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

Proceeding	78598734
Applicant	PARIS CROISSANT CO., LTD.
Applied for Mark	PARIS BAGUETTE
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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of

PARIS CROISSANT CO., LTD. Examining Attorney

ZAK, HENRY S

S. N. 78/598,734 Law Office: 117

Filed: March 30, 2005 Ex Parte Appeal

For: PARIS BAGUETTE & design (class 30)

APPLICANT'S APPEAL BRIEF

This is the appeal brief for the above-referenced matter. Applicant respectfully requests that the Examining Attorney's refusal to register be reversed in view of the responses previously filed and the below noted points.

APPLICANT'S MARK IS NOT GEOGRAPHICALLY DECEPTIVE AND IS NOT PRIMARILY GEOGRAPHICALLY MISDESCRIPTIVE

"To ensure a showing of deceptiveness ... the PTO may not deny registration [under section 2(e)(3)] without a showing that the goods-place association made by the

consumer is material to the consumer's decision to purchase those goods." See In re California Innovations, Inc., 66 USPQ2d 1853 (Fed. Cir. 2003) at 1854.

Applicant respectfully submits here that the Examining Attorney has not made a sufficient showing that a goods-place association would be material to the consumer's decision to purchase the goods.

In view of this, it is respectfully submitted that the rejection of the application should not stand and applicant should be granted an allowance of the application.

The Examining Attorney's rejections and internet literature searches seem to be rejecting registration of French bread or French baguette.

Nowhere does the term "Paris Baguette" appear in the searches of the rejection, let alone together with applicant's design component.

Further, applicant does not merely attempt to register the words "paris baguette", but also includes a distinctive graphic design element of a stylized Eiffel tower and a rectangular blue background field in which the other elements (the words and the tower design) are set. These further make the mark more distinctive than the mere words themselves would be, and, in the applicant's opinion, take

away from the conclusion that the mark is primarily geographically misdescriptive or geographically deceptive.

Considering the Office Action attached search evidence in the response to the request for reconsideration, discussing the delivery of breads from France, to counter act applicant's argument that consumers would expect breads to be made locally, it is noted that many of the testimonials of quick delivery of bread from Lebanon are not from consumers in the US. They are from consumers in other countries, such as Italy (p 54) United Arab Emirites (UAE), Italy, Switzerland p 57, UK, Cyprus (p 60 noting that the bread was damaged because of the packaging method used) Japan (p64).

It is respectfully submitted that testimonials from consumers in other countries regarding products from Lebanon do not support any finding that US consumers would make a goods-place association that is material to the consumer's decision to purchase applicant's goods and that consumers would consider applicant's goods to be from Paris.

Of the testimonials that appear to be from US based consumers related to the Lebanon bread purchase sites, some do refer to purchase of bread from Lebanon, but many others are for non-bread purchases. Applicant's representative counted 9 entries mentioning bread from US consumers (p58,

62, 63, 63, 63, 64, 65, 65, 65). One consumer (page 65) states "I just wished it were a bit more affordable so I could order it weekly, but I will reorder from time to time." Many of the remaining US testimonials that do mention what kinds of goods were purchases are not for bread but for other goods ("nuts" p54 ; baklava p 54; sweets p 54; thyme, coffee, watermelon seeds, soap p 55; cds p 55; CDs and baklava (a dessert); meat spice, thyme and sweets p 56; mezze plates; hazelnuts; CDs and coffee; shawarma spices; Maarmoul, baklawa, nuts and malban; flowers (p59 of office action); cds p 60; flowers p60 ; baklava p60-61;coffee and sweets p61; "petits fours" p61; kaak p61; sweets, baklava p61; rose sryup p 62; arguileh (a water pipe), za'atar (a spice) p 62; coffee, sweets, fig jam p63; baklava p 63; mulberry syrup and sweets p 64, coffee p 64; arak (a distilled beverage) p 65; dates p 65; arak, olive oil, zaatar p 65) or for non-specified goods.

It is respectfully submitted that testimonials of persons buying food goods from Lebanon do not prove that consumers in the US would be mislead and would consider the geographic indication material to the purchase of the goods and does not show that it would be material to purchasers of applicant's goods with the PARIS BAGUETTE and design mark of applicant's.

