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

Proceeding	91200223
Party	Defendant Laguna Candles
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UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

FLAME & WAX, INC.,	)	<b>Opposition No.: 91200223</b>
	)	<b>Serial No.:85/137,006</b>
Opposer,	)	<b>Regarding the Mark: LAGUNA CANDLES</b>
v.	)	
	)	<b>APPLICANT'S MOTION FOR LEAVE</b>
LAGUNA CANDLES,	)	<b>TO FILE SUBSTITUTE TRIAL BRIEF TO</b>
	)	<b>CURE A FORMAT VIOLATION</b>
Applicant.	)	
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**TO THE TRADEMARK TRIAL AND APPEAL BOARD:**

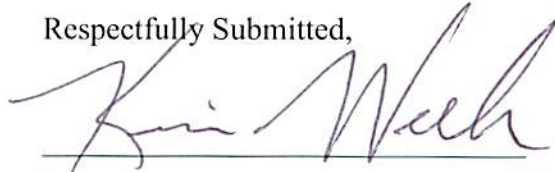
On July 26, 2013 Opposer, Flame & Wax, Inc. filed a Motion to Strike Applicant Laguna Candles' Trial Brief for, *inter alia*, a format violation, namely, a failure to include a table of contents and an alphabetical index of cited cases as prescribed in 37 C.F.R. § 2.128(b).

In the event that Applicant's Trial Brief is stricken for the identified format violation, the Board may, in its discretion, allow the offending party time to submits a *Substitute* Trial Brief complying with the requirements of 27 C.F.R. §2.128(b). See TBMP §539.

At this time Applicant respectfully requests leave to file the accompanying *Substitute* Trial Brief should the Board be persuaded by Opposer's argument. Applicant's *Substitute* Trail Brief contains no substantive changes.

Date: August 19, 2013

Respectfully Submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the following document:

APPLICANT'S MOTION FOR LEAVE TO FILE SUBSTITUTE TRIAL BRIEF TO  
CURE A FORMAT VIOLATION

*SUBSTITUTE TRIAL BRIEF*

has been served upon Opposer FLAME & WAS, INC., through counsel, by U.S. First Class  
Mail, postage prepaid, on August 19, 2013 at the following address:

Goodman, Mooney & Bernstein, LLP  
Att: Eric Goodman  
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Dated: August 19, 2013

By:   
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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LAGUNA CANDLES	)	
	)	
Applicant.	)	
_____	)	

***SUBSTITUTE TRIAL BRIEF FOR APPLICANT***

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## **I. INTRODUCTION AND STATEMENT OF THE FACTS**

Applicant Laguna Candles (“LC” or “Applicant”) is a small, family-owned purveyor of candles and home accessories primarily operated by Sharie Hendricks with the help of her husband Clarence and their two daughters Candice and Amy Hendricks. Sharie began LC over twelve years ago and has worked diligently to get the LAGUNA CANDLES brand of candles into various retail stores, spas, and hotels and to sell the LAGUNA CANDLES brand of candles directly to consumers throughout the United States via LC’s Internet website, [www.lagunacandles.com](http://www.lagunacandles.com), which has been operational and has displayed LC’s mark, LAGUNA CANDLES, since at least as early as January of 2002. *See* ANR Ex. I (TTABVUE #28) Attempting to take all the responsible steps to protect LC’s brand, Sharie also registered the fictitious business name “LAGUNA CANDLES” in Orange County in December of 2003 and again in October of 2008<sup>1</sup> to give notice to the public, especially residents of Orange County including Opposers, that she was doing business under the name LAGUNA CANDLES. *See* ANR Ex. H (TTABVUE #27).

Recently, Opposer, Flame & Wax, Inc. (“F&W”) has taken a liking to the mark LAGUNA CANDLES and began using variations of it causing confusion among both LC’s distributors and consumers alike. After discovering F&W’s use of the mark, LC took appropriate action by filing a federal trademark application for the mark LAGUNA CANDLES and sending a letter, through counsel, to F&W demanding that it cease any and all use of the mark. *See* Artsten Decl. (TTABVUA#38). F&W disregarded LC’s demand and initiated the instant Opposition proceeding alleging that the mark LAGUNA CANDLE is primarily geographically descriptive, and therefore, can be used by F&W with impunity.

LC disagrees with this determination because, *inter alia*: 1) the *primary* meaning of the word LAGUNA is its not as an indicator of a geographic place or location- it is either its dictionary definition or a suggestion of the quality of the goods ANR Ex. A,B,C, and D (TTABVUE #27); 2) the candles purveyed by LC in conjunction with the mark LAGUNA CANDLES do not originate in the City of Laguna Beach ANR Ex. J (TTABVUE #28) ; 3) there does not exist a goods-place association between the candles purveyed by LC and the City of Laguna Beach as the City of Laguna Beach is not known for the manufacture of candles ANR F,

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<sup>1</sup> In Orange County fictitious business name registrations must be renewed every 5 years.

