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IS NOT A PRECEDENT
OF THE TTAB**

Mailed: September 30, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zeller

Serial No. 77544307

Dana B. Robinson of TechLaw LLP for Kathleen Hill Zeller.

Tasneem Hussain, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Bucher and Taylor, Administrative Trademark
Judges.

Opinion by Taylor, Administrative Trademark Judge:

Kathleen Hill Zeller has filed an application to
register on the Principal Register the mark shown below,



for "granola" in International Class 30.¹ In response to a
request by the examining attorney, applicant disclaimed the
exclusive right to use the word "Granola."

¹ Serial No. 77544307, filed August 11, 2008, and alleging a
bona fide intention to use the mark in commerce. The application

The trademark examining attorney finally refused registration under Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2), on the ground that applicant's mark is primarily geographically descriptive of the origin of applicant's goods.

Applicant appealed and requested reconsideration of the final refusal. The request for reconsideration was denied on April 1, 2009 and this appeal resumed on April 20, 2009. Both applicant and the examining attorney filed briefs and applicant filed a reply brief.

We reverse the refusal to register.

Preliminarily, we note that applicant states in her brief that the "Examiner has denied [the] request for reconsideration, but raised additional arguments and cited new cases not mentioned before." (Br. p. 8). We note, however, that an examining attorney is not precluded from raising, even during appeal, new arguments and/or additional case citations in support of a ground for refusal which was timely raised and is the subject of the appeal. See TMBP § 1217 (2d ed. rev. 2004). Accordingly, applicant's objection is overruled.

includes the statement: "The mark consists of the words 'CATALINA ISLAND GRANOLA' stylized with a frame."

Turning then to the merits, the examining attorney maintains that the mark is primarily geographically descriptive of the origin of applicant's goods because the primary significance of the wording "Catalina Island" is a generally known geographic place, applicant is located there and the goods will be sold there, and purchasers would be likely to believe that the goods originate in the geographic place identified in the mark.

The examining attorney has supported the refusal with the following:

a. The definitions of "Catalina Island" and "granola," both taken from the American Heritage[®] Dictionary of the English Language (4th ed. 2000), which defines the terms respectively as:

An island off southern Santa Barbara Islands. Discovered in 1542, it has been a noted resort center since the 1920's.

Rolled oats mixed with various ingredients, such as dried fruit, brown sugar, and nuts, and used especially as a breakfast cereal.²

b. Third-party registrations for marks including the words "Catalina" or "granola" in which those words were disclaimed or the mark was registered pursuant to Section 2(f) of the Trademark Act.

² Retrieved on November 19, 2008 from <https://www.bartleby.com>.

c. Information from wikipedia.org for Santa Catalina Island, in part, as follows (emphasis supplied):

Santa Catalina Island, often called **Catalina Island**, or just **Catalina**, is a rocky island off the coast of the U.S. state of California. The island is 22 miles (35 km) long and eight miles (13 km) across at its greatest width. The island is located about 22 miles (35 km) south-southwest of Los Angeles, California. The highest point on the island is Mt. Orizaba (648 m), at 33°22'29.7"N 118°25'11.6"W.

Part of the Channels Islands of California archipelago, Catalina falls under the jurisdiction of Los Angeles County. Most of the island is owned by the Catalina Island Conservancy.

The total population as of the 2000 census was 3,696 persons, with almost 85 percent living in its only city of Avalon (pop. 3,127, with another 195 south of the city outside of the city limits). The second center of population is the unincorporated town of Two Harbors, in the north, with a population of 298. Development occurs also at the smaller settlements *Ranch Escondido* and *Middle Ranch*. The remaining population is scattered over the island between the two population centers. The island has an overall population density of 49.29/mi² (19.03/km²).

...

Tourism and attractions

About a million tourists visit the island every year.

...

Most of the island is controlled by the Catalina Island Conservancy, a private nonprofit organization. The mission of the Catalina Island Conservancy is to be a responsible steward of its lands through a balance of conservation, education and recreation. Through its ongoing efforts, the Conservancy protects the magnificent natural and cultural heritage of

Santa Catalina Island, stewarding approximately 42,000 acres (170 km²) of land (88 percent of the island), 50 miles (80km) of rugged shoreline, an airport, and more than 200 miles (300km) of roads.

...

