

**This Opinion is Not a
Precedent of the TTAB**

Oral Hearing: October 4, 2018

Mailed: December 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Red Flags Fly, Inc.
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Serial No. 87104371
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Jill M. Pietrini and Susan Hwang of Sheppard Mullin Richter & Hampton LLP
for Red Flags Fly, Inc.

Morgan L. Meyers, Trademark Examining Attorney, Law Office 117,
Travis Wheatley, Acting Managing Attorney.

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Before Lykos, Hightower, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Red Flags Fly, Inc. (“Applicant”), a California corporation with an address in Los Angeles, has filed an application to register the mark displayed below on the Principal Register for “clothing, namely, aprons, bandanas, beach cover-ups, bolo ties, cardigans, culottes, do rags, dresses, infantwear, jackets, jeans, jerseys, leggings, lingerie, loungewear, neckwear, overalls, overcoats, pants, ponchos, rainwear, robes, sarongs, sashes, scarves, shawls, shirts, shorts, skirts, skiwear, sleepwear, socks, surf wear, suspenders, sweat bands, sweaters, sweatpants, sweatshirts, swimwear, tank

tops, track pants, t-shirts, undergarments, and vests, belts; footwear; and headwear”
in International Class 25.¹



Registration has been finally refused in light of Applicant’s failure to comply with the Trademark Examining Attorney’s requirement to disclaim ANAHEIM pursuant to Trademark Act Section 6(a), 15 U.S.C. § 1056(a), on the ground that the term is primarily geographically descriptive of the identified goods. When the refusal was made final, Applicant appealed and requested reconsideration. The Trademark Examining Attorney maintained the refusal to register and denied the request for reconsideration. Thereafter, the appeal was resumed and is now fully briefed. An oral hearing on this appeal was held on October 4, 2018. For the reasons set forth below, we reverse the refusal to register.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). A “disclaimer” is a statement that an applicant does not claim exclusive rights to an unregistrable component of a mark:

[A] disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in

¹ Application Serial No. 87104371, filed July 14, 2016, 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.

the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

Sprague Electric Co. v. Erie Resistor Corp., 101 USPQ 486, 486-87 (Comm'r Pats. 1954). Absent a showing of acquired distinctiveness, terms which are primarily geographically descriptive are unregistrable under Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2),² and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Indus. Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Indus. Inc.*, 157 USPQ 114 (TTAB 1968).

A term is primarily geographically descriptive if

- (1) the primary significance of the term in the mark is a generally known geographic location;
- (2) the goods or services originate in the place identified in the mark; and
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.

² Section 2(e)(2) of the Trademark Act reads in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(e) Consists of a mark which . . . (2) when applied to the goods of the applicant is primarily geographically descriptive . . .

See In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445 (Fed. Cir. 2015); *In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990); *In re Societe General des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852 (TTAB 2014); *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1616 (TTAB 2007). In instances where a geographic location is generally known, and the term's geographic significance is its primary significance, and the goods or services do, in fact, originate from the named location, a goods/place association can be presumed. *Newbridge Cutlery Co.*, 13 USPQ2d at 1449 (citations omitted). All three elements of this test must be satisfied.

Based on our review of the record, we find that at a minimum the second prong of the test has not been met. As noted above, Applicant is located in Los Angeles, California. There is nothing in the record to establish that Applicant's identified goods will originate from Anaheim, California, the geographic location identified in Applicant's mark. Because the application was filed under Section 1(b), we have no specimen to assist us in this inquiry. Under these circumstances, the proper procedure for the Examining Attorney to follow is to either (1) contact the applicant to ascertain the origin of the goods and make a note to the file, or (2) issue an information request under Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b). As explained more fully in TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") Section 1210.03 ("Geographic Origin of the Goods or Services") (Oct. 2018):

If it is unclear where the goods/services originate or will originate because the applicant does not come from the place named in the mark, and the record does not indicate whether the goods/services originate in that place, and

misdscriptiveness would not be material to the decision to purchase the goods/services, the examining attorney must do the following:

(1) If (a) the entire mark would be geographically misdescriptive, or a portion of the mark would be geographically descriptive (making disclaimer an option), (b) there are no other substantive refusals (making an examiner's amendment an option), and (c) the application could be put into condition for publication by examiner's amendment (see TMEP §707), to expedite prosecution, the examining attorney must: Attempt to contact the applicant to determine whether the goods/services originate in the place named and, if so, to obtain authorization for a disclaimer and for any other amendments that would put the application in condition for approval for publication.

