

This Opinion is not a
Precedent of the TTAB

Mailed: March 15, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Ink Projects LLC

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Serial No. 87856799

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Michael F. Snyder of Volpe and Koenig, P.C.,
for Ink Projects LLC.

Susan Leslie DuBois,¹ Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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

Opinion by Lykos, Administrative Trademark Judge:

¹ The application was originally assigned to Trademark Examining Attorneys David C. Reihner and Esther A. Belenker.

Citations to the prosecution record are to each application file in the USPTO's Trademark Status & Document Retrieval ("TSDR") system. Citations to the appeal record are to TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable. Where applicable, citations to the .pdf version in TSDR have been noted.

On March 30, 2018, Ink Projects LLC (“Applicant”), through its predecessor in interest,² filed an application to register on the Principal Register the mark SOHO INK in standard characters for goods and services ultimately identified as:

Tattoo ink; Permanent makeup inks and pigments; Inks for permanent makeup, in International Class 2;

Tattoo and tattooing equipment, accessories and supplies, namely, tattoo machines and parts for tattoo machines, and tattooing needles; tattoo machine accessories, namely, tips, tubes and grips, all specially designed for use with tattoo needles and tattoo machines, in International Class 8;

Clothing, namely, shirts, jackets, sweatshirts, t-shirts, tank tops, long-sleeved t-shirts, sportswear in the nature of sports jerseys and shirts, footwear, sleepwear, outerwear in the nature of jackets, coats, hats, in International Class 25; and

Tattooing services, body piercing services, permanent makeup services, cosmetic tattooing services, in International Class 44.³

During prosecution, Applicant disclaimed the word INK in the mark as to the goods and services in International Classes 2, 8, and 44.⁴

The Trademark Examining Attorney has refused registration (1) under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e), on the ground that Applicant’s

² Ownership of the application changed during prosecution. The original applicant was King of Ink Inc., a corporation organized under the laws of New York. In lieu of a street address, a post office box was provided. King of Ink Inc., through a merger effective on January 21, 2020, conveyed the applied-for mark to Ink Project, LLC, a limited liability company located in South Carolina, and organized under the laws of the state of Delaware. *See* USPTO Assignment Records, Reel/Frame 6843/0865.

³ Application Serial No. 87856799, filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use in commerce.

⁴ *See* February 11, 2020 “Trademark Snap Shot Amendment & Mail Processing Stylesheet.”

mark is primarily geographically descriptive of its identified goods and services in International Classes 2, 8, and 44; and (2) under Trademark Act Section 6(a), 15 U.S.C. § 1056(a), on the ground that Applicant has failed to comply with the Trademark Examining Attorney's requirement to disclaim SOHO for the goods identified in International Class 25.

Following the issuance of final refusals, Applicant timely filed a notice of appeal and request for reconsideration. The Board suspended the appeal. After the Examining Attorney denied Applicant's request for reconsideration, the appeal was resumed and is now briefed.⁵ For the reasons set forth below, we affirm each refusal.

I. Primarily Geographically Descriptive Refusal - International Classes 2, 8, and 44

Absent a showing of acquired distinctiveness, Section 2(e)(2) of the Trademark Act prohibits the registration of a mark on the Principal Register which, when used on or in connection with the goods or services of an applicant, is primarily geographically

⁵ Applicant attached to its brief as Exhibits A-F evidence previously made of record. *See* 16 TTABVUE 20-140. Its submission was superfluous. *See, e.g., In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief evidence previously made of record discouraged). In addition, for record citations, Applicant cited to the exhibits in its brief instead of the electronic record in TSDR. As per Trademark Rule 2.142(b)(3), 37 C.F.R. § 2.142(b)(3), “[c]itation to evidence in briefs should be to the documents in the electronic record for the subject application or registration by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.” “It is of far more utility to the Board for the applicant and examining attorney to provide citations directly to the record and, when there are a large number of attachments to an Office action or response, to the specific page number where the attachment may be found.” *In re Sela Prods. LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013).

descriptive of them.⁶ The test for determining if a mark is primarily geographically descriptive is whether

- (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.

