

This Opinion Is a  
Precedent of the TTAB

Mailed: December 8, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*City of London Distillery, Ltd.*

*v.*

*Hayman Group Limited*  
—

Opposition No. 91235280  
—

J. Scott Gerien and Joy L. Durand of Dickenson, Peatman & Fogarty  
for City of London Distillery, Ltd.

Thomas M. Galgano and Carolyn A. Galgano of Galgano IP Law PLLC  
for Hayman Group Limited.  
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Before Bergsman, Lykos and Pologeorgis, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Hayman Group Limited, a limited company organized under the laws of the United Kingdom and located in Witham, Essex (Applicant), seeks registration on the Principal Register of the mark CITY OF LONDON, in standard character form, for

“gin,” in International Class 33.<sup>1</sup> Applicant disclaims the exclusive right to use the term “London.”

City of London Distillery, Ltd. (Opposer) opposes registration of Applicant’s mark on the following grounds:<sup>2</sup>

- Applicant’s mark CITY OF LONDON for gin is primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3);<sup>3</sup>

- Applicant’s mark CITY OF LONDON for gin is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2);

- Applicant’s mark CITY OF LONDON for gin is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1); and

- Applicant’s mark CITY OF LONDON for gin fails to function as a trademark pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, “due to the prevalence of distilleries which identify their gin as being produced in the city of London, England, and the history of the production of gin in the city of

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<sup>1</sup> Application Serial No. 87290461, filed January 5, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of its mark anywhere and in commerce as of October 2012.

<sup>2</sup> The operative complaint is Opposer’s Amended Notice of Opposition filed February 12, 2019. 21 TTABVue.

<sup>3</sup> Opposer also pleaded that Applicant’s mark is deceptive under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). However, the legal standard for determining whether a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) is the same as applied in determining whether a mark is deceptive under Section 2(a). *See In re Cal. Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1856-57 (Fed. Cir. 2003). Given the incorporation of a geographic term in the mark, we will conduct a Section 2(e)(3) analysis and forego any further reference to Section 2(a).

London, England, such that consumers are likely to perceive the term CITY OF LONDON as merely informational in nature.”<sup>4</sup>

Applicant, in its Answer, denies the salient allegations in the Amended Notice of Opposition. In addition, on June 29, 2018, Applicant moved in the alternative to amend its application to seek registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), if the Board finds that its mark CITY OF LONDON for gin is primarily geographically descriptive or merely descriptive. In the alternative, if the Board finds that Applicant failed to prove that its mark has acquired distinctiveness, then Applicant, pursuant to its motion, seeks to register the mark CITY OF LONDON for gin on the Supplemental Register.<sup>5</sup> Opposer contested Applicant’s motion.<sup>6</sup> The Board, in its February 1, 2019 order, deferred consideration of Applicant’s motion to amend until trial.<sup>7</sup> *See* the discussion below.

### **I. The Record**

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. In addition, Applicant admits that all the documents it produced in response to Opposer’s request for production of documents are true or correct copies of authentic documents.<sup>8</sup> Thus, Opposer may introduce documents produced by Applicant via a notice of reliance. Trademark Rule

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<sup>4</sup> Amended Notice of Opposition ¶8 (21 TTABVUE 9 and 14).

<sup>5</sup> 12 TTABVUE.

<sup>6</sup> 20 TTABVUE 15.

<sup>7</sup> 20 TTABVUE 4.

<sup>8</sup> Applicant’s response to Opposer’s request for admission No. 1 (24 TTABVUE 96).

2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii) (“A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.”).

The parties introduced the testimony and evidence listed below:

A. Opposer’s testimony and evidence

1. Notice of reliance on an excerpt from Opposer’s website [cityoflondondistillery.com](http://cityoflondondistillery.com) purportedly showing use of Opposer’s trade name and brand CITY OF LONDON in connection with gin;<sup>9</sup>
2. Notice of reliance on an excerpt from a third-party website purportedly showing Opposer’s use of the mark CITY OF LONDON for gin;<sup>10</sup>
3. Notice of reliance on an excerpt from the website [mapping.cityoflondon.gov.uk](http://mapping.cityoflondon.gov.uk) purportedly to show the boundaries of the City of London;<sup>11</sup>
4. Notice of reliance on a copy of the [Wikipedia.org](http://Wikipedia.org) entry for “City of London”;<sup>12</sup>
5. Notice of reliance on an excerpt from the [londonist.com](http://londonist.com) website article “Is the Square Mile Actually a Square Mile?” purportedly to show that the City of London is also referred to as the Square Mile;<sup>13</sup>
6. Notice of reliance on Applicant’s responses to Opposer’s first set of interrogatories;<sup>14</sup>

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<sup>9</sup> 24 TTABVUE 25-47.

<sup>10</sup> 24 TTABVUE 49-51.

<sup>11</sup> 24 TTABVUE 53.

<sup>12</sup> 24 TTABVUE 55-74.

<sup>13</sup> 24 TTABVUE 76-88.

<sup>14</sup> 24 TTABVUE 90-94.

7. Notice of reliance on Applicant's admissions in response to Opposer's first set of requests for admission;<sup>15</sup>
8. Notice of reliance on a copy of City of London ENCYCLOPAEDIA BRITANNICA entry (britannica.com);<sup>16</sup>
9. Notice of reliance on copies of news articles downloaded from the Internet;<sup>17</sup>
10. Notice of reliance on a copy of the St. Paul's Cathedral website (stpauls.co.uk);<sup>18</sup>
11. Notice of reliance on excerpts from the Trip Advisor website (tripadvisor.com);<sup>19</sup>
12. Notice of reliance on an excerpt from "The Book of Gin" by Richard Barnett;<sup>20</sup>
13. Notice of reliance on a copy of a "sell sheet" purportedly from Applicant's U.S. importer displaying a bottle of Applicant's CITY OF LONDON gin;<sup>21</sup>
14. Notice of reliance on an excerpt from the pacifiedgeca.com website purportedly displaying bottles of Applicant's CITY OF LONDON gin;<sup>22</sup>
15. Notice of reliance on part of the record for application Serial No. 87838921 for the mark TYLER'S ORIGINAL CITY OF LONDON for "distilled spirits; gin";<sup>23</sup>

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<sup>15</sup> 24 TTABVUE 96-98.

<sup>16</sup> 24 TTABVUE 100-101.

<sup>17</sup> 24 TTABVUE 103-209; <sup>25</sup> TTABVUE 3-13 and 19-69; <sup>26</sup> TTABVUE 3-46, 88-91, 125-150, and 208-210.

<sup>18</sup> 25 TTABVUE 15-17.

<sup>19</sup> 25 TTABVUE 71-109.

<sup>20</sup> 25 TTABVUE 111-121.

<sup>21</sup> 26 TTABVUE 48.

<sup>22</sup> 26 TTABVUE 50-51.

<sup>23</sup> 26 TTABVUE 53-56. *See also* 37 TTABVUE.

16. Notice of reliance on a copy of the London and England, ENCYCLOPAEDIA BRITANNICA entries (britannica.com);<sup>24</sup>
  17. Notice of reliance on an excerpts from websites purportedly to show Applicant's TYLER'S ORIGINAL CITY OF LONDON gin advertised for sale;<sup>25</sup>
  18. Notice of reliance on the London Wikipedia.org entry;<sup>26</sup>
  19. Notice of reliance on the Gin Craze and Gin Wikipedia.org entries;<sup>27</sup>
  20. Notice of reliance on excerpts from third-party websites;<sup>28</sup>
  21. Testimony Declaration of Joy L. Durand, Opposer's counsel;<sup>29</sup> and
  22. Testimony Declaration of Alan Robinson, Opposer's Group Finance Director.<sup>30</sup>
- B. Applicant's testimony and evidence
1. Notice of reliance on excerpts from third-party websites;<sup>31</sup>
  2. Notice of reliance on Opposer's admissions in response to Applicant's first set of requests for admission;<sup>32</sup>
  3. Notice of reliance on Opposer's responses to Applicant's first set of interrogatories;<sup>33</sup>

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<sup>24</sup> 26 TTABVUE 58-80.

