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This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fashion Group S.N.C. Di Bertoncello
Maria Luisa & Michela & C.

Serial No. 76006037

Harvey B. Jacobson, Simor L. Moskowitz and Matthew J.
Cuccias of Jacobson Holman, PLLC for Fashion Group S.N.C.
Di Bertoncello Maria Luisa & Michela & C.

Barbara Gold, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).¹

Before Walters, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Flash & Partners S.r.l., a joint stock company of
Italy, applied to register the stylized mark set forth
below for a wide variety of clothing items in Class 25.
The application was based on the stated intention of the

¹ Examining attorney James Marcus issued the initial and final refusals, and denied applicant's request for reconsideration. Ms. Gold issued two actions after the appeal was suspended and the application was remanded for further examination; and she later filed the Office's brief for the appeal.

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applicant to use the mark in commerce. The application subsequently was assigned to Fashion Group S.N.C. Di Bertoncello Maria Luisa & Michela & C. and the assignment has been recorded in USPTO records at Reel 2517, Frame 0851.



No-Lita
NORTH LITTLE ITALY

There were many office actions and responses during prosecution of this application, both before applicant filed its notice of appeal and after it requested a remand of the appeal to make further evidentiary submissions and arguments. Suffice it to say that the original examining attorney made final a refusal of registration, which we discuss below, and applicant obviously has appealed. The only issue to be decided on appeal is that refusal of registration, made under Section 2(e)(3) of the Lanham Act, 15 U.S.C. § 1052(e)(3). Before addressing the refusal, however, we discuss amendments of the identification of goods and mark.

As filed, the application listed the following identification of goods: "dresses, coats, overcoats, raincoats, jackets, sports jackets, trousers, jeans, shorts, skirts, track suits, sweaters, shirts, t-shirts, cardigans, dressing gowns, night gowns, pyjamas, petticoats, socks, stockings, tights, gloves, scarves, foulards (neckerchiefs), belts, waistcoats, bathing suits, hats, caps, shoes, boots, sandals, slippers." When the identification of goods information in the application was entered into USPTO records, the Office inadvertently omitted the first five items -- "dresses, coats, overcoats, raincoats, jackets."

The original examining attorney, in the first office action, required applicant to make two minor amendments to the identification. Specifically, he required "pyjamas" be amended to "pajamas" and required "foulards (neckerchiefs)" be amended to "foulards, neckerchiefs." The examining attorney then set forth, in one block paragraph, the identification listed in USPTO records (not the identification listed in the application) but with the changes included. Applicant, in response, adopted the examining attorney's proposed amended identification. Applicant did not point out that "dresses, coats, overcoats, raincoats, jackets" had been omitted. Further,

in briefing this appeal, both applicant and the examining attorney have recited the adopted amended identification as the operative identification. Accordingly, we consider the amended identification adopted by applicant to have entered the two minor changes required by the examining attorney and to have effectively deleted "dresses, coats, overcoats, raincoats, jackets" from the identification as filed.

As for the mark, though no mention of a deficiency in the drawing was made prior to appeal, on remand the substituted examining attorney asserted first, that the mark drawing was of poor quality and would not reproduce well, and second, that it impermissibly combined stylized lettering and typed lettering. This examining attorney required the applicant to submit an amended drawing "entirely in special form." Applicant then submitted an amended drawing entirely in typed form rather than in special form. The examining attorney nonetheless accepted this amendment. Thus, the mark involved in this appeal is now NO-L-ITA NORTH LITTLE ITALY.²

² We note applicant's statement, in footnote 2 of its main brief, "that its mark is NO-L-ITA stylized, and not NOLITA, such that this stylized, distinctive and arbitrary depiction of the mark is, in and of itself, a basis for overcoming the Examiner's 2(e) refusal." We take this not as a reference to the mark in the original drawing or as any indication that applicant now contends that NORTH LITTLE ITALY is not part of its mark, but merely as a contention that the NO-L-ITA term in its mark is "stylized" as compared to a presentation of that term as NOLITA.

