

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
June 14, 2007

Mailed:
December 17, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vanity Fair, Inc.

Serial No. 78515219

Edward M. Prince of Alston & Bird LLP, for Vanity Fair, Inc.

Richard A. Straser, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Walters, Walsh, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Vanity Fair, Inc. has filed an application to register the mark FRENCH & FLIRTY (in standard character form) on the Principal Register for "lingerie, sleepwear and hosiery" in International Class 25.¹ In the application, applicant claimed ownership of a prior

¹ Application Serial No. 78515219, filed November 11, 2004, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intent to use the mark in commerce.

registration for the mark FRENCH FLIRTS for "brassieres, panties, slips and camisoles."²

The trademark examining attorney ultimately refused registration of applicant's mark on the grounds that it is deceptive under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), and that it is primarily geographically deceptively misdescriptive under Trademark Act Section 2(e)(3), 15 U.S.C. § 1052(e)(3).³ A request for reconsideration of the final refusal was denied and this appeal was filed.

Applicant and the trademark examining attorney have filed main appeal briefs. An oral hearing was held on June 14, 2007. After careful consideration of the evidence of record and the arguments put forth, we affirm the Section 2(e)(3) refusal to register.

Initially we note that, because applicant's mark involves an

² Registration No. 1433981 issued March 24, 1987, with a disclaimer of the term FRENCH. Sections 8 and 15 affidavits acknowledged and accepted. We do not hesitate to state that while uniform treatment under the Trademark Act is an administrative goal, our decision herein is based on the record before us, and each case must be decided on its own merits. See, e.g., *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001). Neither the current examining attorney nor the Board is bound by the prior action of the examining attorney who examined applicant's earlier-filed application which resulted in the registration of record. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

³ The application's prosecution history has been somewhat puzzling to say the least. The application was approved for publication on three occasions and, each time, said approval was withdrawn. At one point, the examining attorney required a disclaimer of the term FRENCH but did not substantively refuse registration of the mark. Applicant provided the disclaimer, but the examining attorney then issued an Office Action refusing registration on grounds cited in this order and stated that the disclaimer "should be cancelled."

allegedly deceptive geographic designation, the pertinent ground for refusal in this case is that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3), and not that the mark is deceptive under Section 2(a). See *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007).

The elements of a Section 2(e)(3) refusal are as follows: (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 (i.e., that a goods-place association exists), 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. *California Innovations, supra*, 329 F.3d at 1341, 66 USPQ2d at 1858.

Turning to the first factor, we find that the most commonly understood connotation of the word "French" is geographic. Indeed, the definitions of record offered by both applicant and the examining attorney provide a primary meaning of the term "French," as an adjective, as: "of, relating to, or characteristic of France, its people, or their language."⁴ Certainly, the country of France is well

⁴ *Webster's New Collegiate Dictionary* (no publication date or edition information provided), cited by the examining attorney in the September 30,

known and the term does not refer to an obscure or remote geographic place. And, it is this definition that the examining attorney relies on in arguing that the primary significance of the mark FRENCH & FLIRTY is as a generally known geographic location.

Applicant essentially argues that, depending on the context, the word "French" may have a variety of meanings, including serving as a euphemism for "sexy"; that "obviously, 'sexy' is the euphemism in this case"; that "the primary significance of FRENCH & FLIRTY is a reference to stylish, sexy or sassy"; and therefore, the mark has "no geographic significance, much less a geographically deceptive significance." (Applicant's Brief, p. 8-10).

In support of its contention that the term "French" is a euphemism for "sexy," applicant submitted the following entry from the Wikipedia internet information website:⁵

2006 Office Action. The primary definition of the term "French" submitted by applicant is as follows: "of or pertaining to the country of France in Western Europe, its Romance language, or its people" (from *The New Shorter Oxford English Dictionary on Historical Principles* (Clarendon Press, Oxford)).

⁵ In a recent Board decision involving internet evidence, specifically Wikipedia entries, we held that such evidence will be considered "so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information." See *In re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007). Here, applicant submitted the Wikipedia entry with its request for reconsideration thus giving the examining attorney an opportunity to rebut or question the accuracy of the entry. We have therefore given consideration to the Wikipedia entry, but with "the recognition of the limitations inherent with Wikipedia (e.g., that anyone can edit it and submit intentionally false or erroneous information)." *Id.* at 1032.

French (euphemism)

From Wikipedia, the free encyclopedia

For many centuries there has been a rivalry between the French and the English resulting from the way that their histories have interacted from the Battle of Hastings, to Crecy and Agincourt, through Napoleon, Trafalgar, World War II to the Olympic games in 2012.