If the applicant states that the goods/services do not originate in the place named, the examining attorney must so indicate by entering a Note to the File in the record, enter any amendments necessary to put the application in condition for approval, and approve the mark for publication.

(2) If the examining attorney is unable to reach the applicant or cannot obtain authorization for an examiner's amendment, or if the applicant indicates that they do not know where the goods/services will originate, or if an Office action is otherwise necessary to make substantive refusals or requirements that cannot be satisfied by examiner's amendment, the examining attorney must proceed as follows: Issue an information request under 37 C.F.R. §2.61(b), asking where the goods/services originate. This written request is made to ensure the completeness of the record. The examining attorney may also issue a refusal under §2(e)(2) as geographically descriptive (or a requirement for a disclaimer, if appropriate), based on the presumption that the goods/services come from the place named in the mark; and issue any other relevant refusals and requirements.

We see no note to the file memorializing contact with Applicant. In addition, the Examining Attorney's failure to issue an information request asking where the goods

will originate creates an ambiguity as to a critical element of the test for geographically descriptive terms. For this reason, the Examining Attorney's refusal to register Applicant's mark in the absence of a disclaimer of the term ANAHEIM necessarily fails.

Furthermore, even assuming that the record had shown otherwise, we find that the juxtaposition of ANAHEIM with HILLBILLIES creates an incongruity rendering Applicant's mark unitary. As noted above, the third prong of the test for geographic descriptiveness requires prospective consumers to make a goods/place association. If purchasers would not, upon seeing the mark, conclude that it imparts information about the geographical origin of the goods, the mark is arbitrary. *In re Sharky's Dry Goods*, 23 USPQ2d 1061, 1062 (TTAB 1992) (citing *In re House of Windsor, Inc.*, 221 USPQ 53, 55 (TTAB 1983)). The record shows that "Anaheim" is "a city outside Los Angeles, in Southern California. It's home to the Disneyland Resort, a massive complex of family-friendly, Disney-themed rides, restaurants, hotels and shops."³ According to *MacMillan Dictionary*, "hillbilly" is defined as "someone who lives in the countryside, especially someone who is not well educated."⁴ Consumers are well aware that Anaheim is not "the countryside," and therefore likely to perceive Applicant's mark as a sardonic reference to the city's populace and sprawling highly

³ "Quick Facts" about Anaheim, California from www.googlemaps.com attached to the June 1, 2017 Final Office Action; TSDR p. 5. References to the TSDR database are to the downloadable .pdf format.

⁴ www.macmillandictionary.com/dictionary/american/hillbilly attached to the December 4, 2017 Request for Reconsideration; TSDR p. 37.

developed landscape. The intricate gothic stylization of the lettering in the mark creates another point of irony.

In re Sharky's Dry Goods, 23 USPQ2d 1061, 1062-63 (TTAB 1992), presents a similar situation. In that case, the Board reversed the Sections 2(e)(2) and 2(a) refusals of PARIS BEACH CLUB for clothing based on the following logic:

In this case, Paris is certainly not an obscure or remote geographical term, it being the well-known capital of France. However, the mark in question is not the word "Paris" per se; it is PARIS BEACH CLUB. Paris, of course, 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, such that purchasers will view PARIS BEACH CLUB as a humorous mark, with the word "Paris" in the mark being a facetious rather than a geographic reference, a take-off on the fact that the city of Paris is known for haute couture. It is Paris' connection with high fashion that is intrinsic to the satire, and makes this take-off on the cachet associated therewith work. *See, In re Jacques Bernier Inc., supra*, in which the Court pointed out instances in which the goods/place association is not the "primary" meaning a geographic mark connotes, but instead suggests that a product is stylish or of high quality, e.g., HYDE PARK for clothing and FIFTH AVENUE for a car.

The same reasoning applies with equal force here where the combination of the two words "Anaheim" and "hillbillies," in a formal gothic-style lettering, projects a satirical meaning. As such, the requisite goods/place association has not been met. *See id.* at 1063.

In sum, we do not find ANAHEIM as presented in the stylized mark ANAHEIM HILLBILLIES primarily geographically descriptive of the identified goods.

Decision: The refusal to register Applicant's mark in the absence of a disclaimer of ANAHEIM is reversed.