In view of the above-discussed circumstances, the refusal to register now before us is a refusal to register NO-L-ITA NORTH LITTLE ITALY for "sports jackets, trousers, jeans, shorts, skirts, track suits, sweaters, shirts, t-shirts, cardigans, dressing gowns, night gowns, pajamas, petticoats, socks, stockings, tights, gloves, scarves, foulards, neckerchiefs, belts, waistcoats, bathing suits, hats, caps, shoes, boots, sandals, slippers." The refusal is based on Section 2(e)(3) of the Lanham Act, and the examining attorney's contention that the mark, when used, would be geographically deceptively misdescriptive of applicant's clothing goods.

As both the applicant and the examining attorney acknowledge:

[T]he PTO must deny registration under §1052(e)(3) if (1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation was a material factor in the consumer's decision.

In re California Innovations, Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003). See also, In re Les Halles De Paris J.V., 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003), and In re Consolidated Specialty Restaurants, Inc., 71 USPQ2d 1921 (TTAB 2004).

Summary of Arguments

In particular, the examining attorney contends that that NO-L-ITA is shorthand for "North Little Italy" or "North of Little Italy"; that applicant's coupling of NORTH LITTLE ITALY with NO-L-ITA reinforces the perception of the hyphenated term as shorthand for the full phrase; that "NoLIta" is a geographic term designating a particular neighborhood or small section of the borough of Manhattan in New York City;³ that the area is known for retailing of trend-setting fashions; that the area and its association with trend-setting fashions and fashion designers would be known by consumers of applicant's identified goods; that origin of such goods in the place identified by the term "NoLIta" would be a material factor in the purchasing decisions of consumers; and that applicant's goods will not come from the place known as "NoLIta."

Applicant "does not dispute the evidence [made] of record [by the initial action refusing registration] that the 'Nolita' term may refer to an area of New York City," and has stated "that neither Applicant nor its goods come

³ The examining attorney contends that whether displayed as NOLITA, NO-L-ITA, or in any combination involving upper and lower case letters, the term has the same connotation. The record in this case reveals that various presentations of the term are employed, we use NO-L-ITA when referring to the term in applicant's proposed mark and "NoLIta" when referring to the area in Manhattan.

from any locale known as 'Nolita.'"⁴ Response to office action, April 19, 2001. Applicant, however, does dispute that "NoLiTa" is anything more than a designation of a "small area [of New York City] recently 'd dreamed up' by ... real estate brokers" so as to "brand" the area and thereby increase property values. Brief, p. 8 (emphasis by applicant). In essence, applicant contends that the name for this area of New York City is a "passing fancy" and already "on the wane," so that it cannot truly be considered a "generally known" geographic term.⁵ In

⁴ Further, in arguing that the refusal is implausible, applicant contends that because "Italy is a world famous center for fashion design and manufacture[] ... an effort to conceal the Italian origin of the Applicant and its goods in favor of a misrepresentation of U.S. origin would not be of any benefit to the Applicant."

⁵ In its brief, applicant asserts that "Nolita is not a continent, country, province, state, city, town, or topographical feature." P. 7. It first made this observation in its request for reconsideration of the final refusal, where applicant also posited that a neighborhood in a city may not qualify as a geographic location under the Trademark Act. We disagree. See *Les Halles, supra*, which vacated and remanded a Board decision finding that LE MARAIS for a restaurant in New York was geographically deceptively misdescriptive. The Federal Circuit's decision, however, clearly was based on the question whether there was a sufficient services-place association for consumers, between the New York restaurant and a neighborhood in Paris, France, and the related question whether, if such association existed, it would be material to patrons of the restaurant. The court did not question the Board's finding that the primary significance of the "Le Marais," neighborhood is that of a geographical place. See also, *In re Gale Hayman Inc.*, 15 USPQ2d 1478, 1479 (TTAB 1990) ("A geographically descriptive term can indicate any geographic location on earth, including streets and areas of cities.").

addition, applicant contends that "NoLIta" does not appear in an otherwise comprehensive on-line database of the United States Geological Survey or in geographical dictionaries.