In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889, 891 (CCPA 1982). Accord *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1616 (TTAB 2007). All three elements of this test must be satisfied.

The “relevant public is the purchasing public in the United States of [the] types of goods [and services]” identified in the involved application. See *Newbridge Cutlery*, 113 USPQ2d at 1449. Based on the identified goods and services, the relevant public consists of individuals seeking “tattooing services, body piercing services, permanent makeup services, and cosmetic tattooing services,” as well as related goods and collateral merchandise demonstrating a consumer’s affinity for Applicant’s goods and services.

⁶ 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 . . .

A. Is the primary significance of “SoHo” in the mark SOHO INK a generally known geographic location?

Commencing with the first prong of analysis, we observe that Applicant’s applied-for mark SOHO INK is comprised of two distinct words. “Under the first prong of the test — whether the mark’s primary significance is a generally known geographic location — a composite mark such as applicant’s proposed mark must be evaluated as a whole. ... It is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.” *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (internal citations omitted).

“The 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). *See, e.g., In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (“It is clear that the primary significance of the designation CAROLINA APPAREL, APPAREL being generic and disclaimed by applicant, is geographic.”). In other words, “[h]ighly descriptive or generic wording does not convert a geographically descriptive term into a non-geographic term.” *In re Mankovitz*, 90 USPQ2d 1246, 1948 (TTAB 2009) (citing *In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993) (stylized mark FRENCH LINE primarily geographically descriptive of goods and services from France)); *In re Cambridge Digital Sys.*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design

primarily geographically descriptive when applicant's place of business is Cambridge, Massachusetts).

In support of the refusal, the Examining Attorney submitted the following WIKIPEDIA entry for "SoHo, Manhattan" showing that SoHo is a well-known geographical designation for a neighborhood located in New York City:⁷

SoHo is a neighborhood in Lower Manhattan, New York City, which in recent history came to the public's attention for being the location of many artists' lofts and art galleries, but is now better known for its variety of shops ranging from trendy upscale boutiques to national and international chain store outlets. The area's history is an archetypal example of inner-city regeneration and gentrification, encompassing socioeconomic, cultural, political, and architectural developments.

The name "SoHo" refers to the area being "South of Houston Street", a name coined in 1962 by Chester Rapkin an urban planner and author of The South Houston Industrial Area study, also known as the "Rapkin Report".

Almost all of SoHo is included in the SoHo Cast Iron Historic District which was designated by the New York City Preservation Commission in 1973, extended in 2010, and was listed on the National Register of Historic Places and declared a National Historic Landmark in 1978. It consists of 26 blocks and approximately 500 buildings, many of them incorporating cast-iron architectural elements. Many side streets in the district are paved with Belgian blocks.

⁷ https://en.wikipedia.org/wiki/SoHo,_Manhattan accessed on January 14, 2019, submitted with January 14, 2019 Priority Action at TSDR 11 (.pdf).

In terms of boundaries, the same WIKIPEDIA entry explains that while most sources agree that the northern boundary of SoHo is Houston Street and the southern boundary is Canal Street, the east and western boundaries are subject to debate:⁸

THE NEW YORK TIMES: Lafayette to the east and West Broadway to the west.

THE ENCYCLOPEDIA OF NEW YORK CITY and Google Maps: Crosby Street to the east and Sixth Avenue to the west.

NEW YORK MAGAZINE: Lafayette to the east and the Hudson River to the west.

Applicant counters that SoHo in New York City “is more than a geographic location,” “but has come to mean a certain style or artistic nature, due to various studios, galleries, shops, and restaurants” and is known as “a trendy haven for artists and for its upscale shopping.”⁹ In Applicant’s view, consumers associate SoHo with “art and shopping, not Applicant’s goods and services,” as “reinforced by the fact that there is also a SoHo neighborhood in London that is also considered a fashionable district.”¹⁰ Applicant also points to other meanings of SOHO, such as an abbreviation or acronym for the “Solar & Heliospheric Observatory, Save Our Heritage Organization, SOHO family of fonts, Small Office/Home Office, and the Society of Hematologic Oncology.”¹¹

⁸ https://en.wikipedia.org/wiki/SoHo,_Manhattan accessed on January 14, 2019, submitted with January 14, 2019 Priority Action at TSDR 12 (.pdf).

