

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 7, 00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CCC Acquisition Corp.

Serial No. 75/285,708

Karen Artz Ash and Monique L. Ribando of Amster, Rothstein
& Ebenstein for CCC Acquisition Corp.

Paul P. Lamb, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney)

Before Seeherman, Hanak and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

CCC Acquisition Corp. has appealed from the refusal of
the Trademark Examining Attorney to register LONDON BEAT as
a trademark for "clothing, namely swimsuits, skirts,
jackets, vests, dresses, T-shirts, tank tops, shorts,
pants, shirts, swimsuit cover-ups, body suits, headwear and

footwear.”¹ Registration has been refused pursuant to Sections 2(e)(1) and 2(a) of the Trademark Act, 15 U.S.C. 1052(e)(1) and 1052(a), on the ground that applicant’s mark is deceptively geographically misdescriptive and geographically deceptive.

Applicant and the Examining Attorney have filed appeal briefs; an oral hearing was not requested.

Preliminarily, we note that with its response to the first Office action applicant listed a number of third-party registrations for marks containing the term LONDON. The Examining Attorney pointed out that third-party registrations could not be made of record merely by listing them, citing **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974). Applicant subsequently filed a request for reconsideration, but did not submit copies of the registrations. In its brief applicant again has listed the registrations, and in his brief the Examining Attorney has objected to the registrations, pointing out again that they were never properly made of record.

The Examining Attorney’s objection is well taken, and the third-party registrations referred to by applicant have not been considered.

¹ Application Serial No. 75/285,708, filed May 2, 1997, asserting a bona fide intention to use the mark in commerce.

Applicant has also submitted, with its brief, copies of certain articles and excerpts from a Dun & Bradstreet report. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that, after an appeal is filed, if the applicant desires to introduce additional evidence, it may request the Board to remand the application for further examination. Obviously applicant did not follow this procedure. Accordingly, and because the Examining Attorney did not refer to this material in his brief, thereby in essence stipulating to its entry into the record, it has not been considered.

A term is deceptively geographically misdescriptive under Section 2(e)(1) of the Statute if the mark sought to be registered 1) has as its primary significance a generally known geographic place, and 2) identifies products that purchasers are likely to believe mistakenly are connected with that location, i.e., that the public would make a goods/place association.. **In re Wada**, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999). See also, **Institut National Des Appellations D'Origine v. Vintners Int'l Co.**, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992); **In re Societe Generale des Eaux Minerales de Vittel S.A.**, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). In order to

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establish that a mark is geographically deceptive the Office must, in addition to the forgoing, show that the geographic misrepresentation is material to the decision to purchase the goods. **Institut National Des Appellations D'Origine v. Vintners Int'l Co.**, supra. See also, **In re Budge Manufacturing Co., Inc.**, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988).

In support of his position that the mark LONDON BEAT is geographically deceptively misdescriptive and geographically deceptive for the identified clothing items, the Examining Attorney has submitted excerpts from a number of articles taken from the NEXIS data base, including the following:

To the fashion industry, the designer shows in New York, London, Milan and Paris are as big as it gets.
"The Dallas Morning News," March 17, 1999

Paris. Milan. London. New York. The four cities set the tone for fashion the world over.
"The Union Leader," (Manchester, NH), March 17, 1999

Disco diva and occasional movie star Grace Jones, who never met an outfit too outre, capped off her lithe frame with something unusual from British mad hatter Philip Treacy at his show during London Fashion Week.
"People," March 8, 1999

...they had intended to prove that Americans can set, not just follow, trends established in London, Milan, Italy, and Paris. That's why New York's fashion community en masse broke tradition this season and staged shows ahead of Europe.

"Los Angeles Times," February 23, 1999

To the fashion industry, the shows just finished in New York and coming up in London, Milan and Paris are as big as it gets.

