

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: December 4, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Topson Downs of California, Inc.

Serial No. 85067696

Erica Van Loon of Glaser Weil Fink Jacobs et al LLP for
Topson Downs of California, Inc.

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

Before Quinn, Cataldo and Wolfson,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Topson Downs of California, Inc., filed an
application to register as a mark TINSELTOWN in standard
characters on the Principal Register for

belts; blazers; bottoms; capris; dresses; hats;
headwear; hooded sweatshirts; jackets; jeans;
pants; shirts; shorts; skirts; sweaters;
sweatpants; sweatshirts; tops; t-shirts; [and]
vests

in International Class 25.¹

The trademark examining attorney refused registration under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the basis that applicant's mark is primarily geographically descriptive of applicant's goods. In addition, pursuant to Trademark Rule 2.61(b) the examining attorney required applicant to indicate where its goods will originate and argues that applicant has failed to properly respond to the information request.

When the refusal and requirement were made final, applicant appealed. Applicant and the examining attorney filed briefs, and applicant filed a reply brief.²

Evidentiary Matter

Applicant submitted three evidentiary exhibits for the first time with its main brief. By way of explanation, applicant stated the following:

Applicant brings this information to the Board's attention, not as impermissible new evidence, but to demonstrate the unpersuasive quality of the Examiner's evidence.³ (Exhibit 1);

Applicant submits these records and search results not as impermissible new evidence but to explain the Examiner's record evidence.

¹ Application Serial No. 85067696 was filed on June 21, 2010, based upon applicant's assertion of a bona fide intent to use the mark in commerce on or in connection with the goods.

² Applicant's motion to extend the time in which to file its reply brief is moot inasmuch as the reply brief was filed within the required time period.

³ Applicant's brief, p. 6, fn 1, cont'd.

Applicant therefore respectfully requests that the Board consider this explanatory evidence.⁴ (Exhibit 2); and

The examiner's additional Internet evidence regarding third party use of the term "Tinseltown" reproduced poorly as attached to the Office Action. In its response to the Office Action, Applicant argued against the evidence as best it could but reserved the right to comment further. Applicant has now independently downloaded this evidence, true and correct copies of which are attached hereto as Exhibit 3, and supplements its previous arguments.⁵ (Exhibit 3).

The examining attorney objected to this evidence. In its reply brief, applicant stated as follows:

Applicant addressed the examiner's Internet evidence in its response to the April 19, 2011 Office Action. Because of the quality of the attached evidence, Applicant believed it was within its rights to reserve further comment, if necessary, which it made in its Appeal Brief. ... Therefore, to the extent that Applicant's objections were not first introduced in the Appeal Brief, they should be considered. Applicant's objections were timely and preserved its arguments for its response to the final Office Action on reconsideration and on appeal.⁶

Applicant is correct that it may present arguments in its briefs addressing the probative value of the examining attorney's evidence, and pointing out any weaknesses in such evidence. However, Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of the appeal. Notwithstanding that the

⁴ Id., fn 2.

⁵ Id. at 12.

exhibits applicant submitted with its brief were in response to evidence submitted with the examining attorney's first or final Office action, applicant had an opportunity to file this evidence with its request for reconsideration, prior to the appeal. It was also possible to request remand of the application to submit additional evidence after appeal, if good cause was shown. See TBMP §1207.02 (3d ed. rev. 2012). What is not acceptable is for an applicant simply to submit evidence with an appeal brief, at a point where the examining attorney has no opportunity to submit evidence in response.