In its request to suspend the appeal and remand the application for consideration of additional evidence, applicant contended for the first time that "Nolita" is a given name and that the term cannot, therefore, "*primarily* and directly denote a geographical place" (emphasis by applicant). In support of this contention, applicant submitted various articles retrieved from the NEXIS database and a few web pages retrieved from the Internet. Applicant has not, in either of its briefs, reiterated or in any way argued this contention.

Applicant also contends that "Little Italy" is a term used for sections of numerous cities and that the phrase "north of Little Italy" is also widely used, in discussions of these places. Thus, applicant concludes "there is no one place exclusively referred to as 'Little Italy' or 'north of Little Italy.'" Brief, p. 10. For this reason, applicant concludes that prospective purchasers of its identified goods would not make a goods-place association between the goods and the New York City neighborhood of "NoLIta." Applicant's other argument why there is no

goods-place association is based on the issuance, by the USPTO, of two registrations for, respectively, NOLITA and NO LIMITS, NO BOUNDARIES, NOLITA as marks for various hair care products, as well as the issuance of a Notice of Allowance on an intent-to-use application to register NOLITA for jewelry.⁶ Applicant has argued at length why jewelry and hair care products should be considered fashion items or trends and asserts that the USPTO's issuance of the two registrations, and the Office's approval of the application, stand as evidence that the term NOLITA is not primarily geographically misdescriptive or primarily geographically descriptive because there is no goods-place association.

Finally, applicant contends that, even if we assume that we are dealing with a geographic term for a place generally known and that prospective purchasers of the goods listed in applicant's application would associate such goods with the place named in applicant's proposed mark, there is no evidence such association will materially affect purchasing decisions. Specifically, applicant argues in its main brief that the examining attorney did

⁶ The two registrations are owned by the same entity, have virtually identical identifications of goods and list the same dates of use. The application, still pending, is owned by a different entity.

not even address the materiality issue which was highlighted by our reviewing court in the *California Innovations* case; and in its reply brief applicant deconstructs the specific items of evidence on which the examining attorney relied in her brief. Applicant asserts, in essence, that there is no direct evidence of materiality; and that any evidence asserted to establish a goods-place association does not establish such a strong association that materiality could be inferred.

Examining Attorney's Evidence

The examining attorney must establish a *prima facie* case that the mark is primarily geographically deceptively misdescriptive. See In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003). A *prima facie* case "requires 'more than a mere scintilla' of evidence, in other words, 'such relevant evidence as a reasonable mind would accept as adequate to support the finding.'" In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citations omitted).

To support the initial refusal of registration, the original examining attorney introduced certain web pages and "five (5) representative Lexis/Nexis articles." The first web page is the "Nolita Neighborhood Guide" available

at "www.pleasantconcepts.com." This page says the neighborhood has boutiques and galleries, but does not specifically mention fashion or clothing items. The four boutiques and shops listed on the page include one which markets "modernized classics" but does not explain what these are, another that markets "handbags and accessories," a third that markets "handbags" and a fourth that is listed simply as a "home" boutique and which we assume would stock items for one's home. The second web page [part of the text is cut off in the printout] features a "Soho and Nolita Tour" from "Big Onion Walking Tours," and references "fashionable galleries and boutiques" but does not specifically mention clothing and, moreover, lumps the "SoHo" and "NoLiTa" neighborhoods together, so that we are unable to glean from this page whether one neighborhood or both would have the galleries and boutiques.