Breads could be manufactured in France and shipped to this country. But it is respectfully submitted that no evidence has proved that consumers would expect this to be the norm and has not proved that therefore consumers would be mislead and that it would be material to their purchase of the goods from applicant.

In fact, as noted, the comment that says the person wishes that they could buy this bread weekly, but it is expensive to have it shipped overnight from overseas, shows that such overseas overnight purchases are exotic purchase made by discerning consumers at high cost.

Page 8 of the office action of November 1, 2005, prints submitted with the action, notes that, in discussing what a baguette is, that "baguettes can be found everywhere in France, and now, (theoretically) anywhere in the world". It is respectfully submitted that this shows that the term baguette cannot be attributed to have exclusive association and meaning related to France or Paris - it is a world wide available item. It is respectfully submitted that this would therefore indicate that there is not misrepresentation or deception and even if there were, consumers have become so accustomed to finding baguettes anywhere in the world, that they do not and would not presume that they would come from France. Indeed, to get a

baguette from France, it seems, from the evidence submitted by the Examining Attorney, that one would have to take special steps to order and pay for express shipping at high cost, for something that is stated to be "available anywhere in the world". This is respectfully submitted to show that consumers would not expect that applicant's goods are coming from France and the goods-place association made by the consumer would not be material to the consumer's decision to purchase the applicant's goods.

The Examiner relies on Wikipedia to support the position that "Baguettes are seen as closely connected to France and especially to Paris . . "

Applicant respectfully submits that relying on Wikipedia information as evidence can be problematic, since the information therein has be editable by practically anyone wishing to modify the information can do so (for an unprotected page) and, on check today of the page cited by the Examiner, applicant's representative notes that the page is not protected and is freely editable. It is noted that in In Re White, 80 USPQ2d 1654 (TTAB 2006), footnote 3, the Board notes that " the examining attorney submitted an excerpt from the "Wikipedia" website concerning the "Mohawk" hair style. However, we have not relied on this excerpt in reaching our conclusion", which seems to suggest,

at least to the undersigned, that the Board might have had some concern in that case regarding whether Wikipedia could be relied on for basis of a decision.

However, if the Wikipedia entry is to be relied on, it is noted that that the Wikipedia source also notes that baguettes are "available around the world". If baguettes are available around the world (as is noted in another source cited by the Examiner, and referred to above in applicant's brief), then it is submitted that they cannot be said to indicate a source of France.

Applicant submitted evidence in the response to office action and request for reconsideration that consumers in the US would not expect that bread purchased here would have come from Paris. The Examiner cited back websites to show that one can order bread from France for delivery overnight to the US.

Applicant would request that the Board consider this foreign (France) website evidence as being from a foreign publication, as noted in the TTAB manual of procedure, Chapters 1200, section 1208.01, where it is noted that:

> Accordingly, stories from newswires or foreign publications are of minimal evidentiary value because it is not clear that such stories have appeared in any publication available to the consuming public. Wire service stories are competent to show how their authors

> used particular terms, but since they are circulated primarily to newspapers, they are not assumed to have influenced the attitudes of prospective customers.

It is respectfully requested then that the Examining Attorney's use of these foreign websites to attempt to show that US consumers would think bread goods purchased in this country came from France, not be given any significant weight in view of the noted TBMP section.

Applicant has argued previously in the request for reconsideration that consumers would not expect or think that bread they bought in the U.S. would come from France or Paris. Bread is typically baked relatively locally and sold as soon as possible after baking, so as to not be stale.

Consider evidence file number 1 attached in the request for reconsideration, a print of web page http://asymptomatic.net/2005/10/21/2055/america-has-no-bread. The underlined emphasis was been added to note the portion of interest. (underlines added do not appear in the original) The web page described a person who bought bread on the way to the airport in France to bring home for friends to try, noting that "the bread was probably a little stale" by the time the author's friends back in the U.S. got to taste it.

This website print was presented to support applicant's position that consumers would not think bread they purchased in the U.S. would have come from France, because, it would be stale by the time it would arrive here and reached market.

Bread is baked locally. Consumers expect and understand this to be the case. Despite modern transportation and distribution methods that enable people to enjoy foods from all over the world, certain basic foodstuffs must still be produced locally. Bread products are one of such products.