Simply put, applicant's submission of new evidence with its appeal brief is untimely. Further, applicant's attempts to characterize this evidence as argument or comment fails either to change the evidence into something else, namely, argument, or render it timely submitted. Finally, to the extent that a small portion of these submissions are reproductions of evidence timely made of record by the examining attorney, such submissions are cumulative and unnecessary, particularly inasmuch as the copies made of record by the examining attorney appear to have reproduced sufficiently well. Accordingly, while we

⁶ Reply brief, p. 3.

have considered applicant's arguments addressing the strength or weakness of the examining attorney's evidence, the exhibits accompanying applicant's appeal brief have not been considered in reaching our decision.⁷

Requirement For Information

In the first Office action, the examining attorney required applicant to "provide a written statement specifying where its goods will come from or will originate."⁸ Applicant's response stated:

Based on the above [response to the refusal to register under Section 2(e)(2)], Applicant believes that it is not required to provide additional information as to the origin of the goods covered in the application, as such information is irrelevant under the "Hollywood" analysis. Applicant therefore declines, at this time, to provide additional information. By this statement, Applicant acknowledges the request and Applicant's refusal to provide information should not be construed as grounds for refusal *per se*.⁹

In the subsequent, and final April 19, 2011 Office action, the examining attorney, noting that applicant did not provide information regarding the origin of its goods, repeated the requirement and again advised applicant that failure to comply can be grounds for refusing registration. In its October 19, 2001 request for reconsideration, applicant responded as follows:

⁷ We hasten to add, however, that even if the evidence were considered, it does not compel a different result in this appeal.

Applicant responds that its goods will originate in various locations both inside and outside California.¹⁰

Under Trademark Rule 2.61(b), 37 CFR 2.61(b), an examining attorney may require the applicant to furnish such information and other materials "as may be reasonably necessary to the proper examination of the application." This Board has previously affirmed refusals of registration on the basis of an applicant's noncompliance with a requirement under Rule 2.61(b). *See, e.g., In Re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008) (requirement for information affirmed where applicant failed to acknowledge repeated requests and reminders to submit information as to geographic origin of applicant's goods); *In re Planalytics Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004) (requirement for information affirmed where applicant's only response was to refer the examining attorney to its website); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1700 (TTAB 2003) (requirement for information affirmed where applicant "did not specifically address or acknowledge" the requirement for information); and *In re*

⁸ September 28, 2010 Office action, p. 3.

⁹ Applicant's March 28, 2001 communication, p. 4.

¹⁰ Applicant's October 19, 2011 communication, p. 7.

Applicant's request for reconsideration was denied in an Office action issued on November 7, 2011.

SPX Corp., 63 USPQ2d 1592, 1597 (TTAB 2002) (requirement for information affirmed where applicant "totally ignored" request for information). See also, TMEP § 814 (October 2012) and authorities cited therein.

In this case, applicant has not ignored the examining attorney's request for additional information, nor has applicant ultimately refused to comply. Rather, applicant has responded by indicating that "its goods will originate in various locations both inside and outside California." We agree with the examining attorney that applicant's original response is unacceptable. The examining attorney argues that applicant's "second response was disingenuous because the statement encompasses the entire universe."¹¹ On the other hand, applicant argues that it is not required "to identify a specific origin of the goods when Applicant has not yet made that decision."¹² On this record, we have no basis to question applicant's assertion that it has not yet selected the location(s) in which its goods will originate. Accordingly, we find that with its second response applicant has complied with the examining attorney's requirement for information under Trademark Rule 2.61(b).

¹¹ Examining attorney's brief, unnumbered p. 10.

¹² Applicant's reply brief, p. 5.

We note, nonetheless, that in the absence of any addition evidence, we only have applicant's very broad statement regarding the location(s) in which its goods will originate. As noted by the examining attorney, applicant's goods may originate anywhere. In consequence thereof, we will infer that the locations inside California in which applicant's goods will originate include the area of Los Angeles known as Hollywood. Cf. *Cheezwhse.com*, 85 USPQ2d at 1919.