<sup>25</sup> 26 TTABVUE 82-86, 123, and 215-225.

<sup>26</sup> 26 TTABVUE 93-114.

<sup>27</sup> 26 TTABVUE 116-121.

<sup>28</sup> 26 TTABVUE 152-206 and 212.

<sup>29</sup> 26 TTABVUE 226-269.

<sup>30</sup> 26 TTABVUE 270-274.

<sup>31</sup> 30 TTABVUE 7-191.

<sup>32</sup> 31 TTABVUE 8-18.

<sup>33</sup> 31 TTABVUE 20-33.

4. Notice of reliance on Opposer's admissions in response to Applicant's second set of requests for admission;<sup>34</sup>
5. Notice of reliance on Opposer's responses to Applicant's third set of interrogatories;<sup>35</sup>
6. Notice of reliance on excerpts from printed publications;<sup>36</sup>
7. Notice of reliance on two third-party registrations for the mark CITY OF LONDON for clothing and jewelry on the Supplemental Register and one third-party registration for the mark CITY OF for gin;<sup>37</sup>
8. Notice of reliance on a copy of the Wikipedia.org entry for "London";<sup>38</sup>
9. Notice of reliance on Internet documents;<sup>39</sup>
10. Notice of reliance on excerpts from third-party websites purportedly showing use of CITY OF LONDON for gin;<sup>40</sup>
11. Testimony Declaration of Simon Strutt, Applicant's Finance Director;<sup>41</sup> and
12. Testimony Declaration of Carolyn A. Galgano, Applicant's counsel.<sup>42</sup>

## **II. Entitlement to a statutory cause of action**

Even though Applicant does not contest it, the plaintiff's entitlement to a statutory cause of action, formerly referred to as "standing," is a threshold issue in every inter partes case before the Board. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020

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<sup>34</sup> 31 TTABVUE 35-45.

<sup>35</sup> 31 TTABVUE 47-49.

<sup>36</sup> 32 TTABVUE 4-158.

<sup>37</sup> 33 TTABVUE 6-40.

<sup>38</sup> 34 TTABVUE 6-9.

<sup>39</sup> 34 TTABVUE 11-46.

<sup>40</sup> 35 TTABVUE 6-88.

<sup>41</sup> 36 TTABVUE 2-41.

<sup>42</sup> 36 TTABVUE 42-61.

USPQ2d 11277 (Fed. Cir. Oct. 27, 2020). *See also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Spanishtown Enterprises., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388 (TTAB 2020). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute (here, 15 U.S.C. § 1063) and (ii) proximate causation. *Corcamore*, 2020 USPQ2d 11277, at \*4.<sup>43</sup> *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Plaintiffs that are competitors in the same field or industry as a defendant have a personal stake in resolving the question of the defendant's right to register an allegedly merely descriptive, primarily geographically descriptive or primarily geographically deceptively misdescriptive term. *See Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1787 (TTAB 2006); *M-5 Steel Mfg. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1094 (TTAB 2001); *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999). *See also Corporacion Habanos, S.A. v. Rodriquez*, 99 USPQ2d 1873 (TTAB 2011) (“[W]here, as here, the pleaded ground is

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<sup>43</sup> Our decisions have previously analyzed the requirements of §1063 under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting “standing” under §§ 1063 and 1064 remain equally applicable.



that the mark sought to be cancelled is deceptive under Section 2(a), or primarily geographically deceptively misdescriptive under Section 2(e)(3), petitioners do not need to own a pending application for the mark, do not have to be using the term as a mark, or even use the term at all, in order to establish their standing.”).

Alan Robinson, Opposer’s Group Finance Director, testified, “Opposer produces and sells gin labeled with the trade name and brand name CITY OF LONDON,” that “Opposer is the oldest working distillery located in the City of London,” that the “City of London” is “an area of historic significance and independent governance located within the boundaries of the larger city of London in England,” and that the City of London “has a rich gin history.”<sup>44</sup> *See also* City of London, Wikipedia.org (“The City of London is a city and county that contains the historic centre and central business district (CBD) of London.”);<sup>45</sup> City of London, ENCYCLOPAEDIA BRITANNICA (britannica.com) (“City of London, municipal corporation and borough, London, England. Sometimes called ‘the Square Mile,’ it is one of the 33 boroughs that make up the large metropolis of Greater London.”);<sup>46</sup> Vogue.com (“London has always been associated with gin.”);<sup>47</sup> WashingtonPost.com (“London, home of the world’s most popular gin style (London Gin).”).<sup>48</sup>

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<sup>44</sup> Robinson Decl. ¶¶2 and 4 (26 TTABVUER 270-271).

<sup>45</sup> 24 TTABVUE 55.

<sup>46</sup> 24 TTABVUE 100.

<sup>47</sup> 26 TTABVUE 7.

<sup>48</sup> 26 TTABVUE 27.

Opposer has demonstrated an interest falling within the zone of interests protected by the statute and a reasonable basis for its belief of damage proximately caused by registration of the mark. Therefore, Opposer has proven it is entitled to pursue this proceeding.

### **III. Background**

London is the capital of the United Kingdom.<sup>49</sup>

It is among the oldest of the world's great cities – its history spanning nearly two millennia – and one of the most cosmopolitan. By far Britain's largest metropolis. It is also the country's economic, transportation, and cultural centre.<sup>50</sup>

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Historically, London grew from three distinct centres: the walled settlement found by the Romans on the banks of the Thames in the 1st century ce, today known as the City of London, “the Square Mile,” or simply “the City”; facing it across the bridge on the lower gravels of the south bank, the suburb of Southwalk; and mile upstream, on the great southward bend of the river, the City of Westminster.<sup>51</sup>

According to Wikipedia.org, “London's vast urban area is often described using a set of district names, such as Bloomsbury, Mayfair and Whitechapel. These are either informal designations, reflect the names of villages that have been absorbed by sprawl, or are superseded administrative units such as parishes or former boroughs.”<sup>52</sup>

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<sup>49</sup> London, ENCYCLOPAEDIA BRITANNICA (Britannica.com) (26 TTABVUE 58).

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* at 26 TTABVUE 60.

<sup>52</sup> London, Wikipedia.org (26 TTABVUE 97). We emphasize again that Internet documents are admissible only to show what has been printed, not the truth of what has been printed.

Such names have remained in use through tradition, each referring to a local area with its own distinctive character, but without official boundaries. Since 1965, Greater London has been divided into 32 London boroughs in addition to the ancient City of London. The City of London is the main financial district, and Canary Wharf has recently developed into a new financial district and commercial hub in the Docklands to the east.<sup>53</sup>

Further descriptions state:

The City of London is a city and county that contains the historic and primary central business (CBD) of London. ... The City is now only a tiny part of the metropolis of London, though it remains a notable part of Central London. ... The City of London is widely referred to as the City differentiated from the phrase ‘the city of London’ by capitalizing City and is also colloquially known as the Square Mile, as it is 1.12 square miles ... in area.<sup>54</sup>

[The City of London] is only a small component, relatively small in area, of the larger urban area known as London. Its area corresponds closely to that of the ancient city from which modern London has grown. The City belongs geographically to the historic county of Middlesex, but its special status and privileges gave it autonomy from that county for most of its history.<sup>55</sup>

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Hundreds of thousands of workers and tens of thousands of other visitors commute daily to the City via highway, bus, the Underground (subway), or train stations at

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*Safer*, 94 USPQ2d at 1040. In other words, Internet documents have probative value to show what the authors perceive, not the truth of what the authors have written. In addition, Internet documents may have value to show that consumers have been exposed to the term at issue.

