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Mailed:
January 14, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Conair Corporation¹

Serial No. 77210108

Andres N. Madrid for Conair Corporation.

Anthony M. Rinker, Trademark Examining Attorney, Law Office
102 (Karen M. Strzyz, Managing Attorney).

Before Seeherman, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Conair Corporation has filed an application to
register the mark LONDON SOHO NEW YORK in standard
character format on the Principal Register for "cosmetic
bags, namely, cosmetic bags sold empty, cosmetic organizers

¹ The assignment of this application from the original applicant, Markwins Beauty Products Inc., to Allegro Mfg. Inc., and the subsequent name change to Conair Corporation are recorded in the United States Trademark Office (USPTO) at Reel/Frame 4099/0548 and Reel/Frame 4432/0253.

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sold empty, hang-up cosmetic bags sold empty and cosmetic travel bags sold empty" in International Class 18.²

The examining attorney has refused registration on the ground that the mark is primarily geographically deceptively misdescriptive under Trademark Act Section 2(e)(3), 15 U.S.C. §1052(e)(3).³

To maintain a refusal under Section 2(e)(3), the Office must establish that (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 would be a material factor in the consumer's decision to purchase the goods. In re California Innovations Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003).

² Application Serial No. 77210108, filed June 19, 2007, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging February 1, 2007 as the date of first use of the mark anywhere and in commerce.

³ In his brief the examining attorney withdrew the refusal based on geographic deceptiveness under Trademark Act Section 2(a), 15 U.S.C. §1052(a). In re South Park Cigar Inc., 82 USPQ2d 1507, 1509 (TTAB 2007) (Where the refusal involves an allegedly geographically deceptive mark and there is no claim of acquired distinctiveness prior to December 8, 1993, the appropriate refusal is under Section 2(e)(3) (primarily geographically deceptively misdescriptive) and not Section 2(a) (deceptiveness)).

There is no dispute that the goods do not emanate from LONDON, SOHO or NEW YORK. See Applicant's Response dated August 27, 2008 ("...Applicant states that its goods will not be manufactured or originate in or have any other geographic connection with the locations named in the mark.") There is also no dispute that the primary significance of each of the individual words LONDON, SOHO and NEW YORK is a generally known geographic location and this is borne out by the record. See dictionary definitions for LONDON, SOHO and NEW YORK attached to the Office Action dated February 27, 2008.

It is applicant's position, however, that because "Soho" identifies neighborhoods in both London and New York, the "commercial impression" of the proposed mark is of the two Soho neighborhoods and not the entire cities of London and New York. Thus, "the primary significance of Applicant's Mark to consumers viewing it as a whole is most likely to be London's Soho area and the SoHo neighborhood of New York and not, as the Examining Attorney determined, the city of London, England, the SoHo neighborhood in New York City, and New York City." Br. p. 5. Having limited the meaning of the mark to only the two Soho neighborhoods, applicant asserts that the record does not support a goods/place association with either of the two Soho's.

Specifically, applicant argues that "there must be some connection between the place named in the mark and the applicant's goods such that the consuming public would think that the applicant's goods were manufactured or produced there. The mere fact that similar goods of others are sold there is not enough." Br. p. 8. Further, applicant argues that the record only shows that the London Soho is famous for theatres, restaurants and clubs and the New York SoHo is famous for art galleries and studios. Applicant contends that "[b]ecause there is no goods/place association between empty cosmetic bags and either London's Soho area or the SoHo area of New York, consumers seeing cosmetics bags marked with the words LONDON SOHO NEW YORK are most likely to believe that those words are being used commercially to suggest that the products are hip, upscale, artsy and edgy." Br. p. 12.

In response, the examining attorney argues that:

The anti-dissection rule is inapplicable in the context of the composite mark comprised of the three separate geographic terms, LONDON SOHO NEW YORK, under this type of refusal. Primarily geographically deceptively misdescriptive matter need not be the entire mark, or even the dominant portion of the mark. A refusal under Trademark Action Section 2(e)(3) is appropriate if some portion of the applied-for mark is primarily geographically deceptively misdescriptive with respect to the goods and/or services in question. Thus, each component of the mark can and should be considered individually for geographically

deceptively misdescriptive matter. Any portion of the mark that is geographically deceptive or misdescriptive is sufficient to fatally taint the entire mark.

Br. p. 5.

The examining attorney concludes that "the commercial impression created by the mark is that the geographic source of the goods is LONDON or SOHO or NEW YORK, equally. The fact that any one of these locations is primarily geographically deceptively misdescriptive as a source of goods is enough to taint the entire mark." Br. pp. 8-9.