⁹ Applicant’s Brief, p. 3; 16 TTABVUE 7.

¹⁰ Applicant’s Brief, p. 3; 16 TTABVUE 7.

¹¹ Applicant’s Brief, p. 4; 16 TTABVUE 8.

We find persuasive the Examining Attorney's evidence that "SoHo" is a well-known geographic moniker for a neighborhood in New York City.¹² The fact that WIKIPEDIA has a dedicated entry for SoHo as a neighborhood in Manhattan demonstrates that the primary meaning of "SoHo" is that of a geographic location and is recognized as such by the relevant public. If the most prominent meaning or significance of a mark is geographic for the goods and/or services in an application, the fact that the mark may have other meanings in other contexts does not alter its geographic significance in the context of the application. *See In re Opryland USA Inc.*, 1 USPQ2d 1409, 1412-13 (TTAB 1986) (holding the mark THE NASHVILLE NETWORK primarily geographically descriptive of television program production and distribution services when finding that the primary significance of the term referred to Nashville, Tennessee and not that of a style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (noting that where MANHATTAN refers to a type of cocktail and to a geographic location that having an alternative meaning does not alter the mark's primary geographic significance in the context of the goods in the application); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (noting that where NEAPOLITAN refers to a type of ice cream and also means "pertaining to Naples, Italy" that having an alternative meaning does not alter the mark's primary geographic significance in the context of the goods in the application). Thus, while SoHo may also connote fashion or a trendy area for artists,

¹² "By contrast, that the geographic meaning of a location is 'minor, obscure [or] remote' indicates that the location is not generally known." *Newbridge Cutlery*, 113 USPQ2d at 1449.

a neighborhood in London, or constitute an abbreviation for various entities, these other meanings do not detract from its primary significance to the relevant public in the United States as a neighborhood in New York City.

A term can also be considered geographic even if it does not have exact geographic boundaries, i.e., if it refers to a “subdivision[] of the earth – regions, nations, counties, town[s], rivers, lakes, and other natural and artificial geographical units.” *Burke-Parsons-Bowlby v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 594, 10 USPQ2d 1443, 1445 (6th Cir. 1989) (quoting *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 485, 168 USPQ 609, 612 (5th Cir. 1971)) (finding the wording APPALACHIAN is a geographic term); see *In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761, 1764 (TTAB 1991) (finding primary significance of the wording “New England” is geographic). Such is the case here where the east and west boundaries of SoHo are disputed. Whether we consider Lafayette or Crosby Street as the eastern boundary, and the Hudson River or Sixth Avenue as the western boundary, does not alter our determination; any of these boundaries are acceptable lines of demarcation for SoHo.

Furthermore, the geographical significance of the designation “SoHo” is not diminished by the fact that, in Applicant’s mark, it precedes the merely descriptive, if not generic, disclaimed word “ink.” The online edition of MERRIAM-WEBSTER defines the word “ink,” when used as a noun, as “a colored usually liquid material for writing

and printing.”¹³ It also provides an informal definition of “ink” as a synonym of “tattoo.”¹⁴

informal : TATTOO

... got himself an elaborate tattoo, his first, **inked** along his right shoulder ...

—S. L. Price

Kaufman plans on **inking** a tat to memorialize his accident.

—Micah Abrams

His heavily muscled arms are **inked** shoulder to wrist.

—Eve Conant

Emphasis in original. We therefore find that the term INK in Applicant’s mark SOHO INK is, at a minimum, highly descriptive of Applicant’s International Class 2, 8, and 44 goods and services. In accordance with our case law, the presence of the highly descriptive term INK in Applicant’s mark does not detract from the primary geographical significance of the mark as a whole. *See, e.g., Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *6-7 (TTAB 2020) (CHARLESTON HARBOR TOURS primarily geographically descriptive of various travel tour and cruise services because TOURS is generic for the services and CHARLESTON HARBOR is a well-known harbor in Charleston, South Carolina); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014) (holding HOLLYWOOD

¹³ <https://www.merriam-webster.com/dictionary/ink> accessed on March 14, 2023. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

¹⁴ *Id.*

LAWYERS ONLINE primarily geographically descriptive of attorney referrals, online business information, and an online business directory).

