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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Miracle Tuesday, LLC

Serial No. 77649391

Paul D. Supnik of the Law Offices of Paul D. Supnik for Miracle Tuesday, LLC.

Cynthia Sloan, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Bucher, Bergsman and Ritchie,  
Administrative Trademark Judges.

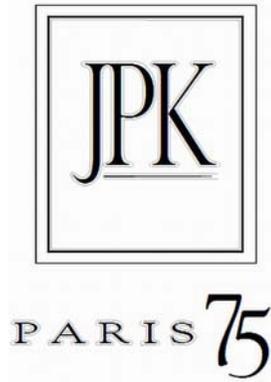
Opinion by Bergsman, Administrative Trademark Judge:

Miracle Tuesday, LLC ("applicant") has filed an intent-to-use application to register the mark JPK PARIS 75 and design, shown below, for the following goods:

Sunglasses, in Class 9;

Wallets, handbags and purses, travel bags, suitcases, in Class 18; and

Belts, shoes, in Class 25.



Applicant disclaimed the exclusive right to use "Paris."<sup>1</sup>

The trademark examining attorney refused registration on the ground that the mark is primarily geographically deceptively misdescriptive of the goods under Section 2(e)(3) of the Trademark Act.

A mark is primarily geographically deceptively misdescriptive of the goods if (1) the mark's primary significance is a generally known geographic location; (2) the relevant public would be likely to believe that the goods originate in the place named in the mark (*i.e.*, that a goods/place association exists) when in fact the goods do not come from that place; and (3) the misrepresentation is a material factor in the consumer's decision. *See In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003).

The facts in this case are not in dispute.

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<sup>1</sup> A disclaimer of geographic matter will not overcome a Section 2(e)(3) refusal. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1542 (Fed. Cir. 1999).

1. Paris is a well-known city in France;
2. Paris is well-known as a center of design and fashion;
3. Applicant is a limited liability company organized under the laws of Nevada and located in Miami, Florida;
4. Jean Pierre Klifa, applicant's Manager, is a citizen of France;<sup>2</sup>
5. Jean Pierre Klifa lived in Paris for 22 years until 1986 and now resides in the United States;<sup>3</sup>
6. Jean Pierre Klifa has "exhibited at the major Prêt à Porter trade show which is located in Paris. I have also exhibited at the Premier Classe accessory designers trade show also located in Paris. Being a French citizen facilitated my ability to participate in these trade shows;"<sup>4</sup> and
7. Jean Pierre Klifa is a handbag designer.<sup>5</sup>

A. Whether the primary significance of applicant's mark is a generally known geographic location?

Applicant argues that because the dominant portion of its mark is the monogram JPK, the primary significance of the mark when considered in its entirety is not a geographical location.<sup>6</sup>

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<sup>2</sup> Klifa Declaration ¶ 1.

<sup>3</sup> *Id.* at ¶¶ 2 and 3.

<sup>4</sup> *Id.* at ¶ 4. Applicant did not identify the goods which Jean Pierre Klifa exhibited at the Paris trade shows, nor did applicant identify the trademarks Mr. Klifa used to identify his products or the trade name under which Mr. Klifa exhibited his wares.

<sup>5</sup> *Id.* at ¶ 5.

<sup>6</sup> Applicant's Brief, p. 6.

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If, when viewed as a whole, a composite mark would not likely be perceived as identifying the geographic origin of the goods (i.e., the mark as a whole is not primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive), then the mark is regarded as arbitrary, fanciful, or suggestive. See *In re Sharky's Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) (PARIS BEACH CLUB, applied to T-shirts and sweatshirts, not deceptive under § 2(a), the Board reasoning that because Paris is not located on an ocean or lake, and does not have a beach, the juxtaposition of "Paris" with "Beach Club" results in an incongruous phrase which purchasers would view as a humorous mark, a take off on the fact that Paris is known for haute couture. Thus, purchasers would not expect T-shirts and sweatshirts to originate in the city of Paris). On the other hand, if a composite mark includes matter that identifies a geographic location, and consumers would likely perceive that the mark in its entirety indicates the geographic origin of the goods, then the mark may be considered geographically descriptive or geographically deceptively misdescriptive. See *In re Perry Manufacturing Co.*, 12 USPQ2d 1751, 1752 (TTAB 1989) (applicant's mark, as shown at right, is deceptive because



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purchasers seeing clothing bearing this mark would immediately assume that such clothing has a connection with New York either in its manufacture or its design); Cf. *Speech-Language-Hearing Assn. v. Nat'l Hearing Aid Soc.*, 224 USPQ 798, 808 (TTAB 1984) (Section 2(a) prohibits the registration of a mark that consists or comprises deceptive matter). In this case, we find that the designation "Paris" in applicant's mark serves to identify the geographic origin of the products and will not be regarded as an arbitrary, fanciful, or suggestive term; that is, consumers seeing applicant's products bearing applicant's mark will assume that such products have a connection with Paris either in their manufacture or their design.

