were filed by Opposer with its brief. In instances where exhibits are voluminous, it would appear that a single submission of all exhibits with the brief would be more convenient for the Board, since it is not likely that the Board would have the opportunity to review any of these materials until the case is fully briefed.<sup>3</sup>

Applicant's argument that Opposer's submission to the Board was "not in conformity with regulations" also appears to focus on complaints about binders, tabs

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<sup>3</sup> Even if the Board were to sustain Applicant's objections, the Board can still take judicial notice of the dictionary definitions of Vegas and Las Vegas which prove the geographical location and the relationship to gambling and playing cards.

and font sizes. In this case, for the Board's convenience, Opposer included the deposition transcripts and the exhibits in binders. Although Applicant had copies of all of the exhibits more than eight months before it filed its trial brief, Opposer provided Applicant with an additional set of the numbered exhibits tabbed and in binders so that Applicant could easily find the cited exhibits and publications. However, Opposer did not include the tabs with its submission to the Board. Thus, Applicant's complaints about three-ring binders and tabs are especially petty given that Opposer went to the trouble to assemble its evidence for Applicant in a fashion that made finding a particular document easier. Finally, it is not clear to which documents Applicant's complaints about font size are directed. With respect to Opposer's documents printed from the Lexis/Nexis database, there does not appear to be any discretion as to the choice of font size during the printing process.

The Board has held that "when a motion to strike a notice of reliance is filed on the ground it does not meet the procedural requirements of the rules, and the Board finds that the notice is defective but that the defect is curable, the Board may allow the party which filed the notice of reliance time to cure the defect." Weyerhaeuser v. Katz, 24 USPQ2d 1230, 1233 (TTAB 1992). Rule 1 of the Federal Rule of Civil Procedure ensures that cases should be decided on their merits rather than on procedural controversies, especially where the opposing party has not been prejudiced. See Fed. R. Civ. P. 1 (The rules "shall be construed and administered for the just, speedy and inexpensive determination of every action.") Where purposes of the rule are served, technical non-compliance is excused. Bohrer v. Hanes Corp., 715 F.2d 213 (5th Cir. 1983)(excusing failure of attorney to renew motion for a directed verdict); Murray v.

Sevier, 145 F.R.D. 563, 570 n.4 (D. Kan. 1993) (allowing untimely motion for class certification); Hernandez v. City of Hartford, 30 F.Supp.2d 268 (D. Conn. 1998) (excusing a failure to specifically raise defenses in an answer where other party was not prejudiced or surprised). Accordingly, in the event the Board determines the exhibits were untimely, Opposer respectfully requests the Board to accept the exhibits and transcripts filed with Opposer's trial brief because Applicant was not prejudiced.

Applicant's reliance on Questor Corporation v. Dan Robbins is misplaced because the Notice of Reliance stricken in that case was filed ***after the oral hearing on the merits*** had taken place. 199 USPQ 358, 361 n.3 (TTAB 1978). In contrast, in this case, Opposer filed its Notice of Reliance in a timely fashion during its testimony period and forwarded copies of those publications to Applicant during its testimony period. Applicant's reliance on Miss Nude Florida is also misplaced because the Petitioner in that case filed his Notice of Reliance on the last day of ***Respondent's*** testimony period, giving the Respondent no chance to rebut the filing in his testimony period, and thus prejudicing the Respondent. Miss Nude Florida, Inc. v. Drost, 193 USPQ 729, 731 (TTAB 1977). Because Applicant was not prejudiced in the present case, Applicant's objections should be overruled.

**B. Opposer does not rely on Exhibit 11**

Opposer included Exhibit 11 with other exhibits sent to Opposer's attorneys by the Court Reporter. However, Opposer does not refer to Exhibit 11 in its Trial Brief, nor rely on its contents in any way. Opposer stands by its previous statement withdrawing Exhibit 11.

**C. Opposer's evidence submitted in the Rebuttal Period was proper**

Applicant submitted the trial testimony of Karl Ondersma, an attorney who visited websites upon instruction by Applicant's counsel. The websites Mr. Ondersma visited showed that playing cards were available for sale from websites with addresses outside of Las Vegas. The testimony of Kathryn Przywara, submitted in rebuttal, demonstrates that there are websites for cancelled Las Vegas casino cards with Las Vegas addresses. Thus, it would appear to the consumer to emanate from Las Vegas. Ms. Przywara's testimony directly rebutted Mr. Ondersma's testimony and thus is proper rebuttal. Furthermore, Ms. Przywara was competent to testify about the websites she visited because her testimony centered on the experience of the viewer of these websites, such as what items the viewer would perceive are available for sale, and what items the website portrays as originating from Las Vegas.

The website printouts that form the exhibits to Ms. Przywara's deposition are also admissible because the proper foundation for their admission was laid. The Board held in Raccioppi v. Apogee Inc., 47 USPQ2d 1368, 1371 (TTAB 1998), that internet evidence is admissible if there is testimony by the person who accessed the information. "The declarant is not required to have personal knowledge of the information set forth in [internet] printouts." Id.

Mr. Robinette's trial testimony is also proper because it rebutted Applicant's testimony which tried to deny the association between playing cards and Vegas. Mr. Robinette's testimony as to the joint promotion between a card company, USPC, and the World Poker Tour for a free trip to Vegas is pertinent to a continued association in the eyes of consumers between Vegas and playing cards.

**D. Objections as to the Trial Testimony are not well taken**

Opposer submitted the Trial testimony of Dan Espenscheid, an employee of USPC who lives and works in Las Vegas, Nevada. Mr. Espenscheid is a Casino Sales Manager for USPC who sells playing cards to Las Vegas casinos. His testimony regarding several website printouts is not inadmissible hearsay, as argued by Applicant, because Mr. Espenscheid was called to testify, in part, to the experience of any normal person looking at a website. Opposer does not offer the information presented on the website as truth, but rather for the information it conveys to the website's viewer, whether truthful or not. As an employee of thirty-five years with USPC, Mr. Espenscheid was competent to testify to the matters on which he did, as he lives in Las Vegas and works with playing cards and Las Vegas casinos. Thus, Mr. Espenscheid's testimony did not lack a proper foundation.

The testimony of Kevin Bagger is also admissible. Applicant objects on the ground that two pages of testimony should be stricken because of leading questions. On page 9, Opposer's counsel, Lynda Roesch, asks Mr. Bagger how he would define gaming. Mr. Bagger responds that he would define gaming as "legal games of chance including slot machines, blackjacks, craps, roulette and so forth." Counsel then asks if Mr. Bagger's definition of gaming would include games played with playing cards. Bagger replies that gaming does include games with playing cards by saying "yes." In no way did counsel suggest the answer; the testimony was merely exploring whether Mr. Bagger considered games played with playing cards as gaming. The second question on page 9 is clearly a foundational question which leads to further testimony. Ms. Roesch's questions on Page 26 also do not suggest an affirmative answer. The

question merely redirects Mr. Bagger to a point brought up in Mr. Linn's cross-examination; it did not unfairly suggest the answer.

**E. Materials submitted by way of Notice of Reliance were proper and timely.**

Applicant argues that the copies of printed publications are improper because they "are some form of press clippings, and apparently a printout of some electronic form of press clipping and other materials." The Board has previously defined press clippings as "essentially compilations by or on behalf of a party of article titles or abstracts of, or quotes from, articles." Hard Rock Licensing Corp. v. Elsea, 48 USPQ2d 1400 (TTAB 1998). Applicant does not identify any specific index number as a "press clipping," and none of the materials submitted by Opposer meets the definition set forth in Hard Rock.

The vast majority of articles from printed publications submitted by Opposer are in the form of complete printouts from the LEXIS/NEXIS database. All of the LEXIS/NEXIS printouts contain the relevant stories in their entirety. The printouts also list the name of the publication, the date of issue, and the page number. The stories are from major publications which are accessible through a basic news search from lexis.com. The Board has previously held that articles from the LEXIS/NEXIS database qualify as printed publications under Trademark Rule 2.122(e). Material from a computerized database may be made of record by notice of reliance under Rule 2.122(e), by filing "either (1) the actual printed publication... or (2) an electronically generated document...which is the equivalent of the printed publication... For example, a party which wishes to file a notice of reliance on an article published in a newspaper or magazine of general circulation may submit with the notice, in lieu of the actual

article, a printout of the article (or a copy thereof) from Mead Data Central's NEXIS computerized library of information." Weyerhaeuser v. Katz, 24 USPQ2d 1230, 1232 (TTAB 1992); see also 37 CFR § 2.122(e). Because replications of entire articles which appeared in periodic publications available to the public are admissible through submission via Notice of Reliance, Applicant's objection on this point should be overruled.