Since the primary significance of SOHO in the mark SOHO INK is a generally known geographic location, i.e. a neighborhood in New York City, that is neither obscure nor remote, the first prong of establishing mere geographic descriptiveness is satisfied.

B. Do the International Class 2, 8, and 44 goods and services originate in SoHo?

We turn now to the second prong of the test, whether Applicant's goods and services originate from or are rendered in SoHo.

The Examining Attorney made the following information request pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b):¹⁵

Applicant must provide a written statement explaining whether the goods are or will be manufactured, packaged, shipped from, sold in or will have any other connection with the geographic location named in the mark.

Applicant must also provide a written statement explaining whether the services or any aspect of the services are or will be rendered in, or will have any other connection with, the geographic location named in the mark.

In response, Applicant confirmed that “[a] least some of Applicant's Goods¹⁶ are or will be sold in Applicant's location at 285 Lafayette St, New York, NY 10012” and

¹⁵ January 14, 2019 Priority Action, TSDR 1.

¹⁶ Applicant's response is vague. We interpret Applicant's statement that “at least some of Applicant's goods” means some goods in each of Applicant's identified International Classes 2, 8, and 25, are either sold or will be sold at its location at 285 Lafayette St, New York, NY 10012.

that “[t]attooing services, body piercing services, permanent makeup services, and cosmetic tattooing services, are or will be offered at Applicant’s location at 285 Lafayette St, New York, NY 10012.”¹⁷

The Examining Attorney also submitted corroborating evidence consisting of an excerpt from Yelp showing this same street address for Applicant,¹⁸ as well as an excerpt from MapQuest, showing Applicant’s location on Lafayette Street, south of Houston Street.¹⁹



As noted above, we acknowledge the disagreement from noted sources regarding the east/west boundaries of SoHo. However, that disagreement does not impact our analysis because “a product that is produced or a service that is provided near the geographic place named in the applied-for mark is sufficient to support a finding that the goods and/or services originate in that geographic location.” *City of London*

¹⁷ July 15, 2019 Response to Office Action, TSDR 3-4 (.pdf format).

¹⁸ <https://www.yelp.com/biz/soho-ink-new-york> accessed on January 14, 2019, submitted with January 14, 2019 Priority Action at TSDR 23 (.pdf).

¹⁹ <https://www.mapquest.com/us/new-york/soho-ink-387528100> accessed on April 25, 2020, submitted with April 26, 2020 Office Action, TSDR 9 (.pdf) (arrow added).

Distillery, Ltd. v. Hayman Grp. Ltd., 2020 USPQ2d 11487, at *9-10 (TTAB 2020) (holding CITY OF LONDON primarily geographically descriptive of gin distilled within and bottled near the city limits of London). Therefore, the second prong for establishing mere geographic descriptiveness has also been satisfied.

C. Are purchasers likely to believe that the goods or services originate in SoHo?

Last, we consider the final prong, whether the relevant purchasers would make an association between Applicant's goods and services with the place identified in the mark.

Applicant maintains that the evidence fails to show that consumers recognize an association between Applicant's tattooing, piercing, and cosmetic services in International Class 44 and the related goods in Classes 2 and 8 with the SoHo neighborhood in New York City.

Applicant's argument represents a misunderstanding of the case law. In instances where a geographic location is generally known and is neither obscure or remote, 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. *See Newbridge Cutlery*, 113 USPQ2d at 1449 (citations omitted). This principle applies here. As explained above, the record shows that "SoHo" is a "generally known" geographic designation, is "neither obscure or remote," and the term's geographic significance is its "primary significance." *Compare In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, 1827 (TTAB 2006) (finding Balashi, Aruba so obscure or remote that purchasers in the United States would not recognize it as

indicating the geographical source of applicant's beer). Here, we have already established that Applicant's business is located in the SoHo neighborhood of New York City on Lafayette Street, south of Houston Street, and that some of Applicant's goods are currently being or will be sold at its location at 285 Lafayette St, New York, NY 10012"²⁰ which is also in SoHo. Applicant also confirmed that its "[t]attooing services, body piercing services, permanent makeup services, and cosmetic tattooing services, are or will be offered"²¹ at the same address. Accordingly, a goods and services/place association may be presumed.

