

THIS OPINION IS NOT A  
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Mailed:  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Flame & Wax, Inc.*  
*v.*  
*Laguna Candles*

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Opposition No. 91200223

Amanda J. Mooney of Goodman Mooney Bernstein LLP for Flame & Wax, Inc.

Kevin Matthew Welch of The Law Offices of Kevin M. Welch for Laguna Candles.

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Before Cataldo, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Laguna Candles, a sole proprietorship composed of Candice Hendricks (“applicant”), filed a use based application for the mark LAGUNA CANDLES, in standard character form, for “candles and fragrant candles,” in Class 4.<sup>1</sup> Applicant disclaimed the exclusive right to use the word “candles.”

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<sup>1</sup> We note that applicant’s brief states that Laguna Candles is “primarily operated by Sharie Hendricks.” (Applicant’s Brief, p. 1; TTABVue 40, p. 3). However, pursuant to an Examiner’s Amendment dated January 5, 2011, applicant identified herself as “Laguna Candles, a Sole Proprietorship, comprised of Candice Hendricks.”

Flame & Wax, Inc. (“opposer”) opposed the registration of applicant’s mark on the ground that the mark LAGUNA CANDLES for candles is primarily geographically descriptive. Section 2(e)(2) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(2). Applicant, in her answer, denied the salient allegations in the notice of opposition.

I. Preliminary Issues

A. Opposer’s motion to strike applicant’s brief.

Pursuant to the Board’s order dated March 1, 2013, opposer’s brief on the case was due June 11, 2013 and applicant’s brief was due on July 11, 2013. Applicant filed its brief on July 12, 2013. Opposer moved to strike applicant’s brief on the ground that it was not timely filed. While applicant failed to provide an explanation for her late-filed brief, we find that applicant’s tardiness, by one day, likely was the result of a miscalculation made without bad faith, and there is no indication of prejudice to opposer. Moreover, it serves the Board’s policy of deciding cases on their merits and it benefits the Board in its ability to make a just determination of the case to have the briefs of both parties before it. Accordingly, opposer’s motion to strike applicant’s brief on the case is denied.

B. Whether applicant’s claim that its mark acquired distinctiveness was tried by implied consent?

Applicant, in her answer, denied the salient allegations in the notice of opposition; but she did not plead as an affirmative defense that her mark had acquired distinctiveness or secondary meaning. During her testimony period, applicant introduced through a notice of reliance Exhibits H and I to prove that her

mark had acquired distinctiveness. Applicant's Exhibit H comprise "Certified Registered Fictitious name Statements from Orange County showing that Applicant has been using the mark LAGUNA CANDLES continuously in commerce since at least as early as 7/1/2003, relevant to whether applicant has achieved second meaning in Applicant's applied for mark."<sup>2</sup> (Emphasis added).

Applicant's Exhibit I consists of "printouts from the Internet Archive company showing that Applicant has been using the mark LAGUNA CANDLES on an Internet Website since at least as early as May of 2002, relevant to whether Applicant has achieved second meaning for the applied for mark."<sup>3</sup> (Emphasis added).

Opposer did not object to applicant's exhibits H and I. During its rebuttal testimony, opposer introduced the declaration of its President who testified that applicant does "not have any significant market share in the candle or home fragrance industry. They are essentially unknown in the marketplace."<sup>4</sup> In its reply brief, opposer did not object to applicant's exhibits H and I and addressed the substance of applicant's claim of acquired distinctiveness.<sup>5</sup>

As noted above, applicant did not plead as an affirmative defense that her mark had acquired distinctiveness and her mere denial that her mark was not primarily geographically descriptive is not sufficient to put opposer on notice that

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<sup>2</sup> Applicant's notice of reliance (TTABVue 27, p. 3).

<sup>3</sup> *Id.*

<sup>4</sup> Declaration of Troy Arnsten ¶11 (TTABVue 38). The parties stipulated that direct testimony may be introduced by declaration or affidavit. (TTABVue 9).