Thus, bread is produced locally, and consumers expect and understand this, and for that reason, would not consider bread having geographic names, to be produced in those geographic regions. Indeed, "french bread" is commonly consumed in the U.S., and consumers do not think that it came from France. They know and understand that it is baked locally and that the term french bread merely refers to a style of bread, not to the country of origin.

Similarly, applicant respectfully submits that baguette in connection with bread refers to a style of bread, not a geographic source of bread. Baguette loaves are generally long and rod-like. Baguette in French

translates as "rod" or "stick", referring to the general shape of a baguette loaf. .

Purchasers would not be likely to believe that applicant's goods originate in Paris, France. Purchasers know and understand that breads are baked locally and that non-local breads would more likely be stale and undesirable.

The Examining Attorney has indicated that Paris is renowned for its bakery goods. The applicant submits, however, that Paris is no more renowned for these goods than any other large cosmopolitan city like New York, Chicago, Toronto, London, or Rome.

Applicant's use of the term "PARIS" in its trademark will not be seen as primarily a location indicator but rather more of a suggestion of the ambiance associated with this location.

The applicant is trying to suggest the "feel of Paris" with its mark, not that the goods come from that location. The applicant, has enlisted the aid from French confectioners who are being permanently stationed at our applicant's stores. Applicant chose the popular French city as the name of its operations and this name has also become part of its marks under which its goods are sold and its franchising, restaurant and retail services are offered.

The applicant has numerous bakeries/shops in Korea and elsewhere through the world and has chosen this mark to offer its fresh bakery cakes, cookies, pastries, and other specialty foods products, and services, to suggest the quality and feeling of this area, NOT to promote the idea the goods/services are from Paris.

The analysis of the factors from In re California Innovations ((1) whether the mark is primarily geographical in nature; whether (2) the goods do not originate in the place identified in the mark, whether (3) the public is likely to believe the goods/services originate in the geographical place; and whether (4) the fact that the goods do not originate there would be material to the purchaser.

Looking at the first prong, the applicant's mark does have "PARIS," a geographical city but the mark also contains another term "BAGUETTE." While this term may be descriptive of a type of bread the applicant may offer, the applicant is offering other unrelated products. The applicant's mark also contains a design. While there is a representation of the Eiffel Tower, the entire mark is enclosed in a blue rectangle.

The fact that a mark contains a well known geographical term does not automatically render the mark unregistrable. The mark must be considered in light of the

goods on which it is used and also the view the relevant purchasing public would have upon seeing it.

As noted above, the applicant does not believe Paris is anymore known for its bakery goods than any other large city. The applicant understands that the country of France is known for a style of cooking (French) and general culinary superiority. While this style of cooking/baking may be found in Paris, France, use of the term" PARIS" does not describe it. It may at most suggest it.

A look at the words "PARIS", "FRANCE" and "FRENCH" in a dictionary supports the applicant's position. In the Webster's Third New International Dictionary Unabridged, 1981, the term French has several meanings, three of which relate to food. French is defined as "to prepare in a French manner" and "to cut (snap beans) in strips lengthwise before cooking" and "to cut off the strip of meat along the bone of (a rib chop)" and "to prepare meat for cooking by slicing it into strips and pounding". Also, there are numerous terms paired with "french" referring to food such as french bean, french bread, french chop, french doughnut, french dressing, french drip, french endive, french fry, french ice cream, french pastry, french roast and french roll.

In the same unabridged dictionary, the term "Paris" has no definition of use as food, nor is the word "Paris" paired with any terms to refer to a food. Paris Baguette does not appear in the dictionary.

Furthermore, the mark must be viewed as a whole and the applicant's mark contains another term and a design which make its mark not primarily geographically descriptive/misdescriptive or deceptive. The term "baguette" means long loaf of bread. "Baguette" has nothing to do with the other food products. Moreover, the addition of a fanciful drawing of the Eiffel tower with the entire mark enclosed in a blue rectangle further takes it out of the realm of being primarily geographically misdescriptive or geographically deceptive. The applicant respectfully submits its mark is not primarily geographic in nature.

Regarding the second prong, applicant's goods do not come from Paris.