Under an agreement with Los Angeles County, the Conservancy has granted an easement to allow day hiking and mountain biking, but visitors must first obtain a permit at the Conservancy's office (on which they declare the parts of the island they intend to visit).

...

The use of motor vehicles on the island is restricted; there is a limit on the number of registered cars, which translates to a 10-year-long wait list to bring a car to the island. Most residents move around via golf cart. Tourists can hire a taxi from Catalina Transportation Services. Bicycles are also a popular mode of transportation. There are a number of bicycle and golf cart rental agencies on the island. Only the city of Avalon is open to the public without restrictions.

d. An excerpt from the website

www.catalinachamber.com that states in part: "Catalina Island is the place where the gentle rhythm of the waves makes time slow down."

e. Excerpts from various websites purportedly to show that "consumers would understand the connection between CATALINA ISLAND and granola" (Final Office Action p. 4), as follows:

Each morning the smell of fresh Granola cooking on the stove fills the air and wakes you from a peaceful slumber. It makes it feel like you are staying in a house with friends and family. Catalina is a great place to visit, and the Old Turner Inn's atmosphere makes it much better

(http://www.tripadvisor.in/ShowUserReviews-g29121-d113202-r1787459-The_Old_Turner_Inn-Avalon-Catalina-Island-California.html);

The Avalon Hotel is one of Catalina Island's premier lodging sources ... the breakfast features fresh fruit, bagels, granola and muffins as well as fresh orange juice, organic coffee and a full selection of teas.

(<http://www.bbonline.com/ca/avalonhotel/>);

A reference to granola as a breakfast item at the Banning House Lodge on Catalina Island.

(www.ecatalina.com/journal_detail.cfm/id/763/img);

An excerpt from a newsletter published by the Home Improvement Ministries containing a recipe for granola served at Campus by the Sea on Catalina Island.

(www.homeimprovementministries.org); and

A small island paradise 26 miles off the coast of Los Angeles, Catalina has two towns (the touristy but fun Avalon and the rustic, granola-haven Two Harbors).

(<http://everything2.com/title/Santa+Catalina+Island>).

Applicant, in urging reversal of the refusal to register, maintains that her CATALINA ISLAND GRANOLA mark is not primarily geographically descriptive "because the main effect of the mark is to suggest a certain lifestyle and relaxation associated with Catalina Inland"; because applicant's goods do not originate from Catalina Island; and because "consumers would not be likely to make a good/place association between applicant's granola and Catalina Island."

As evidentiary support for her position, applicant has submitted the following:

a. An article from the County of Los Angeles Public Library titled "Catalina Island Frequently Asked Questions." The article includes much of the same information included in the Wikipedia article submitted by the examining attorney. The article also includes the following information on the island's main industries.

3. What are the Island's main industries?
Tourism and quarrying are the Island's main industries...

b. An article from the Catalina Island Chamber of Commerce & Visitors Bureau discussing the history of Catalina Island.

c. The declaration of applicant, stating, in part:

While the application is an Intent-to-use, I do not plan to manufacture granola or any of the components on Catalina Island.

...

Catalina is a tiny resort destination, once famous for its casino. It is now popular with southern Californians for short vacations. As such, the concept of the "CATALINA ISLAND GRANOLA" brand is suggestive of a quaint little town with bed and breakfast hotels where one might relax and enjoy a bowl of granola.

d. A copy of the Catalina Island Chamber of Commerce & Visitors Bureau business directory category list.

e. Copies of four third-party registrations for marks including the term "Catalina" or "Catalina Island," which contain no disclaimers of those terms.³

f. Internet evidence of the use of the terms "Hyde Park" and "Rodeo Drive."

"In order for a mark to be considered primarily merely descriptive under Section 2(e)(2), it must be shown that (1) the mark's primary significance is a generally known geographic location; and (2) that the relevant public would be likely to make a goods/place association, that is, would be likely to believe that the goods originate in the place named in the mark." In re Spirits of New Merced LLC, 85 USPQ2d 1614, 1616 (TTAB 2007). See also In re Brouwerij Nacional Balashi NV, 80 USPQ2d 1820, 1821 (TTAB 2006); In re Handler Fenton Western, Inc., 214 USPQ 848, 849-50 (TTAB 1982); and TMEP § 1210.01(a) (5th ed. Sept. 2007) (Test for geographically descriptive marks: (1) the primary significance of the mark is a generally known geographic location; (2) the goods or services originate in the place identified in the mark; and (3) purchasers would be likely

³ We note that the sole third-party registration for a mark containing the term "CATALINA ISLAND," Registration No. 3301873 for the mark CATALINA ISLAND YACHT CLUB, is registered pursuant to Section 2(f) of the Trademark Act.

to believe that the goods or services originate in the geographic place identified in the mark).