<sup>5</sup> Opposer's Reply Brief, pp. 7-9 (TTABVue 42, pp. 11-13).

that applicant's mark had acquired distinctiveness. However, applicant's statement that it was introducing her Exhibits H and I to prove acquired distinctiveness, opposer's rebuttal testimony regarding applicant's marketplace renown, and opposer's reference to that claim in its reply brief demonstrate that opposer was on notice that applicant was claiming that her mark had acquired distinctiveness and opposer responded to that affirmative defense. In view thereof, we find that applicant's claim that her mark had acquired distinctiveness was tried by implied consent and we deem applicant's answer to be amended to add the affirmative defense that her mark acquired distinctiveness to conform to the evidence. *See Fed. R. Civ. P. 15(b)(2)*.

## II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant's application file. In addition, the parties introduced the following testimony and evidence:

### A. Opposer's testimony and evidence.

1. Notice of reliance on the following items:
  - a. Copies of opposer's website and other Internet evidence displaying advertisements for opposer's products (TTABVue 16).  
*See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010);
  - b. Copies of applicant's website and other Internet evidence displaying advertisements for applicant's products (TTABVue

- 17);
- c. Applicant's responses to opposer's first set of interrogatories (TTABVue 18); and
  - d. Internet evidence regarding Laguna Beach (TTABVue 20);
- 2. Notice of reliance on dictionary definitions and encyclopedia entries for Laguna Beach (TTABVue 19);<sup>6</sup>
  - 3. Notice of reliance on applicant's responses to opposer's request for production of documents (TTABVue 21);<sup>7</sup>
  - 4. Notice of reliance on third-party registrations (TTABVue 22);<sup>8</sup> and
  - 5. Declaration of Troy Arnsten, opposer's President, with an attached exhibit (TTABVue 38).

B. Applicant's evidence.

Applicant introduced a notice of reliance of the following items:

- 1. Dictionary definitions of the word "Laguna" (TTABVue 27);
- 2. Internet evidence regarding the word "Laguna" used as part of the name of various cities in California (TTABVue 27);

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<sup>6</sup> This notice of reliance was filed twice (TTABVue 23).

<sup>7</sup> Although the stipulation regarding the introduction of evidence filed by the parties provided that documents produced in response to discovery are considered authentic, it did not provide that the documents may be introduced through a notice of reliance. Trademark Rule 2.120(j)(3)(ii) provides that "[a] party that has obtained documents from another party ... under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone." Because applicant did not object to this notice of reliance and adopted opposer's statement of the record including the introduction of documents produced in response to opposer's document requests, we find that the stipulation of the parties includes documents produced in response to written discovery.

This notice of reliance was filed twice (TTABVue 24).

<sup>8</sup> This notice of reliance was filed twice (TTABVue 25).

3. Internet list of companies located in Laguna Beach (TTABVue 27);
4. Search results from yellowpages.com for the word “candle” near Laguna Beach (TTABVue 27);
5. “Certified Registered Fictitious Name Statements from Orange County showing that Applicant has been using the mark LAGUNA CANDLES continuously in commerce since at least as early as 7/1/2003” (TTABVue 27);
6. “Printouts from the Internet Archive company showing that Applicant has been using the mark LAGUNA CANDLES on an Internet Website since at least as early as May of 2002” (TTABVue 28); and
7. Applicant’s unredacted Response to Opposer’s First Set of Interrogatories (TTABVue 28).<sup>9</sup>

### III. Whether opposer has standing?

To allege standing within the meaning of Section 13 of the Trademark Act, 15 U.C.S. §1063, an opposer must plead and prove facts sufficient to show that it has a

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<sup>9</sup> Trademark Rule 2.120(j)(3)(i)(5) provides the responses to interrogatories may be introduced through a notice of reliance “only by the receiving or inquiring party, except that, if fewer than all of the ... answers to interrogatories ... are offered into evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other ... answers to interrogatories ... which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional ... discovery responses ... and absent such statement the Board, in its discretion, may refuse to consider the ... responses.” Applicant did not include a statement explaining why she needs to rely on each of the additional interrogatory responses. However, because opposer did not object to applicant’s introduction of her entire responses to the interrogatories, we will consider them as having been stipulated into the record.

