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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Les Halles De Paris J.V.

Serial Nos. 75/479,362 and 75/751,177

Lance J. Lieberman of Cohen, Pontani, Lieberman & Pavane
for applicant.

Won T. Oh, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Simms, Cissel and Hanak, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Les Halles De Paris J.V. (applicant), a New York joint
venture, has appealed from the final refusals of the
Trademark Examining Attorney to register the mark shown
below for hotel and lodging services

Le Marais

and the mark LE MARAIS for restaurant services.¹

The Examining Attorney has refused registration under Section 2(e)(3) of the Act, 15 USC §1052(e)(3), on the basis that applicant's mark is primarily geographically deceptively misdescriptive of applicant's services. Applicant and the Examining Attorney have submitted briefs, and an oral hearing was held.

While similar arguments were presented in each of these cases, somewhat different evidence has been made of record in each case. Accordingly, while we will decide these cases in one opinion, after reciting the arguments made by both the Examining Attorney and by applicant's attorney, we shall separately discuss the evidence in each case and decide each case on the basis of that evidence and the arguments pertaining to that evidence.

It is the Examining Attorney's position that the primary significance of applicant's mark is geographic, that purchasers are likely to think that applicant's

¹ Application Serial No. 75/479,362, filed May 4, 1998, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce; and Serial No. 75/751,177, filed July 14, 1999, based on allegations of use since June 4, 1995. Applicant indicated that the English translation of the mark is "The Marsh."

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services originate in the place named in the mark (that is, that there is a services/place association), and that applicant's services do not in fact come from the place named in the mark. According to the Examining Attorney, Le Marais was once a Jewish ghetto in Paris but is now a well-known and fashionable neighborhood, a popular tourist attraction in and of itself. The Examining Attorney maintains that Le Marais is a place of fine lodging and restaurants that serve as tourist attractions. It is not just a place where numerous hotel and restaurant facilities are located, according to the Examining Attorney, but is a part of Paris known for its hotels. Also, the Examining Attorney points to the *Washington Post* article, noted below, which purportedly shows that applicant is using the mark to create an association with this neighborhood of Paris. Nevertheless, the Examining Attorney maintains that there is no requirement that the place identified by the mark be well-known or noted for the goods or services with which the mark is used in order to find a goods- or services/place association. Also, according to the Examining Attorney, Le Marais is not so obscure or remote a geographic place that it would not be recognized as a geographic location by the relevant U.S. consumers. Further, the fact that the mark may have a meaning other

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than that of a geographic place does not alter its primary geographic significance, according to the Examining Attorney. The Examining Attorney contends that a prima facie showing has been made of a services/place association such that the public will associate applicant's hotels and restaurants with the place named in the mark. Because applicant's hotels and restaurants do not have their origin in that section of Paris, it is the Examining Attorney's position that applicant's mark is primarily geographically deceptively misdescriptive.

While the Examining Attorney states that it is Office policy to take consistent action with respect to related cases, the Examining Attorney contends that decisions of other Examining Attorneys in different cases (noted by applicant below) have no precedential value and that Examining Attorneys are not bound by those prior decisions to allow registration. The Examining Attorney also objects to the introduction of the Internet evidence made of record for the first time with applicant's appeal brief.²

Applicant, which owns and operates restaurants under this mark in New York City and in Washington, D.C., contends that the primary significance of LE MARAIS is not

² The Examining Attorney's objection to the new evidence submitted with applicant's briefs is well-taken, and this evidence has not been considered. See Trademark Rule 2.142(b).

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geographic, that there is no services/place association between the Paris neighborhood and restaurant and hotel services, and that, therefore, the public will not be deceived into believing that applicant's restaurants and hotels have their origin in the Le Marais neighborhood of Paris. More particularly, while admitting that its services do not originate from the Le Marais neighborhood of Paris, and that Le Marais may be well-known to the French public as the name of a neighborhood in Paris, applicant contends that there is no "clear evidence" that the average American consumer would necessarily recognize Le Marais as a geographic term, even if he or she were fluent in French. Applicant argues that Internet and other database searches reveal even obscure places, so that the ability to locate references to this neighborhood cannot be deemed conclusive of this term's primary significance to the American public. Relying upon evidence to which the Examining Attorney has objected, applicant also argues that the term "Marais" is also a surname as well as a name included in other place names. Accordingly, applicant states that Le Marais is, if not obscure, at least not widely known to the American hotel or restaurant patron. Rather, applicant contends that its mark suggests to the public an association with things French, such as French

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cooking or cuisine, French-style food, or French architecture or décor (in the case of its hotel services). If the services do not come from the place named in the mark and the public makes no services/place association, then the public is not deceived and the mark is not geographically deceptively misdescriptive, applicant argues.