G, and H (TTABVUE #27).; and 4) finally, even in the event that the mark LAGUNA CANDLES is determined by the Board to be primarily geographically descriptive, Applicant's continuous use of the mark for well over a decade has established sufficient secondary meaning to support registration. ANR Ex. I and J (TTABVUE #28).

At this time Applicant respectfully requests that the Board reject Opposer's arguments and allow the application at issue to proceed to registration, or alternatively, Applicant respectfully requests that the Board return the application at issue to the Examining Attorney for further proceedings regarding whether Applicant's continuous use in U.S. commerce of the mark LAGUNA CANDLES for more than ten years is sufficient to establish secondary meaning.

## **II. DESCRIPTION OF FACTUAL RECORD**

Applicant adopts Opposer's Description of the Factual record.

## **III. ARGUMENT**

### **a. Legal Standard**

The test for whether a mark is "primarily geographically descriptive" pursuant to §2(e)(2) of the Trademark Act is a multipart determination that includes determining: 1) whether the mark in question primarily denotes a geographic place or location; 2) whether the goods and/or services originate, or are connected to, the geographic place or location; and 3) whether there exist a goods-place association in the minds of the consumer. 15 U.S.C. §1052(e)(2).

If a mark is found to be geographically descriptive of the geographic location of the origin of goods or services then the mark is regarded by the law as being not inherently distinctive. However, such marks may still be protected as trademarks upon acquiring distinctiveness through use. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 112 S. Ct. 2753, 2758, 23 U.S.P.Q.2d 1081, 1084 (1992) ("Section 2 of the Lanham Act provides that a descriptive mark that otherwise could not be registered under the Act may be registered if it 'has become distinctive of the applicant's goods in commerce.' ... This acquired distinctiveness is generally called 'secondary meaning.'").

Further, in an opposition proceeding, the opposer has the initial burden to present prima facie evidence or argument upon which the Board could reasonably conclude that applicant's mark has not acquired distinctiveness (secondary meaning). If opposer carries this initial burden, then the burden of proof shifts to the applicant to prove by at least a preponderance of the evidence that the mark has acquired distinctiveness. *Stuart Spector Designs, Ltd. v. Fender*



*Musical Instruments Corporation*, 94 U.S.P.Q.2d 1549, 2009 WL 804142 (T.T.A.B. 2009). (Opposer carried its initial burden of prima face evidence or argument supporting a lack of acquired distinctiveness (secondary meaning) and applicant failed to prove by a preponderance of the evidence that the shape of FENDER guitar bodies had achieved a secondary meaning.).

**b. The *Primary* Significance of the Word “LAGUNA” in the mark LAGUNA CANDLES is Not as an Indicator of a Geographic Place or Location.**

The 1946 Lanham Act, by use of the words “primarily geographically descriptive,” steered away from the prior practice of the Trademark Office of looking a word up in an atlas or gazetteer and then refusing registration if there was any place on earth called by that word. “[O]ne purpose of the Trademark Act of 1946 ... was to change the former statute under which any term could be refused registration solely by reason of a geographical meaning, regardless of whether the geographic meaning of the word was minor or obscure or remote, or could not conceivably have any connection with the goods.” *Ex parte London Gramophone Corp.*, 98 U.S.P.Q. 362 (Chief Examiner 1953). The Fifth Circuit has further cautioned that: “The word ‘primarily’ should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote, or unconnected with the goods.” *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 168 U.S.P.Q. 609 (5th Cir. 1971). *In re Waldron Furniture Mfg. Corp.*, 149 U.S.P.Q. 460 (T.T.A.B. 1966); *In re Penn Dairies, Inc.*, 137 U.S.P.Q. 168 (T.T.A.B. 1963) (LADY PENN ice cream).

Further, a mark that has a popular significance apart from its geographical meaning is *not*, in most cases, “primarily” geographical. For example, HOLLYWOOD and a star design was held not geographically descriptive of french fries and fast food restaurants because in that context HOLLYWOOD denotes the movie industry in general rather a district in Los Angeles. *In re International Taste Inc.*, 53 U.S.P.Q.2d 1604, 2000 WL 177409 (Trademark Trial & App. Bd. 2000) (the star design increased the connection with the movie industry rather than the geographic place).

