

**THIS DISPOSITION IS CITABLE
AS PRECEDENT OF THE TTAB**

10/6/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Hiromichi Wada**

Serial No. 74/**657,464**

Bruce A. Tassan of Jackson & Kelly for applicant.

Kim Saito, Trademark Examining Attorney, Law Office 109
(Deborah S. Cohn, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Hiromichi Wada (doing
business as AJW TransTech), a Japanese citizen with an
address in Michigan, to register the mark NEW YORK WAYS
GALLERY ("NEW YORK" disclaimed) for "backpacks, duffel bags,
carry-on bags, change purses, document cases, garment bags
for travel, hand bags, luggage, pouches (drawstring and
felt), purses, tote bags, traveling bags, waist pouches,
wallets, and toiletry cases sold empty."¹

The Trademark Examining Attorney has refused registration under Section 2(e)(3) of the Trademark Act on the ground that the mark as a whole, if applied to the goods, would be primarily geographically deceptively misdescriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.² An oral hearing was not requested.

In order to establish a prima facie case for refusal of registration under Section 2(e)(3), the Examining Attorney must show that 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. 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.,

¹ Application Serial No. 74/657,464, filed April 7, 1995, alleging a bona fide intention to use the mark in commerce.

² Applicant's reply brief is accompanied by evidence. So as to be clear on this point, we reiterate the Board's remarks in its order dated September 8, 1997. The submission is untimely and, thus, has not been considered in making our decision. Trademark Rule 2.142(d). Applicant's request in its reply brief that the Board take judicial notice of the "thousands of registered marks incorporating the term NEW YORK for products and services that do not originate in New York state or city" is denied. Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986). Further, as indicated in the Board's order dated September 8, 1997, the evidence submitted on August 6, 1997 is not properly of record. We hasten to add that, in any event, even if any or all of this evidence were considered, it would not be persuasive of a different result in this case.

769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

In support of her prima facie case, the Examining Attorney offered evidence to show (1) New York is a place that is neither obscure nor remote, and (2) New York is known for the design, manufacture and sale of leather goods and handbags. In particular, the Examining Attorney introduced listings for "New York" in *Webster's New Geographical Dictionary* (1984) and *The Oxford English Dictionary* (2d ed. 1989), as well as the following materials: excerpts from *Thomas Register of American Manufacturers* (1995) listing manufacturers, which are located in New York, of luggage items, pocketbooks and leather goods; excerpts from *WWD Buyer's Guide--Women's Apparel & Accessories Manufacturers* (1993) showing listings for manufacturers located in New York with product lines for leather goods and handbags; and excerpts retrieved from the NEXIS database wherein statements appear to the effect that handbags are designed in New York and that certain handbag manufacturers' headquarters are located in New York.

We find that this evidence establishes a prima facie case for refusal of registration under Section 2(e)(3).

To rebut the Examining Attorney's prima facie case, applicant contends that its mark NEW YORK WAYS GALLERY is not, when viewed as a whole, the name of a geographic place.

Applicant argues, moreover, that when the words "WAYS GALLERY" are added to the words "NEW YORK," the mark as a whole, NEW YORK WAYS GALLERY, merely suggests that applicant's goods are stylish or aimed at sophisticated consumers. Applicant also contends that it would not be clear to those encountering the mark whether the term "New York" identifies the state or the city. In response to the Examining Attorney's specific inquiry, applicant indicated that "applicant's products will be manufactured in a variety of locations and it is expected that sometime in the future applicant may manufacture products in New York." (response, July 23, 1996)³ Applicant asserts that "everything in the world is made or sold in New York" and that "[a]s a result of the common usage of the term New York, purchasers would not be so naïve as to believe that any mark which includes the term New York identifies products that originate from this state or city." (reply brief, p. 1)

We agree with the Examining Attorney's assessment of this case. Here, applicant's mark includes the term "New York." There is no genuine issue that "New York" is the

³ Later, in his reply brief, applicant states, in making one of his arguments, that "some of applicant's products are made in New York...." Notwithstanding this latest statement, there is no documentary evidence to support the location of manufacture of the goods or otherwise to indicate that the goods have any connection with New York.

name of a geographic place which is not obscure, but rather is generally known to the public.