Even assuming that the American public may understand Le Marais to have primarily geographic significance, applicant maintains that the Examining Attorney must further prove that there is services/place association between the mark and applicant's hotel and restaurant services. The mere existence of hotels and restaurants in this Paris neighborhood is insufficient, according to applicant, to establish a services/place association, where none of the references indicate that the Le Marais neighborhood of Paris is known for or associated with hotels and restaurants. Applicant argues that the Examining Attorney's position would lead to the refusal of registration on the basis of geographic deceptive misdescriptiveness of all known place names for hotel and restaurant services where such ubiquitous services do not in fact originate in the place named in the mark. Applicant maintains that the Examining Attorney's argument

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ignores the "deception" requirement of Section 2(e)(3) of the Act. The required services/place association exists only if the public is likely to believe--that is, will be deceived into believing--that applicant's services come from the place named in the mark, according to applicant. Applicant argues that the Examining Attorney's position requires applicant to prove a negative--that the place named in the mark is not associated by the public with hotel and restaurant services. Finally, pointing to several third-party registrations of geographic terms for hotel and restaurant services, applicant contends that the Examining Attorney's refusal here is at odds with Office practice and policy. In particular, applicant points to applicant's own registered mark LES HALLES for butcher and restaurant services, Les Halles identifying a well-known marketplace in Paris, as well as the third-party mark DALLAS BBQ for restaurant services (Reg. No. 1,567,659, issued November 21, 1989) and NEW YORK NEW YORK for resort/hotel services not rendered in New York City or state (Reg. No. 2,187,032, issued Sept. 8, 1998).

In support of his refusal with respect to applicant's attempt to register the mark for restaurant services, the

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Examining Attorney has made of record the following excerpts from the Nexis database:³

Try Barfly, just off the Champs Elyses [sic], for an international atmosphere. The area around Le Marais also has fun restaurants and bars...
Sunday Business, March 19, 2000

* * * * *

...descended into an architectural wasteland, before being rescued in the 1960s and declared a historical monument. Over the years Le Marais has moved from obscurity into a gilded age of offbeat and fashionable galleries[,] restaurants, chic boutiques and unusual museums. It is a mecca for designers and artists from around the globe and because of its buildings from the 14th through...
The Tribune (San Luis Obispo,) January 25, 2000

* * * * *

...18th and L Streets NW, to be called Le Marais and modeled on their kosher steakhouse in New York City. (Le Marais is the fashionable Jewish Quarter of Paris, near the original Les Halles market.)

According to Les Halles co-owner Michel Verdon, whose two partners will be running new restaurant with its Orthodox Jewish owners, he sometimes eats at the Le Marais in New York, "and except for the margarine on the table, you can't really tell the difference" because the restaurant buys the kosher

³ We have excluded other excerpted references of record to Le Marais contained in foreign newspapers, whose circulation in this country has not been demonstrated. See *In re Urbano*, 51 USPQ2d 1776, 1778 n. 3 (TTAB 1999) and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986).

beef and ages it in-house. Verdon also says Le Marais tends to draw younger Orthodox customers, "who want something a little more '90s than the more common kosher...

The Washington Post, January 9, 1998

* * * * *

The names of good, reasonable restaurants in Paris are to be cherished. Here are two we like (we'd make reservations for either):

Le Marais Ste Catherine, in the heart of the old Marais area, is housed in a medieval cellar. There are two three-course...

Consumer Reports Travel Letter, April, 1993

* * * * *

...a jitterbug dance hall in the Latin Quarter..., the carry-out restaurants in the Jewish quarter of Le Marais...that serve mouth-watering shwarma, lamb with a spicy sauce...