Certainly, the primary significance of each word in applicant's mark is geographic. However, the examining attorney is incorrect that the determination of whether a mark is geographically deceptively misdescriptive (or geographically descriptive) must be based only on a consideration of the individual geographic terms in the mark, rather than viewing the mark as a whole. In re Sharky's Drygoods Co., 23 USPQ2d 1061 (TTAB 1992) (in the context of the mark PARIS BEACH CLUB for t-shirts, PARIS, although a well-known geographic place and center for haute couture, is facetious rather than geographic). We find that the combination LONDON SOHO NEW YORK does present a somewhat ambiguous commercial impression and the structure of the mark leads consumers to focus on the SOHO portion

rather than the individual parts. This in turn minimizes the impression that the mark indicates the origin of the goods, but rather takes on a more atmospheric impression by referencing not London and New York per se, but the artsy Soho neighborhoods of these cities.

Turning then to consider the goods/place association, the evidence of record does not support a finding that either the two Soho's, or the entire cities of London or New York, are known as origins for cosmetic bags. The bulk of the evidence consists of printouts from various websites showing cosmetic bags for sale or given away at promotions. The examining attorney argues that "it is sufficient to show that LONDON, SOHO, and NEW YORK are world famous fashion centers and travel destinations associated by consumers as a source for fashion accessories such as hand bags or cosmetic bags because LONDON and NEW YORK are large metropolitan areas where these items have been manufactured and sold." Br. p. 7.

There is no evidence in the record to support a finding that cosmetic bags sold empty are manufactured in any of these locations. The website printouts list "cosmetic manufacturers" not "cosmetic bags" manufacturers, and the lists consist of the local address in London or New York of companies known as manufacturers of cosmetics. See

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Office Action dated, February 28, 2008, at p. 12; and Office Action dated, September 22, 2008, at pp. 22-26 (list of cosmetic manufacturers in London), p. 31 (list of cosmetics manufacturers in New York). This case is distinguished by its record from *In re Wada*, 48 USPQ2d 1689 (TTAB 1998) affirmed 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (*NEW YORK WAYS* primarily geographically deceptively misdescriptive for, inter alia, luggage). In that case, the record included listings of manufacturers of luggage and handbags located in New York from both the Thomas Register of American Manufacturers and the WWD Buyer's Guide - Women's Apparel & Accessories Manufacturers. There is no such evidence in this record.

Moreover, whatever the evidence about New York as a fashion center, it has not been established on this record that cosmetic bags are considered by either the industry or consumers as a fashion item. In this regard, we take judicial notice of dictionary definitions for "accessory" which do not include empty cosmetic bags within the meaning of "accessory" in the context of fashion: ⁴

⁴ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *In re CyberFinancial.net Inc.*, 65 USPQ2d 1789, 1791 n. 3 (TTAB 2002) (Board may take judicial notice from online resources that are available in print form).

2. an article or set of articles of dress, as gloves, earrings, or a scarf, that adds completeness, convenience, attractiveness, etc., to one's basic outfit. Random House Dictionary (2011) retrieved from www.dictionary.com; and

Article of apparel that completes the costume, such as shoes, gloves, hats, bags, jewelry, neckwear, belts, boutonnieres, scarfs; in the trade usage, also negligees, corsets, lingerie, etc. The Language of Fashion A Dictionary and Digest of Fabric, Sewing, and Dress (1939).

The evidence of cosmetic bags being offered for sale and promotional events featuring cosmetics where cosmetic bags, in some instances, are given away in New York City generally, SoHo New York specifically, and London also is not sufficient to demonstrate a goods/place association between these areas and cosmetic bags. See e.g., Office Action dated, February 27, 2008, at p. 39 ("Complimentary Cosmetic Bags Help to Make Max Factor a High Fashion Name), pp. 48-54 (various cosmetic events at Bloomingdale's Soho New York store). Such evidence could support a goods/place association for every city on the planet that has a drug store.

While there is some evidence of an association between New York (and less so London) and the fashion and beauty industry in general, there is no evidence to indicate that cosmetic bags are a fashion item to the extent that being known generally for "fashion" equates to a goods/place

association for such a specific item as "cosmetic bags."
See Office Action dated, September 22, 2008, at p. 8
(Spring 2009, new york fashion week), pp. 10-12 ("New York
International Beauty Show ... The electrifying energy of
the beauty industry comes alive each year at the New York
International Beauty Show"), pp. 14-15 (beauty trade shows
in London).

Thus, the record does not support a goods/place
association between the goods and the two Soho
neighborhoods or, for that matter, with the cities of
London and New York. Moreover, even if such an association
had been demonstrated, the Office has failed to prove the
third requirement for a geographically deceptively
misdescriptive refusal. To the extent some inference may
be made regarding any renown for fashion generally, this is
not sufficient to find that any of these places are
renowned for cosmetic bags such that believing that the
cosmetic bags originate in any of the locations represented
in this mark is a material factor in a consumer's decision
to purchase these goods. California Innovations, 66 USPQ2d
at 1857.

In summary, in view of the ambiguous nature of the
mark and the lack of evidence of a goods/place association
or of materiality, the examining attorney has not made out

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a prima facie case that the mark LONDON SOHO NEW YORK is primarily geographically deceptively misdescriptive.

Decision: The refusal under Section 2(e)(3) is reversed.