Further, as shown by the Examining Attorney's evidence bearing on a goods/place association, New York is well known as a place for the design, manufacture and sale of goods of the type listed in the application. However, applicant is located in Michigan, and, as noted above, there is nothing in the record to indicate that applicant's goods have their origin in, or any connection with, New York (either the city or the state).⁴

Our view is that the mark, when viewed in its entirety, projects a primarily geographic significance, with the addition of the words "WAYS GALLERY" (even if arbitrary) to "NEW YORK" not detracting from this primary geographic significance of the mark. Applicant simply has not provided any facts as to why, in its view, the primary geographic significance of the mark is lost by the addition of these words. The determination of registrability under Section 2(e)(3) should not depend on whether the mark is unitary or composite. In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986). See also: In re Nantucket Inc., supra, at 893, n. 7; and In re Handler Fenton Westerns, Inc., 214 USPQ 448 (TTAB 1982).

Applicant further asserts that the mark as a whole conveys the idea of stylish products, not a geographic place. In this connection, it is noteworthy that applicant has not submitted any evidence that there is a particular New York style of products of the type listed in the application, and that purchasers would make such an association upon encountering the mark.⁵ Rather, although the words "WAYS GALLERY" arguably may suggest a gallery or collection of products having a New York "way" about them,⁶ the primary significance of the mark as a whole remains geographic.

Applicant also argues that the goods might eventually originate in New York. As noted above, however, this statement is entirely unsupported by any evidence of record.

In sum, based on the record before us in this appeal, we find that it is reasonable to assume that consumers encountering the mark NEW YORK WAYS GALLERY will mistakenly believe that the goods have their origin in New York City or

⁴ Applicant's unsupported statements, regarding New York as the site of manufacture, either currently or sometime in the future, simply are too speculative and ambiguous.

⁵ Even if applicant had established an association between New York and a particular style, such association would not be inconsistent with the primary geographic significance of the mark, as the association may be made precisely because of the primary significance of New York as a city in the United States.

⁶ While we have offered this meaning for the mark, we are, quite frankly, unsure of what connotation the two words are meant to convey. Applicant has offered no guidance other than to state, as indicated above, that the words are arbitrary.

are otherwise connected with New York. In considering this issue, we take note of the Board's language in a prior case wherein it was found that PERRY NEW YORK and design (a silhouette of the New York City skyline) for women's clothing is deceptive because it deceives purchasers into believing that the goods bearing the mark have their geographic origin in New York, when the goods have no connection with New York and, in fact, originate in North Carolina. In re Perry Manufacturing Co., 12 USPQ2d 1751 (TTAB 1989). In this connection, the Board stated:

Only studied ignorance would prevent us from finding as fact that New York is a world renowned center of culture and high fashion and that people from throughout the world go to New York to purchase the latest styles in clothing, from haute couture to off-the-rack garments. Such fact is the appropriate matter for judicial notice. See B.V.D. Licensing v. Body Action Design, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988). That being the case, we have no doubt that purchasers seeing clothing bearing applicant's mark, which incorporates the words "New York" and the New York skyline, would immediately assume that such clothing has a connection with New York, either in its manufacture or its design.

Id. at 1752. See also: In re The Cookie Kitchen, Inc., 228 USPQ 873 (TTAB 1986)[MANHATTAN is primarily geographically deceptively misdescriptive for cookies having no association with that borough of New York].

The present case is to be distinguished from the case relied upon by applicant, namely, *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) ["Hyde Park," being a geographic location not known as a garment manufacturing or clothing design center, conveys a wholly different commercial impression, when applied to garments, than does "New York."]. Here, given the renown of New York City as a fashion center, we can only conclude that consumers would assume a connection with New York when encountering the mark NEW YORK WAYS GALLERY on applicant's hand bags, luggage and related goods. 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*, §14:11 (4th ed. 1998).

The amendments to Section 2 of the Trademark Act of 1946 made by Public Law 103-183, 107 Stat. 2057, The North American Free Trade Enactment Act ("NAFTA"), apply to applications filed on or after December 8, 1993, which includes the one involved in this appeal. Prior to these amendments, the prohibitions against registration on the ground that a mark is primarily geographically descriptive or that a mark is primarily geographically deceptively

misdescriptive were contained in Section 2(e)(2) of the Trademark Act. Under the law as amended, the prohibition against registration on the ground that a mark is primarily geographically deceptively misdescriptive is contained in Section 2(e)(3) of the Trademark Act, which is applicable to the case involved herein. The legal standard of determining the issue has not changed, although marks found to be primarily geographically deceptively misdescriptive are no longer eligible for registration under the provisions of Section 2(f) of the Trademark Act, subject to certain grandfather provisions. *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691, 1692 (TTAB 1996). See generally: 2 J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, supra, at §14:31.