direct and personal stake in the outcome of the opposition and a reasonable basis for its belief that it will be damaged. *See Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). The focus must be on whether opposer has shown a reasonable basis for its belief in damage, and there is no requirement that any actual “damage” be pled or proved to establish standing or even to prevail in an opposition proceeding. In a case involving the assertion of an equal right to use a term, the question is whether the presumptions flowing from the potential registration are damaging to opposer’s right to legal and continuous use of that term. Competitors in the same field or industry as applicant have a personal stake in the resolution of the question. *See Duramax Marine LLC v. R.W. Fernstrum & Co*, 80 USPQ2d 1780, 1787 (TTAB 2006); *M-5 Steel Manufacturing v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1094 (TTAB 2001); and *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999).

Troy Arnsten, opposer’s President, testified that opposer “created its first scented candle in 1999 and soon was known for its high-end, clean burning and fragrant candles,” that its products are sold throughout the country, and that “in early 2010, [opposer] commenced sales of its ‘Maison Laguna’ line of candles.”<sup>10</sup> Arnsten’s testimony is corroborated by the copies of opposer’s website and the websites of third-party retailers introduced into evidence displaying advertising for

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<sup>10</sup> Arnsten Dec., ¶¶ 3-6 (TTABVue 38).

the sale of opposer's candles.<sup>11</sup> In view of the foregoing, opposer has proven its standing.

IV. Whether LAGUNA CANDLES is primarily geographically descriptive?

Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), prohibits registration on the Principal Register of a mark that is primarily geographically descriptive of the goods or services named in the application. To establish a prima facie case for refusal to register a mark as primarily geographically descriptive, opposer must prove that:

1. the primary significance of the mark is a generally known geographic location;
2. 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). *See also In re Societe Generales des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987) (“a prima facie case of unregistrability cannot be made out simply by evidence showing that the mark sought to be registered is the name of a place generally known to the public; it is also necessary to show that the public would make a goods/place association, i.e., believe that the goods for which the mark is sought to be registered originate in that place.”); *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1616 (TTAB 2007) (“Provided that these conditions are met and the goods from the place named by in or in the mark, the mark is primarily geographically descriptive.”).

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<sup>11</sup> TTABVue 16, pp. 12 - 33

A. Whether the primary significance of LAGUNA CANDLES is a generally known geographic location?

A mark is not “primarily” geographic where the geographic meaning is minor, obscure, remote, or unconnected with the goods. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1540 (Fed. Cir. 1999); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 867 (Fed. Cir. 1985) (use of a geographic term in a fictitious, arbitrary or fanciful manner, is not “primarily” as a geographic designation). Thus, registration should not be refused where, for example, the place named in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied; or an admittedly well-recognized term has other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. *See In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849 (TTAB 1982).

A geographic nickname (e.g., “Big Apple” or “Motown”), or an abbreviation or other variant of the name 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 (holding that “Yosemite” – a well-recognized and frequently used shorthand reference to Yosemite National Park and the Yosemite region in general – conveys a readily recognizable geographic significance); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services, where the evidence showed that “Carolina” is used to indicate either the state of North Carolina or the state of South Carolina). *But see*

*In re Trans Cont'l Records, Inc.*, 62 USPQ2d 1541 (TTAB 2002) (O-TOWN found to be a “relatively obscure term” that would *not* be perceived by a significant portion of the purchasing public as a geographic reference to Orlando, Florida).

The fact that the mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. Thus, if applicant submits evidence demonstrating that the geographic term has another meaning, the Board must determine whether the *primary* significance is geographic. If so, registration must be refused under § 2(e)(2). *See, e.g., In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (THE NASHVILLE NETWORK held primarily geographically descriptive of television program production and distribution services, the Board finding that the primary significance of the term was Nashville, Tennessee, and not that of a style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (the fact that MANHATTAN identifies an alcoholic cocktail does not alter the primary significance of that term as a borough of New York City); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (finding that the fact that NEAPOLITAN identifies, among other things, a type of ice cream, does not alter the primary significance of that term as meaning “of or pertaining to Naples in Italy”).

