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Paper Nos. 11 & 10
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re William Aichast

Serial Nos. 75/803,266 & 75/803,693

Robert T. Johnson, Jr., Sana Hakim and Andrea K. Cannon of Bell
Boyd & Lloyd LLC for William Aichast.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Hanak and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

William Aichast has filed applications to register SANTA FE
SPEEDWAY for "license plate holders"¹ and for "calendars and
bumper stickers."²

The Trademark Examining Attorney refused registration on
the ground that this proposed mark as a whole, if applied to the
goods, would be primarily geographically deceptively
misdescriptive of the applicant's license plate holders,

¹ Application Serial No. 75/803,266, filed on September 20, 1999,
based upon applicant's allegation of a *bona fide* intention to use the
mark in commerce on the goods listed in Int. Cl. 12.

² Application Serial No. 75/803,693, also filed on September 20,
1999, based upon applicant's allegation of a *bona fide* intention to
use the mark in commerce on the goods listed in Int. Cl. 16.

calendars and bumper stickers, and is thereby barred from registration by Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3).

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

We affirm the refusal to register.

In order to establish a *prima facie* case for refusal of registration under Section 2(e)(3), the Trademark Examining Attorney must show that prospective purchasers of the goods 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 *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) [NEW YORK WAYS GALLERY for various types of bags, backpacks, purses, etc., not from New York was held unregistrable under Section 2(e)(3)], and *In re Loew's Theaters, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) [DURANGO held unregistrable for chewing tobacco not from Mexico].

The Trademark Examining Attorney argues that applicant's mark is barred from registration because the primary significance of applicant's mark as a whole is the geographic place, Santa Fe, New Mexico. In support of this portion of his *prima facie* case, the Trademark Examining Attorney offered

evidence to show that the city of Santa Fe, New Mexico, is a place that is neither obscure nor remote. In particular, the Trademark Examining Attorney introduced listings for "Santa Fe" from The American Places Dictionary (1994) and Merriam-Webster's Geographical Dictionary (3rd ed. 1997).

The Trademark Examining Attorney also argues that there is an association between the goods in applicant's application and the city of Santa Fe, New Mexico. In support of this portion of his *prima facie* case, the Trademark Examining Attorney has introduced evidence establishing that Santa Fe, New Mexico, is a major tourist center of the Southwest. Further, excerpts retrieved from the LEXIS/NEXIS database contain statements about license plate holders being souvenirs associated with tourists' destination and specific references to calendars and bumper stickers being marketed and displayed in the city of Santa Fe.

Finally, applicant is located in Illinois, and there is nothing in the record to indicate that applicant's goods have their origin in, or are in any connection with, Santa Fe, New Mexico. In fact, in response to the Trademark Examining Attorney's specific inquiry, applicant concedes that its goods will have absolutely no connection with Santa Fe, New Mexico.

Both the Trademark Examining Attorney and applicant's counsel have agreed that Santa Fe is a city in New Mexico. However, while applicant does not contend that Santa Fe, the

capital city of New Mexico, is obscure or relatively unknown, he does argue that even the term "Santa Fe," taken alone, is not "*primarily* geographical." See 2 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §14.18 (4th Ed. 1999).

Applicant argues that for many Americans, "Santa Fe" evokes images of the popular *Santa Fe Railroad*, having 33,500 miles of tracks covering twenty-eight states. Additionally, applicant argues that especially as applied to these items, "... the Trademark Attorney has not identified anyone in the Santa Fe, New Mexico area that uses the mark for such goods." Further, applicant argues that the mere "... fact that calendars and souvenirs are available in stores located in Santa Fe, New Mexico ... is not persuasive evidence that the public will associate Santa Fe, New Mexico with calendars and bumper stickers."

While it is true that license plate holders, calendars and bumper stickers may be sold almost everywhere, it is much more likely that, for example, license plate holders, calendars and bumper stickers having the designation SANTA FE SPEEDWAY would be sold in, or would originate from, Santa Fe, New Mexico, than elsewhere. In short, we agree with the Trademark Examining Attorney's assessment of this case. Because applicant's mark includes the term "Santa Fe," consumers would make the association with Santa Fe, New Mexico.