In the application at issue, Applicant asserts that the *primary* meaning of the term “LAGUNA” in the mark LAGUNA CANDLES is its dictionary definition: a lagoon, lake, or pond. The word has existed for centuries, far longer than the City of Laguna Beach, and has essentially the same definition in several languages: English; Czech; Italian; Polish; Serbo-

Croatian; and Spanish. See ANR Ex. A,B, and C (TTABVUE #27). In relation to Applicant's goods the word LAGUNA is arbitrary and therefore is eligible for registration.

Opposer would like the Board to overlook the statutory requirement that the geographic significance of the term LAGUNA must be found to be the *primary* significance and focus rather on whether the term LAGUNA has *some* or *any* geographic significance. Such a broad interpretation would render the term *primary* irrelevant and is contrary to principles of statutory construction and the intention of the statute as recognized by courts as stated above.

Opposer further urges the Board to analyze the mark as if the mark was LAGUNA BEACH CANDLES and provides evidence of the definition of the City of Laguna Beach and states that "undisputed evidence shows that Laguna Beach, commonly known as Laguna, is a coastal community in Southern California well known for its artisan and resort like culture." See Opposer's brief, page 6.

As is often the case when a party unilaterally states that its evidence is undisputed, Applicant respectfully disputes a portion of that statement. Applicant rejects the prospect that the City of Laguna Beach is commonly known as "Laguna." Applicant submits that due to the proximity of the City of Laguna Hills, the City of Laguna Niguel, and the City of Laguna Woods, that the use of the LAGUNA alone is not specific enough to identify any one particular city and consequently is not used commonly. See ANR Ex. D (TTABVUE #27). Applicant argues that the City of Laguna Beach is commonly referred to as "Laguna Beach." Applicant's assertion is supported by the majority of Opposer's evidence which uses the designation "Laguna Beach" throughout. See ONR Generally. Further, for the purposes of this proceeding, Applicant submits that Opposer has failed to provide adequate evidence that the City of Laguna Beach is commonly referred to as Laguna." See ONR Generally.

Regarding the remainder of the statement, Applicant agrees that the City of Laguna Beach is well known for its artisan and resort-like culture. In fact, Applicant submits that such an argument supports eligibility of registration. If a mark mainly serves to convey an idea about the quality of style of the product, the primary purpose of the mark is to be suggestive, rather than geographic. For instance, the court in *Jacques Bernier* noted that "FIFTH AVENUE" for luxury cars and "HYDE PARK" for clothing would be examples of such use. *Jacques Bernier, Inc.*, 894 F.2d 389, 391, 13 USPQ2d 1725. These usages primarily refer to the quality of the product, rather than the geographic origin. *Id.* Thus, registration was allowed for "RODEO

DRIVE” for perfume. *Id.* Although Rodeo Drive is a location, the mark primarily used the location to evoke images of Hollywood, wealth, and trendsetting, rather than to indicate source location.

In the instant proceeding, as stated by Opposer, Applicant’s website states “Not just a candle, but a lifestyle.” Such a statement is evidence that the word “LAGUNA” is a suggestive reference to the artisan resort-like culture rather than a geographic designation and, as such, is not primarily geographically descriptive.

Should the Board not accept that the primary significance of the word “LAGUNA” is its dictionary definition, Applicant submits, alternatively, that the word “LAGUNA” may be viewed as a suggestive reference that the quality of the product is equal to that of the artisan, resort-like culture.

**c. The Goods for Which Applicant Seeks Registration do not Originate in the Geographical Location From Which Opposer Alleges the Mark is Descriptive**

When determining whether a mark is primarily geographically descriptive, if the goods in fact come from the place named, then most such terms will indicate a geographical place to most customers. In such cases, the Trademark Board will presume that there is a goods/place association. However, this presumption does not apply if the applicant's goods are not exactly from the location named. The presumption of a goods/place association is not triggered by the mere fact that corporate headquarters is in the place named. Rather, the goods themselves must come from the place named. *In re Gale Hayman, Inc.*, 15 U.S.P.Q.2d 1478 (T.T.A.B. 1990) (SUNSET BOULEVARD for perfume is not primarily geographically descriptive where applicant's office is in Century City area of Los Angeles, not on Sunset Blvd. “Nothing in the record, however, indicates or even suggests that purchasers would believe that Sunset Boulevard was the place of manufacture or production of the perfume and cologne.”)

In the instant matter, none of the candles or materials from which the candles are made are manufactured in the City of Laguna Beach. As acknowledged by opposer, LC’s candles suppliers are located in Ohio, Los Angeles, and North Hollywood. See ANR, Exh. J, Response to Interrogatory 8 (TTABVUE #28). As such, it would be inappropriate to give Opposer the benefit of a presumption of goods/place association.