Geographic Descriptiveness

In support of the position that the applied-for mark is primarily geographically descriptive, the examining attorney made of record the following dictionary definitions of Tinseltown:

Hollywood (humorous);¹³

Hollywood, Calif.;¹⁴

Hollywood: Hollywood and the U.S. movie industry regarded as a place of insubstantial glamour (*informal disapproving*);¹⁵ and

(Placename) an informal name for Hollywood.¹⁶

The examining attorney further made of record the following dictionary definitions of Hollywood:

¹³ www.macmillandictionary.com

¹⁴ www.yourdictionary.com

Section of Los Angeles, Calif., once the site of many U.S. film studios; hence, the U.S. film industry or its life, world, etc.

City on the SE coast of Fla: pop. 139,000;¹⁷

Section of Los Angeles, California NW of the downtown district;

City SE Florida N of Miami pop 139,357;¹⁸

The NW part of Los Angeles, Calif.: center of the American motion-picture industry;

A city in SE Florida, near Miami: seaside resort;¹⁹ and

Mod. having phony glitter: *who is this Hollywood dame who just came in?*

A gaudily dressed person in sunglasses. (Also a term of address.) *Ask Hollywood over there to take off his shades and make himself known.*²⁰

In addition, to show a goods/place association the examining attorney made of record printed copies of internet web pages in which the term Tinseltown or Hollywood is used in connection with clothing and fashion.

The following examples are illustrative:

Hollywood Fashion Week

It should be no surprise that such an affluent and desirable destination and the capitol of Bling...

Hollywood finally has a fashion week to call its own.

Hollywood Fashion Week® promises the infusion of fashion, music, and style into a week-long series of events put on like no other city.;²¹

¹⁵ www.encarta.msn.com

¹⁶ www.thefreedictionary.com

¹⁷ www.yourdictionary.com

¹⁸ www.merriam-webster.com

¹⁹ www.dictionary.reference.com

²⁰ Dictionary of American Slang and Colloquial Expressions (McGraw 2007).

²¹ www.hollywoodfashionweek.com

Hollywood & Media Influence on Society's Fashion
How Clothing Trends Have Been Impacted by
Celebrity Trendsetters

Media influence helped Clark Gable, James Dean,
Marlon Brando, Elizabeth Taylor and Rosalind
Russell to heavily impact clothing trends during
Hollywood's golden age. ...;²²

2007 Tinseltown fashion trends

The trendiest A-listers served up some hot
Hollywood style this year. From Katie Holmes'
dramatic new do to Reese Witherspoon's
sensational "break-up" makeover, red-carpet glam
put the power into this year's posh factor.
Discover the styles that shook up showbiz in
'07.;²³

Celebrate Your Wedding Day In Tinseltown Fashion
InStyle Weddings has the "hot list" of how to
celebrate your wedding day Hollywood-Style.

Homegrown Hospitality

Give your out of town guests some local flavor,
filling welcome bags with goodies your wedding
city is famous for. We love Neighborhoodies - a
local Brooklyn company - will custom-make a
totebag for you for wherever your wedding is
held.;²⁴ and

Stars Celebrate Hollywood Fashion Gurus at
Costume Designers Guild Awards

Some of fashion's most important movers and
shakers make their living on the big screen and
on Tuesday actors and actresses honored the
people that make them look so good on camera at
the 2011 Costume Designers Guild Awards. ...²⁵

The test for determining whether a mark is primarily
geographically descriptive under Section 2(e)(2) of the
Trademark Act is whether (1) the mark (or a portion

²² www.suite101.com

²³ www.ctv.ca/CTVNews.com

²⁴ www.weblogs.wpix.com

²⁵ www.etonline.com

thereof) is the name of a place known generally to the public, and (2) the public would make a goods/place association, that is, believe that the goods identified in the application originate in that place. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006); and *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001). If the goods do in fact originate from the place named in the mark, the requisite goods/place association can be presumed. See *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