The fact that the mark 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) (DURANGO held primarily geographically deceptively misdescriptive of chewing tobacco not

grown in Durango, Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that area, even though there is more than one place named Durango); *In re Cambridge Digital Sys.*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily geographically descriptive of computer systems and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge).

Laguna Beach is a city in southwest California near Long Beach.<sup>12</sup> It is a resort and artists' colony<sup>13</sup> that "now draws millions of visitors annually."<sup>14</sup> The tourism industry is a mainstay of the local economy because it is "one of the most beautiful seaside resorts in the West as well as a famous California art colony."<sup>15</sup> *Coastal Living* magazine identified Laguna Beach as one of the "Top 10 Artists Colonies."<sup>16</sup> "Applicant agrees that the City of Laguna Beach is well known for its artisan and resort-like culture."<sup>17</sup>

In 1979, Laguna Beach was described as "a paradise, an inexhaustible source of inspiration" by artist Marco Sassone, one of the many artists who made the "idyllic" town home since the 1920s.<sup>18</sup>

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<sup>12</sup> *Merriam-Webster Dictionary* (m-w.com) (TTABVue 19, p. 6)

<sup>13</sup> **WEBSTER'S NEW GEOGRAPHICAL DICTIONARY** (1988) (TTABVue 19, p. 11); Britannica.com (TTABVue 19, p. 13); *Wikipedia.org* (TTABVue 20, p. 4).

<sup>14</sup> Britannica.com (TTABVue 19, p. 13); *Wikipedia.org* (TTABVue 20, p. 4).

<sup>15</sup> *Wikipedia.org* (TTABVue 20, p. 4).

<sup>16</sup> Coastalliving.com (TTABVue 20, p. 12).

<sup>17</sup> Applicant's Brief, p. 4 (TTABVue 40, p. 6).

<sup>18</sup> *Wikipedia.org* (TTABVue 20, p. 6).

The evidence of record has many instances of Laguna Beach referred to as Laguna. The Laguna Beach Chamber of Commerce sent an email to applicant on September 7, 2009, inviting her to participate in the “Taste of Laguna” and Community EXPO which includes a trade show where applicant could introduce her products.<sup>19</sup>

The San Diego Union Tribune website posted an article about Laguna Beach dated July 13, 2003 where the author referred to Laguna Beach as Laguna.<sup>20</sup>

[A new hotel] Situated on a bluff 50 feet above Laguna’s denim-blue waters, it has a 20,000-square-foot spa, a public park, tide pools, seaside covers, lush gardens, beach path of moonlit strolls and four gourmet restaurant.

\* \* \*

Seek a shady respite from the sun on the leafy side streets of downtown Laguna.

\* \* \*

You’ll love the loveliest of Laguna’s 20 parks, Heisler Park.

\* \* \*

Laguna in the summer is a feast of festivals that includes the Art-A-Fair Festival, with more than 140 exhibiting artists; the Sawdust Art Festival, a vast village of quality art and crafts; and the famed Festival of Arts and Pageant of the Masters, a world-renowned event with a spectacular stage production.

The only problem with Laguna is that there’s so much to do and see, it’s difficult to decide which bits to leave out.

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<sup>19</sup> Applicant’s response to opposer’s request for production of documents (TTABVue 21, p. 38).

<sup>20</sup> SignOnSanDiego.com (TTABVue 20, p. 18)

But it's an easy problem to solve – a return visit is just an hour's drive away.

See also an article posted on the *Orange County Register* website (June 29, 2012),<sup>21</sup> *New York Times* article (October 19, 2012),<sup>22</sup> *Laguna Beach Magazine*,<sup>23</sup> Laguna Beach Visitors & Convention Bureau website,<sup>24</sup> and the Art A-Fair website<sup>25</sup> all featuring references to Laguna Beach as Laguna.