Washington Post, August 14, 1988

* * * * *

Paris has long been a city of ethnic neighborhoods and many of them still offer fascinating strolls. The old Jewish Quarter, Le Marais, for example, these days blends chic apartment renovations with tiny cafes, fine new restaurants and ancient synagogues, all on narrow, sinuous streets. Other ethnic sections are blossoming...

New York Times, September 23, 1984

* * * * *

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The Examining Attorney has also made of record the following Internet evidence concerning the Le Marais neighborhood:

Today, a trip around the Marais shows the numerous restorations it has seen. The neighborhood contains some of the oldest buildings in Paris, and their architectural treasures make the Marais a charming and unforgettable place to visit.

The Trademark Act prohibits the registration of primarily geographically deceptively misdescriptive marks under §2(e)(3). Whether a mark is primarily geographically deceptively misdescriptive is determined according to a two-part test where the Examining Attorney has the initial burden of proving that: (1) the mark's primary significance is a generally known geographic location; and (2) consumers would reasonably believe the applicant's goods are connected with the geographic location in the mark, that is, that purchasers would make a goods or services/place association, when in fact the goods or services do not come from the place named in the mark. *In re Save Venice N. Y., Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1540 (Fed. Cir. 1999); *Institut National des Appellations d'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992); *In re Societe*

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Generale des Eaux Minerals de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Loew's Theaters, 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).

The evidence demonstrates that Le Marais is the fashionable Jewish Quarter in Paris, and we believe that the primary significance of this term, at least to an appreciable segment of applicant's restaurant patrons, will be of the geographic location in Paris. This place is not so obscure that it will be unknown to many American consumers, especially those likely to frequent applicant's restaurants.

With respect to the services/place connection between restaurant services and the Le Marais area of Paris, we acknowledge that restaurant services are "ubiquitous" and that the Board, in *In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369 (TTAB 1999), stated that "the Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location." We find, however, that, with respect to restaurant services, this record is sufficient to satisfy that test.

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On this record, which shows not only that Le Marais is the Paris Jewish Quarter but also that that area has a number of fine restaurants, it is reasonable to assume that consumers encountering applicant's LE MARAIS restaurants will mistakenly believe that applicant's restaurant services have a connection with the Le Marais part of Paris. In this regard, we note that applicant's restaurants are touted as being French kosher steakhouses, with the menu being in French followed by an English translation. Contrary to applicant's contention, we believe that the mark will conjure up more than simply French cuisine. The connection to the Paris Jewish Quarter Le Marais is likely to be made, especially by those patrons and prospective patrons who are likely to frequent applicant's restaurants.

To be clear, we are not finding that the Examining Attorney has shown that Le Marais is noted for its restaurants or cuisine. Rather, we find that there is sufficient evidence of record to show that actual and potential customers of applicant's restaurants will believe that there is a connection between applicant's restaurants and the area in Paris known as Le Marais. Thus, we conclude that the public would mistakenly believe that applicant's restaurant services rendered under applicant's

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mark have a connection with Le Marais. See: *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1989).

With respect to the third-party marks that have been registered by this Office, this evidence is of little help in determining the registrability of the marks at issue in this case. As often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations and applications. While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's marks are registrable.

The evidence of record with respect to applicant's application covering hotel and lodging services consists of the following entry for Le Marais from The Columbia Gazetteer of the World:

[O]ld quarter of Paris, France, on right bank of the Seine R., now comprised in 3^d and 4th *Arrondissements* of the city. Until 18th cent. it was the most aristocratic sect. of Paris. The Hotel Des Tournelles, long the residence of the kings of France (Henry II was killed in its court during a joust), was replaced by the Place des Vosges. The Marais park, surrounded by uniform houses in pink brick and gray slate, remains a perfect ensemble of 17th-cent. architecture. Nearby is the Musee Carnavalet, once the home of Mme. de Sevigne, which now houses the

municipal mus. of Paris. During 19th cent. it became a ghetto area for Jewish refugees from Europe. Since 1969, a major restoration program has been underway, including renovation of several mus., mansions, and hotels, such as the 17th-cent. Hotel Sully.

