

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MBM Company, Inc.

Serial No. 75/243,307

F. William McLaughlin of Wood, Phillips, VanSanten, Clark &
Mortimer for MBM Company, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Seeherman, Wendel and Holtzman, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

MBM Company, Inc. has filed an application to register
the mark LIMOGES for "jewelry, not including ceramic
jewelry."¹

Registration has been finally refused on the grounds
that the mark is geographically deceptive under Section
2(a) and/or that the mark is primarily geographically

deceptively misdescriptive under Section 2(e)(3).

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

The determination of whether a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) requires analysis under the following two-prong test:

- (1) whether the primary significance of the mark as it is used is a generally known geographic place; and
- (2) whether the public would make a goods/place association, i.e., believe the goods for which the mark is sought to be registered originate in that place.

Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992), citing In re Societe Generale des Eaux Minerales de Vittel, S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982); In re Bacardi & Co., 48 USPQ2d 1031 (TTAB 1997). In order for a mark to be geographically deceptive under Section 2(a), it must be shown that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) and additionally that

¹ Serial No. 75/243,307, filed February 18, 1997, based on an

the geographic misrepresentation is material to the decision of the purchaser to buy the goods bearing this mark. *Institut National v. Vinters International, supra*; *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).²

The Examining Attorney has made of record a listing from *Webster's New Geographical Dictionary* identifying Limoges as a manufacturing and commercial city in France, and as the chief seat of the porcelain industry in that country. While applicant argues that it is not apparent from this description whether the primary significance of the word "Limoges" is geographic, as opposed to meaning ceramics per se, we do not agree. The word "Limoges" is the name of the city from which the ceramics originate and, as such, is primarily geographic in significance.

It is the second prong of the test under Section 2(e)(3) which raises the major issue in this case.

assertion of a bona fide intention to use the mark in commerce.
² Section 2 of the Trademark Act was amended by Public Law 103-183, 107 Stat. 2057, The North American Free Trade Enactment Act, effective for applications filed on or after December 8, 1993. As a result, the prohibition against registration on the basis of being primarily geographically deceptively misdescriptive was moved from Section 2(e)(2) to Section 2(e)(3) and the availability of Section 2(f) for marks of this nature was eliminated. Thus, the major distinction between being refused registration as primarily geographically deceptively misdescriptive and geographically deceptive under Section 2(a) no longer exists, in that registration under the provisions of Section 2(f) is not an option in either case.

Applicant has acknowledged that its jewelry is not intended to originate in Limoges, France. However, even if the goods do not come from the place named, if the public makes no goods/place association, the public is not deceived and the mark is not geographically deceptively misdescriptive. In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982). The burden is on the Examining Attorney to establish a prima facie case that the public would make a goods/place association such that they would believe that the goods for which applicant seeks to register the mark LIMOGES do in fact originate in Limoges, France. In other words, it must be shown that the public would have reason to believe that applicant's jewelry (which does not include ceramic jewelry) bearing the mark LIMOGES comes from the French city Limoges.

In his final refusal, the Examining Attorney made of record excerpts from the Nexis database containing references to items such as "Limoges china," "Limoges gem-encrusted music box eggs," "Limoges boxes," and a "Limoges ashtray." He also provided excerpts which refer to "porcelain jewelry" and others which show that Limoges porcelain items may be offered for sale in the same retail outlets as jewelry. After applicant restricted its identification of goods to exclude ceramic jewelry, the

Examining Attorney introduced three additional excerpts, allegedly showing that Limoges is known for jewelry, as well as porcelain products.

Applicant strongly contends that only one of these three excerpts uses the word "Limoges" in connection with jewelry and that the excerpts do not support the Examining Attorney's conclusion that Limoges, France is "known for jewelry." Applicant argues that the Examining Attorney has not established the requisite goods/place association.

After carefully reviewing the excerpts, we agree with applicant. In the first excerpt, we see a reference to "an assortment of gift items (like Limoges jewelry)," in the second, a reference to "Baccarat crystal vases, goblets and candlesticks, Limoges china and jewelry" and in the third, a reference to "a footed Limoges 'jewelry catcher'." The first excerpt may be considered a reference to jewelry from Limoges, although without any indication of type (ceramic or other). In the second excerpt, however, there is no basis for inferring that Limoges refers to any goods other than the "china," and in the third excerpt, the "jewelry catcher" is clearly an item to hold jewelry, not jewelry per se.

This limited reference to Limoges jewelry in a single article is insufficient evidence to support the requisite

goods/place association, much less the Examining Attorney's conclusion that Limoges is "known for jewelry," or that "Limoges is one of the top cities for jewelry and porcelain products." (Examining Attorney's Appeal Brief, p.2).

Although we agree that porcelain or ceramic jewelry would fall within the ambit of the porcelain products for which Limoges is well known, applicant has specifically excluded this type of jewelry from its identification of goods. On the evidence before us, we cannot conclude that the public would make a goods/place association between non-ceramic jewelry and Limoges.

While the record shows that Limoges is a manufacturing and commercial city well-known for porcelain, there is no evidence that Limoges is a city of such size or commercial diversity that purchasers would assume that a wide range of products, including non-ceramic jewelry, comes from there. And the fact that a purchaser might find porcelain items such as Limoges boxes or ashtrays, in the same stores where jewelry, too, is sold does not, in itself, establish a goods/place association between the city of Limoges and jewelry, given the inherent differences between porcelain and jewelry.

In view of the absence of evidence to support a conclusion that the purchasing public would expect non-

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ceramic jewelry such as applicant's to originate in Limoges, we cannot uphold the refusal of registration on the basis of applicant's mark being primarily geographically deceptively misdescriptive. See *In re Nantucket, Inc.*, *supra*; *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990). The refusal under Section 2(a) on the basis that applicant's mark is geographically deceptive must also fall.³

Decision: The refusals to register under Section 2(a) and 2(e)(3) are reversed.

E. J. Seeherman

H. R. Wendel

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

³ We note that upon submission by applicant of a statement of use and the requisite specimen of actual use, the Office is free to reconsider the question of whether support exists for the requisite goods/place association, based on applicant's own promotion of its goods.

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