#### IV. Conclusion

Opposer respectfully requests that Application number 78/253725 be refused registration based on 15 USC §1052 (c)(3) which bars the registration of geographically deceptively misdescriptive trademarks such as VEGAS. USPC has conclusively demonstrated through testimony and exhibits that Vegas is a well known geographic location from which Opposer's product does not originate, that playing cards have a strong goods-place association with the geographic location and that such an association is material to a potential purchaser of Applicant's goods. Accordingly, the Board should sustain the opposition and refuse registration.

Dated: **April 27, 2006**

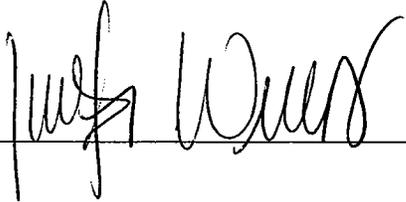


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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a copy of the foregoing was sent by e-mail on this 27<sup>th</sup> day of April, 2006 to Timothy A. Flory, Van Dyke, Gardner, Linn & Burkhart, LLP, 2851 Charlevoix Drive, S.E., P.O. Box 888695, Grand Rapids, MI 49588-8695 at flory@vglb.com .

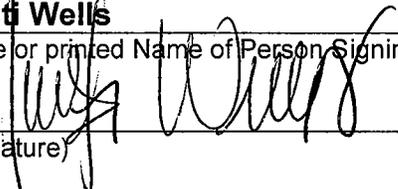
  
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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office on the date shown below.

**Kristi Wells**

\_\_\_\_\_  
(Type or printed Name of Person Signing Certificate)

  
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(Signature)

**April 27, 2006**

\_\_\_\_\_  
(Date)



THE  
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**Last Judgment** *n.* According to the Bible, the final judgment by God of all mankind. Preceded by *the*.

**last-ly** (lās'tlē) *adv.* In the end; in conclusion; finally.

**last minute** *n.* The moment or time immediately before an event or deadline: *She always does everything at the last minute.* Also called "last moment." —**last-min-ute** (lās'tmīn'it) *adj.*

**last name** *n.* A surname.

**last post** *n.* *Sometimes Last Post. Military.* 1. A bugle call blown as a signal for the hour for retiring to bed. 2. A bugle call blown at funerals.

**last resort** *n.* A final measure or course of action open to one.

**last straw** *n.* An additional difficulty, irritation, or trouble that stretches one's tolerance or endurance beyond the limit. Preceded by *the*. [Based on the proverbial phrase, *It's the last straw that breaks the camel's back.*]

**Last Supper** *n.* Christ's supper with his disciples on the night before his Crucifixion, at which he instituted the Eucharist. Preceded by *the*. Also called the "Lord's Supper."

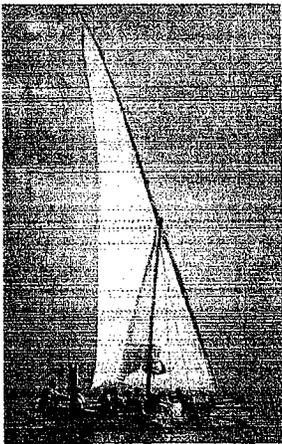
**last thing** *adv. Informal.* As the last or final action: *She'll do that last thing before she leaves.*

**last word** *n.* 1. The final statement in a verbal argument. 2. **a.** A conclusive or authoritative statement or treatment: *the last word in car safety.* **b.** The power or authority of ultimate decision. 3. *Informal.* The newest in fashion; the latest thing. Preceded by *the*.

**Las Vegas** (lās vā'gəz). City in southern Nevada. Set in a remote ranching and mining region, it is the leading gambling city in the country and the site of many famous nightclubs.

**lat.** latitude.

**Lat.** Latin.



**lateen** In a lateen rig, the luff, or leading edge of the sail, is attached to a very long spar, not the mast. Lateen-rigged boats, like this one on the Nile, are still common in many parts of the world.

**lat-a-ki-a** (lāt'ə-kē'ə) *n.* A grade of Turkish tobacco. [After *Latakia*, Syrian port in a tobacco-growing region.]

**latch** (läch) *n.* 1. A fastening or lock, typically a bar that falls into a groove or cavity and is lifted by a lever. 2. A small spring-lock for an outside door that can be opened from the outside by a key. —*v.* **latched, latching, latches.** —*tr.* To close or lock with a latch. —*intr.* To have a latch for closing or locking. —**latch on.** *Informal.* 1. To attach oneself; cling. Used with *to*. 2. To understand; perceive: *The fool still hasn't latched on.* Often used with *to*. 3. To single out (an idea, for example). Used with *to*: *latched on to idealism as the key to his work.* [Middle English *lache*, from *lachen*, to latch, seize, Old English *læccan*, to grasp.]

**latch-et** (läch'it) *n. Archaic.* A thong used to fasten a shoe or sandal. [Middle English, from Old French *latchet, lacet*, shoestring, from *las*, noose, snare.]

**latch-key** (läch'kē) *n.* 1. A key for opening a latch, especially one on an outside door or gate. 2. A symbol of freedom from parental authority.

**latchkey child** *n.* A child who has a key to his home because both parents are out working when he returns from school.

**latch-string** (läch'string) *n.* A cord attached to a latch and often passed through a hole in the door to allow lifting of the latch from the outside.

**late** (lät) *adj.* **later** or **rare latter** (lät'ər), **latest** or **last** (läst, läst). 1. Coming or occurring after the correct, usual, or expected time; delayed. 2. **a.** Beginning at, occurring at, or lasting until a relatively advanced hour or time: *a late breakfast.* **b.** Occurring, being, or continuing towards the end: *the late 19th century.* **c.** Coming from near the end of a period or life: *a late Rembrandt.* **d.** At an advanced hour at night: *It was very late by then.* 3. Taking longer than usual to reach a given stage: *a late developer.* 4. Having recently begun or occurred; just previous to the present: *the latest developments.* 5. Being the immediate past occupant of a position or place; former. 6. Dead, especially recently deceased: *the late Mr. Foster.* —*See* Synonyms at **tardy**.

—*adv.* **later, latest.** 1. After the correct, usual, or expected time; tardily. 2. **a.** At a relatively advanced time: *undertaken late in his life.* **b.** At an advanced hour of the night: *called very late.* **c.** Far into a period of time. 3. In the recent past: *As late as last week, he was still alive.* —*of late.* In the near past; lately. [Middle English, Old English *laet*.] —**late-ness** *n.*

**lat-ed** (lä'tid) *adj. Poetic.* Belated. [From **LATE**.]

**la-teen** (lä'tēn) *adj. Nautical.* 1. Designating a triangular sail hung on a long yard attached to a short mast. 2. Rigged with such a sail. —*n.* A lateen-rigged boat. [French (*voile*) *Latine*, "Latin (sail)" (from its use in the Mediterranean), from Old French, feminine of *Latin*, **LATIN**.]

**Late Greek** *n.* Greek during the early Byzantine Empire, from about the fourth to about the seventh century A.D.

**Late Latin** *n.* Latin from the third to the seventh century A.D.

**late-ly** (lät'lē) *adv.* Not long ago; recently.

**La Tène** (lä'tēn) *adj.* Pertaining to or designating an Iron Age European civilization dating from the fifth to the first century B.C. [After *La Tène*, on Lake Neuchâtel, Switzerland, where the remains were first discovered.]

**la-tent** (lä'tənt) *adj.* Present or potential, but not manifest: *latent talent.* [Latin *latēns* (stem *latent-*), present participle of *latēre*, to lie hidden, be concealed.] —**la-ten-cy** *n.* —**la-ten-ly** *adv.*

**Synonyms:** *dormant, potential, quiescent.*

**latent heat** *n. Symbol L.* The quantity of heat absorbed or released by a substance undergoing a change of state, as by ice changing to water or water to steam.

**latent image** *n.* In photography, an invisible image produced in an emulsion after exposure but before development.

**latent period** *n.* 1. The incubation period of an infectious disease. 2. The interval between stimulus and response.

**later** (lä'tər). Comparative of **late**.

—*adj.* Subsequent.

**lat-er-al** (lät'ər-əl) *adj.* 1. Of, pertaining to, or situated at or on the side or sides. 2. *Phonetics.* Designating a sound produced by breath passing along one or both sides of the tongue.

—*n.* 1. A lateral part, projection, passage, or appendage. 2. *Phonetics.* A lateral sound, such as (l). [Latin *laterālis*, from *latus*† (stem *later-*), side.] —**lat-er-al-ly** *adv.*

**lateral inversion** *n.* Inversion between right and left, such as that which occurs in the formation of an image in a plane mirror.