As a result the word "French" in English (primarily as used by native speakers in the UK and surprisingly often in the US as well) is often used to derogatively describe anything which is to be thought of as stinky, over-stated or rated, as well those things that are illegal, immoral or just generally undesirable; the French respond by often using *anglais* in similar senses. Thus we see:

- French - a racial stereotype of one who is either sexy or dirty

[Exhibit A, Request for Reconsideration]

Applicant also submitted a secondary definition entry of the term "French" in *The New Oxford English Dictionary on Historical Principles* (Clarendon Press, Oxford).⁶ This definition entry provides: "2. Having a quality or qualities attributed to French things, esp. (a) refinement, (b) impropriety."

Applicant otherwise puts forth several reasons why it believes "French" connotes "sexy" in the context of its mark. First, applicant makes reference to the examining attorney's internet evidence displaying advertisements for "French lingerie" and argues that the "sexy nature of the goods was emphasized by picture and written description." (Applicant's Brief, p. 9). Applicant also submitted a copy of a website printout of an advertisement for "French Lingerie Lip Balm" with "all natural ingredients in three sexy flavors." (Request for Reconsideration, Exhibit C). Third, applicant argues the additional word in the mark, "flirty," has no

geographic significance and "it only makes sense when one attributes [the "sexy"] meaning to the word "French." (Applicant's Brief, p. 10).

Viewing the mark as a whole, as we must, and in connection with the identified goods, we are not persuaded that purchasers of lingerie would perceive the mark FRENCH & FLIRTY as having any meaning other than geographic significance.⁷ While we acknowledge that the other word in the mark, "flirty," has no geographic significance and may, itself, suggest sexually flirtatious behavior, the addition of this word does not negate the geographic significance of FRENCH or of applicant's mark as a whole. Instead, we agree with the examining attorney that the overall commercial impression created by the mark FRENCH & FLIRTY is more along the lines of "French origin

⁶ No information was provided as to the date of publication of the dictionary or the edition referenced.

⁷ Most, if not all, of the evidence and arguments presented by the examining attorney pertain to lingerie and the other goods identified in the application, i.e., sleepwear and hosiery, are essentially ignored. Indeed, applicant makes this point in its brief. Therefore, we address only the lingerie goods in our analysis of whether the mark is primarily geographically deceptively misdescriptive; we are not making any determination with respect to sleepwear and hosiery. Nonetheless, we note that is unnecessary for the examining attorney to establish that the mark should be refused registration based on all of the identified goods in the application. So long as the refusal of registration under Section 2(e)(3) is proper as to lingerie, the application may be refused registration as to sleepwear and hosiery because they are in the same class. *Cf. In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975) (if mark is merely descriptive of any of the goods in a particular class, refusal as to all of the identified goods in that class is proper). *Accord, In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505 (CCPA 1980); *In re Harry N. Abrams, Inc.*, 223 USPQ 832 (TTAB 1984).

and playful.”

The evidence of record demonstrates use of the word “French” in a geographic manner in connection with lingerie. This is exemplified in the following Nexis excerpts that were attached by the examining attorney to his final Office Action⁸:

...Vanity Fair, Triumph and Lovable have jumped into the market with considerable success. Textile manufacturer Gokaldas Images has tied up with a **French lingerie** company to produce and market Enamor, a brand exclusively for the Indian market. Nonetheless, 70 per cent of the lingerie...

[Financial Times Information, September 5, 2006]

...doubled to 3.6 mln sfr, from 1.4 mln, driven by a sharp increase in sales following inclusion of **French luxury lingerie** producer Aubade for the first time.

[AFX News Limited, July 27, 2006]

Kristine Cole, owner of Remembrance, a lingerie shop in Hanover, N.H., said, "**Lingerie** Americas and the **French** brands have become an important part of my business, which continues to provide more than basics for my customers. Wacoal is...

[Gale Group, Inc., August 14, 2006]

A plan to shed 450 jobs at Dim, the **French lingerie** company, without making any staff unemployed has the support of the CGT, FO, CFDT, CFE-CGC and Unsa unions, Unsa ...

[Financial Times Information, August 1, 2006]

⁸ The **bold** lettering was supplied by the examining attorney in his submission of evidence for purposes of highlighting key words.

...US\$53.2 million). Groupe Chantelle SA was set up in 1996 and operates a network of 64 **lingerie** stores across **France**. Groupe Chantelle SA is renowned for the Chantelle, Passionata and Darjeeling brands. In 2005, Groupe Chantelle SA generated...

[Mergerstat Review, July 18, 2006]

Applicant, on the other hand, has not demonstrated any third party use where we may find the word "French" being used as a euphemism or otherwise synonymous with or connoting "sexy." Applicant's reliance on the "French lingerie Lip Balm" advertisement is misplaced because there is no indication that the term "French" is being used in a non-geographic manner to create any sexual suggestiveness of the lip balm.