B. Whether the relevant public would be likely to believe that applicant's goods originate in Paris (i.e., that a goods/place association exists) when in fact the goods do not come from Paris?

The evidence submitted by the examining attorney establishes, and applicant does not dispute, that Paris is a center of design and fashion.<sup>7</sup> While applicant is not located in Paris, in fact, its primary place of business is in Miami, Florida, applicant asserts that its connection with Paris is substantial because Jean Pierre Klifa, applicant's Manager and designer, is Parisian.

[T]he context and the meaning that the consumer is likely to perceive when they

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<sup>7</sup> Applicant's Brief, p. 4 ("Applicant does not take issue with the well known concept that Paris is associated with fashion").

purchase JPK handbags is that the designer "JPK" has some connection with Paris. This is a true statement made to the consumer because in fact I am a French citizen and I spent some 23 years living in Paris, four of those years having an office in Paris and have exhibited at trade shows in Paris. Thus the association and connotation in the consumer's (sic) mind when they purchase handbags with the mark, and Paris even if it has a place-goods association, is not a deceptive or misdescriptive representation but in fact it is a truthful statement to the consumer.<sup>8</sup>

In other words, because the creative force behind applicant's products lived and worked in Paris for 23 years, the Board should consider the design of applicant's products as having originated in Paris. We disagree, because the current connection between applicant and Paris on this record is too tenuous to avoid the prohibition under Section 2(e)(3). In this case, applicant is located in Miami, applicant's designer is presumably located in Miami, but not in Paris (otherwise Jean Pierre Klifa would have said he currently lives and works in Paris), and applicant's products are currently designed and produced somewhere other than Paris (otherwise applicant would have presented evidence that its products are designed and manufactured in Paris). Although Mr. Klifa may still consider himself to be Parisian, the goods that applicant seeks to register are not because there is no current connection between the goods and Paris. See *K-Swiss Inc. v. Swiss Army Brands*,

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<sup>8</sup> Klifa Declaration, ¶ 6.

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*Inc.*, 58 USPQ2d 1540, 1542-1543 (TTAB 2001) ("a registration more than five years old can be cancelled on the ground of geographic deceptiveness if a registrant, through its own actions, causes its mark to become geographically deceptive subsequent to the issuance of the registration").

Accordingly, we find that the relevant public would likely believe that applicant's products offered under the mark JPK PARIS 75 and design come from Paris (*i.e.*, that a goods/place association exists) when in fact the goods will not come from that place. *See California Innovations*, 66 USPQ2d at 1857 (noting the "relatively easy burden of showing a naked goods-place association.").

C. Whether the misrepresentation is a material factor in the consumer's decision?

"[I]n order to establish a prima facie case of materiality there must be some indication that a substantial portion of the relevant consumers would be materially influenced in the decision to purchase the product or service by the geographic meaning of the mark." *In re Spirits International N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009) (finding that the materiality test of Section 2(e)(3) embodies a requirement that a "substantial portion" of the relevant consumers is likely to be deceived).

As indicated above, the evidence submitted by the examining attorney establishes that Paris is a recognized center of design

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and fashion. Because we have determined that the primary significance of Paris to the relevant public is the geographic place, and in view of the renown and reputation of fashion designs originating in Paris, we may infer that at least a substantial portion of consumers who encounter applicant's mark featuring the word "Paris" on applicant's products are likely to be deceived into believing that those products come from or were designed in Paris. *Cf., for example, In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1339, 67 USPQ2d 1475, 1478 (Fed. Cir. 2003) ("dictionary evidence alone can be sufficient to satisfy the PTO's burden" of showing that "a substantial composite of the general public considers a word scandalous."); *see also California Innovations*, 66 USPQ2d at 1857, *citing In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 n.6 (Fed. Cir. 1985); and *In re House of Windsor*, 221 USPQ 53, 56-57 (TTAB 1983); finding, respectively, that materiality may be inferred from a showing that the goods are "a principal product" of the place named in the mark, that the place is "noted for" the goods, or that the goods are, or are related to, the "traditional" products of the place named in the mark.

In this regard, we recently held that the burden on the PTO is to show that there is a reasonable predicate for the conclusion that the geographic indicator in the mark would be a

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material factor in the purchasing decision. *In re Jonathan Drew, Inc. d/b/a Drew Estate*, \_\_\_ USPQ2d \_\_\_, Serial No. 77099522 (TTAB 2011), quoting *In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003). In the present case, the evidence is sufficient to establish a reasonable predicate that a substantial portion of relevant consumers would understand that the reference to Paris in applicant's mark refers to Paris, France, and thus we may infer from the evidence showing that Paris is a famous center for design and fashion, that a substantial portion of relevant consumers would be deceived. See *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) ("[f]or goods, the PTO may raise an inference in favor of materiality with evidence that the place is famous as a source of the goods at issue.").

**Decision:** In view of the foregoing, we find that applicant's mark JPK PARIS 75 and design is primarily geographically deceptively misdescriptive as applied to applicant's goods.

The refusal to register under Section 2(e)(3) is affirmed.