<sup>53</sup> *Id.* at 26 TTABVUE 97.

<sup>54</sup> City of London, Wikipedia.org (24 TTABVUE 55). *See also* City of London, ENCYCLOPAEDIA BRITANNICA (Britannica.com) (24 TTABVUE 100) (“City of London, municipal corporation and borough, London, England. Sometimes called ‘the Square Mile,’ it is one of the 33 boroughs that make up the large metropolis of Greater London.”).

<sup>55</sup> City of London, ENCYCLOPAEDIA BRITANNICA (Britannica.com) (24 TTABVUE 100).

Blackfriars and at Liverpool, Frenchurch, and Cannon streets.<sup>56</sup>

Mr. Strutt testifies that the consumption of gin became popular in Great Britain and particularly in London during the so-called “Gin Craze” during the 18<sup>th</sup> century.<sup>57</sup>

As noted in Wikipedia:

The Gin Craze was a period in the first half of the 18th century when the consumption of gin increased rapidly in Great Britain, especially in London. ... Many people overconsumed and the city had an epidemic of drunkenness; this provoked moral outrage and a legislative backlash that some compare to the modern drug wars.<sup>58</sup>

As a result, London has become associated with gin. Online publications and various third-party websites corroborate this. For example,

- “What Does ‘London Dry’ Mean In Today’s Gin Era?” Gin Foundry website (ginfoundry.com) (June 6, 2016).

We’ve always considered London as the global capital of gin. It is both the birthplace of and now a mecca for juniper-centric spirits and if gin is your thing – nowhere else can really live up to it. When it comes to gin, London has it all, from modern bars specializing in the spirit, distilleries producing it, a longstanding heritage associated with it embedded into the very fiber of the city and, of course, a term that is emblazoned onto many gin bottles the world over.<sup>59</sup>

- “Distilleries and bars unite for London Gin Trail,” thespiritsbusiness.com (November 9, 2015).

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<sup>56</sup> *Id.* at 24 TTABVUE 101.

<sup>57</sup> Strutt Decl. ¶15 (36 TTABVUE 4).

<sup>58</sup> Gin Craze, Wikipedia.org (26 TTABVUE 116).

<sup>59</sup> 26 TTABVUE 208.

British gin has a strong vibrant history. By publishing the gin trail map we hope to mark its renaissance and ensure its future as a quintessentially British, internationally recognized spirit.<sup>60</sup>

- “How Gin Bounced Back From Decades of Decline to Become London’s Latest Drink,” Vogue.com (June 11, 2018).

London has always been associated with gin. Rumor has it that, in medieval times, peasants downed it to ward off the plague. From there, it became part of their culture – nay, brand: the world’s most famous gins, like Beefeater and Gordon’s, are all British. Simply put: if anyone is going to drink gin, it’ll be the Brits.<sup>61</sup>

- “In London, gin comes roaring back,” washingtonpost.com (January 10, 2013).

### **The comeback**

It’s a great story, not the least because London, the home of the world’s most popular gin style (London Dry), is so inextricably linked to the juniper-infused spirit. The city’s residents have been knocking the drink back in varying quantities ever since the end of the 17th century, when William of Orange arrived from the Netherlands bearing muscular Protestantism and a drink called Jenever.<sup>62</sup>

- “The Story Behind London’s Gin Revival – Plus, Where to Drink,” Foodandwine.com (March 27, 2018).

The history of gin is inextricable from the history of London. This was the city that fell prey to the infamous “Gin Craze” in the 1700s; embraced gin in classic cocktails as much as a century ago; and is still home to the one of the world’s stalwart distillers, Beefeater. Even the best-known style of gin tells the city’s story: London Dry.”<sup>63</sup>

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<sup>60</sup> 25 TTABVUE 30.

<sup>61</sup> 26 TTABVUE 7.

<sup>62</sup> 26 TTABVUE 27.

<sup>63</sup> 26 TTABVUE 88.

- [Beefeaterdistillery.com](http://Beefeaterdistillery.com) (accessed November 22, 2019).

London, one of the world's great cities, has played a leading role in the development of London Dry Gin.<sup>64</sup>

- [Brokersgin.com](http://Brokersgin.com) (accessed November 11, 2019).

Broker's is seriously good gin with a decidedly playful spirit. The bowler hat atop each bottle and the image of a bowler-hatted gentleman – an archetypal London stockbroker – are a respectful nod to England's historical reputation as the home of gin.<sup>65</sup>

- Fifty Pounds gin website ([fiftypoundsgin.london/fifty-pounds-gin](http://fiftypoundsgin.london/fifty-pounds-gin)) (accessed April 29, 2019).

From the botanicals used to the method of production and bottling Fifty Pounds Gin pays tribute to London's rich gin history.<sup>66</sup>

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London is the global capital of gin. It is the birthplace of and the mecca of juniper-based spirits.<sup>67</sup>

- [Gin, Wikipedia.org](http://Gin, Wikipedia.org) (accessed March 31, 2019).

Gin was developed based on older Dutch liquor, jenever, and became popular in Great Britain (particularly in London) when William of Orange became of King William III of England.<sup>68</sup>

Finally, as Mr. Strutt testifies, London Dry is a type of gin.

4. ... A London Dry gin is a type of distilled gin that is made by exclusively using ethyl alcohol of agricultural origin. This type of ethyl alcohol is re-distilled in the presence of

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<sup>64</sup> 34 TTABVUE 44.

<sup>65</sup> 30 TTABVUE 18.

<sup>66</sup> 30 TTABVUE 59.

<sup>67</sup> 30 TTABVUE 60.

<sup>68</sup> 26 TTABVUE 119

juniper berries and other natural botanicals. Colorants or flavorants cannot be added after distillation, save for water or a small amount of sugar.<sup>69</sup>

5. London Dry gins do not have to be produced in or originate from London to qualify as a London Dry gin. Therefore, London Dry gins can be produced anywhere in the world.<sup>70</sup>

“Applicant’s CITY OF LONDON gin uses gin distilled at Thames Distillers Limited located in London, at Timbermill Distillery, Timbermill Way, Guaden Road, London SW4 6LY.”<sup>71</sup> Thames Distillers subsequently bottles Applicant’s gin in Essex, just outside London.<sup>72</sup> Applicant in response to an interrogatory asserted that it adopted the mark CITY OF LONDON to suggest that its gin is a London Dry gin.<sup>73</sup>

With this background, we turn to the merits.

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<sup>69</sup> Strutt Decl. ¶4 (36 TTABVUE 2). *See also* Applicant’s response to Opposer’s interrogatory No. 16 (24 TTABVUE 93) (“Although London dry gin is a style of gin that can be made internationally, the geographical location of London, United Kingdom remains its true spiritual home.”); Applicant’s admission to Opposer’s request for admission No. 8 (24 TTABVUE 97); Theginisin.com (34 TTABVUE 11) (“The term “London Dry’ is a quality designation. For a gin to be called London Dry Gin, the base spirit must be distilled to a completely neutral spirit of 96% ABV, must add a flavor through distillation in presence of ‘natural plant materials,’ and can have nothing added after distillation save water and a trivial quantity of sugar.”); “What Does ‘London Dry’ Mean In Today’s Gin Era?” Gin Foundry website (ginfoundry.com) (“London Dry Gin doesn’t have to be made in London; it does not even have to be made in England. Instead, London Dry (also known as London Gin) refers to that which is made under a series of mind-bogglingly exciting EU regulations put in place in February 2008.”) (26 TTABVUE 208).

<sup>70</sup> Strutt Decl. ¶¶4-5 (36 TTABVUE 2-3).

<sup>71</sup> Strutt Decl. ¶13 (36 TTABVUE 4). *See also* Applicant’s response to Opposer’s interrogatory No. 14 (24 TTABVUE 92).