As for the five article excerpts retrieved by the examining attorney's LEXIS/NEXIS search for the terms "nolita" and "north little italy," these are items 1-4 and 7, of 127 articles. As noted earlier, the examining attorney terms them "representative." The first is from The Boston Globe and is an article about Boston's Italian neighborhood, the North End. The excerpt refers to New York's "NoLiTa" as "the hip boutique-laden 'hood that

translates to 'north of Little Italy.'" The second excerpt is from Real Estate Weekly which notes the appointment of a leasing agent for a retail space "in NoLita," explains that the term means "north of Little Italy" and states it is a "developing center for up-and-coming fashion retailing." It also states: "Calypso, Jamin Puech, Sigerson Morrison, Zero, Mark Schwartz, Soco, Language, and Fresh are neighborhood staples."⁷ The third article excerpt is from The New York Post, is headlined "High Fashion Is Moving Uptown," and states: "After a passing flirtation with the quaint streets of NoLita (North of Little Italy), the avant garde Commes des Garçons label headed for Chelsea and much-hyped designer boutique Jeffrey opened its headquarters in the Meatpacking District, respectively." The fourth excerpt is from The New York Law Journal and reports on the success of certain leasing agents having "arranged for Illuminations, the national lifestyles retailer, to open its first store at 54 Spring Street, in the heart of 'NoLita' (North of Little Italy)."⁸ We have no information, however, as to whether a "lifestyles retailer" is a retailer of clothing items, items for the home, or

⁷ While this particular article excerpt does not reveal the wares of each of these "neighborhood staples," other evidence reveals that these include shoe, handbag and clothing retailers.

⁸ We presume the topic is the retailer's first New York store.

something else altogether. Finally, the fifth article excerpt, from The New York Times, is on bargain hotels for frugal travelers and reports: "Trendy and desirable, the downtown neighborhoods of SoHo, NoLita (North of Little Italy) and TriBeCa have fewer hotels than other parts of Manhattan -- and almost none I could afford." These five articles are dated between May and August 2000.

The evidence offered in support of the initial refusal, by itself, likely would be insufficient to allow the examining attorney to carry the Office's burden of proof, at least in regard to the goods-place association and materiality elements of the refusal. Later submissions, however, clearly show a goods-place association between "NoLita" and fashion design and retailing. This association has been noted not only in New York publications but also in publications from other cities and on web sites geared to the fashion conscious and/or the fashion conscious prospective visitor to New York.

In support of the final refusal of registration, the original examining attorney introduced 15 additional LEXIS/NEXIS article excerpts.⁹ These are all dated between

⁹ The examining attorney stated in his office action that 14 excerpts were attached, but we count 15.

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April 1997 and July 2001. The searches used to retrieve these excerpts were "nolita," or "nolita" and "north little italy," or "nolita" within five words of "north little italy," or "nolita" and "clothing." Of these 15 articles, 13 clearly discuss clothing design or retailing of clothing in "NoLita." While most of the articles appeared in New York publications, others appeared in Houston, Dallas, and San Diego publications.

Next, the original examining attorney denied applicant's request for reconsideration and introduced reprints of pages from 10 websites; a reprint of the search results list from a search of the Internet utilizing the Yahoo search engine; and 10 additional article excerpts retrieved from LEXIS/NEXIS databases. The web pages include reprints from the New York pages of "Citysearch.com" ("find cutting edge fashion in Nolita" one page states; others list numerous clothing stores); a "Visualstore.com" news article on a new shop opening in "NoLita" ("Designer Leeora Catalan, who counts Madonna, Destiny's Child, Gwen Stefani, Britney Spears and Jennifer Lopez among her celebrity clientele, has opened her own store, Shop Noir, in New York's Nolita district."); a "DigitalCity.com" listing of six of "The Best Women's Clothing Stores" in New York, which includes two stores

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listed as located in "NoLita"; a web page from "onemedia.com" ("brought to you by Zagat") featuring a profile of a "NoLita" shoe store; web pages from the website of designer Margie Tsai ("MargieTsai.com") detailing that she has an "exclusive boutique" in "NoLita," that her fashions have been featured in numerous magazines and that some are also available in other stores around the country; a page from a city guide to New York from "BlackVoices.com" ("NoLita, one of Manhattan's quietest neighborhoods, also is one of its most creative - and lately its most desirable location for fledgling artists and fashion designers to launch their own businesses"); a web page from the city guide to New York by "Trendcentral" ("[NoLita] was originally an authentic Italian neighborhood, but nowadays it's full of hipsters and fashion types who live, work, eat, and shop in the neighborhood").