Looking at the 3rd and 4th prong of the test, the applicant maintains there is no danger nor likelihood the purchasing public would ever realistically believe its goods and services originated in Paris. The applicant is using its mark on various food products, and acknowledges bread is one of the products. Use of PARIS BAGUETTE and

design for these goods and services will not deceive the public.

Even if Paris may be known for baked goods, the public would not realistically believe Paris, France was the source of a fresh loaf of bread, cake or pastry sold at a coffee shop in the United States. As noted before, it would be cost prohibitive to have fresh bread flown in from Paris to be sold at a local bakery/coffee shop. Applicant submits that purchasers would not reasonably believe the goods it offers originated in Paris, France. With respect to the 4th prong of the analysis, the fact the applicant's goods/services do not originate in Paris would not be material to the purchaser. To support the rejection, the public must be deceived by the mark, reasonably (but wrongly) thinking the goods came from Paris. The Court stated:

Applicant in this case submits that purchasers would not be deceived into thinking bread goods bearing the mark PARIS BAGUETTE and design actually came from Paris, France. While the applicant's mark contains the term PARIS, because of the design and other term in the mark, and because of the nature of the goods, purchasers would not reasonably ever believe these goods originated in Paris, France any more than they would believe a bagel purchased from "New

York Deli" in Detroit was flown in from New York City. It is the feeling or suggestion of Paris that is conveyed in this mark - not the fact that the goods come from that location.

The applicant believes it has clearly demonstrated why its mark is not primarily geographically misdescriptive nor geographically deceptive. In the reality of the marketplace, these goods would not be associated with Paris, France in such a manner as to deceive the public.

Applicant's mark has been allowed in class 32 (S.N. 78598737) and class 43 (78598739) already and believes this should lend support to allowance in this present application.

Finally, the applicant's mark has been registered by the Trademark Offices of France, Japan and Korea, for goods including bread. Since the US is a signatory to some of the same treaties related to trademarks as Japan, France and Korea, it is believed the US should give some weight to the foreign registrations as evidence that the mark is not geographically deceptive and is not primarily geographically misdescriptive.

Attached Evidence Appendices

Applicant attaches copies of the French and Japanese registrations. Note on page 2 of the Japanese registration (class 30) the term "パン" appears. This is katakana (Japanese writing characters) that transliterates to "pan" which means "bread" in Japanese.

The French registration includes "pain" in the goods description, French for "bread".

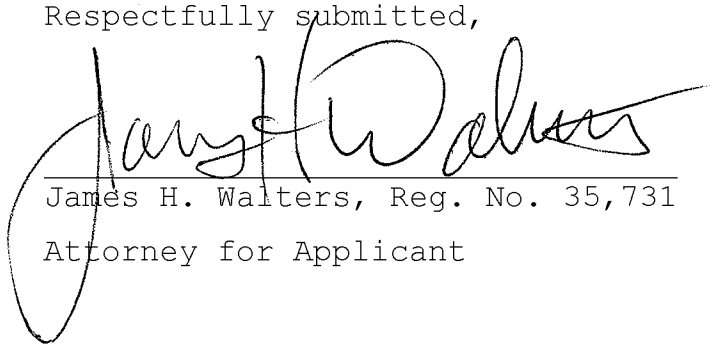
CONCLUSION

Applicant respectfully submits here that the Examining Attorney has not made a sufficient showing that a goods-place association would be material to the consumer's decision to purchase the goods.

It is respectfully requested that in view of the above, that applicant has demonstrated that it is entitled to registration of the mark and that the mark is not geographically deceptive nor primarily geographically misdescriptive for goods of bread or related goods as asserted by the Examining Attorney's final refusal to register.

Please contact applicant's attorney at 503-224-0115 if there are any questions. Thank you.

Respectfully submitted,



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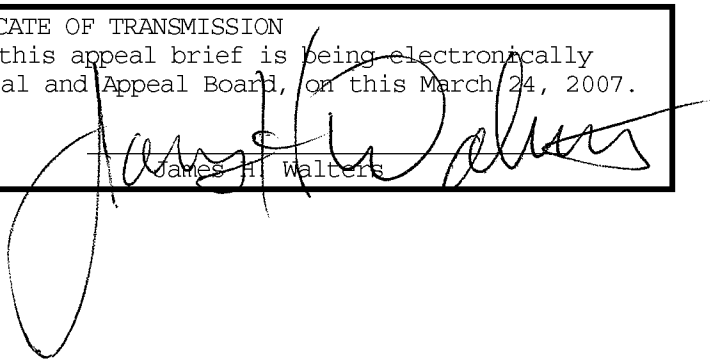

James H. Walters

TABLE OF AUTHORITIES

In re California Innovations, Inc., 66 USPQ2d 1853 (Fed. Cir. 2003) at 1854

In Re White, 80 USPQ2d 1654 (TTAB 2006) footnote 3.

