

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 9, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Deep South Studios LLC

Serial Nos. 86896313 and 86896327

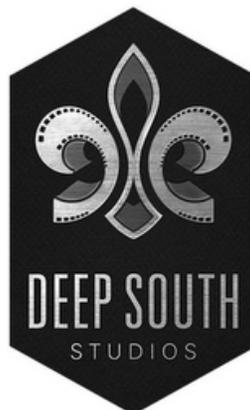
Benjamin W. Janke of Baker Donelson Bearman Caldwell & Berkowitz, PC
for Deep South Studios LLC.

Daniel Stringer, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Quinn, Adlin and Goodman, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Deep South Studios LLC (“Applicant”), which is based in New Orleans, seeks
Principal Register registrations for the mark DEEP SOUTH STUDIOS, in standard
characters and the form shown below



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for “movie studio services.”¹ Because he found that the term DEEP SOUTH is primarily geographically descriptive of Applicant’s services, the Examining Attorney refused registration of the standard character mark under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), and refused registration of the design mark absent a disclaimer of all of the wording therein (DEEP SOUTH as primarily geographically descriptive and STUDIOS as merely descriptive). After the refusals became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.²

The Evidence

According to the Macmillan Dictionary, “the Deep South” means “the states of Alabama, Georgia, Louisiana, Mississippi, and South Carolina in the southern part of the U.S.” Office Action of May 24, 2016 at 2.³ The American Heritage dictionary defines “Deep South” as “[a] region of the southeast United States, usually comprising the states of Alabama, Georgia, Louisiana, Mississippi, and South Carolina,” in other words, the exact same states identified by the Macmillan Dictionary. *Id.* at 12.⁴ The Merriam-Webster Dictionary defines “Deep South” similarly, in that it also includes

¹ Application Serial Nos. 86896327 and 86896313, respectively, each filed February 3, 2016 under Section 1(b) of the Trademark Act, based on an alleged bona fide intent to use the mark in commerce. The ‘313 application includes this description of Applicant’s design mark: “The mark consists of an elongated hexagon containing a fleur-de-lis above the words ‘DEEP SOUTH’ in capital letters. Below this is the word STUDIOS in smaller letters.”

² These appeals involve common questions of law and fact and the records are substantially similar. Accordingly, we consolidate and decide both appeals in this single decision. *See In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TBMP § 1214 (2017). Citations are to the record in Application Serial No. 86896313.

³ <http://www.macmillandictionary.com/dictionary/american/the-deep-south>.

⁴ <https://www.ahdictionary.com/word/search.html?q=Deep%20South>.

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the same states, including Louisiana, but the definition is broader: “region SE United States – usually considered to include Alabama, Georgia, Louisiana, Mississippi, North Carolina, South Carolina, and all or part of the adjacent states of Florida, Virginia, Tennessee, Arkansas & Texas.” *Id.* at 6.⁵ According to Wikipedia and the New World Encyclopedia, the Deep South “is a cultural and geographic subregion in the Southern United States ... Today, the Deep South is usually delineated as being those states and areas where cultural elements most often thought of as ‘Southern’ exist in their most concentrated form.” Furthermore, “[m]ost definitions include the states Georgia, Alabama, South Carolina, Mississippi, and Louisiana,” with Arkansas sometimes included, as well as “[a]djoining areas of East Texas, West Tennessee, and North Florida.” *Id.* at 14-23.⁶

The Examining Attorney also relies on evidence depicting how third parties use the term DEEP SOUTH. For example:⁷

TrekAmerica offers an eight-day tour, “Deep South Budget Lodging Tour,” which begins and ends in New Orleans.

The book Mountain Biking the Deep South includes 77 rides in Louisiana, Mississippi, Alabama and Georgia.

A blurb on the “modernhealthcare.com” website entitled “Medicaid expansion hits Deep South” discusses a Louisiana patient who was able to obtain Medicaid coverage.

⁵ <http://www.merriam-webster.com/dictionary/Deep%20South>.

⁶ http://www.newworldencyclopedia.org/entry/Deep_South and https://en.wikipedia.org/wiki/Deep_South.

⁷ We have not relied upon evidence which appears to be from foreign sources.

The Urban Dictionary defines “Deep South” as “a cultural and geographic subregion of the American South,” including the “core states” of Alabama, Georgia, Louisiana and Mississippi.

The G Adventures website (“gadventures.com”) offers a nine-day tour, “Highlights of the Deep South,” which includes New Orleans.

The Deep South Rugby Referees Society website (“deepsouthrugbyrefs.com”) indicates that the group serves Alabama, Louisiana, Mississippi and the Florida panhandle, and offers an officiating course in New Orleans.