<sup>72</sup> Strutt Decl. ¶14 (36 TTABVUE 4). *See also* Applicant’s response to Opposer’s interrogatory No. 14 (24 TTABVUE 92).

<sup>73</sup> Applicant’s response to Opposer’s Interrogatory No. 4 (24 TTABVUE 91).

**IV. Whether Applicant's mark CITY OF LONDON for gin is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2)?**

The elements for proving that a mark is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), are

- (1) The mark is the name of a place known generally to the public;
- (2) The goods for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to believe that the goods originate in the geographic place identified in the mark.

*See In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Broken Arrow Beef & Provision, LLC*, 129 USPQ2d 1431, 1432 (TTAB 2019); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014).

The parties neither introduced evidence regarding the relevant public nor analyzed or identified the relevant purchasing public in their briefs. The relevant public for purposes of our analysis is the purchasing public in the United States of the types of goods or services at issue. *See, e.g., Newbridge*, 113 USPQ2d at 1449; *Institut National Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1580-81, 22 USPQ2d 1190, 1195-1196 (Fed. Cir. 1992) (for goods identified as “citrus flavored wine,” “the relevant portion of the American public [is] consumers of wine and wine products”). Because the goods at issue here are gin, the public includes ordinary purchasers and drinkers of gin.



**A. Whether the “City of London” is a generally known geographic place?**

Opposer contends that the “City of London” is a generally known geographic designation for the business or financial district of greater London.

City of London is a place with international influence and recognition having within its borders the Bank of England, the London Stock Exchange, Lloyd’s of London, much of the rest of London’s financial district, the Temple and Royal Courts of Justice, constituting the heart of the British legal profession, Fleet Street, once the hub of London’s newspaper establishment, as well as the main branch of the Museum of London and the iconic St. Paul’s Cathedral. 24 TTABVUE 3, Opposer’s First NOR ¶4, Exh. D.<sup>74</sup> City of London vies with New York City as the financial capital of the world. 24 TTABVUE 3, Opposer’s First NOR ¶4, Exh. D. Hundreds of thousands of workers and tens of thousands of visitors commute daily into City of London. 24 TTABVUE 4, Opposer’s First NOR ¶8, Exh. H.<sup>75</sup>

Accordingly, Americans are routinely exposed to City of London given its stature as a world financial hub and destination for tourists from around the world. Indeed, American media companies including the Wall Street Journal, New York Times, The Los Angeles Times, The Washington Post, The Chicago Tribune, CNN, Fox Business, NBC, Bloomberg, MSN, Reuters, and ZD Net routinely feature stories discussing City of London given its world prominence. 24 TTABVUE 4-8, Opposer’s First NOR ¶¶9-25, Exhs. I-Y. Thus, the evidence demonstrates that the primary significance of City of London to Americans is a geographic location.<sup>76</sup>

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<sup>74</sup> Exhibit D refers to City of London, Wikipedia.org (24 TTABVUE 55).

<sup>75</sup> Exhibit H refers to City of London, ENCYCLOPAEDIA BRITANNICA (britannica.com) (24 TTABVUE 100).

<sup>76</sup> Opposer’s Brief, p. 8 (38 TTABVUE 13).

Opposer relies primarily on finance news articles, mostly about Brexit, to support its contention that “Americans are routinely exposed to City of London.”<sup>77</sup> The articles listed below are representative:

- “A Bad Brexit Deal for Banks Threatens Cities Across the U.K.,” Bloomberg.com (July 25, 2018).<sup>78</sup>

While finance represents a 29 percent share of London’s total exports, it makes up 56 percent of those for Edinburgh and 54 percent for Cardiff, according to a study, carried out by the Centre for Cities <<http://centreforcities.org/>> think tank and sponsored by the City of London Corporation.<sup>79</sup>

- “As Brexit Vote Looms, U.S. Banks Review Their European Ties,” NBCnews.com (May 17, 2016).<sup>80</sup>

The five largest U.S. banks employ 40,000 people in London, more than the rest of Europe combined, taking advantage of the EU “passporting” regime that allows them to offer services across the bloc out of their British hubs.

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But it is outside the euro zone, in the City of London, that they base their EU business. The investment bankers heading up M&A advisory teams for the likes of Italy and France all tend to live in London rather than Rome or Paris.

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<sup>77</sup> *Id.* Opposer also introduced the testimony declaration of Joy Durand, an attorney for Opposer, who introduced, inter alia, a screenshot of a map from the website [mapping.cityoflondon.gov.uk](http://mapping.cityoflondon.gov.uk) showing the boundaries of the City of London and from the Google Maps search engine at [google.com](http://google.com). (26 TTABVUE 226-227 and 261-264). These maps show that the City of London is a geographical location; but that is not at issue. The issue is whether the City of London is generally known to American consumers or drinkers of gin.

<sup>78</sup> 24 TTABVUE 103.

<sup>79</sup> *Id.* at 24 TTABVUE 103-104.

<sup>80</sup> 24 TTABVUE 106.

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The major U.S. banks also use their London entities to help them avoid the brunt of new U.S. trading rules brought in with the Dodd-Frank regulation, booking swap trade agreements with non-U.S. counterparts in Britain rather than in America.<sup>81</sup>

- “Baffled by Brexit: With So Much Unknown, London Bankers Struggle to Plan,”

FoxBusiness.com (June 20, 2017).

The City of London is back in the dark over Brexit after this month’s U.K. general election muddied the outlook for the U.K.’s departure from the European Union. Banking chiefs here have been left to wonder whether to accelerate plans to move operations to the EU.<sup>82</sup>

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The surprise electoral result upended this. “The election results gave an opportunity to [illegible] and reset the tone as the U.K. enters negotiations,” says Catherine McGuinness, Policy Chairman, City of London Corporation, which promotes the city as a financial service centre.<sup>83</sup>

- “Bank of England says payments system can serve blockchain users,” Yahoo.com

(July 23, 2018).<sup>84</sup>

The BoE is aiming to revamp the system that underpins British banking and trading in the City of London by 2020 to strengthen defenses against cyber-attacks and widen the number of businesses that can use it.

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<sup>81</sup> 24 TTABVUE 109-110.

<sup>82</sup> 24 TTABVUE 114.

<sup>83</sup> *Id.* at TTABVUE 115.

<sup>84</sup> 24 TTABVUE 119.

- “‘Brexit’ to Cost UK Up to 12,000 Finance Jobs – City Chief,” NYTimes.com (July 24, 2018).<sup>85</sup>

Brexit will cost Britain up to 12,000 financial services jobs in the short-term, the City of London financial district’s leader said on Tuesday, and many more jobs might disappear in the longer term.

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So far, there have been 1,600 confirmed job moves, a City of London spokeswoman said separately.

The City was disappointed that Britain’s government ditched its preferred option of future EU trade based on mutual recognition, whereby Britain and the EU accept each other’s rules under two-way regulatory cooperation.

- “Gray skies are no match for the world’s largest solar bridge,” CNN.com (September 24, 2014).

Over 4,400 solar panels compose the roof of Blackfriars bridge in the City of London, making it the largest solar-paneled bridge in the world.<sup>86</sup>

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If the gray skies of London can accomplish such results across the Thames, imagine the potential elsewhere.<sup>87</sup>

- “In London’s financial center, resignation about ‘Brexit’ – and a hope that nothing will change,” LATimes.com (July 1, 2016).

At a financial conference this week in the City of London, Britain’s equivalent to Wall Street, four eminent executives and business experts on a panel were asked whether they thought the country actually would ever

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<sup>85</sup> 24 TTABVUE 130.

<sup>86</sup> 24 TTABVUE 137.

<sup>87</sup> *Id.* at TTABVUE 138.

leave the European Union, as voters mandated in a referendum June 23.