We turn then to the question of whether the term sought to be registered, *i.e.*, TINSELTOWN, primarily denotes a geographical place. Based upon the evidence of record, it is clear that Tinseltown is a term used, with varying degrees of approval, to refer both to the Hollywood section of Los Angeles, California as well as the motion picture industry - with the attendant glitz and glamour - for which it has become famous. To state the obvious, the record clearly supports a finding that Hollywood denotes a section of Los Angeles, California and also the motion-picture industry once exclusively located in Hollywood and now located in various parts of Los Angeles, as well as the iconic styles associated therewith and its often desperate

imitators.²⁶ Thus, the term Tinseltown denotes, *inter alia*, a nickname for the geographic place known as Hollywood, located in Los Angeles, California. It is settled that a nickname of a geographic location is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public. See *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007); and *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998). However, on this record, Tinseltown also denotes the movie industry, its stars, and the fashion and style trends they have made famous. Indeed, the examining attorney's own evidence, excerpted above, suggests that it is the latter meaning, namely, that of the movie industry, that may be the primary denotation of the term Tinseltown as used in relation to applicant's goods. We find, therefore, that the examining attorney has failed to establish that the primary significance of Tinseltown is a geographic location.

²⁶ We note in addition that Hollywood denotes a small resort city near Miami, Florida. However, it is settled that merely because the term in question identifies more than one geographic location does not necessarily detract from the term's primary geographic significance. See, e.g., *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and *In re Cambridge Digital Sys.*, 1 USPQ2d 1659, 1662 (TTAB 1986).

In regard to the term Hollywood, this tribunal has previously held that

in view of the other prominent, significant meaning of the term "Hollywood" as referring to the entertainment industry in general, we find that the Examining Attorney has not established that the *primary* significance of the term "Hollywood" is that of a geographic location in California. That is, the record does not establish that to the purchasing public the primary connotation of the term "Hollywood" is the particular California town and not the general entertainment industry.

In re International Taste Inc., 53 USPQ2d 1604, 1605 (TTAB 2000). See also *In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369 (TTAB 1999); and *In re Dixie Insurance Company*, 223 USPQ 514 (TTAB 1984). In distinguishing the *International Taste* decision from the instant case, the examining attorney argues that

In this case, the mark TINSELTOWN could just as well refer to the geographic location known as Hollywood but even if it has the same connotation as the entertainment aspect of Hollywood, the fashion industry goes hand in hand with the entertainment industry. In fact, applicant states that "Hollywood is synonymous with the film industry, glamour and a particular American lifestyle."²⁷

However, the examining attorney's arguments do not overcome the evidence that the terms Tinseltown and Hollywood denote the movie industry itself, its members and imitators at least as significantly as a geographic area. That is to

say, even if we accept that the entertainment industry and fashion industry are closely related, it remains that the term Tinseltown possesses a prominent and significant meaning other than that of a geographic location. Thus, we find the facts of the case before us to be quite similar to the facts in *International Taste*. Simply put, the term Hollywood refers both to a geographic location and the motion picture industry. Its nickname, Tinseltown, refers even more strongly to the motion picture industry than it does to a geographic location.

In view of our finding that the term Tinseltown is not primarily a geographical term, we need not reach the question of whether the examining attorney has established a goods/place association between the term and the applied-for goods. As a result, even if we infer, as discussed above, that applicant's goods originate in Hollywood, a geographic area that together with other locations in the Los Angeles area has been nicknamed Tinseltown, the examining attorney cannot prevail in this case because the record of this case does not support a finding that the primary significance of Tinseltown is a geographic term.

Based upon the evidence in this case, including any evidence not specifically discussed herein, we find that

²⁷ Examining attorney's brief, unnumbered p. 8-9.

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the primary significance of the term comprising applicant's mark is not a geographic term. To the extent that there is any doubt as to the primary significance of the term TINSELTOWN, we resolve doubt in favor of the applicant. See *In re John Harvey & Sons Ltd.*, 32 USPQ2d 1451, 1455 (TTAB 1994).

Decision: The refusal of registration is reversed, and the application will be forwarded for publication in the Official Gazette.