**lateral line** *n.* A linear series of sensory pores and tubes for sensing sound and vibration, as along the side of a fish.

**lateral pass** *n. Football.* A pass thrown sideways, parallel to the line of scrimmage.

**Lat-er-an** (lät'ər-ən) *n.* 1. The church of Saint John Lateran, the cathedral church of the pope as bishop of Rome. 2. The palace, now a museum, adjoining this church. Preceded by *the*. [Latin *Laterana*, district of ancient Rome, residence of the family *Plautii Laterani*.]

**la-te-ra rec-ta.** Plural of **latus rectum**.

**lat-er-ite** (lät'ər-īt) *n.* A reddish-brown earthy substance, the residue produced by leaching of the soil in tropical regions, consisting of a preponderance of hydrated iron oxide with some hydrated aluminum oxide. Compare *bauxite*. [Latin *later*†, brick, tile + *-ITE*.]

**lat-est** (lä'tist). Alternate superlative of **late**.

—*adj.* Most recent, modern, or up-to-date.

—*n. Informal.* The most recent or up-to-date news, fashion, or the like. Preceded by *the*.

**la-ter** (lä'téks) *n., pl. latices (lä'tə-séz) or **-texes**. 1. The usually milky, viscous sap of certain trees and plants, such as the rubber tree, that coagulates on exposure to air. 2. An emulsion of rubber or plastic globules in water, used in paints, adhesives, and other products. [New Latin, from Latin *latex*, fluid.] —**la-ter** *adj.**

**latex paint** *n.* A paint having a binder that is a latex. Also called "rubber-base paint."

**lath** (läth, läth) *n., pl. laths* (läthz, läthz, läths, läths). 1. A narrow, thin strip of wood or metal, used especially in making a supporting structure for plaster, shingles, slates, or tiles. 2. Any other building material, such as a sheet of metal mesh, used for similar purposes. 3. A slat. 4. Lathing.

—*tr.v.* **lathed, lathing, laths.** To build, cover, or line with laths. [Middle English *lat, lath*, Old English *laett*.]

**lathe** (läth) *n.* 1. A machine on which a piece of wood or metal, for example, is spun on a horizontal axis and shaped by a fixed cutting or abrading tool. 2. A potter's wheel.

—*tr.v.* **lathed, lathing, lathes.** To cut or shape on a lathe. [Perhaps Middle English *lath*, Old Danish *lad*, supporting stand, perhaps a special use of *lad*, pile, from Old Norse *hladh*.]

**lath-er** (läth'ər) *n.* 1. A light foam formed by soap or detergent agitated in water. 2. Froth formed by profuse sweating, as on a horse. —*in a lather.* *Informal.* Highly excited or upset; agitated.

—*v.* **lathered, -ering, -ers.** —*tr.* 1. To put lather on; coat with lather. 2. *Informal.* To give a beating to; whip. —*intr.* 1. To produce lather; foam. 2. To become coated with lather. Used especially of horses. [Revival of Old English *leathor*, washing soda.] —**lath-er-er** *n.* —**lath-er-y** *adj.*

**lath-ing** (läth'ing, läth'-) *n.* 1. The act or process of building with laths. 2. A structure made of laths. Also called "lath."

**lath-y** (läth'ē, läth'ē) *adj. -ier, -iest.* Tall and thin like a lath.

**la-ti-ci-fer** (lä-tis'ə-fər) *n.* A cell or vessel containing latex, found in such plants as rubber, poppy, and euphorbia. [New Latin, from *latex* (stem *latic-*) + *-FER*.]

**lat-i-cif-er-ous** (lä'tə-sif'ər-əs) *adj.* Secreting or exuding latex. [New Latin *latex* (stem *latic-*), **LATEX** + **-FEROUS**.]

**lat-i-fun-di-um** (lä'tə-fün'dē-əm) *n., pl. -dia* (-dē-ə). A landed estate, especially one in the ancient Roman world or in Latin America. [Latin *latifundium*: *lātus*, broad + *fundus*, estate, bottom.]

**Lat-in** (lä'tn) *adj.* 1. *Abbr. L., Lat.* Of or pertaining to Latium, its people, or its culture. 2. Of or pertaining to ancient Rome, its people, or its culture. 3. Of, pertaining to, or composed in the language of ancient Rome and Latium. 4. Of or pertaining to those countries or peoples using Romance languages, especially the countries of Latin America. 5. Of or pertaining to the Roman Catholic Church, as distinguished from the Eastern Orthodox Church.

—*n.* *Abbr. L., Lat.* 1. The ancient Italic dialect of Latium or the language into which it evolved, which through the political and cultural expansion of Rome became the dominant language of the Western Roman Empire, and survived into the Middle Ages as a language of learning and state documents, and until modern times as the official language of the Roman Catholic Church. See **Late Latin**, **Medieval Latin**, **New Latin**, **Old Latin**, **Vulgar Latin**. 2. A native or resident of ancient Latium. 3. A member of a Latin people, especially of Latin America. 4. A Roman Catholic.

**Latin alphabet** *n.* The Roman alphabet (*see*).

**Latin America.** A division of the Americas, consisting broadly of the countries of Central and South America (specifically those speaking Romance languages), together with Mexico. The region constitutes the fourth largest of the world's major divisions, with 14 percent of its land and 8 percent of its people. Latin America's backbone of young fold mountains, the Sierra Madre of Mexico and the Andes, is earthquake-prone and forms part of the Pacific's

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# EXHIBIT B

Offered by Opposer, United States Playing Card Company

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**THE UNITED STATES PLAYING  
CARD COMPANY,**

**Opposer,**

v.

**HARBRO, LLC,**

**Applicant.**

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**Opposition No.: 91162078**

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THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: September 6, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Doyna, Ltd.

v.

Doyna Michigan Co.

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Cancellation No. 92033012

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Thomas S. Keaty and Bella I. Safro of Keaty Professional Law Corporation for Doyna, Ltd.

Doyna Michigan Co., pro se.<sup>1</sup>

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Before Seeherman, Chapman and Walsh, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Doyna, Ltd. (a New York limited liability company) has filed a petition to cancel a registration issued on the Principal Register to Doyna Michigan Co. (a Michigan

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<sup>1</sup> On December 18, 2003, respondent filed a letter to the Board interpreted by the Board (in an order dated April 6, 2004, p. 2) as a motion to extend dates. In the letter respondent's president, Alexander Kaytser, stated that "the attorney that we have retained for this matter is unable to attend the proceedings due to other obligations." To be clear, no attorney has ever entered an appearance on respondent's behalf in this cancellation proceeding.

**Cancellation No. 92033012**

corporation) for the mark ZHIGULY for "beer" in International Class 32.<sup>2</sup>

Petitioner alleges, inter alia, that it "is now and has been for the last several years engaged in the business of importing and selling alcoholic and non-alcoholic beverages, including beer 'Zhigulevskojo' (Zhigulevskoye) or 'Zhiguli' for short" (paragraph 1); that petitioner "has been importing 'Zhiguli' beer from Russia, particularly 'Zhiguli' beer manufactured by Brewery Hamovniki (Khamovniki), Moscow, Russia" (paragraph 2); that 'Zhigulevskoye' beer is named for its place of origin, the town of Zhiguli in the Samara region of Russia; that 'Zhiguli' or 'Zhiguly' is a well-known mountain range along the Volga river, in Russia, and it is also the name of a region which includes the mountain range and a national park; that "the term 'Zhiguli' is a well-known geographic place" and it is a "well-known geographic place in Russia where beer is manufactured" (paragraphs 8-9); that "the term 'Zhiguli' has long been associated with Russian beer in the minds of the U.S. public" and "the term is recognized as a geographic term and as a term for Russian beer by distributors of alcoholic beverages in this country" (paragraph 16); that "purchasers of [respondent's] products would reasonably identify or

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<sup>2</sup> Registration No. 2549428 issued March 19, 2002, from an application filed August 25, 2000, based on a claimed date of first use and first use in commerce of August 1, 2000.

**Cancellation No. 92033012**

associate the goods sold under the mark 'Zhiguli' [sic -- 'Zhiguly'] with the geographic location contained in the mark" (paragraph 23); that respondent imports and sells beer manufactured in a brewery in Lithuania; and that respondent (through an attorney) sent a letter to petitioner demanding that petitioner cease its use of the mark ZHIGULI for beer based on respondent's asserted rights in the mark ZHIGULY.