They thought yes, one no and one voted “it’s so hard to say.” But all were convinced that the City’s march to global business supremacy would continue as if the vote never happened.<sup>88</sup>

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The City, colloquially known as the “square mile” – it’s actually 1.1 square miles – is one of the most densely packed assemblages of financial talent in the world, home to more than 400,000 bankers, traders and support staff.

Since the deregulatory “big bang” of 1986 launched the City on its path to global prominence, its denizens have acquired the image of a class convinced that the world needs them more than they need the world.<sup>89</sup>

Applicant, meanwhile, introduced excerpts from numerous London travel guides and books referring to the City of London simply as the City.<sup>90</sup> The exhibits listed below are illustrative:

- London, DK Eyewitness (2019)

#### THE CITY

The towering skyscrapers of the City make up London’s traditional financial district, where corporates in suits scurry around during the week, making it a bustling place at lunchtimes, but an early deserted one during the weekend.<sup>91</sup>

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<sup>88</sup> 24 TTABVUE 143.

<sup>89</sup> *Id.* at 24 TTABVUE 144.

<sup>90</sup> 32 TTABVUE.

<sup>91</sup> 32 TTABVUE 12.

- Frommer's Easy Guide To London 2019

#### SUGGESTED ITINERARIES & NEIGHBORHOODS

As recently as the early 1800's, London – and by London, I mean what we now call The City, between St. Paul's and the Tower – was a frenzied cluster where many lives, birth to death, were carried out within the same few blocks. ... All around The City were dozens of villages, many of which retain their names as modern neighborhoods – and, if you're lucky, a whiff of their original personalities, but not of their pestilence.<sup>92</sup>

- London, Fodor's Travel (2019)

#### WHAT'S WHERE

The City. London's Wall Street might be the oldest part of the capital, but thanks to new skyscrapers and a sleek Millennium Bridge, it also looks like the newest. History fans won't be shortchanged, however; head for St. Paul's Cathedral, Tower Bridge, and the Tower of London.<sup>93</sup>

The testimony and evidence that Opposer introduced showing that an American in the financial field or an American with an interest in world financial affairs might know that the City of London is London's financial district or central business district does not necessarily establish what "City of London" means to an American consumer of gin. Even though it may be reasonable to assume that some Americans in the financial field are gin consumers, the record in this case does not establish the nature or extent of any overlap.

Nevertheless, it is common knowledge among the American public that London is a major city in England. While the "City of London" is technically a subdivision of the

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<sup>92</sup> 32 TTABVUE 21.

<sup>93</sup> 32 TTABVUE 40.

“city of London,” the American public, including gin drinkers and purchasers, are likely to perceive the mark CITY OF LONDON as referring generally to the city of London, England. Indeed, if they perceive CITY OF LONDON as a sub-area within London, that necessarily means they perceive it as referring to London. *See B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (rejecting the argument that the letter “A” when inverted resembles the letter “V” because “[t]he purchasing public, we believe, does not indulge in such recognitional contortions but sees things as they are.”); *In re Johnson Prods. Co.*, 220 USPQ 539, 540 (TTAB 1983) (“It is undeniable that if the mark is carefully examined, the two overlapping ‘S’s can be discerned. What is more significant, however, is that this sort of studied analysis of the mark is unlikely to occur in the marketplace where these products are sold.”).

In addition, because Applicant is seeking to register CITY OF LONDON in standard characters, Applicant may display the mark in any manner, regardless of the font style, size, or color, and might at any time in the future display it in a way that the term LONDON in the mark stands out prominently compared to the words CITY OF.

In the absence of any evidence indicating that the addition of the words “City of” would either prevent American consumers from understanding that the mark refers to London, England, or points to something else, we find that the mark CITY OF LONDON for gin is the name of a geographic place (i.e., London) known generally to the American gin drinking and purchasing public.

**B. Whether Applicant’s gin originates from the “City of London” and whether American gin purchasers and drinkers are likely to believe that Applicant’s gin originates there?**

The second element of a Section 2(e)(2) claim is whether Applicant’s gin originates in or near the City of London. *See, e.g., In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007) (YOSEMITE BEER held geographically descriptive of beer produced and sold in a brewpub in Merced, California, the Board stating that “[s]ince the goods originate at or near [Yosemite National Park], we can presume an association of applicant’s beer with the park.”). While Applicant’s gin does not originate in the technical City of London (i.e., within the boundaries of the financial district subdivision of London), it does originate in London. As noted above, “Applicant’s CITY OF LONDON gin uses gin distilled at Thames Distillers Limited located in London, at Timbermill Distillery, Timbermill Way, Guaden Road, London SW4 6LY.”<sup>94</sup> Thames Distillers subsequently bottles Applicant’s gin in Essex, just outside London.<sup>95</sup>

As held in the preceding section, the term “city of London” means London, the well-known major city in England.<sup>96</sup> Thus, Applicant is using the mark CITY OF LONDON to reflect its association with the geographic location known as the city of

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<sup>94</sup> Strutt Decl. ¶13 (36 TTABVUE 4). *See also* Applicant’s response to Opposer’s interrogatory No. 14 (24 TTABVUE 92).

<sup>95</sup> Strutt Decl. ¶14 (36 TTABVUE 4). *See also* Applicant’s response to Opposer’s interrogatory No. 14 (24 TTABVUE 92).

<sup>96</sup> Even assuming an American consumer or drinker of gin is familiar with the technical definition of the City of London as London’s central business district, the City of London has a significant relationship to London where Applicant produces its gin, as well as nearby Essex, where Applicant bottles it.



London. In fact, Applicant asserted that it adopted the mark CITY OF LONDON to suggest that its gin is a London Dry gin.<sup>97</sup> We find, therefore, that a goods-place association exists (the third element of a 2(e)(2) claim) because American gin purchasers and drinkers will believe that Applicant's gin originates within or near the city limits of London and there is some association or connection between the gin and London. *See In re Spirits of New Merced, LLC*, 85 USPQ2d at 1621. *See also In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1310 (TTAB 2006) ("we presume a goods/place association [of vodka with BAIKALSKAYA meaning 'from Baikal'] because applicant is located near Lake Baikal, in the city of Irkutsk.").

We find that Applicant's mark CITY OF LONDON for gin is primarily geographically descriptive and sustain the opposition as to Opposer's Section 2(e)(2) claim.

**V. Whether Applicant's mark CITY OF LONDON for gin is primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3)?**

A mark is primarily geographically deceptively misdescriptive, and thus barred from registration, if: (1) "the primary significance of the mark is a generally known geographic location"; (2) "the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place"; and (3) "the misrepresentation was a material factor in the consumer's decision" to purchase the goods. *In re Miracle Tuesday, LLC*, 695 F.3d

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<sup>97</sup> Applicant's response to Opposer's Interrogatory No. 4 (24 TTABVUE 91). While an adopter's intent is not evidence of consumer perception of a mark, it represents the view of one immersed in the market whose interests are dependent upon correctly gauging consumer perception.

1339, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012) (*quoting Cal. Innovations*, 66 USPQ2d at 1341).

In analyzing the Section 2(e)(2) claim above, we determined that London is a generally known location to the relevant American gin drinker or purchaser. In addition, we found that the City of London, being located within the city limits of London, has a sufficient relationship to London to support the goods/place association. Because Applicant produces its gin in London and bottles it in nearby Essex, the mark CITY OF LONDON for gin does not present any material misrepresentation of fact. Accordingly, the opposition is dismissed as it pertains to Opposer's Section 2(e)(3) claim.

**VI. Whether Applicant's mark CITY OF LONDON for gin is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1)?**

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register that, when used in connection with an applicant's goods, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). "A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought." *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (*quoting N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). We "must consider the mark as a whole and do so in the context of the goods or services at issue." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *see also In re Calphalon*, 122 USPQ2d 1153, 1163 (TTAB 2017) ("[W]e must assess whether

the standard character mark SHARPIN is incongruous as applied to ‘cutlery knife blocks which incorporate built-in sharpeners that automatically sharpen knives.’”).

“Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Instead, “the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

Opposer contends that Applicant’s mark CITY OF LONDON is merely descriptive because it immediately conveys to purchasers that Applicant’s gin is a London dry gin.<sup>98</sup> As noted above, London Dry is a type of gin.

4. ... A London Dry gin is a type of distilled gin that is made by exclusively using ethyl alcohol of agricultural origin. This type of ethyl alcohol is re-distilled in the presence of juniper berries and other natural botanicals. Colorants or flavorants cannot be added after distillation, save for water or a small amount of sugar.<sup>99</sup>

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<sup>98</sup> Opposer’s Brief, p. 14 (38 TTABVUE 19).

<sup>99</sup> Strutt Decl. ¶4 (36 TTABVUE 2). *See also* Applicant’s response to Opposer’s interrogatory No. 16 (24 TTABVUE 93) (“Although London dry gin is a style of gin that can be made internationally, the geographical location of London, United Kingdom remains its true spiritual home.”); Applicant’s admission to Opposer’s request for admission No. 8 (24 TTABVUE 97); Theginisin.com (34 TTABVUE 11) (“The term “London Dry’ is a quality designation. For a gin to be called London Dry Gin, the base spirit must be distilled to a completely neutral spirit of 96% ABV, must add a flavor through distillation in presence of ‘natural plant materials,’ and can have nothing added after distillation save water and a trivial quantity of sugar.”).

In fact, Applicant concedes that it uses the CITY OF LONDON mark to identify, inter alia, its London Dry gin.<sup>100</sup>

However, Applicant's mark includes CITY OF, and is not the equivalent of or synonymous with LONDON DRY. The record does not establish that Applicant's CITY OF LONDON mark immediately conveys any information concerning a feature, quality, or characteristic of the gin itself for purposes of our analysis under Trademark Act Section 2(e)(1). As already established, the City of London is a historic district of London serving as London's central business district known as a finance center. American consumers of gin will not view CITY OF LONDON as connoting a characteristic of the gin itself, but, as we have just held regarding the Trademark Act Section 2(e)(2) claim, as describing where it comes from. CITY OF LONDON does not directly convey to the American gin drinker or purchaser that Applicant's product is a London dry gin or any other type of gin.

We find that the CITY OF LONDON for gin is not merely descriptive of Applicant's gin in derogation of Section 2(e)(1) of the Trademark Act and dismiss this claim.

**VII. Whether Applicant's mark CITY OF LONDON for gin fails to function as a mark?**

Opposer argues "the words 'city of London' are merely informational as they are highly geographically descriptive and/or highly descriptive of the style, purity, quality, ingredients and geographic origin of gin, such that CITY OF LONDON fails

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<sup>100</sup> Strutt Decl. ¶3 (36 TTABVUE 2).

to function as a mark.”<sup>101</sup> See Sections 1, 2, and 45 of the Trademark Act. Section 45 defines a “trademark” as “any word, name, symbol, or device, or any combination thereof — (1) used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127.

There are several different reasons why matter might not function as a mark. For example, matter is merely informational and does not function as a mark when, based on its nature and the context of its use by the applicant or others in the marketplace, consumers would perceive it as merely conveying general information about the goods (which is different from merely conveying more specific information about a feature, quality, or characteristic of the goods) or constitutes an informational message untethered to the goods. See generally TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.04 (2018). See also *Yarnell Ice Cream*, 2019 USPQ2d 265039, at \*17 (TTAB 2019) (giving the following as examples of terms that are incapable of functioning as marks: “No More RINOS!,” “Once a Marine, Always a Marine,” “Drive Safely,” and “I ♥ D.C.”).

Here, Opposer contends:

Applicant’s use of the term “CITY OF LONDON” just informs consumers that Applicant’s “City of London Gin is a small batch, hand-crafted Premium London Dry Gin distilled in London.” 24 TTABVUE 13, Opposer’s First

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<sup>101</sup> Opposer’s Brief, p. 11 (38 TTABVUE 16). See also *id.* at p. 13-14 (38 TTABVUE 18-19) (“Additionally, the prevalence of distilleries that identify their gin as being produced in the city of London, England, their references to the history of the production of gin in the city of London, England increases the likelihood that consumers will perceive the term “city of London” as being merely informational.”).

NOR ¶40, Exh. NN. Accordingly, the place, the city of London, is so highly descriptive and informational of the origin and history of gin, including Applicant's gin, that no single party can claim exclusivity in it as it fails to function as a mark.<sup>102</sup>

While Opposer uses the term “informational,” the specific issue that Opposer asserts is the allegedly highly descriptive nature of CITY OF LONDON as to gin. This is the issue the Federal Circuit identified in *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999), where the court determined that the mark at issue there was so highly descriptive of the goods and so commonly used by others in connection with the goods “as to be incapable of acquiring distinctiveness as a trademark.”<sup>103</sup> As explained above, we agree with Opposer that the proposed mark is primarily geographically descriptive (though not merely descriptive), but we do not view the record here as showing that the phrase is **so** highly geographically descriptive and commonly used in connection with gin that it is incapable of being perceived, in the eyes of the gin-consuming public, as a source identifier. Accordingly, we dismiss the opposition as it pertains to Opposer's claim that CITY OF LONDON fails to function as a trademark in derogation of Sections 1, 2 and 45 of the Trademark Act.

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<sup>102</sup> Opposer's Brief, p. 14 (38 TTABVUE 19).

<sup>103</sup> Opposer's failure to function claim thus does not assert that the phrase CITY OF LONDON is a commonly-used informational message untethered to any particular type of good, such as PROUDLY MADE IN USA, see *In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987), or THINK GREEN, see *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992).

**VIII. Whether Applicant's motion to amend its application is timely and procedurally proper.**

Because we have found Applicant's mark CITY OF LONDON for gin to be primarily geographically descriptive and have sustained Opposer's Section 2(e)(2) of the Trademark Act claim, but have also found that it is not so highly geographically descriptive and commonly used that it could never function as a trademark, we turn to Applicant's motion to amend its application, in the alternative, to seek registration under the provisions of Section 2(f) of the Trademark, 15 U.S.C. § 1052(f), or on the Supplemental Register.

The amendment of an application that is the subject of an opposition proceeding is governed by Trademark Rule 2.133, 37 C.F.R. § 2.133. That rule provides that an applicant may not amend in substance its application that is the subject of an opposition, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. This means that the Board, in its discretion, may grant a motion to amend an application that is the subject of an opposition, even if the opposer does not consent. *Cf. Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (noting principle that an acceptable amendment to the identification may be permitted despite opposer's objection if amendment limits identification and applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification).

Where, as here, a motion to amend an application in substance is made without the consent of the other party, it should be made prior to trial to give the opposer fair notice. *See Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1394 (TTAB

2016) (applicant's motion to amend the application to the Supplemental Register raised for the first time in applicant's brief on the case failed to fairly apprise opposer prior to trial that applicant intended to amend its application); *Drive Trademark Holdings*, 83 USPQ2d at 1435 ("the Board will generally defer determination of a timely filed (i.e., pre-trial) unconsented motion to amend in substance until final decision."); *Personnel Data Sys., Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863, 1864-65 (TTAB 1991) (respondent's Section 18 motion to restrict identification of goods in its registration, filed with brief on case, denied because petitioner had not been put on notice before it presented its case that respondent intended to amend its identification of goods).

That is to say, the Board will exercise its discretion under Trademark Rule 2.133(b) only where the petitioner or opposer has been put on notice during the trial period that the Board will be considering the issue of confusion with respect to a recitation of goods or services narrower in scope than that which was shown in the registration or application at the commencement of the proceeding.

*Personnel Data Sys.*, 20 USPQ2d at 1865.