The “oldest and longest-standing theater” in Laguna Beach is The Laguna Playhouse.<sup>26</sup> A nonprofit coalition of arts educators, professional artists and art advocates in Laguna Beach is the Laguna Outreach for Community Arts.<sup>27</sup> The Laguna Beach art museum is Laguna Art Museum.<sup>28</sup> In 2002, The Laguna Beach School of Art changed its name to Laguna College of Art & Design.<sup>29</sup>

A profile of Dr. Ari Novick, a certified anger management professional in Laguna Beach, included the following passage:

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<sup>21</sup> Ocregister.com (TTABVue 20, p. 21).

<sup>22</sup> Travel.nytimes.com (TTABVue 20, pp. 32, 34, 35).

<sup>23</sup> Lagunabeachmagazine.com (TTABVue 20, p. 41) (“Did you know that one of Laguna’s most posh resorts is also one of the greenest?”).

<sup>24</sup> Lagunabeachinfo.blogspot.com (TTABVue 20, p. 52) (“Laguna was the perfect setting for to [sic] the ‘Plein Air’ philosophy.”).

<sup>25</sup> Art-a-fair.com (TTABVue 20, p. 75) (“Laguna Beach is famous for its artists’ community. But Art-A-Fair goes beyond to discover artists from around the world and in other parts of the country who live right here in Laguna.”).

<sup>26</sup> *Laguna Beach Magazine* (lagunabeachmagazine.com) (TTABVue 20, p. 40); Laguna Beach Alliance for the Arts website (lagunabeachcharts.org) (TTABVue 20, p. 67) .

<sup>27</sup> Locaarts.org (TTABVue 20, p. 60).

<sup>28</sup> Laguna Beach Alliance for the Arts website (lagunabeachcharts.org) (TTABVue 20, p. 66).

<sup>29</sup> Laguna Beach Alliance for the Arts website (lagunabeachcharts.org) (TTABVue 20, p. 68).

When asked about anger among Lagunans, Ari says, “I think if we looked at Laguna in comparison with other parts of the country, I would suspect that anger management issues are relatively low.”<sup>30</sup>

Applicant submitted the evidence discussed below to prove that the name “Laguna” has meanings other than Laguna Beach.

1. The word “Laguna” is also defined as a “lagoon, lake, pond.”<sup>31</sup>
2. *Wikipedia.org* entry for “Laguna” providing information that Laguna is a surname and the name for multiple geographic locations, most notably Laguna Army Airfield in Arizona, Laguna Imperial County in California and Laguna, New Mexico.<sup>32</sup>

- a. The *Wikipedia.org* entry for Laguna, Imperial County, California states that “Laguna is a former settlement in Imperial County, California.”<sup>33</sup> There is no indication that it currently exists.

- b. The *Wikipedia.org* entry for Laguna Army Airfield states that it “is a military airport located at Yuma Proving Ground” outside of Yuma, Arizona. It has two asphalt paved runways.<sup>34</sup> No there is no other information provided

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<sup>30</sup> *Id.* at p. 41.

<sup>31</sup> **WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY** (TTABVue 27, p. 6). *See also* Dictionary.com (TTABVue 27, p. 7) (“a Pueblo Indian people of west central New Mexico”); *Wikipedia.org* (TTABVue 27, p. 13)..

<sup>32</sup> TTABVue 27, p. 13. The *Wikipedia.org* entries regarding Laguna province in the Philippines, Laguna, a Brazilian city, and Laguna City, a housing complex in Hong Kong while demonstrating that Laguna indicates multiple geographic locations, does not persuade us that that the primary significance of Laguna to people in the United States is anything other than Laguna Beach.

<sup>33</sup> TTABVue 27, p. 30.

<sup>34</sup> TTABVue 27, p. 31.

about this base such as the number of people stationed there, the amount of air traffic it handles, or anything else regarding its renown.