We would also be remiss if we did not acknowledge that lingerie, by definition⁹ and its very nature, may be considered as "sexy" or "sexually enticing." Thus, the fact that several of the Internet lingerie advertisements submitted by the examining attorney are sexually suggestive, as noted by applicant, appears to be normal for such goods. We disagree with applicant to the extent that it argues the sexually suggestive nature of advertisements somehow changes or gives new meaning to the word "French." All lingerie, whether it's

⁹ Defined as "women's intimate apparel," *Merriam-Webster's Collegiate Dictionary* (Eleventh Edition). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Italian, American or French, may be considered sexually enticing.

Likewise, applicant's argument that "French" is being used euphemistically in the mark to connote "sexy" is not persuasive or well supported. First, the references relied on by applicant indicate that this connotation appears to be generally limited to native speakers in the United Kingdom. The New Shorter Oxford English Dictionary on Historical Principles, where applicant finds the secondary dictionary definition of "impropriety," is published in the United Kingdom and we take judicial notice there is no similar alternative definition entry found in two prominent American dictionaries.¹⁰ And, as noted in the Wikipedia entry itself, the euphemistic use of the term "French" to connote "sexy or dirty" derives from a rivalry between the people of France and England.

In view thereof, we are not convinced that purchasers in the United States, upon viewing the mark in connection with the goods would perceive the word "French" in the manner suggested by applicant. Instead, we find that the word FRENCH in applicant's mark

¹⁰ The Board takes judicial notice of references in *The American Heritage Dictionary of the English Language* (Fourth Edition copyright 2000) and *Merriam-Webster's Collegiate Dictionary* (Eleventh Edition). The former provides the following definition:

ADJECTIVE: **1.** Of, relating to, or characteristic of France or its people or culture. **2.** Of or relating to the French language.

The latter provides:

would be directly and immediately perceived by purchasers in its primary geographic sense, namely, "of, relating to, or characteristic of France."

Accordingly, the first element under Section 2(e)(3) has been met and we find that the primary significance of the mark, FRENCH & FLIRTY, is a reference to a generally known geographic location. Again, even though the other element of the mark, "flirty," has no geographic significance, it does not detract from or obviate the overall geographic connotation created by the word "French."

The second element of the Section 2(e)(3) refusal requires a showing that the consuming public is likely to believe that the place identified by the mark indicates the origin of the goods bearing the mark (i.e., that a goods-place association exists), when in fact the goods do not come from that place.

The examining attorney has asserted on numerous occasions in Office Actions and in his brief that applicant's goods do not come from France but instead emanate from Delaware. Applicant, a Delaware corporation, has not denied this assertion and the issue is not raised in applicant's appeal brief. Therefore, the question for determination under the second element of the Section 2(e)(3) refusal in this case is whether consumers are likely to believe that France

ADJECTIVE: 1 : of, relating to, or characteristic of France, its people, or their language 2 : of or relating to the

is the origin of applicant's goods. We find that the requisite goods-place association has been established by the evidence of record.

"In a case involving goods, the goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product." *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1373-74, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003). The evidence of record in this case clearly establishes that consumers would identify France as a known source for at least some of the goods identified in applicant's application, lingerie.

In addition to the Nexis article excerpts already identified above, the examining attorney has provided an article entitled "Shopper's World: In Paris, Lace and Luxe" [dated January 21, 1990] published in the New York Times. In this article, the writer discusses several high-end boutiques in Paris selling lingerie and other intimate apparel. The following are excerpts from the article:

For many women, **French lingerie** is the ultimate in beautiful underwear. Feminine but rarely frilly, **French lingerie** differs in style from Italian, which is more elaborate. **French lingerie**, on the other hand, blurs the distinction between can-can and muse, femme fatale and woman on a pedestal. Yet it is actually quite understated, its style more dependent on superb fabrics and workmanship than adornment. As Miss Cadolle is fond of saying, "Good taste is enough."

The lingerie departments at Au Printemps and Galeries Lafayette offer enormous variety at all prices. At Galeries Lafayette,

overseas descendants of the French people.

you'll find beautiful paisley, polka-dot and floral silk bras, bustiers and panties by Jeune Europe, a 16-year-old Lyons company whose signature is bold patterns (bras for about \$140, panties about the same; bustiers from \$250 to \$700). There are ruby velours bodysuits by Scandale, as well as matching bras and panties with panels of red and black silk (most items under \$100). Au Printemps carries Pascale Madonna, known for full-cut panties in spotted damask with buttons down the front (briefs around \$100, bras about \$150).

Christian Dior lingerie can be found throughout Paris but it isn't the same Dior underwear in American department stores. The French product, for example, is predominantly silk, compared with only 10 to 15 percent of the Dior lingerie produced for the American market by Carole Hochman, a New York manufacturer, under a licensing agreement. For the French Dior, you have to go to Paris.