If an applicant wishes to defend against the opposition by asserting that it is at least entitled to a registration with a particular restriction (e.g., applicant's mark has acquired distinctiveness or is registrable on the Supplemental Register), applicant should raise the defense either in its answer or by way of a timely motion to amend the application to include the restriction. *See Ayoub*, 118 USPQ2d at 1394 (applicant's motion to amend to Supplemental Register raised for first time in its main brief on the case deemed untimely where issue was neither raised prior to or during trial nor tried by implied consent).



If the Board ultimately finds that an applicant is entitled to registration only upon entry of a restriction that applicant timely proposed, the Board will approve and enter the restriction. *See Embarcadero Tech. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1841 (TTAB 2013) (applicant's Section 18 motion to restrict its identification of goods raised in alternative prior to close of discovery is timely and avoids likelihood of confusion). *But see Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, Applicant filed its motion, in the alternative, to amend its application to seek registration under Section 2(f) of the Trademark Act or on the Supplemental Register after the close of discovery but before Opposer's pretrial disclosures were due. 1031 n.152 (TTAB 2015) (applicant not allowed time to amend application where no specific restriction was suggested or tried by any party), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016).

Opposer did not consent to Applicant's motion "because any such amendment would be futile."<sup>104</sup> In addition, Opposer contested the motion on the ground that Applicant failed to plead its proposed amendment as an affirmative defense in its Amended Answer.<sup>105</sup> Thus, Opposer contends that, because it has not had the opportunity to conduct discovery on this issue, if the Board grants Applicant's motion, Opposer is entitled to take discovery as to whether Applicant's mark has acquired distinctiveness.<sup>106</sup>

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<sup>104</sup> Opposer's opposition to Applicant's motion for summary judgment and motion to amend, p. 14 (13 TTABVUE 15).

<sup>105</sup> *Id.*

<sup>106</sup> *Id.*

First, Opposer's assertion that Applicant's amendment would be futile goes to the merits of Applicant's amendment rather than whether it is procedurally appropriate. The assertion that Applicant's mark CITY OF LONDON for gin is entitled to registration under Section 2(f) or on the Supplemental Register is not wholly without merit.

Second, Applicant's proposed amendment is akin to an affirmative defense because it raises new facts and arguments that, if true, would circumvent Opposer's 2(e)(1) and 2(e)(2) claims. *Cf. Embarcadero Tech.* 105 USPQ2d at 1828-29 (applicant moved to amend its descriptions of goods and services, requested at trial that the amendment be considered in the alternative, and the Board deemed the answer amended to include the affirmative defense under Section 18).

An affirmative defense assumes the allegations in the complaint to be true but, nevertheless, constitutes a defense to the allegations in the complaint. An affirmative defense does not negate the elements of the cause of action; it is an explanation that bars the claim. *Blackhorse v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011) (*citing Gwin v. Curry*, 161 F.R.D. 70, 71 (N.D. Ill. 1995)) (the affirmative defense concept codifies the common law plea in confession and avoidance: "Each defendant either expressly or impliedly treats the factual allegations in a complaint as true, but then goes on to assert new matter that eliminates or limits the defendant's ordinary liability stemming from those allegations."). *See also Parkinson v. DOJ*, 874 F.3d 710, 720-721 n.9 (Fed. Cir. 2017) (*quoting* Affirmative Defense, under Defense, BLACK'S LAW DICTIONARY (10th ed. 2014) ("A defendant's assertion of facts and arguments

that, if true, will defeat the plaintiff's or prosecution's claim, even if all the allegations in the complaint are true.")).

Although Applicant did not plead its Section 2(f) claim of acquired distinctiveness or alternative amendment to the Supplemental Register in its Amended Answer, Applicant was not categorically precluded from raising either basis for registration later by way of motion to amend the application. *See, e.g., Embarcadero Tech. Inc. v. RStudio Inc.*, 105 USPQ2d at 1828-29. In such situations, such as in the case before us, Trademark Rule 2.133(a), 37 C.F.R. § 2.133(a), specifically provides that an application subject to an opposition may be amended upon a motion granted by the Board. Thus, Applicant could have asserted, as an affirmative defense, registration in the alternative, under Section 2(f) or on the Supplemental Register, if it knew it was going to amend its application when it filed its Answer. However, after Applicant filed its Answer, Trademark Rule 2.133(a) permits Applicant to file a motion to amend its application so long as the motion gives Opposer sufficient notice to prepare for trial.

Third, Opposer's claim that Applicant's mark CITY OF LONDON for gin fails to function as a mark presupposes that it is incapable of functioning as a mark and, therefore, is not registrable on the Supplemental Register. Therefore, we find that Opposer has not shown that it needs additional discovery on this claim because it is part of Opposer's case in chief.

Finally, we turn to whether Applicant's motion seeking registration pursuant to Section 2(f) of the Trademark Act has prejudiced Opposer. As noted above, Applicant

filed its motion to amend prior to trial and, therefore, it is prima facie timely. In support of its motion for summary judgment filed simultaneously with its motion to amend, Applicant introduced a declaration by Simon Strutt, Applicant's Finance Director, attesting to the following:

Applicant has continuously and exclusively sold Applicant's Gin through its exclusive U.S. distributor, Pacific Edge, in the United States for more than five years, i.e., since at least as early as October 2012. Applicant's CITY OF LONDON gin has been distributed in approximately 4,000 outlets in 21 states. Sales of Applicant's Gin, to date, has exceeded approximately \$1.2 million. In 2012, Applicant's CITY OF LONDON gin won gold medal at the Spirits Business Gin Masters Awards.<sup>107</sup>

Because the Board deferred ruling on Applicant's motion until final hearing, it was incumbent upon Opposer to renew its request to reopen discovery for the limited purpose of exploring the evidence supporting Applicant's claim of acquired distinctiveness if, in light of Mr. Strutt's testimony, Opposer required additional discovery. Opposer's failure to renew its motion to renew discovery belies Opposer's belief that it is prejudiced by Applicant's motion to pursue registration, in the alternative, under the provisions of Section 2(f).

In view of the foregoing, we find that Applicant's motion to amend is procedurally timely and would not prejudice Opposer if we were to grant it. We therefore now turn to the merits of the motion, beginning with our analysis as to whether Applicant's involved mark has acquired distinctiveness.

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<sup>107</sup> Strutt Decl. ¶11 (11 TTABVUE 24).

**IX. Whether Applicant's mark CITY OF LONDON has acquired distinctiveness?**

As noted above, under Section 2(f) of the Trademark Act, matter that is primarily geographically descriptive under Section 2(e)(2) may nonetheless be registered on the Principal Register if it “has become distinctive of the applicant’s goods in commerce.” Thus, the USPTO may register CITY OF LONDON on the Principal Register if Applicant proves that it has acquired distinctiveness (also known as “secondary meaning”) as used in connection with Applicant’s gin. *See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at \*5 (TTAB 2020) (“A primarily geographically descriptive mark may be registered if it ‘has become distinctive of the applicant’s [services] in commerce.’”); *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006) (“If the geographic term is ‘primarily geographically descriptive’ under Section 2(e)(2), the term may be registered on the Supplemental Register or upon a showing of acquired distinctiveness.”). *See also In re Bacardi & Co.*, 48 USPQ2d 1031, 1036 n.17 (TTAB 1997) (“A mark refused registration under Section 2(e)(2) may be registrable on the Supplemental Register, under Section 23, or it may be registrable on the Principal Register with a showing of acquired distinctiveness under Section 2(f).”).

Acquired distinctiveness means an acquired “mental association in buyers’ minds between the alleged mark and a single source of the product.” *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017) (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed., June 2017 Update)). In this regard, in analyzing above whether the CITY

OF LONDON is a generally known geographic location, we considered all of the evidence touching on the relevant public's perception of that name.

An applicant seeking registration of a mark under Section 2(f) bears the ultimate burden of establishing acquired distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (“The applicant ... bears the burden of proving acquired distinctiveness.”) (citation omitted).