A Boston Globe article entitled “A Boston-New Orleans Connection Forged After the Civil War” states that “In June 1880, with the wounds of the Civil War still fresh, New Orleans sent emissaries from the Deep South to help Boston commemorate the 105th anniversary of the Battle of Bunker Hill.”

The Pelican Publishing Company offers a book entitled Louisiana, the Jewel of the Deep South, which covers “Louisiana’s statehood in 1812 to designation of the fleur-de-lis as the state symbol in 2008.”

A Wikipedia article entitled “New Orleans in the American Civil War” indicates that “Antebellum New Orleans was the commercial heart of the Deep South”

Office Action of June 22, 2016 at 21-124.

Finally, the Examining Attorney relies on the “Why Louisiana” section of Applicant’s website, which touts the benefits of “filmmaking and television production” in Louisiana:

8/21/2016

Why Louisiana | Deep South Studios



HOME ABOUT SITE > WHY LOUISIANA VIRTUAL TOUR PRESS CONTACT

Why Louisiana?

In the last decade, Louisiana has nurtured a blossoming film industry. Cost-effective skilled workforce, new infrastructure, diverse locations, and a long-term commitment to the country's most aggressive film and entertainment tax incentives have made Louisiana the second most significant production hub in the United States. Since 2006, over 300 films have been shot in Louisiana by major film studios such as Warner Bros, Paramount, Universal, Sony and 20th Century Fox. Louisiana has been host to nearly every genre of filmmaking and television production. These include Action, Comedy, Drama, Horror and Fantasy. Some of these films such as The Curious Case of Benjamin Button, Monster's Ball, Ray, Dallas Buyers Club and 12 Years a Slave have been Oscar winners.

Louisiana's Tax Incentive Program

In 2002, the Louisiana legislature enacted a flagship incentive program in order to induce productions to shoot in Louisiana. The Louisiana Motion Picture Tax Incentive Act offered all incoming productions up to 35% on in-state expenditure. This has driven the meteoric rise in the state's annual production spend to achieve its status as #2 in the country, and growing.

Louisiana's Incentives At A Glance

30% of qualifying local spending, including the payroll for residents and nonresidents; plus an additional 5% on resident payroll ≤ \$1 million	Partially refundable, fully transferable motion picture production tax credits; the credits can be transferred to the state of Louisiana for 85% of face value on projects certified on/after July 1, 2009	\$180 million annual cap on redemption and \$30 million per project cap; for the additional 10% resident payroll credit there is a compensation cap of \$1 million per person
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Id. at 17.

Applicant does not take issue with this evidence as a general matter, but instead counters with its own evidence that New Orleans, its home base, is within Louisiana but not part of the Deep South. For example, one book states: “South Carolina, Georgia, Alabama, Mississippi, and Louisiana are commonly considered the Deep

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South states, although parts of these states don't meet the criteria, and parts of adjoining states do." The book goes on to identify "South Louisiana" as one of "three big exceptions" which are "southern for some purposes but not for others," stating that the area "is Southern, sure enough, but with a Gallic twist that has caused us all kinds of headaches in this book. New Orleans is – well, something else." Office Action Response of June 9, 2016 at 14-17 (John Shelton Reed and Dale Volberg Reed, 1001 Things Everyone Should Know About the South (1996)). Applicant claims that another book depicts the New Orleans area as separate from the Deep South:



<p>NEW FRANCE. Occupying the New Orleans area and southeastern Canada, New France blends the folkways of <i>ancien régime</i> northern French peasantry with the traditions and values of the aboriginal people they encountered in northeastern North America. After a long history of imperial oppression, its people have emerged as down-to-earth, egalitarian, and consensus driven, among the most liberal on the continent, with unusually tolerant attitudes toward gays and people of all races and a ready acceptance of government involvement in the economy. The New French influence is manifest in Canada, where multiculturalism and negotiated consensus are treasured.</p>	<p>DEEP SOUTH. Established by English slave lords from Barbados, Deep South was meant as a West Indies-style slave society. This nation offered a version of classical Republicanism modeled on the slave states of the ancient world, where democracy was the privilege of the few and enslavement the natural lot of the many. Its caste systems smashed by outside intervention, it continues to fight against expanded federal powers, taxes on capital and the wealthy, and environmental, labor, and consumer regulations.¹²</p>
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Applicant’s Appeal Brief at 8⁸ Finally, Applicant cites to a 2010 Internet message board posting from an unidentified author stating that while New Orleans “has Deep South influences its (sic) not a typicall (sic) Deep South city the way let’s say Birmingham, Atlanta, or Nashville are.”⁹ *Id.* at 9.¹⁰

⁸ Applicant failed to make the relevant passages from this book of record, but appears to have reproduced excerpts of the book in its Office Action Response of June 9, 2016. Because the Examining Attorney has not objected to Applicant’s apparent reproduction of this evidence in its Office Action Response or Appeal Brief, we have considered it.