3. Excerpts from the websites of Laguna Niguel, California,<sup>35</sup> Laguna Hills, California,<sup>36</sup> and Laguna Woods, California.<sup>37</sup> None of these websites provide any information regarding the renown of these cities that would detract from our finding that the primary significance of the name Laguna is anything other than Laguna Beach. We note that while Laguna Beach, Laguna Hills, Laguna Niguel and Laguna Woods are all cities located in Orange County, California,<sup>38</sup> Laguna Beach is the only city, at least according to this record, for which there is any renown outside of Orange County as evidenced by the fact that the dictionary and encyclopedia entries of record reference only Laguna Beach.

We are satisfied with opposer's evidence demonstrating that Laguna is primarily a geographic term that pertains to Laguna Beach, California.

B. Whether purchasers would be likely to believe that opposer's candles originate in Laguna Beach?

Whether a term is primarily geographically descriptive under § 2(e)(2) depends on whether the mark identifies the place from which the applicant's candles originate. Goods "originate" from a geographic location if, for example, they are manufactured, produced, or sold there. *See Fred Hayman Beverly Hills Inc. v.*

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<sup>35</sup> TTABVue 27, p. 33.

<sup>36</sup> TTABVue 27, p. 34.

<sup>37</sup> TTABVue 27, p. 36.

<sup>38</sup> *Wikipedia.org* (TTABVue 27, p. 44). *See also Wikipedia.org* (TTABVue 20, p. 5 (Laguna Woods borders Laguna Beach on the northeast and Laguna Niguel borders Laguna Beach on the east)).

*Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sell "prestige" fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive).

A wide variety of factors must be considered in determining the origin of a product or service. For example, goods and services do not always originate in the applicant's place of business. *See In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993) (NANTUCKET NECTARS held primarily geographically descriptive of soft drinks, even though the goods were manufactured elsewhere, where the record showed that applicant's headquarters and research and development division were on Nantucket; the distributor of the goods was located on Nantucket; the goods were sold in the applicant's store on Nantucket; and the specimens were labels that bore a picture of Nantucket, stated that the goods were "born" or "created" on Nantucket, and mentioned no other geographic location); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air, because the applicant's services included flights to and from Paradise Island, Bahamas, even though the flights were not based there); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON held not deceptive of, *inter alia*, radios and televisions because, although the applicant is an American corporation, the goods are made in Japan).

The essence of this analysis is to determine whether the public is likely to believe that the goods originate in the place identified in the mark. To make this determination, the Board may review evidence in the record that shows the context in which the mark is used. *See In re Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1517 (TTAB 2001) (finding that applicant's point of purchase display catalogs "foster a goods/place association between its furniture and Tuscany by referring to 'Europe's Mediterranean coast' and 'European sensibility'"); and *In re Nantucket Allserve Inc.*, 28 USPQ2d at 1146 (finding that applicant's product labels bore a picture of Nantucket, stated that the goods were "born" or "created" on Nantucket and "[embody] the wholesome quality of the Island whose name they bear," and mentioned no other geographic location).

Applicant is located in Laguna Beach, California. Applicant's FACEBOOK posting features photographs of applicant's Laguna Beach location.<sup>39</sup> Her advertisements create a connection with the artisans for which Laguna Beach has become known.

Laguna Candles is a family owned candle company committed to creating artisan quality candles derived from the purest essential oils combined with all natural waxes. Laguna Candles works with local Laguna Beach artists to create heirloom quality vessels that will transport your candle burning experience to a level you will never forget. ... Renowned for innovative ideas, aesthetic enhancements and the highest standards of quality, inspired by the beautiful coastal town of Laguna

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<sup>39</sup> Facebook.com (TTABVue 17, p.

Beach. Laguna Candles is a family-owned candle company located in Laguna Beach, California.<sup>40</sup>

Applicant's Coastal Collection was inspired by her location at Laguna Beach.