### **A. Degree of Geographic Descriptiveness**

The initial question before us in our analysis of whether the CITY OF LONDON has acquired distinctiveness is its degree of geographic descriptiveness as used in connection with Applicant's gin. *See Spiritline Cruises*, 2020 USPQ2d 48324, at \*5 (quoting *Royal Crown Cola*, 892 F.3d 1358, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018) (“the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.”) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005))). As the Board has explained:

[T]he greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. The sufficiency of the evidence offered to prove acquired distinctiveness should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source-indicators.

*In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010) (internal citations omitted). *See also La. Fish Fry Prods.*, 116 USPQ2d at 1265 (Board has discretion not

to accept an applicant's allegation of five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness when the proposed mark is "highly descriptive"); *Boston Beer Co.*, 53 USPQ2d at 1058 ("[C]onsidering the highly descriptive nature of the proposed mark, [Applicant] has not met its burden to show that the proposed mark has acquired secondary meaning.").

As discussed above, American gin drinkers and purchasers will perceive the commercial impression of the mark CITY OF LONDON to mean and engender London, a well-known major metropolitan area in England, long associated with gin. Because the evidence here convinces us that London is so well-known and so closely-associated with gin generally—indeed, it gives its name to a specific and popular type of dry gin—we find CITY OF LONDON highly geographically descriptive in connection with gin.

### **B. Evidence of Acquired Distinctiveness**

Because we found that CITY OF LONDON is highly geographically descriptive of Applicant's goods, Applicant's burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See Steelbuilding.com*, 75 USPQ2d at 1424; *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990); *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1199 (TTAB 2016); *In re Greenliant Sys. Ltd.*, 97 USPQ2d at 1085.

"To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or

service itself.” *Steelbuilding.com*, 75 USPQ2d at 1422; *see also Coach Servs.*, 101 USPQ2d at 1729. We base our Section 2(f) analysis and determination in this case on all of the evidence considered as a whole, guided by the following factors:

(1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. ... All six factors are to be weighed together in determining the existence of secondary meaning.

*In re Snowizard, Inc.*, 129 USPQ2d 1001, 1005 (TTAB 2018) (quoting *Converse, Inc. v. Int’l Trade Comm’n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)). *See also Steelbuilding.com*, 75 USPQ2d at 1424; *Cicena Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401, 1406 (Fed. Cir. 1990). On this list, no single fact is determinative. *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) (“Direct evidence [of acquired distinctiveness] includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers.”). We now turn to an analysis of the evidence in the record.

1. Association of CITY OF LONDON with a particular source by actual purchasers (typically measured by customer surveys).

Applicant did not submit any direct evidence of acquired distinctiveness, such as testimony from actual consumers or a customer survey. Applicant did supply,



however, some circumstantial evidence of acquired distinctiveness, which we discuss below.

2. Length, degree, and exclusivity of use.

Applicant has used CITY OF LONDON in the United States since October 2012.<sup>108</sup> There is no evidence of any other entity using CITY OF LONDON for gin or any other alcoholic beverage in the United States.<sup>109</sup>

3. Amount and manner of advertising.

Applicant proffered no testimony or other evidence regarding its advertising expenditures in the U.S. However, Applicant's U.S. distributor, Pacific Edge Wine and Spirits, advertises Applicant's "Tyler's City of London Imported Dry Gin" on its website.<sup>110</sup> In addition, both parties introduced copies of third-party websites advertising the sale of Applicant's CITY OF LONDON gin.<sup>111</sup>

4. Amount of sales and number of customers.

Applicant has sold its CITY OF LONDON gin in the United States through its exclusive U.S. distributor Pacific Edge Wine and Spirits.<sup>112</sup> Pacific Edge Wine and Spirits has distributed Applicant's CITY OF LONDON gin to approximately 4,000

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<sup>108</sup> Strutt Decl. ¶7 (36 TTABVUE 3).

<sup>109</sup> Applicant's witness testified that he is unaware of any third-party use of CITY OF LONDON for gin in the United States and, aside from Opposer, the witness is unaware of any third-party use of CITY OF LONDON for gin anywhere else in the world. Strutt Decl. ¶ 12 (36 TTABVUE 4).

<sup>110</sup> 36 TTABVUE 12.

<sup>111</sup> 26 TTABVUE 82-86, 123, and 215-225; 35 TTABVUE 6-88.

<sup>112</sup> Strutt Decl. ¶8 (36 TTABVUE 3).

outlets in 21 states.<sup>113</sup> Sales of CITY OF LONDON gin in the United States from October 2012 through November 22, 2019 (date of the declaration) has exceeded \$1.5 million dollars.<sup>114</sup>

The third-party online retailers noted above advertise the sale of a 750ml bottle of Applicant's gin for as low as \$14.99 and as high as \$31.99. Assuming an average retail price of \$20 per bottle, then Applicant has sold approximately 75,000 bottles of gin between October 2012 and November 22, 2019 (seven years), or approximately 10,714 bottles per year. Inasmuch as Applicant has sold its gin through 4,000 outlets, each outlet has sold on average 2.7 bottles.<sup>115</sup> Nevertheless, because Applicant provided no context in the form of market share or growth, these numbers do not show that CITY OF LONDON has acquired distinctiveness. *See Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007) (sales alone without context not sufficient to establish acquired distinctiveness). *Cf. Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("some context in which to place raw statistics is reasonable."); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (Board rejected an applicant's attempt to show weakness of a term in a mark through citation to a large number of GOOGLE "hits" because the results lacked sufficient context).

##### 5. Intentional copying.

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<sup>113</sup> Strutt Decl. ¶9 (36 TTABVUE 3).

<sup>114</sup> Strutt Decl. ¶11 (36 TTABVUE 4).

<sup>115</sup> Because Applicant failed to provide context for its sales figures, Applicant left us to apply the above-noted assumptions to give meaning to the testimony of Applicant's witness regarding Applicant's sales.

Applicant did not present any testimony or other evidence regarding intentional copying.

6. Unsolicited media coverage of the product embodying the mark.

Applicant did not introduce any testimony or evidence regarding media coverage of its CITY OF LONDON gin in the U.S.

Applicant's witness testified that in 2012, Applicant's CITY OF LONDON gin won a gold medal at the EU Spirits Business Masters Award presented in the United Kingdom.<sup>116</sup> However, there is no testimony or evidence as to whether American gin purchasers and drinkers are aware of that award, and the third parties advertising the sale of Applicant's CITY OF LONDON gin did not promote the award on their websites.

We considered the evidence as a whole and find that in light of the highly geographically descriptive nature of the mark, this meager showing falls far short of proving acquired distinctiveness. Although Applicant's use of the mark CITY OF LONDON for gin has been continuous and substantially exclusive since October 2012, its sales and advertising have been de minimis and it has received no media attention. Accordingly, Applicant failed to prove that CITY OF LONDON for gin has acquired distinctiveness and we refuse to register the mark under Section 2(f) of the Trademark Act.

Nevertheless, consistent with our finding earlier rejecting Opposer's failure to function claim, we find that Applicant's mark CITY OF LONDON for gin is capable

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<sup>116</sup> Strutt Decl. ¶10 (36 TTABVUE 3).

of functioning as a mark and, therefore, we therefore grant Applicant's motion to amend pursuant to Trademark Rule 2.133 solely to the extent that we approve Applicant's mark for registration on the Supplemental Register.

**Decision:** The opposition is sustained as to the claim under Section 2(e)(2) of the Trademark Act.

The opposition is dismissed as to the claims under Sections 2(e)(3), 2(e)(1) of the Trademark Act, and failure to function as a mark under Sections 1, 2, and 45 of the Trademark Act.

Applicant has not established it is entitled to registration on the Principal Register under Section 2(f), but we approve Applicant's mark for registration on the Supplemental Register.