Inasmuch as we have found applicant's applied-for mark to be primarily geographically deceptively misdescriptive under Section 2(e)(3), the mark is unregistrable. However, an additional comment is in order. We note that applicant has disclaimed the term "New York," apparently in an attempt to salvage the registrability of the mark as a whole. It is our view that a disclaimer of a primarily geographically deceptively misdescriptive term apart from a mark as a whole is not permissible.

NAFTA and the Trademark Act, as accordingly amended, are silent on the propriety of disclaimers of primarily

geographically deceptively misdescriptive terms in composite marks. Further, we could find nothing in the legislative history of NAFTA addressing this point, and our research failed to turn up any case law on point. What we did find is that the United States Patent and Trademark Office, in an *Official Gazette* notice (dated April 1, 1994), addressed the amendments to Section 2(e) of the Trademark Act as a result of NAFTA, stating that

[a] mark that is unregistrable under §2(e)(3) because it contains matter which is primarily geographically deceptively misdescriptive of the goods or services will not be rendered registrable by a disclaimer of the geographically deceptively misdescriptive component. Matter that is primarily geographically deceptively misdescriptive may be omitted or deleted from the drawing of a mark in appropriate cases.

1170 TMOG 266 (January 3, 1995). Section 1210.06 of the *Trademark Manual of Examining Procedure* (1997) contains the identical language.⁷

⁷ Reference to another section provides an analogous situation. Section 1203.04 of the *Trademark Manual of Examining Procedure* (1997) addresses the change to Section 2(a) of the Trademark Act regarding geographical indications for wines and spirits. Section 2(a) now prohibits the registration of a designation which consists of or comprises "a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996]." This provision was added by the Uruguay Round Agreements Act, implementing the Trade Related Intellectual Property (TRIPs) portions of the General Agreement on Tariffs and Trade (GATT). The *TMEP* section goes on to state that "[n]either

The only way to give effect to the statutory amendments to the Trademark Act as a result of NAFTA's prohibition against registration of geographically misdescriptive designations is to prohibit disclaimers of such designations when they appear in composite marks. To do otherwise would eviscerate the intent of Section 2(e)(3), as amended. That is to say, it would be anomalous to prohibit registration of the mark NEW YORK WAYS GALLERY because it is primarily geographically deceptively misdescriptive, but allow registration of the same geographically deceptively misdescriptive mark with a mere disclaimer of the geographic element which renders the mark primarily geographically deceptively misdescriptive. As stated in the past, the public is unaware of disclaimers that quietly reside in the records of the Office. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The mark NEW YORK WAYS GALLERY has the same connotation to the public regardless of the disclaimer.

The rationale underlying this disclaimer prohibition is the absolute bar to registration under Section 2(f) of such primarily geographically deceptively misdescriptive terms. An analogous situation involves disclaimers of deceptive

a disclaimer of the geographical designation nor a claim that it has acquired distinctiveness under §2(f) can obviate a §2(a) refusal if the mark consists of or comprises a geographical indication which identifies a place other than the origin of wines or spirits."

terms under Section 2(a). Such disclaimers do not permit registrability.⁸ See: In re Perry Manufacturing Co., supra [PERRY NEW YORK and design (NEW YORK disclaimed) for clothing not originating in New York is deceptive]; and Evans Products Company v. Boise Cascade Corporation, 218 USPQ 160 (TTAB 1983) [CEDAR RIDGE (CEDAR disclaimed) for hardboard siding not made of cedar is deceptive]. See also: In re Budge Manufacturing Co. Inc., 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988) [LOVEE LAMB for automobile seat covers is deceptive: "a mark which includes deceptive matter is barred from registration...."]. Deceptive terms are barred on the Supplemental Register as well as on the Principal Register. A mark which runs afoul of Section 2(e)(3) should not be treated any differently when it comes to disclaimers.⁹

⁸ In this regard, deception has been found where the offending word has been combined with a suggestive term and even where the significance of the mark as a whole was not entirely clear. See, e.g., R. Neumann & Co. v. Overseas Shipments, Inc., 326 F.2d 786, 140 USPQ 276 (CCPA 1964) [DURA-HYDE held deceptive and deceptively misdescriptive of plastics material of leatherlike appearance made into shoes]; and E. Hubschman & Sons Inc. v. Sommers Plastic Products Co., Inc., 148 USPQ 165 (TTAB 1965) [CAFFETTA held deceptive and deceptively misdescriptive of vinyl plastic piece goods sold in rolls and used in making handbags, wallets, portfolios, belts, and the like].

⁹ Section 23 prohibits registration of marks "declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of §2 of this Act...."

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Decision: The refusal to register is affirmed.

T. J. Quinn

G. D. Hohein

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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