The LEXIS/NEXIS article excerpts included with the denial of applicant's request for reconsideration were retrieved by searches for "nolita" or "nolita" within 5 words of "clothing or fashion," and are dated between January and May 2002. Nine out of the ten articles clearly discuss clothing, clothing designers, or clothing shops in the "NoLita" neighborhood. Eight of these nine articles

appeared in New York publications, and one appeared in The Boston Globe.

The search results list from the Yahoo search *per se* is not probative. See In re Remacle, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002).

The second examining attorney, following suspension of the appeal and remand of the application, issued two office actions. The first of these actions did not introduce any additional evidence in support of the refusal. The second action introduced 36 more LEXIS/NEXIS article excerpts. These are dated between March 1998 and January 2004. While the office action does not indicate the search query used to retrieve these excerpts, it appears that the search was for the term "nolita" and either "Italy" or "New York," as these are the terms that appear in bold in the excerpts. This search returned articles that appeared in New York publications, but also articles in The Chicago Tribune, Washingtonian magazine, the Providence Journal-Bulletin, The Patriot Ledger (Quincy, MA), The Times Union (Albany, New York), The San Francisco Chronicle, The Baltimore Sun, Fortune magazine, Entrepreneur magazine, The Bergen Record (New Jersey), Footwear News, and Real Estate Weekly. We agree with applicant's assessment (brief, p. 6) that these 36 excerpts have been presented in extremely truncated

fashion; and many which might otherwise have been found probative of a goods-place association merely are probative of the meaning of "NoLIta." Nonetheless, 14 of the article excerpts clearly associate "NoLIta" and clothing or footwear; another two associate the neighborhood with handbags; and two associate it with jewelry or "chokers."

Is the Primary Significance of the Proposed Mark a Generally Known Geographic Location?

"Under the first prong of the test - whether the mark's primary significance is a generally known geographic location - a composite mark such as the applicant's proposed mark must be evaluated as a whole. It is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole."

In re Save Venice New York, Inc., 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001)(citations omitted).

On the evidence of record, we find the primary significance of the proposed mark is that of a geographic location. The record includes dozens of article excerpts retrieved from the NEXIS database that show "NoLIta" to be a particular place and a term derived from the phrase

"North Little Italy" or "North of Little Italy."¹⁰

Moreover, because applicant's proposed mark includes the phrase NORTH LITTLE ITALY, there is little, if any, likelihood that a consumer would perceive the NO-L-ITA element as anything other than shorthand reference for the longer phrase.¹¹

The next question is whether this geographic location is "generally known." Applicant has argued, in essence, that the "NoLita" neighborhood certainly is not generally known outside New York City, and may not even be a widely used term within that city. On this record, however, we have no difficulty finding that the neighborhood is generally known. In New York, it would be known among real estate professionals, artists, fashion designers and those who follow the retailing of clothing and other designer items. Even outside New York City, the neighborhood and

¹⁰ Applicant and the examining attorney have debated whether it is significant that most of the evidence shows "NoLita" is considered to be shorthand for "North of Little Italy" rather than for "North Little Italy." We find the difference insignificant, for no matter the derivation of the term "NoLita," it identifies only one place.

¹¹ As noted previously, that although applicant at one point during prosecution of its application argued that "Nolita" can be a given name, it did not press the argument on appeal. Even had it done so, we would find the argument unavailing, both because given names are not usually hyphenated, as is the term NO-L-ITA, and also because the phrase NORTH LITTLE ITALY in the mark leaves little room for NO-L-ITA to be perceived as anything other than shorthand for the full phrase.

the items that are designed and/or retailed within the neighborhood would be generally known among those who follow the fashion industry, as well as among travel agents or travel writers who would be expected to know of the diverse neighborhoods within a particular city that travelers might want to visit; and it can scarcely be doubted that New York City is a significant tourist destination, whether for domestic or international travelers. Finally, even casual readers of newspapers from Boston, Baltimore, Chicago, Providence, Quincy (MA), Bergen (NJ), Austin, Dallas, Houston, San Diego and San Francisco, as well as casual visitors to travel-related websites featuring information on New York, may have read of the neighborhood.