Applicant and the Trademark Examining Attorney also disagree over the significance of the additional, arbitrary term SPEEDWAY within the composite mark. The Trademark Examining Attorney argues that the presence of this term does not create a composite having a non-geographic connotation.

Contrariwise, applicant takes the position that the word SPEEDWAY takes the mark as a whole out of being "the name of a place known generally to the public." To rebut the Trademark Examining Attorney's *prima facie* case, applicant contends that its mark SANTA FE SPEEDWAY is not, when considered in its entirety, the name of a geographic place.

The mark SANTA FE SPEEDWAY, when analyzed as a whole, is not primarily geographically deceptively misdescriptive because 'Santa Fe Speedway' does not connote a specific geographic place to reasonable consumers.

(Applicant's reply brief, p. 3).

Further, applicant argues that the Trademark Examining Attorney has violated the anti-dissection rule, giving too little weight to SPEEDWAY - a totally arbitrary component of this mark.

The Trademark Examining Attorney acknowledges that the entire mark is more than the name of New Mexico's capital city. However, the Trademark Examining Attorney argues that the overall impression of applicant's mark does not detract from the geographic significance of the word "Santa Fe" contained within

the mark. According to the Trademark Examining Attorney, the mark as a whole still emphasizes that applicant's goods have their origin in the city of Santa Fe, New Mexico.

The word "speedway" suggests the existence of an actual motor speedway, and further suggests that these license plate holders, calendars and bumper stickers are collateral goods sponsored by the motor speedway under that name. Nonetheless, adding the word "speedway" to the place name "Santa Fe" does not overcome the primarily geographic significance of the mark as a whole. Rather, the geographic significance of the mark remains.

In this regard, the Trademark Examining Attorney has shown that the DAYTONA INTERNATIONAL SPEEDWAY is located in Daytona Beach, the INDIANAPOLIS MOTOR SPEEDWAY is located in Indianapolis, the ATLANTA MOTOR SPEEDWAY is located in Atlanta, etc. Hence, it would be reasonable for prospective consumers to assume that the SANTA FE SPEEDWAY is located in Santa Fe.

In short, we find the term SPEEDWAY that applicant has added to the SANTA FE designation, though arbitrary in relation to license plate holders, calendars and bumper stickers, nonetheless tends to reinforce, not to detract from, the primary geographical connotations of the mark, considered in its entirety. Applicant simply has not provided any facts as to why - provided we find SANTA FE alone to be primarily geographical - the primary geographic significance of the composite mark is

lost by the addition of this term. Certainly, the determination of registrability under Section 2(e)(3) of the Lanham Act should not depend upon whether a composite mark is or is not unitary.

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).

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). In the Wada case, this Board 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. See In re Wada, 48 USPQ2d 1689, 1690 (TTAB 1998).

Applicant argues, moreover, that when the word "SPEEDWAY" is added to the words "SANTA FE," this composite mark, if it has any meaning at all to members of the public, will evoke images of a former race track in Chicago. We agree that the mark clearly suggests a connection to motor sports. However, we find that most consumers would likely be misled into thinking that the license plate holders, calendars and bumper stickers are from New Mexico, and specifically a motor speedway in the Santa

Fe area. On the other hand, it is not incumbent upon the Trademark Examining Attorney to prove that Santa Fe, New Mexico, has, or does not have, any racing in the general area, or that Santa Fe has, or does not have, an actual attraction known as the "Santa Fe Speedway."³

Conversely, applicant, a resident of Chicago, may find a market in the Midwest by tapping into nostalgia over a now defunct clay track for motorcycles and stock cars. However, that does not change the result herein. It would be relevant to our determination herein if the record showed that a substantial portion of the American population was aware of the actual Santa Fe Speedway - a dirt track that has been closed for years. If the record showed that this Chicago area track had once been nationally famous and that these license plate holders, calendars and bumper stickers represented some kind of commemorative items for that once famous track, then it would be obvious to prospective purchasers that the Santa Fe Speedway had nothing to do with New Mexico. However, that is not the case herein.

³ Because this is an Intent-to-Use application, we cannot be sure exactly how consumer will see this mark in context. However, on its face, there is nothing inherently incongruous about SANTA FE SPEEDWAY, nor do we know of any reason why the potential consumer would view this entire composite as a joke. Cf. *In re Sharky's Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) ["PARIS BEACH CLUB" would be viewed as a humorous mark and hence not primarily geographical given the facetious juxtaposition of "Paris" with "Beach Club."].