TTAB MANUAL OF PROCEDURE (TBMP) section 1200, 1208.01

商標登録証
(CERTIFICATE OF TRADEMARK REGISTRATION)

登録第４９４７８９９号
(REGISTRATION NUMBER)

商標(THE MARK)

PARIS BAGUETTE

指定商品又は指定役務並びに商品及び役務の区分(LIST OF GOODS AND SERVICES)

第３０類　フランス産のバゲットを使用したフルーツゼリー，フランス産のバゲットを使用したサンドイッチ，フランス産のバゲットを使用しトーストされたパン，フランス産のバゲットを使用したビスケット，フラン
その他別紙記載

商標権者(OWNER OF THE TRADEMARK RIGHT)

大韓民国　キョンギド　ソンナンシ　ジュンワング　サンデワンドン　１４９－３
国籍　大韓民国
株式會社　パリクラサン

出願番号(APPLICATION NUMBER)　商願２００５－０３１７１１

出願年月日(FILING DATE)　平成１７年　４月１１日(April 11,2005)

この商標は、登録するものと確定し、商標原簿に登録されたことを証する。
(THIS IS TO CERTIFY THAT THE TRADEMARK IS REGISTERED ON THE REGISTER OF THE JAPAN PATENT OFFICE.)

平成１８年　４月２８日(April 28,2006)

特許庁長官(COMMISSIONER, JAPAN PATENT OFFICE)

中嶋　誠

商標登録証

(CERTIFICATE OF TRADEMARK REGISTRATION)

登録第４９４７８９９号(REGISTRATION NUMBER)
商願２００５－０３１７１１(APPLICATION NUMBER)

指定商品又は指定役務並びに商品及び役務の区分(LIST OF GOODS AND SERVICES)

（第３０類）　ス産のバゲットを使用したアイスクリーム，フランス産のバゲットを使用したケーキ，フランス産のバゲットを使用したあんパン，フランス産のバゲットを使用した食パン，フランス産の緑茶，フランス産のコーヒー，フランス産のコーヒー飲料

［以下余白］

bread
(Japanese)

Cabinet GERMAIN & MAUREAU
12, rue Boileau
69006 LYON

N° National : **05 3 350 620**

Dépôt du : 4 AVRIL 2005

à : I.N.P.I. LYON

PARIS CROISSANT CO. LTD., Société de droit sud coréen, 149-3 Sangdaewon-dong, Joongwon-ku, Songnam-shi, Kyoungki-do, 462-807 REPUBLIQUE DE COREE, COREE DU SUD.

Mandataire ou destinataire de la correspondance :
Cabinet GERMAIN & MAUREAU, 12, rue Boileau, 69006 LYON.

PARIS BAGUETTE

bread (French)

Marque déposée en couleurs.

Produits ou services désignés : Gelées de fruits, confitures, fruits et légumesen conserves, marmelade, lait fermenté, yogourts, lait, boissons d'acides lactiques, fromages. Sandwiches, pain grillé, biscuits, glacescomestibles, gâteaux, beignets, pain, thé vert, café, boissons à base de café. Carottes, choux, tomates, piments, fraises,citrons, melons, pommes, oranges [fruits et légumes frais], malt (à brasser et distiller). Jus de légumes, sirops de fruits, cocktails(non alcoolisés), sodas, jus d'orange, sirop de café, jus de tomate, jus d'ananas, eaux, eaux minérales. Services de bar et de restaurant, services desnack-bar (restauration rapide), services de boulangerie, de cafétérias, de cantines ; services de restauration dans des aires de repos et salles d'attente ; informations dans le domaine de la restauration et de l'alimentation.

Classes de produits ou services : 29, 30, 31, 32, 43.

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