"Pittsburgh Post-Gazette," February 21, 1999

...London's enfant terrible, Alexander McQueen, plans to hit New York next season. And that news has a few stiff upper lips trembling. In The Sunday Times of London recently, style scribe Colin McDowell wrote, "Most devastating of all for London's esteem as a fashion center, it looks as if our No. 1 international star, Alexander McQueen, will also start to show his own-label collection [in New York] next October." "Daily News," (New York), February 15, 1999

Each year, Mrs. Johnson travels to the fashion capitals of the world including Paris, Milan, Rome, London, New York and Los Angeles to purchase garments by internationally-acclaimed designers." "Jet," February 15, 1999

Applicant does not dispute that London is a well-known geographic term, and that the goods on which its mark is intended to be used will not originate in London. In this connection, we note that applicant is a Delaware corporation which is located in Los Angeles. Nor has

applicant argued that the mark LONDON BEAT does not have a geographic significance.²

The NEXIS evidence submitted by the Examining Attorney clearly demonstrates a goods/place association between London and clothing items. London is referred to throughout these articles as a center of fashion. Thus, we find that LONDON BEAT is geographically deceptively

² Applicant does make reference to the inclusion of the term LONDON in third-party registrations (which were not properly made of record) as part of its argument that there is no goods/place association between London and clothing. Apparently it is applicant's position that, in the same manner that third-party registrations which contain a particular term can be used to show, in a likelihood of confusion analysis, that the term has been adopted by those in the industry for its suggestive significance, third party registrations can be used, in cases involving geographic refusals, to show that the geographic term is suggestive of a certain style. It is not clear to us how such asserted suggestiveness would rebut evidence of a goods/place association, and we are not persuaded that it is appropriate to use the third-party registrations in an analysis of geographic descriptiveness in the same manner they are used in a determination of likelihood of confusion. There are many reasons why third-party LONDON marks may have registered which have nothing to do with a suggestive significance of London, including the fact that the goods do emanate from London, and the registrations issued pursuant to Section 2(f) of the Act, or LONDON is used in such a manner in the mark that consumers would not view the entire mark as having a geographic significance. In any event, as we stated above, the third-party registrations are not properly of record, and have not been considered. To the extent that applicant is asserting that LONDON BEAT is suggestive of a particular style from London, the Examining Attorney has correctly pointed out that there is no evidence of a particular London style. The Court, in *In re Wada*, supra, aff'g 48 USPQ2d 1689 (TTAB 1998), accepted the Board's finding that the primary geographic significance of NEW YORK was not lost by the addition of WAYS GALLERY. So, too, in this case, the addition of BEAT to LONDON does not avoid the primary geographic significance of the mark.

misdescriptive, and affirm the refusal of registration under Section 2(e)(3).

Moreover, because of the association of London with fashionable clothing, we further find that the geographic misrepresentation would be material to the decision to purchase the goods. Accordingly, we affirm the refusal of registration under Section 2(a).

In reaching these conclusions we have considered, but reject, applicant's argument that consumers would not make a goods/place association between clothing and London because the articles reference designers from countries other than England who merely show their clothing in London. Several of the articles make reference to English designers, while other articles clearly discuss London as a fashion center.

Nor are we persuaded by applicant's argument that the evidence shows an association between London and couture goods, while applicant's goods are athletic sportswear and swimwear, and no goods/place association has been shown with respect to those goods. Applicant's identification of goods is not limited to athletic sportswear and swimwear; the identification includes dresses, skirts, jackets, and pants, which can be designer clothing. Further, there is

no evidence in this record that designers do not produce sportswear and swimwear.

Finally, applicant relies on the fact that its predecessor-in-interest had previously filed an intent-to-use application for the same mark for the same goods, and that in March 1994 this application was passed to publication. Although the application was subsequently abandoned for failure to file a Statement of Use, applicant argues that the fact that an Examining Attorney had previously found the mark to be registrable should engender a similar result for the present application.

As the Examining Attorney has pointed out, the Office is not bound by a prior registration if to issue a registration would be contrary to the statute. In the present case, applicant did not have a prior registration and, as the Examining Attorney also points out, the fact that an intent-to-use application is approved for publication does not guarantee that a mark will register, since issues may arise in the examination of the Statement of Use which may result in a further ground for refusal. In any event, our decision in the present appeal must be based on the evidence in the record, and the law as it has been interpreted at the present time. In this connection, we note that many of the cases cited by applicant and the

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Examining Attorney, as well as the cases cited herein, had not been decided in 1994.

Decision: The refusals of registration pursuant to Sections 2(a) and 2(e)(3) are affirmed.

E. J. Seeherman

E. W. Hanak

D. E. Bucher
Administrative Trademark Judges
Trademark Trial and Appeal Board