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10/4/00 GFR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AIT, Inc.

Serial Nos. 75/323,782; 75/323,783; 75/323,785;  
75/323,786; and 75/323,787

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Shanna Blaustein, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney).

Before Simms, Quinn and Rogers, Administrative Trademark  
Judges.

Opinion by Rogers, Administrative Trademark Judge:

AIT, Inc., a corporation of Connecticut with a  
business address in Connecticut, has filed applications to  
register KEY LARGO LIMES, KEY WEST WAHOOS, MARCO ISLAND  
MANATEES, SANIBEL STINGRAYS, and SIESTA KEY SNOOKS, each as  
a trademark in International Class 25 for goods identified  
as "men's, women's and children's clothing, namely, shirts,  
sweatshirts, T-shirts, jackets, coats, robes, sweaters,

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hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear and neckwear."<sup>1</sup>

The Trademark Examining Attorney has made final a refusal of registration on the ground that each of the proposed marks is primarily geographically deceptively misdescriptive of the applicant's goods and is thereby barred from registration by Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3). In addition, the Examining Attorney has, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), made final a likelihood of confusion refusal to register MARCO ISLAND MANATEES, in view of the prior registration of MANATEE for "men's and women's sportswear; namely, shorts, pants, slacks, shirts, skirts, blouses, jackets and coats,"<sup>2</sup> and a likelihood of confusion refusal to register SANIBEL STINGRAYS, in view of the prior registration of STING RAY for "boys swimsuits."<sup>3</sup>

Applicant has appealed from each of these refusals. Briefs were filed; and the applicant filed but subsequently

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<sup>1</sup> Respectively, Serial Nos. 75/323,782, 75/323,783, 75/323,785, 75/323,786, and 75/323,787, all filed July 14, 1997, based on applicant's allegation of a bona fide intention to use each mark in commerce.

<sup>2</sup> Registration No. 1,722,055, in International Class 25, issued October 6, 1992. Section 8 and 15 affidavits filed and accepted.

<sup>3</sup> Registration No. 1,358,138, in International Class 25, issued September 3, 1985. Section 8 and 15 affidavits filed and accepted.

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withdrew a request for a consolidated oral hearing. The issues presented by the respective refusals under Section 2(e)(3) of the statute are essentially identical, and the facts are similar. Accordingly, in the interest of judicial economy, we consider the appeals together and issue a single opinion.

***The Section 2(e)(3) Refusals***

In order to establish a prima facie case for refusal of registration under Section 2(e)(3), the Examining Attorney must show that the primary significance of each of applicant's composite marks is its geographical connotation, and that members of the public would believe that the goods for which the mark is sought to be registered originate in the geographic place named in the mark when, in fact, the goods do not originate in that geographic place. See The Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992); In re Societe Generale des Eaux Minerals de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In re Loew's Theaters, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

The Examining Attorney has introduced evidence establishing that KEY LARGO, KEY WEST, MARCO ISLAND, SANIBEL, and SIESTA KEY, are the names of specific geographic locations in Florida.<sup>4</sup> Indeed, applicant does not contend otherwise, e.g., it does not contend that these locations are obscure and relatively unknown, or that the terms have other, non-geographic meanings or connotations.

The applicant and the Examining Attorney do disagree, however, as to the import of the presence of an additional, arbitrary term in each of the composite marks. The Examining Attorney argues that, in each instance, the presence of the arbitrary term does not create a composite that has a non-geographic connotation. In contrast, the applicant argues that the Examining Attorney has not considered each mark in its entirety, in violation of the anti-dissection rule, and gives too little weight to the arbitrary component in each mark.

In each application, the applicant specifically concedes "Applicant does not presently intend to manufacture or produce the goods of the application at the

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<sup>4</sup> This evidence includes photocopies of portions of maps, listings from Merriam Webster's Geographical Dictionary (3<sup>rd</sup> ed.), and articles retrieved from the NEXIS computerized database of publications.

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geographic location included in the mark; but certainly, Applicant intends to sell the goods there (and elsewhere)."

As Professor McCarthy has observed, "[i]f the composite mark contains the name of the geographic location from which the goods do not come, a court may be more strict in its scrutiny..." 2 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 14:11 (4<sup>th</sup> ed. 1998). This Board, in *In re Wada*<sup>5</sup>, adopted just such an approach, and faulted the applicant therein for not providing "any facts as to why, in its view, the primary geographic significance of the mark is lost" by the addition of even arguably arbitrary words. *Wada, supra*, 48 USPQ2d at 1690.