Some of the Nexis excerpts are set forth below:

...I visited about a dozen hotel booking sites, some run by large chains and others by groups of smaller, independent properties. The number of choices overwhelmed me. I ended up picking a 23-room hotel in the Marais district simply because I like the photo of the stone walls in the breakfast room.
Business Week, March 29, 1999

* * * * *

...The first salons in the seventeenth century were centered on the hotels of aristocracy in the Marais. With the increasing importance of the noblesse de robe, the basis of conversation changed: descent was replaced by education, biensance, and esprit as the fundamental code of communication...
Daedalus, June 22, 1998

* * * * *

Last month that breakfast, coffee, tea, or hot chocolate, croissant and baguettes, butter, jam, and a wedge of cheese, cost 50 francs per person at our charming three-star hotel in the Marais...
The Record (Bergen County, N. J.),
September 21, 1997

* * * * *

Her favorite place to stay is the top floor of the Hotel Pratic in the Marais district. "It's very basic: six floors, with no elevator, just a narrow, winding stairway. It's quiet, which can be a real challenge in Paris."

The San Diego Union-Tribune, August 24, 1997

* * * * *

...An Internet search for keywords "Paris Hotels" led to www.paris-hotel.com, a reservation service with photos that turned up a romantic hotel in the Marais for \$100 a night.

Daily News (New York), March 30, 1997

* * * * *

The best time to visit Paris is in late spring, early summer and September. During July and August the city is besieged by tourists.

Where to stay:

There are many small hotels in the southern section of the Marais.

Here are some...

The Plain Dealer, March 9, 1997

* * * * *

To learn more about the city's past, take the Metro to the fashionable Marais district. Here the Hotel Carnavalet serves as the Museum of the History of Paris. Built in 1548 for the family Kernevoi...This rich renaissance residence evokes the rhythms of the city from antiquity to the present.

The Tennessean, February 16, 1997

* * * * *

Hotel Place Des Vosges near its beautiful namesake square in the 4th Arrondissement,

is simple and small (16 rooms), so book early. The hotel's neighborhood, the Marais, is the trendiest in Paris now, and the requisite street seems interesting little shops and hopping bars and restaurants make it a fun quartier to stay in...

The Commercial Appeal (Memphis), October 13, 1996

* * * * *

Like many of its Marais neighbors, the Hotel de Sully is an example of France's greatest, most civilized contribution to residential architecture - l'hotel particulier entre cour et jardin - the private townhouse elegantly situated between courtyard and garden...

House Beautiful, July 1995

* * * * *

...More than two days in the park would be excessive. In fact, here's what I would do if I had to do it all over: I'd fly to Paris, check into a charming hotel in the Marais and have a dinner at Bofinger...

Newsday, May 3, 1992

* * * * *

Save the Louvre for your second day. Start your art and culture tour in the less crowded and more manageable Marais district, where "hotels," or homes built by the nobility in the 16th and 17th centuries grace the streets. A glimpse into these historic gardens and rooms gives your youngsters a sense of court life in a time of castles and kings.

The Washington Times, March 22, 1992

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The Examining Attorney has also made of record a page from a Web site listing six hotels in Le Marais district of Paris.

With respect to the issue of geographic deceptive misdescriptiveness of LE MARAIS as it pertains to hotel and lodging services, we do not believe that this evidence is sufficient to demonstrate that a services/place association exists between applicant's hotel services and the place in Paris. Unlike the case with regard to restaurant services, where there is evidence that the Le Marais area of Paris is the home of ethnic restaurants not unlike applicant's, there is no analogous evidence with respect to hotel services beyond the fact that hotels are located there. The evidence that the nobility built "hotels" or homes there in the 16th and 17th centuries and that hotels are now located there is not sufficient to make out a prima facie case of a services/place association. Accordingly, we conclude that the Examining Attorney has not satisfied his burden with respect to demonstrating a services/place association concerning applicant's hotel and lodging services.

Decision: The refusal to register the mark in Application Serial No. 75/479,362 is reversed; the refusal

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to register the mark in Application Serial No. 75/751,177
is affirmed.