Our Coastal collection of clean burning candles, eco friendly, handmade soy candles, is a welcoming breeze washing over you, the sun cooled by the vast Pacific Ocean, a sunset in Laguna Beach compels you to light one of our best smelling candles and breath.<sup>41</sup>

Another Internet posting for applicant's Coastal Collection tells potential customers to "Take home the memory of Laguna Beach with our Coastal collection."<sup>42</sup>

Candles are one of the products sold by artisans doing business in Laguna Beach. For example,

1. *Laguna Beach Magazine* had a feature about "eco-friendly, essential oil-and-soy-based candles" by AroVela "[s]old at ROOTS the Beauty Underground and Green Tree Boutique."<sup>43</sup>

2. The Pure Light candle shop is located in Laguna Beach featuring studio made candles.<sup>44</sup> The owners conduct candle-making classes.<sup>45</sup>

3. Makana, a "candle studio which is nestled in the artist community of Laguna Canyon in the southern California resort town of Laguna Beach," produces

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<sup>40</sup> Lagunacandles.com (TTABVue 17, p. 3).

<sup>41</sup> *Id.* at 10.

<sup>42</sup> Lagunacandles.net (TTABVue 17, p. 14). See also TTABVue 17, p. 13.

<sup>43</sup> Lagunabeachmagazine.com (TTABVue 20, p. 42).

<sup>44</sup> Pressrelease.org (TTABVue 20, pp. 56-57).

<sup>45</sup> TTABVue 20, p. 78.

“hand-crafted” candles “in the artisan tradition using only simple, sustainable ingredients.”<sup>46</sup>

The public, understanding that Laguna Beach or Laguna is known as an artists' colony, is likely to believe that applicant's candles originate there. This is especially true because applicant associates herself with the geographic location and advertises her products by asking consumers to “Take home the memory of Laguna Beach with our Coastal collection.”<sup>47</sup> Thus, opposer's evidence demonstrates that the public would be likely to make the requisite goods/place association between candles and Laguna. Moreover, it is not necessary that the public believe that candles are manufactured in Laguna Beach to also believe that applicant's candles come from there. Here, opposer has shown that candles are products sold by artisans located in Laguna Beach, and thus the public will be likely to believe that applicant's candles come from Laguna Beach. *See e.g., In re Nantucket Allserve, Inc.*, 28 USPQ2d at 1146 (NANTUCKET NECTARS is primarily geographically descriptive of soft drinks, where company has its headquarters and research and development center, but not its manufacturing facilities, on Nantucket). *Compare In re Gale Hayman, Inc.*, 15 USPQ2d 1478 (TTAB 1990) (SUNSET BOULEVARD not primarily geographically descriptive because there was nothing in the record to indicate or suggest that purchasers would believe that Sunset Boulevard was the place of manufacture or production of applicant's perfume).

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<sup>46</sup> Makaanacandlestudios.com (TTABVue 20, p. 58).

<sup>47</sup> Lagunacandles.net (TTABVue 17, p. 14). See also TTABVue 17, p. 13.

Laguna Beach evokes images of affluence, sophistication and an artisan culture. It is the artisan culture that Laguna Beach uses to promote tourism and arts festivals. Thus consumers may perceive applicant's mark as an attempt to capture that image by indicating this origin for its candles. Because the primary meaning of Laguna is Laguna Beach, purchasers would be likely to expect candles sold under the mark LAGUNA CANDLES to originate from Laguna Beach. *See Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d at 1695.

In view of the foregoing, we find that applicant's mark LAGUNA CANDLES for candles and fragrant candles is primarily geographically descriptive.

V. Whether LAGUNA CANDLES has acquired distinctiveness?

Contrary to applicant's argument, opposer does not have the initial burden to present prima facie evidence or argument that applicant's mark has not acquired distinctiveness.<sup>48</sup> Because applicant seeks registration on the Principal Register and, by virtue of Fed. R. Civ. P. 15(b)(2), as discussed above, applicant has, in essence, pleaded that its mark has acquired distinctiveness as an affirmative defense, therefore, applicant has the burden of proof. *See Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988) (at final hearing, "evaluation of the entire record, not of prima facie showings previously made by the respective parties, is the only issue relevant to the outcome" and "[t]he burden of proving secondary meaning is on the party asserting it.").

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<sup>48</sup> Applicant's Brief, p. 7 (TTABVue 40, p. 10).

The Court of Appeals for the Federal Circuit, our primary reviewing court, explained how to establish acquired distinctiveness by actual evidence.

An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.

*In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985). The issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. *In re Redken Labs., Inc.*, 170 USPQ 526, 528 (TTAB 1971); *In re Fleet-Wing Corp.*, 122 USPQ 335, 335 (TTAB 1959). Thus, we may look to how long the mark has been used, advertising expenditures, evidence of consumer recognition of the mark as a source indicator, survey evidence, market research or any other evidence of consumer reaction.

The fictitious name statements filed by applicant prove only that applicant filed a fictitious name statement for "Laguna Candles" on those dates; they are not evidence that applicant was using the trademark LAGUNA CANDLES at that time.

The website printouts from the Internet Archive purporting to show that applicant has been using the mark LAGUNA CANDLES since 2002 are evidence only of what those documents show on their face (i.e., that applicant had a website advertising its products). This evidence does not indicate what, if any, commercial impression, those website advertisements made on the public (e.g., how many

viewers saw the websites, whether the public is aware of applicant's mark and products, how many viewers purchased product, etc.). Nevertheless, applicant claimed that it began using the mark LAGUNA CANDLES at least as early as December 6, 2001.<sup>49</sup>

From December 6, 2001 through November 21, 2011, applicant claimed to have sold "approximately 15,000 candles" for "approximately \$384,000."<sup>50</sup> In other words, she sold approximately 1,500 candles per year for \$38,400 per year. All of applicant's sales took place through eight stores located in Orange County, California, and one store in San Diego.<sup>51</sup> During this same time period, applicant spent \$85,600 for advertising; that is, approximately \$8,560 per year.<sup>52</sup> All of the trade shows applicant claims to have attended took place in 2011.<sup>53</sup>

We do not find applicant's evidence to be convincing. First, applicant's use of her mark since December 2001, while indicative of her ability to stay in business is not conclusive or persuasive that her mark is commercially recognized as a source indicator. *See In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (applicant's use of the product designs ranging from seven to seventeen years

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<sup>49</sup> Applicant's response to opposer's interrogatory No. 1 (TTABVue 28, p. 84).

<sup>50</sup> Applicant's responses to opposer's interrogatory Nos. 3 and 4 (TTABVue 28, p. 85).

<sup>51</sup> Applicant's response to opposer's interrogatory No. 5 (TTABVue 28, p. 86) and *Wikipedia.org* (TTABVue 27, p. 42). In interrogatory No. 6, applicant claims to have sold candles throughout the entire United States, but this is contradicted by applicant's response to interrogatory No. 5. The copies of applicant's website also indicate that applicant may be making online sales; however, there is no testimony regarding the extent of any such activities.

<sup>52</sup> Applicant's response to opposer's interrogatory No. 7 (TTABVue 28, p. 87).

<sup>53</sup> Applicant's response to opposer's interrogatory No. 13 (TTABVue 28, p. 89).

is insufficient to bestow acquired distinctiveness). *See also In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (evidence submitted by applicant held insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, inter alia, continuous and substantially exclusive use for sixteen years, deemed “a substantial period but not necessarily conclusive or persuasive”).

Second, applicant’s sales do not indicate recognition of the term LAGUNA CANDLES as a trademark. Applicant responses to opposer’s interrogatories provided information regarding sales of 15,000 candles for \$384,000 over ten years or 1,500 candles at \$38,400 dollars per year. These figures are hardly persuasive evidence of acquired distinctiveness for products marketed to the general consuming public.

Finally, the record is lacking in any media recognition regarding applicant’s products and how the term LAGUNA CANDLES points uniquely and exclusively to applicant.

In this particular case, more persuasive evidence than that offered here is necessary to establish that applicant’s mark LAGUNA CANDLES has acquired distinctiveness.

**Decision:** The opposition is sustained and registration to applicant is refused.