Based on these allegations, petitioner alleges that (i) respondent obtained its registration of a geographic term for its beer products contrary to the provisions of Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2); or (ii) alternatively, the mark ZHIGULY, in relation to respondent's goods, is primarily geographically deceptively misdescriptive contrary to the provisions of Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3); or (iii) alternatively, respondent obtained registration of a deceptive term contrary to the provisions of Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), because respondent imports and sells beer made in Lithuania under a mark which identifies a place in Russia.

In its answer respondent admits the following paragraphs of the petition to cancel:

"Petitioner has been importing 'Zhiguli' beer from Russia, particularly 'Zhiguli' beer manufactured by Brewery Hamovniki (Khamovniki), Moscow, Russia" and there is a reference to petitioner's beer label, Exhibit No. 1 (paragraph 2);

**Cancellation No. 92033012**

"Registrant applied for a trademark registration for 'Zhiguly' in International Class 32 on August 25, 2000, alleging the date of first use in interstate commerce of August 1, 2000. On March 25, 2002, the mark was registered on the Principal Register for beer" (paragraph 17);

"...Registrant imports and sells beer manufactured by Gubernija Brewery in the city of Shaulay, Lithuania" and there is a reference to respondent's beer label, Exhibit No. 24 (paragraph 18); and

"On May 24, 2002, Registrant, through its attorneys..., sent a letter to [petitioner], demanding that Petitioner cease and desist using the term 'Zhiguli'..." and there is a reference to a copy of the letter, Exhibit No. 25 (paragraph 24).

Respondent otherwise denies the salient allegations of the petition to cancel.

**The Record**

The record includes the pleadings, and particularly, the paragraphs admitted by respondent, including the exhibits mentioned therein -- copies of petitioner's beer label, respondent's beer label and respondent's cease and desist letter to petitioner (Exhibit Nos. 1, 24 and 25);<sup>3</sup> and the file of respondent's registration as provided in

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<sup>3</sup> With one exception not relevant herein, exhibits to pleadings are not evidence of record in the case unless properly identified and introduced during testimony. See Trademark Rule 2.122(c). See also, TBMP §317 (2d ed. rev. 2004). However, the exhibits noted above (Nos. 1, 24 and 25) are of record because respondent admitted those paragraphs of the petition to cancel. In addition, we note that some of the exhibits to petitioner's

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Trademark Rule 2.122(b)(1) and (2). Petitioner submitted the deposition transcript, with exhibits, of the testimony of its president and owner, Yakov Bromberg.<sup>4</sup>

Petitioner also submitted a notice of reliance on 17 listed items, some of which are admissible evidence and some of which are not. Petitioner noted in its brief (p. 8) that respondent "did not challenge Petitioner's evidence..." However, the adverse party is not necessarily obligated to object to evidence not submitted in accordance with the rules. A party waives its right to object only on certain matters (generally those relating to curable procedural matters). As the Board stated in *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, footnote 3 (TTAB 1987): "[A party] may not reasonably presume evidence is of record when that evidence was not offered in accordance with the Trademark Rules." See also, TBMP §§707.02(a) and 707.04 (2d ed. rev. 2004). In the circumstances of the case now before us, we find that respondent has not waived its objections to petitioner's involved materials. We now determine and explain seriatim the admissibility of petitioner's 17 noticed items.

Item Nos. 1-5 are copies of (i) a page from an Oxford Press map of the Volga Basin, (ii) a page from an MSN map of

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pleading were later properly submitted as items in petitioner's notice of reliance, which is fully discussed later herein.

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the Samara region, (iii) a page from The Columbia Gazetteer of the World (1998), (iv) a few excerpted pages from a study on "Alcohol in the USSR" (1982) published by Duke (University) Press, and (v) a few excerpted pages from The World Guide To Beer (1977). These are all printed publications properly made of record by way of notice of reliance pursuant to Trademark Rule 2.122(e).

Item No. 6 is a copy of petitioner's requests for admissions to respondent which have been deemed admitted under Fed. R. Civ. P. 36(a) as they were unanswered by respondent.<sup>5</sup> This material is admissible under a notice of reliance pursuant to Trademark Rule 2.120(j)(3)(i).

Item Nos. 7-13 are photocopies of pages from Internet websites (some in English and some in Russian with a translation into English attached). As Internet materials are transitory in nature, they are not self-authenticating and therefore are not admissible under Trademark Rule 2.122(e) as printed publications. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). See also, TBMP §704.08 (2d ed. rev. 2004). Attached to the notice of reliance is the affidavit of Bella I. Safro, one of petitioner's attorneys, averring to information regarding

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<sup>4</sup> Respondent did not attend petitioner's deposition of Mr. Bromberg.

<sup>5</sup> In addition, the Board noted in an order dated April 6, 2004 that petitioner's requests for admission were deemed admitted by operation of Rule 36(a).

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the translations from Russian to English and the sources of the Internet printouts. However, the affidavit testimony of a witness is not admissible unless the parties have agreed thereto in writing pursuant to Trademark Rule 2.123(b). There is no such stipulation of the parties herein. Thus, none of the Internet evidence is admissible and cannot be considered.

Item No. 14 consists of photocopies of one-page letters from four U.S. distributors of alcoholic beverages (in California, Georgia and New York). These letters are not printed publications under Trademark Rule 2.122(e), and there is nothing in the record to indicate that respondent stipulated to the entry of such evidence. These four letters cannot be considered.

Item No. 15, the affidavit of a Russian-born person now living in Tennessee, is inadmissible for the reason explained above regarding Trademark Rule 2.123(b).

Item No. 16, a photocopy of respondent's beer label, is already of record as Exhibit No. 24 to petitioner's pleading, because it was admitted by respondent in its answer.

Item No. 17 is a copy of a letter sent by respondent to the Board during the prosecution of this cancellation proceeding. This is neither a printed publication nor an

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official record under Trademark Rule 2.122(e). It cannot be considered herein.

In sum, Item Nos. 1-6, and 16 from petitioner's notice of reliance are properly of record and have been considered in reaching our decision. Item Nos. 7-15 and 17 are not properly of record and have not been considered by the Board. Of course, all evidence of record is considered only for whatever appropriate probative value it may have.

Only petitioner filed a brief on the case after trial, and neither party requested an oral hearing.

**The Parties**

Petitioner, Doyna Ltd., located in Brooklyn, New York, was founded in 1997 and is an importer of wine, beer and spirits from eastern European countries. Petitioner has been importing ZHIGULI beer, from Moscow, Russia, for over three years.

The information of record regarding respondent comes from its registration file; from its admissions in its answer to the petition to cancel; and from its deemed admitted answers to petitioner's requests for admission (the latter item having been made of record by petitioner). Respondent, Doyna Michigan Co., is a Michigan corporation located in Farmington Hills, Michigan. Respondent imports and sells beer manufactured by a brewery in Shaulay, Lithuania. Respondent first used the mark ZHIGULY for beer

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on August 1, 2000. In May 2002, respondent sent a cease and desist letter to petitioner regarding petitioner's use of the mark ZHIGULI for beer.

**Burden of Proof**

In Board proceedings regarding the registrability of marks, our primary reviewing Court has held that the plaintiff must establish its pleaded case, as well as its standing, and must generally do so by a preponderance of the evidence. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); and *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

**Standing**

Standing requires only that a party seeking cancellation of a registration have a good faith belief that it is likely to be damaged by the registration. See Section 14 of the Trademark Act, 15 U.S.C. §1064. See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:46 (4th ed. 2005). The belief in damage can be shown by establishing a direct commercial interest.

Petitioner uses the mark ZHIGULI for beer, and respondent demanded that petitioner cease such use in a May 2002 letter from an attorney for respondent to petitioner. These facts establish petitioner's direct commercial

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interest and its standing to petition to cancel. See *Cunningham v. Laser Golf Corp.*, supra.

**Pleaded Grounds**

Petitioner has pleaded three grounds for cancellation -  
- Section 2(a) deceptive, 15 U.S.C. §1052(a), Section  
2(e)(2) primarily geographically descriptive, 15 U.S.C.  
§1052(e)(2), and Section 2(e)(3) primarily geographically  
deceptively misdescriptive, 15 U.S.C. §1052(e)(3).

We begin with a discussion of the relevant changes to  
the Trademark Act as a result of the North American Free  
Trade Agreement (NAFTA) Implementation Act, Pub. L. No. 103-  
182, 107 Stat. 2057 (1993), and the comments of our primary  
reviewing Court, the Court of Appeals for the Federal  
Circuit, in relation thereto.

NAFTA amended Section 2(e)(2) of the Trademark Act by  
deleting reference to primarily geographically deceptively  
misdescriptive marks; adding Section 2(e)(3) to the  
Trademark Act to prohibit registration of primarily  
geographically deceptively misdescriptive marks; and  
amending Section 2(f) of the Trademark Act to eliminate  
primarily geographically deceptively misdescriptive marks  
from becoming registrable via a showing of acquired  
distinctiveness.

