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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Kimpton Hotel & Restaurant Group, Inc.**

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Serial No. 75/201,119

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Gary D. Krugman of Sughrue, Mion, Zinn, MacPeak & Seas,  
PLLC for applicant.

Henry S. Zak, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney).

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Before Simms, Cissel and Rogers, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Kimpton Hotel & Restaurant Group, Inc. (applicant), a California corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark HOTEL MONACO for hotel services.<sup>1</sup> The Examining Attorney has refused registration under Section 2(e)(3) of the Act, 15 USC § 1052(e)(3), arguing that the mark HOTEL MONACO is

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<sup>1</sup> Application Ser. No. 75/201,119, filed November 12, 1996, claiming use since June 15, 1995. Applicant has disclaimed the word "HOTEL" apart from the mark.

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primarily geographically deceptively misdescriptive with respect to applicant's hotel services which do not originate in the principality of Monaco. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

In order to establish a *prima facie* case for refusal because a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Act, the Examining Attorney must show that the primary significance of the mark is geographic; that purchasers would be likely to think that the services originate in the geographic place identified in the mark, that is, purchasers would make a services/place association; and that the services do not in fact originate in the place identified in the mark. In re Wada, 194 F.3d 1297, 52 USPQ 1539 (Fed. Cir. 1999); 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); and In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

Here, applicant's attorney does not dispute that Monaco is a geographic location generally known by the public and that it does not have any meaning other than its significance as a geographic place. Nor does applicant

dispute the fact that its hotel services do not originate in Monaco. The only real issue before us is whether there is sufficient evidence to conclude that the public is likely to associate hotel services with the place named in applicant's mark.

**Examining Attorney's Evidence and Arguments**

Relying upon information from geographic dictionaries, travel guide books, the Nexis database and material provided by Monaco's travel bureau as well as other sources, the Examining Attorney argues that the principality of Monaco on the Mediterranean Sea has an important tourism industry which accounts for a significant source of its income and between 20 and 25% of its gross national product. Receiving millions of tourists each year, the tiny principality of Monaco has at least 18 hotels and other facilities for tourists, from four-star deluxe hotels near its famous casino overlooking the Mediterranean to various family-oriented hotels or facilities for the more budget-conscious, according to the Examining Attorney. Some of the material made of record by the Examining Attorney discusses the "Gems of Monaco: The Principality and Its Legendary Hotels" including the Hotel de Paris, "one of the world's most famous hotels and most spectacular beaux-arts monuments," and the Monte Carlo, the

largest hotel complex on the Riviera. Material relied on by the Examining Attorney indicates that Monaco is home to four of Europe's most exquisite and legendary hotels. The Examining Attorney maintains that the hotel industry is a key element in Monaco's economy.

The Examining Attorney has also noted that applicant's brochures emphasize its hotels' sense of foreign style, from the French-inspired architecture and design as well as the European furnishings and French-style paintings and accessories.<sup>2</sup> The Examining Attorney has also introduced some evidence showing that hotels in the United States have foreign ownership or foreign-based operations. Accordingly, it is the Examining Attorney's position that the relevant public will assume some association between applicant's hotel services and the principality of Monaco, a place noted for its tourism and famous hotels. These consumers will think, according to the Examining Attorney,

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2 The San Francisco brochure states:

With its French-inspired architecture and sensually rich décor, the newly restored Hotel Monaco is very clear in its intentions. The idea is to seduce and pamper--to surround guests with a sense of escape to far away places, and to do it in the style to which the savviest of travelers have become accustomed.

that applicant's hotel services originate in Monaco when in fact they do not.

**Applicant's Evidence and Arguments**

Essentially, it is applicant's position that the Examining Attorney has not made out a *prima facie* case that the mark HOTEL MONACO is primarily geographically deceptively misdescriptive and that, even if such a case has been made out, applicant's evidence rebuts such a *prima facie* case. More particularly, applicant argues that the Examining Attorney has failed to establish the required services/place association between the principality of Monaco and applicant's hotel services. While applicant agrees that Monaco has a significant tourist industry, applicant's attorney argues that Monaco is not a "hotel-exporting entity" which operates or sponsors hotels outside of Monaco. Applicant argues that it does not follow that, if a place is known for tourism and that tourists must, therefore, stay in hotels there, then that place is known for hotel services rendered outside that place, such that U.S. consumers would associate hotel services rendered in this country with the place named in the mark. With respect to applicant's brochures, applicant argues that, while these brochures may tout the French-inspired architecture and design and European furnishings, Monaco is

not France and these features do not suggest a connection with Monaco. Applicant argues that the Examining Attorney has made no showing that consumers would expect applicant's hotel services to come from Monaco.

Also, relying upon the recent case of *In re Municipal Capital Markets Corporation*, 51 USPQ2d 1369 (TTAB 1999), applicant's attorney argues that the Examining Attorney needs evidence to show more than that services as ubiquitous as hotel services are offered in the particular geographic area named in the mark.

Applicant's attorney also refers to various third-party registrations which include the names of various geographic locations. These are submitted in support of applicant's argument that the relevant public is not likely to make any association of the term Monaco with hotel services.

Finally, applicant has submitted a survey (discussed below) and three declarations of professionals in the travel and hotel business who state that they have never made any association between the principality of Monaco and applicant's hotel services, and that they have not encountered any hotel customers whose inquiries have reflected a belief in such association.