[Underlines, as emphasis, supplied]

The New York Times article also contains several comments from purchasers or those involved in the industry testifying to the higher quality of European lingerie and expensive nature of such goods.

The following article excerpt of record further establishes that there are retail stores that feature expensive or luxury French lingerie:

...fashion, accessory and gift retailer formerly located in The Woodlands Mall; Dolce Bella, a luxury boutique offering **French** and Italian **lingerie** lines; and The Woodlands Home Theater. The announcement of these new retail leases follows the recent openings of Houston's first Lilly Pulitzer...

[Houston Business Journal, July 24, 2006]

Based on the evidence of record, we find that France is associated with lingerie, and that the requisite goods-place association for these goods therefore exists.

Applicant argues that there is no goods-place association because the "realities of the marketplace" are such that "the idea that a purchaser will buy applicant's lingerie because the goods are thought to originate in France is not believable." Applicant posits "[I]t is not the geographic origin of the goods that is significant; rather it is the look and feel of the lingerie that is significant." Applicant also argues that if a purchaser has any question as to the origin of the goods, there are "country-of-origin" tags on the goods. (Applicant's Brief, p. 10-11).

The evidence of record and caselaw do not support applicant's arguments. To the contrary, the evidence demonstrates that lingerie is specifically touted as being from France or as "French lingerie." In addition to the article excerpts already identified, the examining attorney made of record third-party Internet websites advertising "French lingerie" for sale. (Attached to Office Action dated September 23, 2005). One website, "Pampered Passions," has a "French Lingerie" category of goods. Other categories (with links thereto) are: "Fine lingerie", "Italian Lingerie", "Wedding lingerie", etc..

Another retail website, "Azzuma, Fine Imported Lingerie", encourages potential customers to "[p]amper yourself in luxurious French lingerie. Experience the elegance and distinctive beauty of our designer collections." The website identifies many collections of lingerie that it sells, several of which say "of Paris" or simply

contain the capital of France at the bottom of the collection name.

The advertisements, and the previous article excerpts, show that customers actually are accustomed to seeing lingerie advertised as coming from France. The fact that lingerie is categorized on the website as coming from France (or Italy) suggests that customers may specifically seek such goods because they originate from France (or Italy). Thus applicant's argument that it is the "look and feel of the lingerie that is significant" is not only contradicted by the examining attorney's evidence, but similar arguments that a geographic term creates a "look and feel" or "ambience" have previously been rejected by the Board and our principal reviewing court. See *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK in NEW YORK WAYS GALLERY mark denotes geographic location, not a hypothetical "New York Style" of the goods at issue); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA in various marks denotes geographic location, not hypothetical "free-wheeling lifestyle" of pre-Castro Cuba).

Likewise, the Board has previously rejected the argument that "country of origin" labels on clothing may somehow obviate a geographically deceptive mark. See *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992) ("fact that clothing may include labels specifying country of origin does not alter finding that mark is geographically deceptive").

Based on the evidence of record, and for the reasons discussed above, we find that France is associated with and is a known source of lingerie, and that a goods-place association therefore exists as between lingerie and France. Because applicant's lingerie does not originate from France, the second element of the Section 2(e)(3) refusal is established.

The third and final element of the Section 2(e)(3) refusal requires a showing that the misrepresentation as to the geographic origin of applicant's goods which is created by applicant's mark (i.e., that the goods would be believed to come from France, when they do not) would be material to the consumer's decision to purchase the goods. We find that the evidence of record in this case, much of which has already been highlighted or discussed, establishes the materiality element of the refusal.

"For 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." *In re Les Halles De Paris J.V.*, *supra*, 334 F.3d at 1374, 67 USPQ2d at 1542. The evidence of record in this case establishes that France is associated with lingerie.

The evidence of record establishes that the materiality to the purchasing decision of French lingerie is not only based on France being touted as a source of lingerie, but the materiality in the decision is further established by the evidence of record showing

that French lingerie is carried in "luxury" or "boutique" retail establishments and, thus, is presumably thought to be of a higher quality. For these reasons, lingerie from France may be considered by purchasers to be more desirable, i.e., the fact of its origin is material to the purchasing decision.

For these reasons, we find that the third element of the Section 2(e)(3) refusal, materiality, is established in this case.

Based on all of the evidence of record¹¹ and for the reasons discussed above, we find that applicant's mark is primarily geographically deceptively misdescriptive, at least as applied to the lingerie, and that the Section 2(e)(3) refusal therefore is proper.

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

¹¹ Though we have not specifically discussed all of the evidence submitted by applicant, we have carefully considered it in determining that applicant's mark is primarily geographically deceptively misdescriptive.