Applicant's argument that New York City real estate agents "dreamed up" the name and did so only "recently" is not persuasive of a contrary result. It is largely irrelevant how the name came to be and only relevant what significance it has to consumers. Moreover, the NEXIS article excerpts show that the neighborhood has been called "NoLiTa" for years. We likewise find unpersuasive applicant's argument that the use of the name for the neighborhood is a "passing fancy" or "on the wane." This argument is based on one or two of the articles retrieved

from NEXIS and a single website visited by applicant, and is outweighed by the many other articles of recent vintage that reveal no indication that use of the name is waning.

We also find unpersuasive applicant's argument based on its submission of evidence showing the existence of other "Little Italy" neighborhoods in the United States, and the consequent use of the phrase "north of Little Italy" to describe places north of those neighborhoods. By this argument, applicant essentially contends that prospective consumers of clothing will not necessarily think of only one of these places, i.e., the New York City neighborhood, and may think of other places. This evidence, however, does not establish that any of these places are also referred to by the term NO-L-ITA. The mere possibility that a resident of, for example, San Francisco, might consider clothing marketed under applicant's mark to indicate origin of the clothing in some place north of that city's Little Italy neighborhood does not establish the registrability of applicant's mark. Rather, it only establishes that such a consumer would still misapprehend the geographic source of applicant's goods.¹²

¹² In addition, applicant has not put any evidence into the record that would tend to establish that people in other cities that have a Little Italy neighborhood are accustomed to seeing those neighborhoods designated by terms such as NO-L-ITA, whereas the record does reveal that NO-L-ITA is recognized in New York City.

In sum, as to the first factor under the California Innovations analysis, we find that NO-L-ITA and applicant's composite mark NO-L-ITA NORTH LITTLE ITALY are geographic in significance; and we find the place to which both the hyphenated term and composite mark refer is generally known.

Is There a Goods-Place Association Between "NoLIta" and Clothing?

The evidence submitted by the examining attorney shows that the neighborhood known as "NoLIta" is associated with various things: narrow streets and smaller buildings than in nearby neighborhoods, which mean less vehicle traffic; easy pedestrian access to boutiques and specialized shops and cafes; and that the boutiques and shops may market clothing, shoes, jewelry, handbags, cosmetics, or housewares. The preponderance of the evidence, however, shows an association of the New York City neighborhood with clothing designers and retailers, many of whom apparently have found the neighborhood a suitable location for their businesses.

We find the record sufficient to establish a goods-place association between clothing items and the New York neighborhood known as "NoLIta." We are not persuaded that we should reach a contrary result by applicant's argument

based on the issuance, by the USPTO, of two registrations for, respectively, NOLITA and NO LIMITS, NO BOUNDARIES, NOLITA, for various hair care products. First, applicant's argument is predicated on a finding that hair care products are "fashion items." While we do not disagree that the styling of hair may be a matter of fashion, we find no support for the contention that, for example, a hair styling gel *per se* is a fashion product. Second, even if we accepted applicant's contention that hair care products *per se* were fashion items, we would not find the Office's issuance of the two registrations in question probative that consumers would not make a goods-place association between clothing and the New York City neighborhood known as "NoLita." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).¹³

Is it Material to Consumers that Clothing Come From or Be Designed in the "NoLita" Neighborhood of New York City?

Evidence establishing a goods-place association, as we have found to be present in this case, raises "an inference of deception based on the likelihood of a goods-place

¹³ The third-party application on which applicant relies has even less probative value than the third-party registrations. See Zappia-Paradiso, S.A. v. Cojeva Inc., 144 USPQ 101 (TTAB 1964) (Information regarding applications evidences only that they were filed on a particular date, even if the marks therein have been published for opposition).

association that [does] not reflect the actual origin of the goods. A mere inference, however, is not enough to establish the deceptiveness [and] consequence of non-registrability under ... NAFTA and the amended Lanham Act [which] place an emphasis on actual misleading of the public." *California Innovations*, 66 USPQ2d at 1857. Thus a showing of materiality is required. *Id.*

If there "is evidence that goods like applicant's or goods related to applicant's are a principal product of the geographical area named by the mark" or "the place is noted for the particular goods," deceptiveness is likely. *California Innovations*, 66 USPQ2d at 1857, citing, respectively, In re House of Windsor, 221 USPQ 53, 57 (TTAB 1983) and In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 868 n.6 (Fed. Cir. 1985).