Applicant in these cases argues that it is important to understand that each mark "was conceived as a designation for an imaginary sports team, hypothetically representing an island in the vicinity of Florida and being a member of an imaginary league of teams."<sup>6</sup> Applicant suggests that the "imaginary nature" of these teams may make the marks more arbitrary or fanciful. A similar

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<sup>5</sup> *In re Wada*, 48 USPQ2d 1689 (TTAB 1998), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

<sup>6</sup> Applicant concedes its marks are, or will be, printed prominently on its goods, in the same manner that professional, college and high school teams display their names.

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argument was unsuccessful by the applicant in *Wada*, where "New York Ways Gallery" was argued to be a fictitious location and therefore a fanciful or arbitrary designation, rather than a primarily geographical designation. *Wada*, *supra* 52 USPQ2d at 1540.

Applicant herein has pointed to no facts in support of its conclusion that prospective consumers, if confronted with its goods bearing the names of fictitious teams, would consider the marks as having other than geographic connotations. In fact, applicant presents argument that leads to the contrary conclusion. Specifically, applicant posits that "a person/place association, arising from a sense of inter-island competitiveness<sup>7</sup> and equal in strength to that which involves a real team, could well be the motivation for purchase" of applicant's goods. This suggests that, if applicant's marks are perceived as intended, consumers may purchase the goods bearing the marks precisely because they have a geographic connotation.

Finally, although neither the Examining Attorney nor the applicant has discussed the significance of the terms LIMES, WAHOOS, MANATEES, STINGRAYS and SNOOKS, we note Internet evidence made of record by the Examining Attorney

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<sup>7</sup> In two of the applications, applicant uses the word "competition," rather than "competitiveness."

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in the applications, and take judicial notice of dictionary definitions, that suggest each of these five terms will tend to reinforce, rather than detract from, the geographic significance of the marks.<sup>8</sup>

In the KEY LARGO LIMES application, the Examining Attorney's Internet evidence reveals that the "Largo Cargo" store in Key Largo features "Tropical Key Lime products." In the KEY WEST WAHOOS application there are Internet listings for the "Key Lime Shoppe," which offers "[l]ots of key lime goodies and gifts for sale"; for "Key West's Finest Gifts and Baskets," which feature, among other items, "gourmet treats, Key lime flavors and Key West Memorabilia"; and for "Nellie & Joe's," with a phone number "1-800-LIME-PIE" and which promotes sales of "original Key

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<sup>8</sup> **wahoo...** *n.*, *pl.* **-hoos...** a large, swift mackerel, ...widespread in warm seas, of a steel blue to greenish blue above and silver below, often leaping from the water and occasionally schooling in great numbers: valued as a food and game fish. The Random House Dictionary of the English Language 2136 (2d ed. 1987).

**manatee...** *n.* any of several plant-eating aquatic mammals ...of West Indian, Floridian, and Gulf Coast waters... The Random House Dictionary of the English Language 1167 (2d ed. 1987).

**stingray...** *n.* any of the rays, esp. of the family Dasyatidae, having a long, flexible tail armed near the base with a strong, serrated bony spine with which they can inflict painful wounds. The Random House Dictionary of the English Language 1871 (2d ed. 1987).

**snook...** *n.*, *pl.* **...snooks.** 1. any basslike fish... inhabiting waters off Florida and the West Indies and south to Brazil, valued as food and game. The Random House Dictionary of the English Language 1808 (2d ed. 1987).

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West Lime Juice" that Nellie and Joe have been bottling for 29 years.

The dictionary definitions we have noted reveal that manatees and snooks inhabit Floridian waters and that wahoos are a game fish inhabiting warm seas. Further, "The Florida Keys Internet Guide," made of record by the Examining Attorney in the KEY LARGO LIMES application, reveals charter boat captains will take sportfishers "searching for marlin, dolphin, wahoo or tuna just a few miles off shore" (emphasis added).

In short, we find the terms applicant has added to each of the geographical designations, though arbitrary in relation to clothing items, nonetheless tend to reinforce the geographical connotations of the marks, considered in their entirety. We are not persuaded otherwise by applicant's argument that there is an alliterative quality in each mark sufficient to overcome their primarily geographic connotations.