The Court in *In re California Innovations, Inc.*, 329  
F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), concluded that

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the standard for determining whether a mark is primarily geographically deceptively misdescriptive under the new Section 2(e)(3) of the Act is different from, and more rigorous than, the standard for determining registrability of the same types of marks under Section 2(e)(2) of the Act prior to the NAFTA amendment. The Court stated the following (66 USPQ2d at 1856-1857, and 1858):

NAFTA and its implementing legislation obliterated the distinction between geographically deceptive marks and primarily geographically deceptively misdescriptive marks.

...

Thus, §1052 no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks. Like geographically deceptive marks, the analysis for primarily geographically deceptively misdescriptive marks under §1052(e)(3) focuses on deception of, or fraud on, the consumer. ... Accordingly, the test for rejecting a deceptively misdescriptive mark is no longer simple lack of distinctiveness, but the higher showing of deceptiveness.

...

The amended Lanham Act gives geographically deceptively misdescriptive marks the same treatment as geographically deceptive marks under §1052(a).

...

As a result of the NAFTA changes to the Lanham Act, 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). While there are identical legal standards for deception in each section, subsection (e)(3) specifically involves deception involving geographic marks.

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In view thereof, we will give no further consideration to petitioner's Section 2(a) claim, but will turn to an analysis of the Section 2(e)(3) ground.

The Court in California Innovations articulated the following standard for determining whether a mark is primarily geographically deceptively misdescriptive, Id. at 66 USPQ2d at 1858:

(1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is 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) the misrepresentation was a material factor in the consumer's decision.

See also, *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001).

With regard to the first prong of the test for whether a term is primarily geographically deceptively misdescriptive, "the primary significance of the mark is a generally known geographic location," petitioner's evidence clearly shows that Zhiguly (also spelled Zhiguli)<sup>6</sup> is a geographic place in Russia and is primarily known as that geographic location. Zhiguly is the name of an area in Russia on the Volga River, as well as a town in Russia, a mountain range and a national park, all in the Zhiguly region. This area is known for its natural beauty and it is

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referred to as "the pearl of Russia." (Bromberg dep., pp. 11-13; and notice of reliance item Nos. 1-3.) Respondent

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<sup>6</sup> The word is sometimes spelled ending with an "i" and sometimes ending with a "y." The difference appears to be a difference in transliteration from the Russian alphabet.

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admits that ZHIGULY is the name of a geographic region in the Volga region of Russia; and that both the city of Zhiguly and the Zhiguly National Preserve are located in Russia.

On this record, Zhiguly, Russia is not an obscure place. It is not a small region, and there are numerous geographic places named Zhiguly in the region, including a town, a mountain range and a national preserve. The first prong of the test has been met. Cf., *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926 (TTAB 1984); and *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73 (TTAB 1983).

Turning to whether "the consuming public is 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," we find that petitioner has established this prong of the test. Beer has been produced in the Zhiguly region of Russia for over 40 years; and the Zhiguly region along the Volga River is associated with beer. "Zhiguly, or Zhigulyovskoye, it's a short name for regional place of production." (Bromberg dep., p. 12.)<sup>7</sup>

"The Zhiguly represent basically the traditional beer

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<sup>7</sup> Mr. Bromberg grew up in the Soviet Union/Russia, and it is apparent from his testimony that his English grammar is not perfect.

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production [in] former Soviet Union and Russia. And it's connected to certain place in Volga region -- Zhiguly."  
(Bromberg dep., p. 13.) Petitioner imports ZHIGULI beer for its "community" of Russian-speaking customers, and this community numbers about seven and one-half million people.  
(Bromberg dep., p. 14.)

The 1982 study "Alcohol in the USSR" published by Duke (University) Press, includes the following statements (pp. 16 and 24):

The popular Zhiguli beer containing 2.8 percent alcohol composed some 90 percent of all beer produced in 1956 ... and its dominance has probably remained.

There are eight to ten brands of beer sold in the USSR, but Zhiguli beer constituted about 90 percent of all beer sold in this period. ...

The average price of Zhiguli beer rose from 0.45 rubles in 1954 to 0.47 in 1978.

Further, The World Guide To Beer (p. 197) states: "The range includes Russia's everyday beer-brand, the light ... 'Zhiguli,' which is named after the region where the barley is grown. In the brewing of 'Zhiguli,' unmalted barley and corn-flour are used as adjuncts."

While we do not take these statements in the two publications for the truth of the matter asserted, they provide additional evidence as to the perception of the relevant consumers, the Russian-speaking community in the United States. See also, Mr. Bromberg's testimony relating to learning about Zhiguly, Russia and "Zhiguly" beer from

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the time of his childhood in Russia. (Bromberg dep., p. 12.)

There is no question that respondent's beer does not come from Zhiguly, Russia or the Zhiguly region of Russia. Respondent has admitted that the beer it imports and sells under the mark ZHIGULY is produced in a brewery in Lithuania. See petitioner's notice of reliance Item No. 6 (petitioner's requests for admission, request No. 6).

As to the third prong of the test, "the misrepresentation was a material factor in the consumer's decision," the record establishes that Zhiguly, Russia is known for its beer and that the relevant public in the United States is aware of that connection. According to the record, there are seven and one-half million people in the Russian-speaking community in the United States who would purchase this beer specifically because of the geographic connotation (Bromberg dep., pp. 14 and 17). This is not an insignificant number of purchasers. That is, for at least this number of consumers the term "Zhiguly," and the belief that the beer comes from the Zhiguly region, is material to their decision to buy the product.

Accordingly, we find that petitioner has established, by a preponderance of evidence, that respondent's registered mark ZHIGULY is primarily geographically deceptively

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misdescriptive in relation to respondent's beer not made in the Zhiguly region of Russia.

We have held herein that the term ZHIGULY is primarily geographically deceptively misdescriptive for beer not made in the Zhiguly region of Russia. Because respondent's beer does not come from the place named, the term cannot be primarily geographically descriptive under Section 2(e)(2) in relation to respondent's goods.

**Decision:** The petition to cancel is granted only on the ground of geographically deceptive misdescriptiveness, and Registration No. 2549428 will be cancelled in due course.



Mailed:  
December 3, 2004

**This Opinion is Not  
Citable as Precedent  
of the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Fashion Group S.N.C. Di Bertoncello  
Maria Luisa & Michela & C.

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Serial No. 76006037

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Harvey B. Jacobson, Simor L. Moskowitz and Matthew J.  
Cuccias of Jacobson Holman, PLLC for Fashion Group S.N.C.  
Di Bertoncello Maria Luisa & Michela & C.

Barbara Gold, Trademark Examining Attorney, Law Office 106  
(Mary Sparrow, Managing Attorney).<sup>1</sup>

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Before Walters, Chapman and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Flash & Partners S.r.l., a joint stock company of  
Italy, applied to register the stylized mark set forth  
below for a wide variety of clothing items in Class 25.  
The application was based on the stated intention of the

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<sup>1</sup> Examining attorney James Marcus issued the initial and final refusals, and denied applicant's request for reconsideration. Ms. Gold issued two actions after the appeal was suspended and the application was remanded for further examination; and she later filed the Office's brief for the appeal.

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applicant to use the mark in commerce. The application subsequently was assigned to Fashion Group S.N.C. Di Bertoncello Maria Luisa & Michela & C. and the assignment has been recorded in USPTO records at Reel 2517, Frame 0851.

*No-Lita*  
NORTH LITTLE ITALY

There were many office actions and responses during prosecution of this application, both before applicant filed its notice of appeal and after it requested a remand of the appeal to make further evidentiary submissions and arguments. Suffice it to say that the original examining attorney made final a refusal of registration, which we discuss below, and applicant obviously has appealed. The only issue to be decided on appeal is that refusal of registration, made under Section 2(e)(3) of the Lanham Act, 15 U.S.C. § 1052(e)(3). Before addressing the refusal, however, we discuss amendments of the identification of goods and mark.

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As filed, the application listed the following identification of goods: "dresses, coats, overcoats, raincoats, jackets, sports jackets, trousers, jeans, shorts, skirts, track suits, sweaters, shirts, t-shirts, cardigans, dressing gowns, night gowns, pyjamas, petticoats, socks, stockings, tights, gloves, scarves, foulards (neckerchiefs), belts, waistcoats, bathing suits, hats, caps, shoes, boots, sandals, slippers." When the identification of goods information in the application was entered into USPTO records, the Office inadvertently omitted the first five items -- "dresses, coats, overcoats, raincoats, jackets."