⁹ This evidence was also not properly made of record but the Examining Attorney has not objected to it so we have considered it for whatever probative value it might have.

¹⁰ Applicant and the Examining Attorney also introduced or cited dueling third-party registrations. Specifically, the Examining Attorney relies on five registrations for marks containing DEEP SOUTH in which DEEP SOUTH is disclaimed, registered on the Supplemental Register or registered on the Principal Register with a claim of acquired distinctiveness. Office Action of June 22, 2016 at 2-14. Applicant relies on a mere list in its Appeal Brief of four third-party registrations in which marks containing DEEP SOUTH are allegedly registered on the Principal Register without a disclaimer or claim of acquired distinctiveness. Applicant’s Appeal Brief at 11. The Examining Attorney did not object to, and addressed, this list in his Appeal Brief, so we have considered it. However, weighing all of the third-party registrations together, and assuming that Applicant accurately characterized those on its list, we find that the third-party registrations do not support Applicant’s or the Examining Attorney’s position. In short, “[t]he Board must decide each case on its own merits ... Even if some prior registrations had some characteristics similar to [Applicant’s] application, the PTO’s allowance of such prior registrations does not bind the

Analysis

In order to establish that Applicant's mark is primarily geographically descriptive, the Examining Attorney must establish that: (1) the primary significance of the mark sought to be registered is the name of a place known generally to the public; (2) the public would make a services/place association, i.e. believe that the services for which the mark is sought to be registered originate in that place;¹¹ and (3) the source of the services is the geographic region named in the mark. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015) (quoting *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987) and *In re Jacques Bernier, Inc.*, 894 F.2d 389, 13 USPQ 1725 (Fed. Cir. 1990)); TMEP § 1210.01(a) (2017). The Examining Attorney has established each element.

The evidence makes clear that the primary significance of "Deep South" is a place generally known to the public. Indeed, there is no evidence that the term's meaning is anything other than geographic. Moreover, books and reference works discuss the Deep South region, with all agreeing it includes Louisiana; tours of the Deep South region include visits to New Orleans and Louisiana; a group of rugby referees serving Alabama, Louisiana, Mississippi and the Florida panhandle uses DEEP SOUTH in

Board or this court." *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

¹¹ "If the Trademark Examiner establishes such a *prima facie* case, an applicant may rebut this showing with evidence 'that the public would not actually believe the goods derive from the geographic location identified by the mark.'" *Newbridge Cutlery*, 113 USPQ2d at 1449 (quoting *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1783 (Fed. Cir. 2001)).

its trade name and offers a course in New Orleans; and the overwhelming majority of third-party DEEP SOUTH registrations of record are owned by entities and individuals from the Deep South region. Applicant does not dispute that the Deep South is a generally known place, which includes Louisiana, nor does it counter the voluminous evidence that the term's primary significance is a geographic region which includes Louisiana.

We presume that the public would believe that Applicant's services originate in the Deep South, because Applicant is based in Louisiana, which is universally recognized to be in the Deep South. *In re MCO Properties Inc.*, 38 USPQ2d 1154, 1155 (TTAB 1995) ("When it has been demonstrated that the primary significance of the term is geographic, and the services of the applicant are in fact rendered from the place the term names, a public association of the services with the place will be presumed."); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 850 (TTAB 1982).¹² This presumption is bolstered in this case by Applicant's website, which includes an entire section entitled "Why Louisiana," explaining the advantages of rendering and retaining movie studio services in that state, including that Louisiana: (1) "has nurtured a blossoming film industry;" (2) has "[c]ost-effective skilled workforce, new infrastructure, diverse locations, and a long-term commitment to the country's most aggressive film and entertainment tax incentives;" and (3) is "the second most

¹² Even though Applicant's website suggests that Louisiana is well-known for movie studio services, this is not required for us to find Applicant's mark primarily geographically descriptive. *In re Newbridge Cutlery*, 113 USPQ2d at 1449; *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1661 (TTAB 1986).

significant production hub in the United States.” In fact, while in some circumstances “a geographical term in a mark may not be as readily perceived as indicating the geographical origin of services as it does goods, simply because services are normally rendered where the consumer is,” in this case Applicant’s website, and the nature of its services, make clear that at least some of the services are rendered in Louisiana. *Cf. In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988).