We hasten to add that even if we were not able to invoke this presumption, there is sufficient evidence in the record showing that the relevant consumers would associate Applicant's goods and services with SoHo. SoHo has a well-known reputation for its art galleries and as an artist colony,²² and tattooing has evolved into an art form for personal expression. Indeed, Applicant touts its tattoo service providers on its website as "resident artists" with their own portfolios of work.²³

In view of the foregoing, consumers are likely to believe that the goods are or will be sold and services are or will be rendered in SoHo, thereby satisfying the third prong.

²⁰ July 15, 2019 Response to Office Action, TSDR 3-4 (.pdf format).

²¹ *Id.*

²² https://en.wikipedia.org/wiki/SoHo,_Manhattan accessed on January 14, 2019, submitted with January 14, 2019 Priority Action at TSDR 11 (.pdf).

²³ <https://www.soho.ink/> accessed on December 31, 2020, submitted with December 31, 2020 Office Action at TSDR 14 (.pdf).

D. Conclusion

We find that the primary significance of Applicant's mark SOHO INK, when considered as a whole, is a well-known geographic location, namely a neighborhood in New York City, that is not minor, obscure or remote; that the goods and services in International Classes 2, 8 and 44 are either sold or are rendered at Applicant's location on Lafayette Street in SoHo; and that purchasers would make a goods/place association between Applicant's goods and services and the place named in the mark.²⁴ We therefore affirm the refusal under Section 2(e)(2).

II. Disclaimer Requirement– International Class 25

We now direct our attention to the refusal to register Applicant's clothing items identified in International Class 25 due to the failure to disclaim SOHO.

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 the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration

²⁴ In reaching our finding, we have considered the approximately 80 third-party registrations Applicant made of record to purportedly show that the Office does not treat SOHO as geographically descriptive. See July 15, 2019 Response to Office Action, TSDR 11-32 (.pdf); February 7, 2020 Response to Office Action, TSDR 39-121 (.pdf); and June 30, 2021 Request for Reconsideration TSDR 22-25 (.pdf). Applicant's third-party registration evidence lacks probative value. We are not privy to the registration files for each of the third-party registrations. This which would shed light on any evidence submitted pertaining to the second or third prongs of the test for geographically descriptive marks. Without this information, we cannot evaluate the utility of these third-party registrations.

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), 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).

Based on the evidence discussion in Section I., *supra*, SOHO, as used in the mark SOHO INK, in connection with Applicant's clothing items in International Class 25, is geographically descriptive. This is because all three prongs of the test for evaluating geographically descriptive terms have been satisfied.

The fact that the goods consist of clothing does not alter the geographical significance of SOHO. We can presume a goods/place association because Applicant confirmed, without any limitations as to international class, that some of its goods are or will be sold from its SoHo location.²⁵ And even in the absence of this presumption, within the context of Applicant's other goods and services in International Classes 2, 8, and 44, the clothing items consist of collateral

²⁵ July 15, 2019 Response to Office Action, TSDR 3-4 (.pdf format).

merchandise demonstrating a consumer's affinity for Applicant's goods and services sold and rendered in SoHo. The disclaimer requirement is therefore affirmed.

Decision: The Trademark Act Section 2(e)(2) refusal to register Applicant's mark SOHO INK as geographically descriptive of the goods and services identified in International Classes 2, 8, and 44 is affirmed.

The refusal to register Applicant's mark in the absence of a disclaimer of SOHO for the goods identified in International Class 25 is affirmed. However, this portion of the decision will be set aside if, within thirty (30) days of the mailing date of this decision, Applicant submits to the Board a proper disclaimer of SOHO. *See* Trademark Rule 2.142(g); 37 C.F.R. § 2.142(g). The standardized disclaimer format is as follows: "No claim is made to the exclusive right to use SOHO apart from the mark as shown."