**Responsive Arguments of the Examining Attorney**

The Examining Attorney maintains that applicant's declarations do not rebut his *prima facie* case of primary geographic deceptive misdescriptiveness because, among other things, they are not from actual customers. Also, the Examining Attorney contends that, even if they do make an association, customers may not ordinarily inquire about any connection between a country and any product or service; and this lack of inquiry does not necessarily mean that customers do not believe that there is no such relationship.

With respect to the third-party registrations, the Examining Attorney contends that they are largely irrelevant and that, in any event, those registered marks lack primary geographic significance. For example, the Examining Attorney points to such third-party registered marks as BARCELONA COURT, VALHALLA INN (naming the heaven of the gods of Norse mythology), OLDE LONDON INN MOTOR HOTELS, PARIS ON THE POTOMAC and CAFÉ ATLANTICO.

**Survey**

With a request for reconsideration, applicant submitted a survey of one hundred individuals conducted to determine whether relevant consumers would associate applicant's HOTEL MONACO hotel services with the

principality of Monaco. The "relevant market" for the survey was defined as men and women 25 to 74 years of age who traveled in the United States in the past year or might travel in the United States in the next year. Also, they must have stayed in a hotel in a U.S. city in the past year or plan to stay in such a hotel in the next year.

Consumers were screened in two large shopping center malls in Santa Monica, California, and Trumbull, Connecticut.

Potential survey respondents were told that they would be shown brochure covers, photographs and an advertisement of HOTEL MONACO hotels. They were told that these hotels are located in San Francisco and Seattle, and that additional hotels will be opening soon in Chicago and Denver. The brochures were taped shut so that respondents could only see the front and back covers as well as copies of photographs of actual HOTEL MONACO signage. Then the survey respondents were asked survey questions designed to determine their awareness and knowledge of the principality of Monaco. Those who had heard of Monaco and knew where it was or knew about its ruling family were asked questions to measure whether or not they thought HOTEL MONACO hotels are connected or affiliated with the principality of Monaco. Fifty-nine respondents, or 59%, knew at least something of what Monaco is. These fifty-nine respondents were then

asked: "Do you think the hotels shown in the brochure covers, photos, and the ad are connected or affiliated with the country or principality of Monaco?" Forty-nine respondents answered "No," while six respondents answered "Yes." Four respondents answered "Don't know/not sure." Applicant concludes that these survey results indicate that very few, if any, consumers associate the mark HOTEL MONACO for hotel services with the country or principality of Monaco.

The Examining Attorney has raised a number of objections to the survey. First, the Examining Attorney argues that the limited number of survey respondents is below the generally accepted level for such a survey. According to the Examining Attorney, such an inadequate number is not projectable.

Second, the Examining Attorney also suggests that qualifying criterion with respect to foreign travel should have been permitted, and that the inclusion of U.S. travelers to foreign destinations is important to determine the correct universe of people to be surveyed.

Third, the Examining Attorney also argues that the survey questions are leading, and bias the survey respondents in favor of applicant. For example, because survey respondents were first told of the present and

future U.S. locations of applicant's HOTEL MONACO hotels, the Examining Attorney contends that this information predisposed or "cued" the interviewees to believe that there was no association between applicant's hotels and the country of Monaco.

Fourth, the Examining Attorney also objects to the fact that the survey respondents were shown only the front and the back of the brochure covers. The Examining Attorney notes that some of the text and the illustrations inside, with respect to French-inspired architecture and décor, may have affected responses. According to the Examining Attorney, the entire brochure may create an association in the minds of the viewers between HOTEL MONACO hotels and Monaco.

The Examining Attorney also notes that about 10% of the 59 survey respondents thought that there was a relationship between applicant's HOTEL MONACO hotel services and Monaco.

With regard to the Examining Attorney's objections, we do agree with the Examining Attorney at least to the extent that an insufficient number of survey respondents was included in applicant's survey. Moreover, we find a more serious flaw with applicant's survey. When survey respondents were asked if they thought the hotels shown in

the material provided "are connected or affiliated with the country or principality of Monaco," we believe it possible, if not likely, that many of the survey respondents may have interpreted "connected or affiliated with" to mean some sort of official or governmental ownership or sponsorship by the principality of Monaco. The more appropriate question, in our view, would have been whether the survey respondents believed that applicant's hotels (or hotel services) have their origin in or come from Monaco. Such a question would permit the respondents to answer "yes" if they thought that the hotels had their origin in that place. Because we cannot, of course, determine how the question was interpreted by the survey respondents, and because of the insufficient number of survey respondents, we do not find the survey results to be persuasive or probative.

**Opinion**

Upon careful consideration of this record and the arguments of the attorneys, we find that this record demonstrates a reasonable basis for concluding that consumers encountering applicant's HOTEL MONACO hotel services will mistakenly believe that those services have their origin in Monaco, or are otherwise related in some way to a hotel or hotels located there. While we

acknowledge that hotel services are "ubiquitous" and that the Board, in *Municipal Capital Markets*, indicated that the Office must present evidence that does more than merely establish that such services are offered in a particular geographic location, we believe that the record before us is sufficient to demonstrate at least a *prima facie* case that consumers are likely to believe applicant's hotels originate in Monaco. In this connection we note that applicant's brochures emphasize the French and European aspects of applicant's hotels. Also, the Examining Attorney has demonstrated that Monaco is noted for some of its famous hotels. We believe that this record is sufficient to support the conclusion that the public would mistakenly believe that applicant's hotel services rendered under the mark HOTEL MONACO originate in Monaco. See *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1989).

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Decision: The refusal of registration is affirmed.

R. L. Simms

R. F. Cissel

G. F. Rogers  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal