

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Piter Societa' A Responsabilita' Limitata

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Serial No. 74/621,510

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Jonathan Myers and Herbert Dubno of The Firm of Karl F. Ross, P.C. for applicant.

Andrew D. Lawrence, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Seeherman, Hohein and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Piter Societa' A Responsabilita' Limitata has filed an application to register the mark depicted below

for "clothing articles, namely, wind-resistant jackets, neckerchiefs, jackets, trousers, waistcoats, jeans, vests,

gloves, socks, tank tops, blousons, T-shirts, stockings, bandannas, head bands, pants, belts, scarves, skirts, head wear, and footwear".<sup>1</sup>

Registration has been finally refused under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), on the ground that the mark, when used in connection with applicant's goods, is primarily geographically deceptively misdescriptive thereof.<sup>2</sup>

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<sup>1</sup> Ser. No. 74/621,510, filed January 17, 1995, with a claimed first use date of Nov. 26, 1993 and a claimed first use date in commerce between Italy and the United States of October 10, 1994.

<sup>2</sup> In the early stages of prosecution of this case, applicant submitted disclaimers of the terms MOTOR JACKET and CALIFORNIA, separately. Applicant next submitted a declaration under Section 2(f) and a request to amend the application to one on the Supplemental Register. The Examining Attorney, in response, pointed out that the latter two avenues could not be undertaken concurrently, and that in any event, neither avenue was available to applicant since its first alleged use in commerce was not until October 10, 1994. By the amendment of the Trademark Act, on January 1, 1994, to implement provisions of the North American Free Trade Agreement, primarily geographically deceptively misdescriptive marks may no longer be registered under 2(f), with the exception of marks which had become distinctive in commerce before December 8, 1993, nor may they be registered on the Supplemental Register, with the exception of marks which had been in lawful use in commerce before December 8, 1993. Thus, applicant could not qualify for either exception. Applicant subsequently withdrew the request to amend to the Supplemental Register, but the 2(f) declaration, although unacceptable, remains of record.

In the continuation of the final refusal, after consideration of applicant's response after such refusal, the Examining Attorney noted that applicant's change of position to arguing the merits of the 2(e)(3) refusal only occurred after its other attempts had failed. The Examining Attorney argued that the attempt to register under 2(f) should be considered a concession that the matter was not inherently distinctive.

In its brief on appeal, applicant maintains that it should not be precluded from arguing that its mark is inherently

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

The criteria to be applied in determining whether a mark is primarily geographically deceptively misdescriptive are:

- (1) whether the primary significance of the mark is the name of a generally known geographic place,
- (2) whether the goods come from other than the place named, and
- (3) whether purchasers would be likely to believe that the goods with which the mark is used originate from that place.

See *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); *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996).

Applicant has stated for the record that the goods involved originate in Italy, rather than California. Thus, the second criterion has been met.

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distinctive, inasmuch as the attempt to show acquired distinctiveness was simply an alternative measure adopted in seeking to register applicant's mark.

We agree that no preclusive effect should be given to the alternative positions taken by applicant during prosecution and thus have given full consideration to applicant's arguments with respect to the Section 2(e)(3) refusal. Applicant has abandoned any attempt to rely upon Section 2(f) and thus no consideration need be given to this claim. See TMEP § 1212.02(c).

Looking to the first of the two remaining criteria, we find that the initial inquiry in this case must be whether the primary significance of the mark as a whole would be the name of a geographic location. Applicant argues that the features of this composite mark other than the term CALIFORNIA, namely, the motorcycle design, the initials C.M.J. and the words MOTOR JACKET, all serve to remove the mark from the category of being "primarily geographic". The Examining Attorney, on the other hand, takes the position that a mark need not be comprised solely of a geographic term to be refused registration as being primarily geographically deceptively misdescriptive and that the additional features in the present mark would not detract from the primary significance of the mark as an indicator of geographic origin, namely, CALIFORNIA.

We do not consider the additional features in applicant's mark to be of sufficient import to obviate the mark's geographic significance. The motorcycle design clearly ties in with the words MOTOR JACKET, which has been disclaimed as being descriptive of applicant's goods. The initials C.M.J., while having some source-indicative significance, do not overcome the primary geographic significance of the present mark. Instead we find this to be a case similar to *In re Perry Manufacturing Co.*, 12

USPQ2d 1751 (TTAB 1989), in which the primary significance of the mark PERRY NEW YORK and the outline of New York skyline was found to be the indication to purchasers that the clothing with which it was used was manufactured in or had a connection with New York, despite the presence of the term PERRY. See also *In re Cambridge Digital Systems*, 1 USPQ 1659 (TTAB 1986) [addition of highly descriptive term DIGITAL and design does not detract from primary geographic significance of mark CAMBRIDGE DIGITAL].

Applicant's main argument, however, is that the primary significance of the term CALIFORNIA, in itself, is as an indicator of a style of living or clothing that is typical of those who travel by motorcycle or motorbike in California, rather than as an indicator of geographic origin. In support of its position, applicant has introduced one of the definitions found in Webster's Third New International Dictionary (1993) for the adjective "California", namely, "of the kind or style prevalent in California".

The Examining Attorney, on the other hand, points to the geographical definition which he has made of record for "California" from Webster's New Geographical Dictionary (1988) as a "western state of U.S.A.". The Examining Attorney has also noted, in the course of prosecution, that

applicant has provided no specific evidence that prospective purchasers would think that "California Motor Jacket" identifies a particular style of motor jacket which is readily identifiable with California.

In order to make a determination on this issue, however, we find it necessary to review the evidence produced by the Examining Attorney with respect to the third criterion, the goods/place association.

In this regard, the Examining Attorney has made of record numerous articles obtained from the Nexis database as evidence of the significance of fashion in California, or more importantly, the significance of California as a source of fashion apparel. For example, articles have been introduced referring to "California couture", "California fashion", "California fashion trends", "California chic" as well as to the "California fashion industry" and "California fashion designers". The Examining Attorney argues that this evidence is adequate to meet the required prima facie showing of a goods/place association, i.e., that there is a recognized fashion industry in California and thus purchasers would be likely to believe applicant's clothing comes from California.

Applicant has challenged the Examining Attorney's interpretation of several of these articles, contending

that the references to "California fashion" or California fashions", and particularly, "California chic", may as easily be construed as an indication of a style of clothing and lifestyle of those who wear clothing of this type, as that of a specific indication of the geographic source of the clothing. In support of its position, applicant points to references such as

"...the California-chic Zimmerman, who was dressed in a natty suit with a black turtleneck" (Newsday, May 5, 1996, North Hempstead Edition);

"... Medearis has just opened a clothing store California fashions in the Georgian capital of Tbilisi" (Business Week, Sept. 11, 1995, International Editions); and

"Any mention of casual or California signals that clothes should be relaxed, colorful and not too structured, but made of a fine material, such as silk" (Los Angeles Times, Oct. 27, 1994).

In rebuttal, the Examining Attorney argues that, while some of the articles might be interpreted in the manner advocated by applicant, applicant has still failed to submit sufficient evidence to overcome the prima facie showing made by the Office. We agree that the evidence submitted by the Examining Attorney is adequate to meet the requisite showing that, if the primary significance of applicant's mark is one of geographic location, there is a reasonable basis for concluding that the public would be likely to make the goods/place association that the

clothing with which applicant's mark is used comes from California. See *In re Loew's Theatres, Inc*, 226 USPQ at 868.

The determinative factor in this case is thus whether applicant has established that the primary significance of the term CALIFORNIA in its mark, as viewed by the purchasing public, would be as an indicator of style, rather than geographic location. If this is true, the question of a goods/place association is moot. But we find that applicant has failed to produce sufficient evidence to demonstrate that the public would associate the term "California" with the particular style at issue, in this case a style of jacket, rather than with a geographic location. See *In re Californian Pizza Kitchen, Inc.*, 10 USPQ2d 1074 (TTAB 1988) [no evidence that "California" indicator of style of cooking, rather than geographic location]. While applicant has introduced evidence that "California" may, under certain circumstances, have the connotation of a particular style of dress which is prevalent in California, applicant has introduced no evidence that there is a particular style of motor or motorcycle jacket which would be viewed as a "California Motor Jacket".

Accordingly, we find that the primary significance of applicant's mark as a whole is that of the geographical term "California", and that purchasers would be likely to believe that applicant's goods come from California, when in fact they originate in Italy. Applicant's mark is therefore primarily geographically deceptive misdescriptive with the meaning of the statute.

Decision: The refusal of registration under Section 2(e)(3) is affirmed.

E. J. Seeherman

G. D. Hohein

H. R. Wendel  
Trademark Administrative Judges,  
Trademark Trial and Appeal Board

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