Turning to the requirement that, for a refusal of registration under Section 2(e)(3), there be a goods/place association, the Examining Attorney has submitted evidence in each application to demonstrate that shirts and related items of wearing apparel can be purchased in each of the five Florida locations involved herein, and in some

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locations, the goods are designed and made. Applicant, relying on the Board's *Municipal Capital*<sup>9</sup> decision, argues that it is hard to conceive of goods that are more widely available for purchase than clothing and that it was incumbent upon the Examining Attorney to establish "something more" than the mere availability of the identified goods in each of the Florida locations. The Examining Attorney, however, is not required to "marshal evidence that the place named is noted for or famous for the goods recited in the application but, rather, ...must make a persuasive case that, on seeing the mark, purchasers would be deceived into believing that the goods came from the place named in the mark." In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849 (TTAB 1982).

We find that something more is present in these cases, beyond the availability of clothing items for purchase in the places named in applicant's marks, and we find that purchasers would believe that applicant's goods come from the places named in the marks. The Examining Attorney has established that each of the locations named in the marks is a known tourist destination<sup>10</sup> and that, to borrow a

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<sup>9</sup> In re Municipal Capital Markets Corp., 51 USPQ2d 1369 (TTAB 1999).

<sup>10</sup> See, e.g., "The Florida Keys Internet Guide" introduced by the Examining Attorney in the KEY LARGO LIMES application; Merriam

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characterization of the goods, T-shirts and other such "souvenirs for the pilgrims of popular culture"<sup>11</sup> are widely available in these places.

In *Municipal Capital*, the majority reasoned that in the absence of evidence associating any particular type of cuisine or food preparation with the place called Cooperstown, restaurant diners in a restaurant bearing that name but located elsewhere and not affiliated in any way with the place, would not draw an association between the restaurant and the place. We find the cases before us distinguishable. While T-shirts and related souvenir apparel may be sold almost everywhere, it is much more likely that, for example, KEY LARGO LIMES emblazoned apparel would be sold in, or would originate from, Key Largo, Florida, than elsewhere. In short, in these cases, we believe consumers would make the association.

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Webster's Geographical Dictionary 587 (3<sup>rd</sup> ed.) in the KEY WEST WAHOOS application; the newspaper article from The Sunday Oklahoman (December 22, 1996) in the MARCO ISLAND MANATEES application; the Internet sites referenced in the SANIBEL STINGRAYS application which provide information on the island, accommodations, and shopping; and the newspaper article from the Sarasota Herald-Tribune (February 6, 1998) discussing the Siesta Key fifth annual Craft Festival, featuring local and national exhibitors.

<sup>11</sup> Rock and Roll Hall of Fame and Museum Inc. v. Gentile Productions, 134 F.3d 749, 45 USPQ2d 1412, 1419 (6<sup>th</sup> Cir. 1998).

Applicant analogizes its goods to those of real, as opposed to fictitious, sports teams, arguing that "it is hardly likely that shirts bearing the BALTIMORE ORIOLES trademark originate in Baltimore--and it is hardly likely that any purchaser cares." Applicant asserts it is incredible to claim that the prospective purchaser of such goods, whether bearing the mark of a real team or one of the fictitious teams in applicant's marks, would actually believe that the goods originate in the places named. Apart from the utter absence of any evidence to support applicant's view of consumer concerns, we note that the question is not only whether consumers would perceive that applicant's shirts are manufactured in the places named, but also whether they would perceive some other type of connection or relationship with the place named. See, e.g., In re Olin Corp., 181 USPQ 182 (TTAB 1973) ("The 'ornamentation' of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name 'New York University'... will serve as ornamentation on a T-shirt [but] will also advise the purchaser that the university is the secondary source of that shirt. It is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt. Where

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the shirt is distributed by other than the university the university's name upon the shirt will indicate the sponsorship or authorization by the university.")

In regard to applicant's goods, we believe consumers will perceive associations with the places named. It is sufficient for the Examining Attorney's refusal of registration if consumers would believe the goods are manufactured in the places named in applicant's marks; but it is also sufficient if consumers would believe the goods were manufactured *for* businesses located in these places.

We note applicant's argument that other applications it has filed for other island-based, fictitious sports teams' names have been approved, including at least one such application that was approved by the Examining Attorney who refused the applications involved herein. It is, however, well settled that each case is to be taken on its own merits and we are not privy to the records created in those cases. Likewise, how this Examining Attorney has examined other applications involving allegedly similar marks, and some of the same marks, for different goods, is not an issue before us.<sup>12</sup>

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<sup>12</sup> Throughout prosecution and briefing of these applications, applicant has cited marks, serial numbers of applications, and registration numbers to support its arguments. It is well settled, however, both that mere listing of such information, even if garnered from the Office's records, is insufficient to

Finally, we also note some explanation by the Examining Attorney that applicant does not have the option, in these cases, of entering disclaimers of the geographic place names, to obtain approval of its applications. To the extent the Examining Attorney's observations on this subject are prompted by the acceptance of disclaimers in some of applicant's other applications, we agree with the Examining Attorney's conclusion that this is not an option now available to applicant. See the *Wada* decisions, cited herein, for a fuller discussion of this issue.