Finally, there is no question that the source of the services is the Deep South, because Louisiana is universally recognized to be part of the Deep South. Therefore, the Examining Attorney has established that Applicant’s mark is primarily geographically descriptive. Moreover, the requirement to disclaim the term STUDIOS for Applicant’s “movie studio services” is obviously appropriate, and Applicant does not argue to the contrary. In fact, Merriam-Webster defines “studio” as “a place where movies are made.” Office Action of June 22, 2016 at 126-28.¹³

Applicant has not rebutted the Examining Attorney’s case. Applicant’s argument that the term “Deep South” is “amorphous” and not the mark’s *primary* significance is not well-taken. All evidence of record makes clear that DEEP SOUTH is a geographic term, and that it includes Louisiana, the place where Applicant is based and which it specifically touts on its website.

¹³ “[T]he presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole.” *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001).

Applicant's contention that the fleur-de-lis is "French influenced" and without "any meaningful connection with any 'Deep South' imagery" is belied by the evidence that the fleur-de-lis became Louisiana's state symbol in 2008. See *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144, 1145 (TTAB 1993) ("We believe that applicant's labels for its NANTUCKET NECTARS soft drinks ... would cause the consuming public to make a goods/place association. These labels bear the mark NANTUCKET NECTARS above a picture of Nantucket Town").

The evidence which indicates there are differences between New Orleans and other parts of the Deep South is contradicted and far more ambiguous than Applicant contends. First, all of the dictionary definitions and encyclopedia entries of record identify Louisiana as part of the Deep South, without separately addressing New Orleans. Second, the evidence upon which Applicant relies merely differentiates New Orleans culturally and in other ways from other parts of the Deep South without stating or arguing that New Orleans is not still part of the Deep South. Third, the "general public" (Internet message board) evidence Applicant cites does not support Applicant's position, as the unidentified poster merely indicates that New Orleans is not "typical" of the Deep South, even though it has "Deep South influences." Fourth, multiple tours of the Deep South include New Orleans, the Deep South Rugby Referees Society serves Louisiana and offers a course in New Orleans and according to Wikipedia, "Antebellum New Orleans was the commercial heart of the Deep South." Fifth, Applicant's website stresses its location in Louisiana, which is indisputably part of the Deep South, rather than its address in New Orleans

specifically, so any consumers who perceive a difference between New Orleans and the Deep South would be more likely to believe, to the extent there is a difference, that Applicant's services come from Louisiana generally rather than New Orleans specifically, or to focus on Louisiana rather than New Orleans as the origin of the services. Moreover, the "Why Louisiana" page on Applicant's website impacts the significance of the term DEEP SOUTH in Applicant's mark, establishing or at least strongly suggesting that it is primarily geographic. Finally, even if New Orleans is not perceived to be part of the Deep South, New Orleans is at the very least extremely close to the Deep South, which supports a finding that Applicant's mark is primarily geographically descriptive. *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1617-18 (TTAB 2007) (finding YOSEMITE BEER primarily geographically descriptive of alcoholic beer originating "in the city of Merced, California, which is approximately 80 miles from Yosemite National Park," stating "[s]ince the goods originate at or near the place named in the mark, we can presume an association of applicant's beer with the park"); *In re Joint-Stock Company "Baik,"* 80 USPQ2d 1305, 1310 (TTAB 2006) ("we presume a goods/place association [of vodka with BAIKALSKAYA meaning 'from Baikal'] because applicant is located near Lake Baikal, in the city of Irkutsk"). *See also In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) ("Here the evidence of record shows that 'Carolina', in addition to being the name of an American colony, also is used to indicate either the state of North Carolina or the state of South Carolina ... It is clear that the primary significance of the designation CAROLINA APPAREL, APPAREL being generic and disclaimed by applicant, is geographic.").

Conclusion

“The purpose of the proscription in Section 2(e)(2) of the Act against registration of primarily geographically descriptive terms is to leave place names free for all businesses operating in particular areas to inform customers where the goods or services originate. It would be completely inconsistent with the objectives of the Trademark Act” to register DEEP SOUTH for Applicant’s movie studio services rendered in the Deep South unless applicant had claimed and proved that the term has acquired secondary meaning. *In re MCO Properties*, 38 USPQ2d at 116.

Decision: The refusal to register the standard character mark in application Serial No. 86896327 is affirmed. The refusal to register the design mark in application Serial No. 86896313 in the absence of a disclaimer of DEEP SOUTH and STUDIOS is also affirmed, but the decision with respect to this application will be set aside if, within thirty days of the mailing date of this order, Applicant submits to the Board a proper disclaimer of DEEP SOUTH and STUDIOS. Trademark Rule 2.142(g). The disclaimer should be worded as follows: “No claim is made to the exclusive right to use DEEP SOUTH or STUDIOS apart from the mark as shown.”