Further, the Federal Circuit has quoted the Board as correctly saying:

[H]ere a refusal of registration is based on the finding that a mark is primarily geographically descriptive of the goods, that is, the goods actually come from the geographical place designated in the mark, the Examining Attorney must submit evidence to establish a public association of the goods with the place, if, for example, there exists a genuine issue raised that the place named in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods.

In re Societe Generale Des Eaux Minerales de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450, 1451 (Fed. Cir. 1987).
(Emphasis omitted).

We note first that applicant's mark is not CATALINA ISLAND but rather CATALINA ISLAND GRANOLA with a rectangular frame design. We do not believe that the addition of the generic word "granola" and the design is sufficient to establish a non-geographically descriptive meaning for the mark. Highly descriptive or generic wording does not convert a geographically descriptive term into a non-geographic term. In re Compagnie Generale Maritime, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993) (FRENCH LINE (stylized) primarily geographically

descriptive of goods and services from France); and In re Cambridge Digital Systems, 1 USPQ 1659, 1662 (TTAB 1986)

 primarily geographically descriptive when applicant's place of business is Cambridge, Massachusetts).

We then consider whether the primary significance of the term "Catalina Island" is as a generally known geographic location. The evidence shows that Santa Catalina Island, also commonly known as "Catalina Island,"⁴ is a rocky island off the coast of the state of California, with approximately 3,700 inhabitants, and it is a popular tourist destination hosting about a million visitors every year. Indeed, applicant states in her brief that "Applicant does not dispute that Catalina Island is not remote or obscure." (Br. p. 2). Instead, applicant argues that the geographic meaning of CATALINA ISLAND GRANOLA is minor and unconnected to the goods. Applicant particularly

⁴ Although the issue was not raised by either applicant or the examining attorney, it is settled that a recognized nickname or other informal name for a geographic location is considered the equivalent of the official or formal name for purposes of determining registrability of the geographic term. See In re Carolina Apparel, 48 USPQ2d 1452 TTAB 1998) (The term CAROLINA, used to indicate either North Carolina or South Carolina, is geographically descriptive); and In re Charles S. Loeb Pipes, Inc., 190 USPQ 238, 246 (TTAB 1975) (Old Dominion is an accepted nickname for the state of Virginia; "nicknames and even abbreviations and maps of geographical areas and the names of the geographical area they identify are, for purposes of registration, identical, and ... the same criteria for registration necessarily apply thereto.").

contends that "[t]he primary significance is the connotation attached with Catalina Island: that of leisure, luxury, and a Southern Californian lifestyle. Catalina Island is the epitome of island living, and attracts visitors who wish to unwind and enjoy themselves." However, applicant has not submitted any evidence whatsoever in support of her contention that the public would associate "Catalina Island" with a leisurely lifestyle - the fact that "hordes" of tourists flock to Catalina Island every year is not evidence of how they perceive the term "Catalina Island."

We are also not persuaded by applicant's contention that the CATALINA ISLAND GRANOLA mark is an "arbitrary, fanciful or suggestive" composite. There simply is nothing incongruous in the combination of the terms "Catalina Island" and "granola." We accordingly conclude that, on this record, the primary significance of "Catalina Island" is geographic.

We next consider whether the goods come from the area and whether the public would make a goods/place association; that is, would the public be likely to believe that the goods originate in the place named in the mark. When "there is no genuine issue that the geographical significance of a term is its primary significance and

where the geographical place is neither obscure or remote, a public association of the goods with the place *may ordinarily* be presumed from the fact that the applicant's own goods come from the geographical place named in the mark." *Handler Fenton*, 214 USPQ at 850 (emphasis added). Therefore, when goods come from a specific geographic location, that is normally enough to find a goods/place relationship. *Compagnie Gererale Maritime*, 26 USOQ2d at 1655 ("We likewise hold that the Board did not clearly err in finding that 'France, a major manufacturing and commercial nation, would be perceived as the source of the numerous good and services listed in the applications if the mark is primarily geographical'") and *In re JT Tobacconists*, 59 USPQ2d 1080, 1084 (TTAB 2001) ("[W]e find that a goods/place association exists in that customers for applicant's goods would believe that its cigars, cigar cases and humidors are manufactured in the state of Minnesota and that, because applicant's goods do indeed come from such state, its mark is primarily geographically descriptive of its goods").