The original examining attorney, in the first office action, required applicant to make two minor amendments to the identification. Specifically, he required "pyjamas" be amended to "pajamas" and required "foulards (neckerchiefs)" be amended to "foulards, neckerchiefs." The examining attorney then set forth, in one block paragraph, the identification listed in USPTO records (not the identification listed in the application) but with the changes included. Applicant, in response, adopted the examining attorney's proposed amended identification. Applicant did not point out that "dresses, coats, overcoats, raincoats, jackets" had been omitted. Further,

in briefing this appeal, both applicant and the examining attorney have recited the adopted amended identification as the operative identification. Accordingly, we consider the amended identification adopted by applicant to have entered the two minor changes required by the examining attorney and to have effectively deleted "dresses, coats, overcoats, raincoats, jackets" from the identification as filed.

As for the mark, though no mention of a deficiency in the drawing was made prior to appeal, on remand the substituted examining attorney asserted first, that the mark drawing was of poor quality and would not reproduce well, and second, that it impermissibly combined stylized lettering and typed lettering. This examining attorney required the applicant to submit an amended drawing "entirely in special form." Applicant then submitted an amended drawing entirely in typed form rather than in special form. The examining attorney nonetheless accepted this amendment. Thus, the mark involved in this appeal is now NO-L-ITA NORTH LITTLE ITALY.<sup>2</sup>

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<sup>2</sup> We note applicant's statement, in footnote 2 of its main brief, "that its mark is NO-L-ITA stylized, and not NOLITA, such that this stylized, distinctive and arbitrary depiction of the mark is, in and of itself, a basis for overcoming the Examiner's 2(e) refusal." We take this not as a reference to the mark in the original drawing or as any indication that applicant now contends that NORTH LITTLE ITALY is not part of its mark, but merely as a contention that the NO-L-ITA term in its mark is "stylized" as compared to a presentation of that term as NOLITA.

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In view of the above-discussed circumstances, the refusal to register now before us is a refusal to register NO-L-ITA NORTH LITTLE ITALY for "sports jackets, trousers, jeans, shorts, skirts, track suits, sweaters, shirts, t-shirts, cardigans, dressing gowns, night gowns, pajamas, petticoats, socks, stockings, tights, gloves, scarves, foulards, neckerchiefs, belts, waistcoats, bathing suits, hats, caps, shoes, boots, sandals, slippers." The refusal is based on Section 2(e)(3) of the Lanham Act, and the examining attorney's contention that the mark, when used, would be geographically deceptively misdescriptive of applicant's clothing goods.

As both the applicant and the examining attorney acknowledge:

[T]he PTO must deny registration under §1052(e)(3) if (1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is 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) the misrepresentation was a material factor in the consumer's decision.

In re California Innovations, Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003). See also, In re Les Halles De Paris J.V., 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003), and In re Consolidated Specialty Restaurants, Inc., 71 USPQ2d 1921 (TTAB 2004).

***Summary of Arguments***

In particular, the examining attorney contends that that NO-L-ITA is shorthand for "North Little Italy" or "North of Little Italy"; that applicant's coupling of NORTH LITTLE ITALY with NO-L-ITA reinforces the perception of the hyphenated term as shorthand for the full phrase; that "NoLita" is a geographic term designating a particular neighborhood or small section of the borough of Manhattan in New York City;<sup>3</sup> that the area is known for retailing of trend-setting fashions; that the area and its association with trend-setting fashions and fashion designers would be known by consumers of applicant's identified goods; that origin of such goods in the place identified by the term "NoLita" would be a material factor in the purchasing decisions of consumers; and that applicant's goods will not come from the place known as "NoLita."

Applicant "does not dispute the evidence [made] of record [by the initial action refusing registration] that the 'Nolita' term may refer to an area of New York City," and has stated "that neither Applicant nor its goods come

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<sup>3</sup> The examining attorney contends that whether displayed as NOLITA, NO-L-ITA, or in any combination involving upper and lower case letters, the term has the same connotation. The record in this case reveals that various presentations of the term are employed, we use NO-L-ITA when referring to the term in applicant's proposed mark and "NoLita" when referring to the area in Manhattan.

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from any locale known as 'Nolita.'"<sup>4</sup> Response to office action, April 19, 2001. Applicant, however, does dispute that "NoLIta" is anything more than a designation of a "small area [of New York City] recently 'd dreamed up' by ... real estate brokers" so as to "brand" the area and thereby increase property values. Brief, p. 8 (emphasis by applicant). In essence, applicant contends that the name for this area of New York City is a "passing fancy" and already "on the wane," so that it cannot truly be considered a "generally known" geographic term.<sup>5</sup> In

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<sup>4</sup> Further, in arguing that the refusal is implausible, applicant contends that because "Italy is a world famous center for fashion design and manufacture[] ... an effort to conceal the Italian origin of the Applicant and its goods in favor of a misrepresentation of U.S. origin would not be of any benefit to the Applicant."

<sup>5</sup> In its brief, applicant asserts that "Nolita is not a continent, country, province, state, city, town, or topographical feature." P. 7. It first made this observation in its request for reconsideration of the final refusal, where applicant also posited that a neighborhood in a city may not qualify as a geographic location under the Trademark Act. We disagree. See *Les Halles, supra*, which vacated and remanded a Board decision finding that LE MARAIS for a restaurant in New York was geographically deceptively misdescriptive. The Federal Circuit's decision, however, clearly was based on the question whether there was a sufficient services-place association for consumers, between the New York restaurant and a neighborhood in Paris, France, and the related question whether, if such association existed, it would be material to patrons of the restaurant. The court did not question the Board's finding that the primary significance of the "Le Marais," neighborhood is that of a geographical place. See also, *In re Gale Hayman Inc.*, 15 USPQ2d 1478, 1479 (TTAB 1990) ("A geographically descriptive term can indicate any geographic location on earth, including streets and areas of cities.").

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addition, applicant contends that "NoLita" does not appear in an otherwise comprehensive on-line database of the United States Geological Survey or in geographical dictionaries.

In its request to suspend the appeal and remand the application for consideration of additional evidence, applicant contended for the first time that "Nolita" is a given name and that the term cannot, therefore, "*primarily and directly denote a geographical place*" (emphasis by applicant). In support of this contention, applicant submitted various articles retrieved from the NEXIS database and a few web pages retrieved from the Internet. Applicant has not, in either of its briefs, reiterated or in any way argued this contention.

Applicant also contends that "Little Italy" is a term used for sections of numerous cities and that the phrase "north of Little Italy" is also widely used, in discussions of these places. Thus, applicant concludes "there is no one place exclusively referred to as 'Little Italy' or 'north of Little Italy.'" Brief, p. 10. For this reason, applicant concludes that prospective purchasers of its identified goods would not make a goods-place association between the goods and the New York City neighborhood of "NoLita." Applicant's other argument why there is no

goods-place association is based on the issuance, by the USPTO, of two registrations for, respectively, NOLITA and NO LIMITS, NO BOUNDARIES, NOLITA as marks for various hair care products, as well as the issuance of a Notice of Allowance on an intent-to-use application to register NOLITA for jewelry.<sup>6</sup> Applicant has argued at length why jewelry and hair care products should be considered fashion items or trends and asserts that the USPTO's issuance of the two registrations, and the Office's approval of the application, stand as evidence that the term NOLITA is not primarily geographically misdescriptive or primarily geographically descriptive because there is no goods-place association.

Finally, applicant contends that, even if we assume that we are dealing with a geographic term for a place generally known and that prospective purchasers of the goods listed in applicant's application would associate such goods with the place named in applicant's proposed mark, there is no evidence such association will materially affect purchasing decisions. Specifically, applicant argues in its main brief that the examining attorney did

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<sup>6</sup> The two registrations are owned by the same entity, have virtually identical identifications of goods and list the same dates of use. The application, still pending, is owned by a different entity.

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not even address the materiality issue which was highlighted by our reviewing court in the *California Innovations* case; and in its reply brief applicant deconstructs the specific items of evidence on which the examining attorney relied in her brief. Applicant asserts, in essence, that there is no direct evidence of materiality; and that any evidence asserted to establish a goods-place association does not establish such a strong association that materiality could be inferred.

***Examining Attorney's Evidence***

The examining attorney must establish a *prima facie* case that the mark is primarily geographically deceptively misdescriptive. See In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003). A *prima facie* case "requires 'more than a mere scintilla' of evidence, in other words, 'such relevant evidence as a reasonable mind would accept as adequate to support the finding.'" In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citations omitted).