In *California Innovations*, the appeal was limited to the USPTO's refusal to register that applicant's mark for insulated bags and wraps. While there was a great deal of evidence in the case, "[a]t best, the evidence of a connection between California and insulated bags and wraps [was] tenuous." *California Innovations*, 66 USPQ2d at 1859. Thus, the appeal was remanded to the Board for further proceedings, including review of the evidence to see if it supported a finding of materiality. *Id.*

The record in this case establishes much more than a tenuous connection between "NoLita" and clothing items. Instead, the record establishes that clothing designers are concentrated in the neighborhood and that it is known for its trend-setting and unique clothing boutiques. Some of the evidence speaks directly to consumers' recognition that "NoLita" is noted for its fashionable clothing. See, for example:

Headline: Boutiques find niche in chic kids' apparel; Buyers often are older, wealthier
"Puma shoes and Nolita T-shirts (referring to a New York City neighborhood 'north of Little Italy') have been popular with adults who are now dressing their tykes in them."
Chicago Tribune, January 26, 2004.

"...Jonsson exudes downtown chic. 'But if I want to walk around looking at things, I go east,' he said, referring to the upstart neighborhood Nolita (North of Little Italy). 'It's got more new designers. It's more fun. It's what SoHo used to be.'"
Newsday (New York, NY), February 18, 2002.

"...the area has been perceived as a destination for shoppers looking for something special that cannot be found in ordinary stores.
...fashion publications seek out the designers located there for new trends in clothing and accessories.
...Tracy Feith offers his concept of fashion to women who want to make a statement. ... '[Feith's] Customers come here for the designer look.'"
The New York Times, May 13, 2001.

Ms. Uprichard, who has been a downtown designer since the 1980's, originally selling in the East Village, said that NoLita has flourished as an alternative fashion mecca because of all the

moneyed shoppers drawn to the greater SoHo district. Another factor has been customers' hunger for clothing that is not mass marketed." The New York Times, May 31, 1998.

"...Manhattan has all the same chains,' says Barbara White-Sax, a New Jersey resident who often comes to NoLiTa to shop. 'This area truly offers things you can't find anywhere else.'" Crain's New York Business, April 21, 1997.

The record also includes an excerpt from a Washingtonian magazine article (December 2003) which, although truncated, clearly discusses the opening of high fashion shoe stores in the Washington metropolitan area, "so the hip girls will be suitably shod. Fashionable types used to shopping in New York's SoHo and NoLita won't have to make an Amtrak run anymore..."; an excerpt from Footwear News (July 28, 2003), which reports that a new boutique in Chicago is selling brands selected by, among other actions, "patrolling New York's Nolita neighborhood"; and a web site posting, by an individual reviewing the "NoLita" neighborhood (www.iagora.com's "iTravel" site; review posted by "Sacha," June 15, 2000):

Soho stands for "South of Houston," Tribeca stands for "Triangle Beneath Canal," and then there is Nolita: "North of Little Italy." Extremely cool little fashion boutiques have sprouted up in the last couple of years and so the real estate people gave it a name so as to make more money. But the area definitely is distinctive enough to merit its own name.

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In sum, we find the evidence of record sufficient to establish that principal products of the "NoLita" neighborhood, and the products for which it is chiefly noted, are fashionable clothing items. Moreover, the evidence establishes that, for consumers, the origin of clothes in "NoLita" is a material factor in their shopping decisions. Thus, we find the evidence establishes the third prong of the *California Innovations* test.

Decision: The refusal of registration under Section 2(e)(3) of the Lanham Act is affirmed.