While the evidence shows that Catalina Island is a popular tourist destination, the record is devoid of any evidence that Catalina Island is a well-known geographic location, from which we could assume that a wide variety of

goods and services originate. Indeed, the record reflects that it has no agricultural concerns and little to no manufacturing or other industrial industries. In this case, the examining attorney argues that:

- (1) "applicant is located in Avalon which is a city on Catalina Island and therefore there is a presumed goods/place association" (Br. p. 5);
- (2) "although applicant states that the granola will not be manufactured on Catalina Island, applicant has not excluded selling the goods on Catalina Island and has stated that the goods will be sold nationwide which, naturally, includes Catalina Island" (*id.*); and
- (3) the evidence of record demonstrates goods such as granola often originate from and are sold in popular tourist destinations, and therefore, there is a reasonable basis for a consumer to believe that granola bearing the name CATALINA ISLAND GRANOLA would have originated for that same location (*id.* at p. 6).

Applicant, on the other hand, argues the fact that "Applicant's address is in Avalon, located on Catalina Island is of no moment. There is no indication that granola is manufactured on Catalina Island, and no indication that people believe this to be the case." (Br. p. 5). She further argues that "the location of

Applicant's office will not cause people to assume a good/place [sic] association ... [and t]he mere fact that people eat granola on the island does not establish a place/goods association." (*Id.*).

We agree with applicant that merely living on Catalina Island is not necessarily enough to establish a goods/place relationship. Indeed, even the location of a corporate headquarters is not necessarily sufficient to show a goods/place relationship. In re John Harvey & Sons Ltd., 32 USPQ2d 1451, 1454 (TTAB 1994) ("[T]he mere fact that applicant's headquarters are in Bristol, England does not mandate a finding here that a goods/place association should be presumed."). In another case, an applicant applied to register the mark LAUDERDALE FARM for meats and poultry. The fact that the applicant was located in Lauderdale, Alabama, did not establish a goods/place relationship.

That reference indicates only that it [Lauderdale County, Alabama] is a cotton-growing area and makes no reference to any of the products [meats and poultry] for which applicant now seeks to register the mark LAUDERDALE FARM. Even assuming the facts set forth in the Gazetteer are common knowledge, an assumption we find difficult to accept, the evidence is insufficient to support any public association on the part of the public of the term "Lauderdale" with fresh processed meat and poultry products.

In re Consolidated Foods Corp., 218 USPQ 184, 186 (TTAB 1983). Accord In re Gale Hayman Inc., 15 USPQ2d 1478, 1479 (TTAB 1990) (footnotes omitted):

The mere fact that applicant's principal offices are in Century City, close to Sunset Boulevard, does not mandate a finding that a goods/place association should be presumed. Sunset Boulevard itself would have to be associated with the products in such a way that the consuming public would be likely to assume that Sunset Boulevard was the place in which the perfume and cologne originated. Nothing in the record, however, indicates or even suggests that purchasers would believe that Sunset Boulevard was the place of manufacture or production of the perfume and cologne. Indeed, there is no indication that any perfume or cologne is manufactured or produced on Sunset Boulevard.

Although the Board found in the NANTUCKET NECTARS case that the products did not have to be made on the island of Nantucket in order to establish a goods/place relationship, the applicant had a substantial presence in that place (and the specimens - consisting of the product labels - reinforced the goods/place association). In re Nantucket Allserve Inc., 28 USPQ2d 1144, 1145 (TTAB 1993). ("While it is true that applicant's NANTUCKET NECTARS soft drinks are manufactured in Worcester, Massachusetts, applicant's corporate headquarters and, perhaps more importantly, applicant's center for research and development are located on Nantucket. Thus, a principal origin, if not the principal origin, of applicant's products is Nantucket.").