Further, Opposer argues that the goods/place association may be found because LC is located in the City of Laguna Beach. Applicant submits this argument is unpersuasive because LC is merely located in the City of Laguna Beach because it is run out of the Laguna Beach home of Sharie and Clarence Hendricks and the Board has previously stated on numerous occasions that the location of a corporate headquarters is not necessarily enough to establish a good/place association. In re John Harvey & Sons Ltd., 32 USPQ2d 1451, 1454 (TTAB 1994) (“[T]he mere fact that applicant’s headquarters are in Bristol, England does not mandate a finding here that a goods/place association should be presumed.”); *In Re Zeller*, Appeal No.: 77544307 (TTAB 2009) (Finding that living on Catalina Island insufficient to form goods/place association regarding the mark CATALINA ISLAND GRANOLA).

**d. The City of Laguna Beach is Not Known for Manufacturing Candles**

If the presumption of a good-place association is rebutted, it could be proven that customers would not associate the goods with that place named. Applicant submits that a reasonable consumer would not presume that Applicant LC’s goods because the City of Laguna Beach has relatively few purveyors or candles. Applicant provides a list of Orange County companies on the website [www.madeinoc.com](http://www.madeinoc.com). The list shows that the City of Laguna Beach is the home to only one other candles company. ANR Ex. F (TTABVUE #27). This does not support a finding that the City of Laguna Beach as known a city that manufactures candles. Applicant also provides printout of the search results for the search term “candle” near the city of Laguna Beach on the Internet website [www.yellowpages.com](http://www.yellowpages.com). The search shows that there are far more purveyors of candles in the surrounding cities than in the city of Laguna Beach. ANR Ex. G (TTABVUE #27). This does not support a finding that the City of Laguna Beach is known for purveyors of candles. Applicant also provided a printout from the National Candles Association, [www.candles.org](http://www.candles.org). The printout lists the names and addresses of all its members including Opposer F&W. (TTABVUE #27). None of the members are located in the city of Laguna Beach. This does not support a finding that is City of Laguna Beach is significantly associated with the production, manufacture, or sale of candles. Applicant respectfully request that the Board find that there exist no significant goods/place association in the instant matter.

**e. Opposer has Failed Present a Prima Facie Case that Applicant Has Not Achieved Secondary Meaning in its Mark LAGUNA CANDLES**

In an opposition proceeding, the opposer has the initial burden to present prima facie evidence or argument upon which the Board could reasonably conclude that applicant's mark has not acquired distinctiveness (secondary meaning). If the opposer carries this initial burden, then the burden of proof shifts to the applicant to prove by at least a preponderance of the evidence that the mark has acquired distinctiveness. Yamaha Intern. Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 1576, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988); American Flange & Manufacturing Co., Inc. v. Rieke Corporation, 80 U.S.P.Q.2d 1397, 1411, 2006 WL 1706438 (T.T.A.B. 2006) (product design was found not to have acquired distinctiveness and opposition was sustained), decision withdrawn after settlement, 90 U.S.P.Q. 2d 1127, 2009 WL 770683 (T.T.A.B. 2009); Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corporation, 94 U.S.P.Q.2d 1549, 2009 WL 804142 (T.T.A.B. 2009) (Opposer carried its initial burden of prima face evidence or argument supporting a lack of acquired distinctiveness (secondary meaning) and applicant failed to prove by a preponderance of the evidence that the shape of FENDER guitar bodies had achieved a secondary meaning).

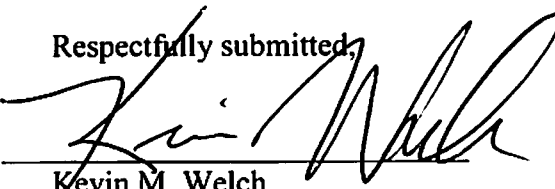
Here, Opposer urges the Board to find that the mark LAGUNA CANDLES is primarily geographically descriptive but is silent as to the issue of whether Applicant has achieved secondary meaning in the mark LAGUNA CANDLES over the last decade of use. For Opposer to prevail in preventing the registration of Applicant's mark, Opposer must present a prima facie case both that Applicant's mark is primarily geographically descriptive *and* that there exist not secondary meaning. Applicant evidence from the Internet Archive, the Way Back Machine, that LC has been using the mark LAGUNA CANDLE in U.S. Commerce for at least ten years. ANR Ex. J (TTABVUE #28). Applicant submits both that opposer failed to present evidence supporting a prima facie case that Applicant's mark has not achieved secondary meaning *and* Applicant has provided evidence of significant use in commerce.

**IV. CONCLUSION**

For the above mentioned reasons Applicant respectfully requests that the Board reject Opposer's arguments and allow the instant application to proceed to registration, or alternatively, return the application to the Examining Attorney for further proceeding regarding whether

Applicant has achieved secondary meaning in its mark LAGUNA CANDLES over the course of its ten years of use in commerce.

Dated: August 19, 2013

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