To support the initial refusal of registration, the original examining attorney introduced certain web pages and "five (5) representative Lexis/Nexis articles." The first web page is the "Nolita Neighborhood Guide" available

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at "www.pleasantconcepts.com." This page says the neighborhood has boutiques and galleries, but does not specifically mention fashion or clothing items. The four boutiques and shops listed on the page include one which markets "modernized classics" but does not explain what these are, another that markets "handbags and accessories," a third that markets "handbags" and a fourth that is listed simply as a "home" boutique and which we assume would stock items for one's home. The second web page [part of the text is cut off in the printout] features a "Soho and Nolita Tour" from "Big Onion Walking Tours," and references "fashionable galleries and boutiques" but does not specifically mention clothing and, moreover, lumps the "SoHo" and "NoLiTa" neighborhoods together, so that we are unable to glean from this page whether one neighborhood or both would have the galleries and boutiques.

As for the five article excerpts retrieved by the examining attorney's LEXIS/NEXIS search for the terms "nolita" and "north little italy," these are items 1-4 and 7, of 127 articles. As noted earlier, the examining attorney terms them "representative." The first is from The Boston Globe and is an article about Boston's Italian neighborhood, the North End. The excerpt refers to New York's "NoLiTa" as "the hip boutique-laden 'hood that

translates to 'north of Little Italy.'" The second excerpt is from Real Estate Weekly which notes the appointment of a leasing agent for a retail space "in NoLita," explains that the term means "north of Little Italy" and states it is a "developing center for up-and-coming fashion retailing." It also states: "Calypso, Jamin Puech, Sigerson Morrison, Zero, Mark Schwartz, Soco, Language, and Fresh are neighborhood staples."<sup>7</sup> The third article excerpt is from The New York Post, is headlined "High Fashion Is Moving Uptown," and states: "After a passing flirtation with the quaint streets of NoLita (North of Little Italy), the avant garde Commes des Garcons label headed for Chelsea and much-hyped designer boutique Jeffrey opened its headquarters in the Meatpacking District, respectively." The fourth excerpt is from The New York Law Journal and reports on the success of certain leasing agents having "arranged for Illuminations, the national lifestyles retailer, to open its first store at 54 Spring Street, in the heart of 'NoLita' (North of Little Italy)."<sup>8</sup> We have no information, however, as to whether a "lifestyles retailer" is a retailer of clothing items, items for the home, or

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<sup>7</sup> While this particular article excerpt does not reveal the wares of each of these "neighborhood staples," other evidence reveals that these include shoe, handbag and clothing retailers.

<sup>8</sup> We presume the topic is the retailer's first New York store.

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something else altogether. Finally, the fifth article excerpt, from The New York Times, is on bargain hotels for frugal travelers and reports: "Trendy and desirable, the downtown neighborhoods of SoHo, NoLita (North of Little Italy) and TriBeCa have fewer hotels than other parts of Manhattan -- and almost none I could afford." These five articles are dated between May and August 2000.

The evidence offered in support of the initial refusal, by itself, likely would be insufficient to allow the examining attorney to carry the Office's burden of proof, at least in regard to the goods-place association and materiality elements of the refusal. Later submissions, however, clearly show a goods-place association between "NoLita" and fashion design and retailing. This association has been noted not only in New York publications but also in publications from other cities and on web sites geared to the fashion conscious and/or the fashion conscious prospective visitor to New York.

In support of the final refusal of registration, the original examining attorney introduced 15 additional LEXIS/NEXIS article excerpts.<sup>9</sup> These are all dated between

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<sup>9</sup> The examining attorney stated in his office action that 14 excerpts were attached, but we count 15.

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April 1997 and July 2001. The searches used to retrieve these excerpts were "nolita," or "nolita" and "north little italy," or "nolita" within five words of "north little italy," or "nolita" and "clothing." Of these 15 articles, 13 clearly discuss clothing design or retailing of clothing in "NoLiTa." While most of the articles appeared in New York publications, others appeared in Houston, Dallas, and San Diego publications.

Next, the original examining attorney denied applicant's request for reconsideration and introduced reprints of pages from 10 websites; a reprint of the search results list from a search of the Internet utilizing the Yahoo search engine; and 10 additional article excerpts retrieved from LEXIS/NEXIS databases. The web pages include reprints from the New York pages of "Citysearch.com" ("find cutting edge fashion in Nolita" one page states; others list numerous clothing stores); a "Visualstore.com" news article on a new shop opening in "NoLiTa" ("Designer Leeora Catalan, who counts Madonna, Destiny's Child, Gwen Stefani, Britney Spears and Jennifer Lopez among her celebrity clientele, has opened her own store, Shop Noir, in New York's Nolita district."); a "DigitalCity.com" listing of six of "The Best Women's Clothing Stores" in New York, which includes two stores

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listed as located in "NoLita"; a web page from "onemedia.com" ("brought to you by Zagat") featuring a profile of a "NoLita" shoe store; web pages from the website of designer Margie Tsai ("MargieTsai.com") detailing that she has an "exclusive boutique" in "NoLita," that her fashions have been featured in numerous magazines and that some are also available in other stores around the country; a page from a city guide to New York from "BlackVoices.com" ("NoLita, one of Manhattan's quietest neighborhoods, also is one of its most creative - and lately its most desirable location for fledgling artists and fashion designers to launch their own businesses"); a web page from the city guide to New York by "Trendcentral" ("[NoLita] was originally an authentic Italian neighborhood, but nowadays it's full of hipsters and fashion types who live, work, eat, and shop in the neighborhood").

The LEXIS/NEXIS article excerpts included with the denial of applicant's request for reconsideration were retrieved by searches for "nolita" or "nolita" within 5 words of "clothing or fashion," and are dated between January and May 2002. Nine out of the ten articles clearly discuss clothing, clothing designers, or clothing shops in the "NoLita" neighborhood. Eight of these nine articles

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appeared in New York publications, and one appeared in The Boston Globe.

The search results list from the Yahoo search *per se* is not probative. See In re Remacle, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002).

The second examining attorney, following suspension of the appeal and remand of the application, issued two office actions. The first of these actions did not introduce any additional evidence in support of the refusal. The second action introduced 36 more LEXIS/NEXIS article excerpts. These are dated between March 1998 and January 2004. While the office action does not indicate the search query used to retrieve these excerpts, it appears that the search was for the term "nolita" and either "Italy" or "New York," as these are the terms that appear in bold in the excerpts. This search returned articles that appeared in New York publications, but also articles in The Chicago Tribune, Washingtonian magazine, the Providence Journal-Bulletin, The Patriot Ledger (Quincy, MA), The Times Union (Albany, New York), The San Francisco Chronicle, The Baltimore Sun, Fortune magazine, Entrepreneur magazine, The Bergen Record (New Jersey), Footwear News, and Real Estate Weekly. We agree with applicant's assessment (brief, p. 6) that these 36 excerpts have been presented in extremely truncated

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fashion; and many which might otherwise have been found probative of a goods-place association merely are probative of the meaning of "NoLIta." Nonetheless, 14 of the article excerpts clearly associate "NoLIta" and clothing or footwear; another two associate the neighborhood with handbags; and two associate it with jewelry or "chokers."

*Is the Primary Significance of the Proposed Mark a Generally Known Geographic Location?*

"Under the first prong of the test - whether the mark's primary significance is a generally known geographic location - a composite mark such as the applicant's proposed mark must be evaluated as a whole. It is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole."

In re Save Venice New York, Inc., 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (citations omitted).

On the evidence of record, we find the primary significance of the proposed mark is that of a geographic location. The record includes dozens of article excerpts retrieved from the NEXIS database that show "NoLIta" to be a particular place and a term derived from the phrase

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"North Little Italy" or "North of Little Italy."<sup>10</sup>

Moreover, because applicant's proposed mark includes the phrase NORTH LITTLE ITALY, there is little, if any, likelihood that a consumer would perceive the NO-L-ITA element as anything other than shorthand reference for the longer phrase.<sup>11</sup>

The next question is whether this geographic location is "generally known." Applicant has argued, in essence, that the "NoLita" neighborhood certainly is not generally known outside New York City, and may not even be a widely used term within that city. On this record, however, we have no difficulty finding that the neighborhood is generally known. In New York, it would be known among real estate professionals, artists, fashion designers and those who follow the retailing of clothing and other designer items. Even outside New York City, the neighborhood and

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<sup>10</sup> Applicant and the examining attorney have debated whether it is significant that most of the evidence shows "NoLita" is considered to be shorthand for "North of Little Italy" rather than for "North Little Italy." We find the difference insignificant, for no matter the derivation of the term "NoLita," it identifies only one place.