The refusals of registration under Section 2(e)(3) of the Trademark Act are affirmed.

***The Section 2(d) Refusals***

Our determination under Section 2(d), of each of the two refusals to be reviewed, is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by the first case, two key considerations are the similarity of the marks and the

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place the applications or registrations in evidence. Moreover, it is equally well settled that the Board does not take judicial notice of such matters.

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legally identical nature of some of the goods; in the second case, we focus on the similarity of the marks and the relatedness of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider first, the Examining Attorney's refusal of registration of MARCO ISLAND MANATEES, for "men's, women's and children's clothing, namely, shirts, sweatshirts, T-shirts, jackets, coats, robes, sweaters, hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear and neckwear," in view of the prior registration of MANATEE for "men's and women's sportswear; namely, shorts, pants, slacks, shirts, skirts, blouses, jackets and coats."

In part, the involved goods are identical, e.g., men's and women's shorts, slacks, shirts, skirts, jackets and coats. With no restrictions on the channels of trade for the respective goods, we presume that the respective goods move in all normal channels of trade and to all usual classes of consumers therefor. See CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). In short, for our analysis, some of the goods are identical and their channels of trade and classes of consumers are presumptively the same. Indeed, applicant makes no

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arguments to the contrary. Rather, applicant focuses solely on the marks.

The entirety of the registered mark is MANATEE and appears to be arbitrary or fanciful. The commercial impression created by applicant's mark is very similar, albeit applicant's mark has the connotation of manatees frequenting the waters of Marco Island, Florida. We do not find this minor distinction significant, especially in view of the fallibility of memory of the average purchaser, who may not be able to make a side-by-side comparison of the marks, and who tends to retain a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Consumers familiar with registrant's MANATEE mark, used on its identified goods, if confronted with applicant's mark used on applicant's identified goods in the marketplace, will likely be confused as to source or sponsorship.

Turning to the second Section 2(d) refusal, the Examining Attorney has refused registration of SANIBEL STINGRAYS, for "men's, women's and children's clothing, namely, shirts, sweatshirts, T-shirts, jackets, coats, robes, sweaters, hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear and neckwear," in view

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of the prior registration of STING RAY for "boys swimsuits." While applicant's identified goods do not include boys' swimsuits, they do include a wide variety of children's clothing, some of which, as with registrant's swimsuits, would be considered appropriate beach attire, e.g., T-shirts, caps, and shorts. We find some of applicant's identified goods closely related to registrant's swimsuits. *Cf.* John B. Stetson Company v. Playboy of Miami, Inc., 154 USPQ 63 (TTAB 1967), and Ship 'N Shore Inc. v. The Stafford-Higgins Company, Inc., 129 USPQ 240 (TTAB 1961). We note also, in this regard, the Examining Attorney's Internet evidence in the SANIBEL STINGGRAYS application, which lists the "Cricket Shop" as featuring "a unique selection of resort wear, swimsuits, shoes and accessories."

The entirety of the registered mark is STING RAY and appears to be arbitrary or fanciful. The commercial impression created by applicant's mark SANIBEL STINGGRAYS is very similar, albeit applicant's mark has the connotation of stingrays frequenting the waters of Sanibel Island, Florida. We do not find this minor distinction significant, especially in view of the fallibility of memory of the average purchaser, who may not be able to make a side-by-side comparison of the marks, and who tends

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to retain a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., *supra*.

Consumers familiar with registrant's STING RAY mark, used on its identified goods, if confronted with applicant's mark used on applicant's identified goods in the marketplace, will likely be confused as to source or sponsorship.

Applicant argues that each of the two marks, MARCO ISLAND MANATEES and SANIBEL STINGGRAYS, because they are plural, creates a sports team connotation. The argument, however, is based solely on speculation and is without any support in the record. Applicant also argues that each of these marks has an alliterative quality that serves to distinguish it from the mark in the relevant cited registration. We are not persuaded, by either of these arguments, that either of these Section 2(d) refusals should be reversed.

The refusals of registration under Section 2(d) of the statute both are affirmed.

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Decision: Each of the refusals of registration is affirmed, for the reasons stated herein in regard to each.

R. L. Simms

T. J. Quinn

G. F. Rogers

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board