In this case, we have no evidence regarding applicant's presence on Catalina Island, save applicant's acknowledgment that her address is in Avalon, a city on Catalina Island. This falls short of establishing that the origin of applicant's goods is Catalina Island such that there is a presumption of a goods/place association between CATALINA ISLAND and granola. Therefore, it is incumbent upon the examining attorney to introduce evidence sufficient to establish such a goods/place association. As previously indicated, the examining attorney made of record five excerpts from articles retrieved from the Internet that she argues demonstrate that goods such as granola often originate from and are sold in popular tourist destinations, and therefore, there is a reasonable basis for a consumer to believe that granola bearing the name CATALINA ISLAND GRANOLA would have originated from that same location. First, three of the excerpts reference the term "granola," commonly used as a breakfast cereal, merely as a menu selection offered by three lodging establishments located on Catalina Island, and one other provides a recipe for "granola" that again is offered as a menu item at "Campus by the Sea" on Catalina Island. There is nothing in these four excerpts that leads us to believe that purchasers of such granola will associate their choice of

breakfast with the geographic designation CATALINA ISLAND, much less with the origin of applicant's granola. They are more likely to associate the granola they consumed as a meal with the establishment that served it, and not the island on which the establishment is located. We are also not persuaded that the requisite goods/place relationship is established by the fifth, and last, excerpted article discussing Catalina Island. The article states that Catalina has two towns (the touristy but fun Avalon and the rustic granola-haven Two Harbors). Given the juxtaposition of the phrases "touristy but fun Avalon" and "rustic granola-haven" in the sentence, someone reading this article will likely perceive the term "granola" not as a breakfast cereal associated with Catalina Island, but as describing one town as being laid back and the other one as being fun. The perception is reinforced by the lack of any food processing, or manufacturing, facilities in Two Harbors or anywhere else on the island. This perception does not change because, as the examining attorney argues, "there is no intricate technology or highly specialized methods required to make granola." (Br. p.6).

A place does not have to be noted for a product to establish that a term is geographically descriptive. JT Tobacconist, 59 USPQ2d at 1084 ("There is no requirement...

that the state of Minnesota be noted for cigars and cigar products in order for a mark such as 'MINNESOTA CIGAR COMPANY' to be held primarily merely geographically descriptive."). However, in this case, not only do we not have any competent evidence that granola originates on CATALINA ISLAND, but we have specific evidence, in the form of applicant's declaration, that applicant's goods will not originate on CATALINA ISLAND. The notion that granola could be manufactured on CATALINA ISLAND is too speculative.

Last, to the extent that the examining attorney is arguing that a goods/place association exists in this case solely because applicant's goods will be sold on Catalina Island, we find such argument unpersuasive. CATALINA ISLAND itself would have to be associated with granola in such a way that the consuming public would be likely to assume that CATALINA ISLAND was the place in which the granola originates or is somehow connected. See *Gale Hayman*, 15 USPQ2d at 1478. We do not think potential sales alone create such an association. The situation at hand is different from that in *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) relied upon by the examining attorney. In that case, the Board found that the public would likely make a goods/place

association between perfume and RODEO DRIVE, since the public, having been exposed to articles reporting on "prestige" fragrances launched on Rodeo Drive and having frequented stores carrying fragrances of Rodeo Drive retailers, was likely to believe that perfumes bearing the name "Rodeo Drive" originated there, especially when Rodeo Drive retailers, in the promotion and marketing of their perfume, emphasized their association with Rodeo Drive. Herein, there is no evidence that there has been any promotion and/or marketing of the geographic designation "Catalina Island" in connection with granola such that consumers would readily associate granola sold under the mark CATALINA ISLAND GRANOLA with that geographic designation. Stated simply, the evidence of record does not show a reasonable basis for concluding that the public is likely to believe that CATALINA ISLAND identifies the place from which granola originates.⁵

In conclusion, because this record fails to establish that purchasers would make a goods/place association with respect to applicant's mark CATALINA ISLAND GRANOLA and

⁵ We add that the application is based on an intent to use. It is of course possible that applicant's specimens for the goods may demonstrate a connection with Catalina Island that is not apparent now.

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granola, we find that a prima facie case under Section 2(e)(2) has not been made.

Decision: The refusal to register is reversed.