<sup>11</sup> As noted previously, that although applicant at one point during prosecution of its application argued that "Nolita" can be a given name, it did not press the argument on appeal. Even had it done so, we would find the argument unavailing, both because given names are not usually hyphenated, as is the term NO-L-ITA, and also because the phrase NORTH LITTLE ITALY in the mark leaves little room for NO-L-ITA to be perceived as anything other than shorthand for the full phrase.

the items that are designed and/or retailed within the neighborhood would be generally known among those who follow the fashion industry, as well as among travel agents or travel writers who would be expected to know of the diverse neighborhoods within a particular city that travelers might want to visit; and it can scarcely be doubted that New York City is a significant tourist destination, whether for domestic or international travelers. Finally, even casual readers of newspapers from Boston, Baltimore, Chicago, Providence, Quincy (MA), Bergen (NJ), Austin, Dallas, Houston, San Diego and San Francisco, as well as casual visitors to travel-related websites featuring information on New York, may have read of the neighborhood.

Applicant's argument that New York City real estate agents "dreamed up" the name and did so only "recently" is not persuasive of a contrary result. It is largely irrelevant how the name came to be and only relevant what significance it has to consumers. Moreover, the NEXIS article excerpts show that the neighborhood has been called "NoLita" for years. We likewise find unpersuasive applicant's argument that the use of the name for the neighborhood is a "passing fancy" or "on the wane." This argument is based on one or two of the articles retrieved

from NEXIS and a single website visited by applicant, and is outweighed by the many other articles of recent vintage that reveal no indication that use of the name is waning.

We also find unpersuasive applicant's argument based on its submission of evidence showing the existence of other "Little Italy" neighborhoods in the United States, and the consequent use of the phrase "north of Little Italy" to describe places north of those neighborhoods. By this argument, applicant essentially contends that prospective consumers of clothing will not necessarily think of only one of these places, i.e., the New York City neighborhood, and may think of other places. This evidence, however, does not establish that any of these places are also referred to by the term NO-L-ITA. The mere possibility that a resident of, for example, San Francisco, might consider clothing marketed under applicant's mark to indicate origin of the clothing in some place north of that city's Little Italy neighborhood does not establish the registrability of applicant's mark. Rather, it only establishes that such a consumer would still misapprehend the geographic source of applicant's goods.<sup>12</sup>

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<sup>12</sup> In addition, applicant has not put any evidence into the record that would tend to establish that people in other cities that have a Little Italy neighborhood are accustomed to seeing those neighborhoods designated by terms such as NO-L-ITA, whereas the record does reveal that NO-L-ITA is recognized in New York City.

In sum, as to the first factor under the California Innovations analysis, we find that NO-L-ITA and applicant's composite mark NO-L-ITA NORTH LITTLE ITALY are geographic in significance; and we find the place to which both the hyphenated term and composite mark refer is generally known.

*Is There a Goods-Place Association Between "NoLita" and Clothing?*

The evidence submitted by the examining attorney shows that the neighborhood known as "NoLita" is associated with various things: narrow streets and smaller buildings than in nearby neighborhoods, which mean less vehicle traffic; easy pedestrian access to boutiques and specialized shops and cafes; and that the boutiques and shops may market clothing, shoes, jewelry, handbags, cosmetics, or housewares. The preponderance of the evidence, however, shows an association of the New York City neighborhood with clothing designers and retailers, many of whom apparently have found the neighborhood a suitable location for their businesses.

We find the record sufficient to establish a goods-place association between clothing items and the New York neighborhood known as "NoLita." We are not persuaded that we should reach a contrary result by applicant's argument

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based on the issuance, by the USPTO, of two registrations for, respectively, NOLITA and NO LIMITS, NO BOUNDARIES, NOLITA, for various hair care products. First, applicant's argument is predicated on a finding that hair care products are "fashion items." While we do not disagree that the styling of hair may be a matter of fashion, we find no support for the contention that, for example, a hair styling gel *per se* is a fashion product. Second, even if we accepted applicant's contention that hair care products *per se* were fashion items, we would not find the Office's issuance of the two registrations in question probative that consumers would not make a goods-place association between clothing and the New York City neighborhood known as "NoLiTa." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).<sup>13</sup>

*Is it Material to Consumers that Clothing Come From or Be Designed in the "NoLiTa" Neighborhood of New York City?*

Evidence establishing a goods-place association, as we have found to be present in this case, raises "an inference of deception based on the likelihood of a goods-place

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<sup>13</sup> The third-party application on which applicant relies has even less probative value than the third-party registrations. See Zappia-Paradiso, S.A. v. Cojeva Inc., 144 USPQ 101 (TTAB 1964) (Information regarding applications evidences only that they were filed on a particular date, even if the marks therein have been published for opposition).

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association that [does] not reflect the actual origin of the goods. A mere inference, however, is not enough to establish the deceptiveness [and] consequence of non-registrability under ... NAFTA and the amended Lanham Act [which] place an emphasis on actual misleading of the public." *California Innovations*, 66 USPQ2d at 1857. Thus a showing of materiality is required. *Id.*

If 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" or "the place is noted for the particular goods," deceptiveness is likely. *California Innovations*, 66 USPQ2d at 1857, citing, respectively, *In re House of Windsor*, 221 USPQ 53, 57 (TTAB 1983) and *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 n.6 (Fed. Cir. 1985).

In *California Innovations*, the appeal was limited to the USPTO's refusal to register that applicant's mark for insulated bags and wraps. While there was a great deal of evidence in the case, "[a]t best, the evidence of a connection between California and insulated bags and wraps [was] tenuous." *California Innovations*, 66 USPQ2d at 1859. Thus, the appeal was remanded to the Board for further proceedings, including review of the evidence to see if it supported a finding of materiality. *Id.*

The record in this case establishes much more than a tenuous connection between "NoLita" and clothing items. Instead, the record establishes that clothing designers are concentrated in the neighborhood and that it is known for its trend-setting and unique clothing boutiques. Some of the evidence speaks directly to consumers' recognition that "NoLita" is noted for its fashionable clothing. See, for example:

Headline: Boutiques find niche in chic kids' apparel; Buyers often are older, wealthier  
"Puma shoes and Nolita T-shirts (referring to a New York City neighborhood 'north of Little Italy') have been popular with adults who are now dressing their tykes in them."  
Chicago Tribune, January 26, 2004.

"...Jonsson exudes downtown chic. 'But if I want to walk around looking at things, I go east,' he said, referring to the upstart neighborhood Nolita (North of Little Italy). 'It's got more new designers. It's more fun. It's what SoHo used to be.'"  
Newsday (New York, NY), February 18, 2002.

"...the area has been perceived as a destination for shoppers looking for something special that cannot be found in ordinary stores.  
...fashion publications seek out the designers located there for new trends in clothing and accessories.  
...Tracy Feith offers his concept of fashion to women who want to make a statement. ... '[Feith's] Customers come here for the designer look.'"  
The New York Times, May 13, 2001.

Ms. Uprichard, who has been a downtown designer since the 1980's, originally selling in the East Village, said that NoLita has flourished as an alternative fashion mecca because of all the

moneyed shoppers drawn to the greater SoHo district. Another factor has been customers' hunger for clothing that is not mass marketed." The New York Times, May 31, 1998.

"...Manhattan has all the same chains,' says Barbara White-Sax, a New Jersey resident who often comes to NoLiTa to shop. 'This area truly offers things you can't find anywhere else.'" Crain's New York Business, April 21, 1997.

The record also includes an excerpt from a Washingtonian magazine article (December 2003) which, although truncated, clearly discusses the opening of high fashion shoe stores in the Washington metropolitan area, "so the hip girls will be suitably shod. Fashionable types used to shopping in New York's SoHo and NoLita won't have to make an Amtrak run anymore..."; an excerpt from Footwear News (July 28, 2003), which reports that a new boutique in Chicago is selling brands selected by, among other actions, "patrolling New York's Nolita neighborhood"; and a web site posting, by an individual reviewing the "NoLita" neighborhood (www.iagora.com's "iTravel" site; review posted by "Sacha," June 15, 2000):

Soho stands for "South of Houston," Tribeca stands for "Triangle Beneath Canal," and then there is Nolita: "North of Little Italy." Extremely cool little fashion boutiques have sprouted up in the last couple of years and so the real estate people gave it a name so as to make more money. But the area definitely is distinctive enough to merit its own name.

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In sum, we find the evidence of record sufficient to establish that principal products of the "NoLita" neighborhood, and the products for which it is chiefly noted, are fashionable clothing items. Moreover, the evidence establishes that, for consumers, the origin of clothes in "NoLita" is a material factor in their shopping decisions. Thus, we find the evidence establishes the third prong of the *California Innovations* test.

Decision: The refusal of registration under Section 2(e)(3) of the Lanham Act is affirmed.