We turn next to the requirement that, for a refusal of registration under Section 2(e)(3), there must be a goods/place association. The Trademark Examining Attorney argues that the public is likely to believe that applicant's goods come from Santa Fe, New Mexico. He has placed evidence into the record of this application to demonstrate that calendars featuring people and places of local interest are sold in Santa Fe, that there is something out-of-towners recognize as a "Santa Fe-style bumper sticker," and that novelty license plate holders are among the most common of souvenirs available in major tourist centers such as Santa Fe, New Mexico.

Because of this, the Trademark Examining Attorney argues that the city of Santa Fe will be associated with all of applicant's goods identified in these two applications.

The Trademark Examining Attorney 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 believe consumers will perceive an association between applicant's goods listed herein and Santa Fe. It is sufficient for the Trademark Examining Attorney's refusal of registration if consumers would believe

the goods are manufactured in the places named in applicant's marks. Having established that merchants in Santa Fe sell calendars featuring people and places of local interest, that cars sport bumper stickers having a "Santa Fe style,"⁴ and that novelty license plate holders are popular in major tourist centers such as Santa Fe, the Trademark Examining Attorney has made out a *prima facie* case on this matter with evidence showing that the goods in question emanated from, or were sold in, the place named by the mark. No more can be expected from the Office in the way of proof. In re Loew's Theaters, Inc., *supra* at 869.

Furthermore, the question is not only whether consumers would perceive that applicant's license plate holders, calendars and bumper stickers are manufactured and/or sold in the place

⁴ Additionally, applicant argues that especially as applied to these "Santa Fe-style" bumper stickers, its bumper stickers will clearly not incorporate a uniquely Santa Fe motif or decorative style. See In re International Taste Inc., 53 USPQ2d 1604 (TTAB 2000). [Because "Hollywood" is also seen as a general reference to the entertainment industry, it is not primarily geographical in the mark "HOLLYWOOD FRIES with star design."]. This is an Intent-to-Use application, so we have no specimens (e.g., photographs of the license plate holders, calendars and bumper stickers) showing us the exact motifs applicant intends to use in an actual marketing context. Arguably, to the extent the artwork of the license plate holders, calendars and bumper stickers were to evoke regional motifs or decorative styles associated with Santa Fe's Native American and Spanish heritage, it would merely reinforce the geographic significance of the city of Santa Fe. On the other hand, to the extent that the license plate holders, calendars and bumper stickers were to show, for example, pictures of motorcyclists racing around a dirt track, it would do nothing to reinforce this contention about the term "Santa Fe" representing a regional "style."

named, but alternatively 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 ..."]. Hence, it is sufficient if the record shows that consumers would believe the goods were manufactured as collateral products for businesses located in Santa Fe.

The Trademark Examining Attorney has pointed out that Santa Fe is a major metropolitan area. See Nantucket, *supra*, Nies J., concurring, 213 USPQ at 895-96 [CHICAGO for shirts would be protectable only upon the establishment of acquired distinctiveness]. The Trademark Examining Attorney has established that Santa Fe is a known tourist destination and that, to borrow a phrase, license plate holders, calendars and bumper stickers and other such "souvenirs for the pilgrims of popular culture" are widely available in these places. Rock and Roll Hall of Fame and Museum Inc. v. Gentile Productions, 134 F.3d 749, 45 USPQ2d 1412, 1419 (6th Cir. 1998). Accordingly, as a large American city that is also a tourist destination, license plate holders, calendars and bumper stickers emblazoned with "Santa Fe" alone, and "Santa Fe" followed immediately by other local designations (e.g., "Santa Fe Horse Park," "Santa Fe

Children's Museum," or "Santa Fe Speedway"), would be significant sales items for souvenir outlets in Santa Fe.

In sum, based on the record before us in this appeal, we find that consumers encountering the mark SANTA FE SPEEDWAY on license plate holders, calendars and bumper stickers would be likely to believe mistakenly that such license plate holders, calendars and bumper stickers have their origin in Santa Fe or are otherwise connected with Santa Fe, New Mexico.

Decision: The refusal to register under Section 2(e)(3) of the Trademark Act is affirmed.