

Oral Hearing:
December 11, 2003

*THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE TTAB*

March 16, 2004
Paper No. 16
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fame Jeans, Inc.

Serial No. 78091743

Lewis F. Gould of Duane Morris for Fame Jeans, Inc.

Michael Levy, Senior Attorney, and Rebecca A. Smith,¹
Trademark Examining Attorney, Law Office 110 (Chris A.F.
Pedersen, Managing Attorney).

Before Sams, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Fame Jeans, Inc. has filed a trademark application to
register the mark US WEAR for "clothing, namely, boys and
girls sportswear, namely, pants, jumpers, overalls,
coveralls and woven and knit shirts and skirts."² The

¹ Mr. Levy argued the case at the oral hearing. Ms. Smith issued the
final refusal to register, following initial examination by a third
Examining Attorney, and wrote the brief on appeal.

² Serial No. 78091743, in International Class 25, filed November 5,
2001, based on use of the mark in commerce, alleging first use and use
in commerce as of April 2000; with a claim of priority, under Section
44(d) of the Trademark Act, 15 U.S.C. 1126(d), based on a Canadian
application. However, on March 13, 2002, applicant deleted its Section
44(d) claim of priority.

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application includes a disclaimer of "WEAR" apart from the mark as a whole.

The Trademark Examining Attorney issued a final refusal to register under Section 2(e)(3) of the Trademark Act, 15 U.S.C. 1052(e)(3), on the ground that applicant's mark is primarily geographically deceptively misdescriptive in connection with its goods; and under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that applicant's mark is deceptive of the origin of its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held.

The North American Free Trade Agreement (NAFTA) Implementation Act, Pub. L. No. 103-182, 107 Stat. 2057 (1993) amended Section 2(e)(2) of the Trademark Act by deleting reference to primarily geographically deceptively misdescriptive marks; added Section 2(e)(3) to the Trademark Act to prohibit registration of primarily geographically deceptively misdescriptive marks; and amended Section 2(f) of the Trademark Act to prohibit primarily geographically deceptively misdescriptive marks from becoming registrable via a showing of acquired distinctiveness.

Prior to the briefing stage in this ex parte appeal, our primary reviewing court, in *In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir.

2003), concluded that the standard for determining whether a mark is primarily geographically deceptively misdescriptive under the new Section 2(e)(3) of the Act is different from, and more rigorous than, the standard for determining registrability of the same types of marks under Section 2(e)(2) of the Act prior to the NAFTA amendment. The court stated the following (at 1339):

Thus, § 1052 no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks. ... Accordingly, the test for rejecting a deceptively misdescriptive mark is no longer simple lack of distinctiveness, but the higher showing of deceptiveness.

The court stated the following about the pre-NAFTA amendment requirement for a goods-place association (at 1340):

Therefore, the relatively easy burden of showing a naked goods-place association without proof that the association is material to the consumer's decision is no longer justified, because marks rejected under § 1052(e)(3) can no longer obtain registration through acquired distinctiveness under § 1052(f). To ensure a showing of deceptiveness and misleading before imposing the penalty of non-registrability, the PTO may not deny registration without a showing that the goods-place association made by the consumer is material to the consumer's decision to purchase those goods. This addition of a materiality inquiry equates this test with the elevated standard applied under § 1052(a).

...

The shift in emphasis in the standard to identify primarily geographically deceptively misdescriptive marks under § 1052(e)(3) will bring that section into harmony with § 1052(a).

The court articulated the following standard for determining whether a mark is primarily geographically deceptively misdescriptive (at 1341-1342):

Thus, due to the NAFTA changes in the Lanham Act, the 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.

...

As a result of the NAFTA changes to the Lanham Act, geographic deception is specifically dealt with in subsection (e)(3), while deception in general continues to be addressed under subsection (a). Consequently, this court anticipates that the PTO will usually address geographically deceptive marks under subsection (e)(3) of the amended Lanham Act rather than subsection (a). While there are identical legal standards for deception in each section, subsection (e)(3) specifically involves deception involving geographic marks.

In the case before us, applicant and the Examining Attorney, in their briefs, articulated the above-quoted standard for determining whether a mark is primarily geographically deceptively misdescriptive in connection with the identified goods under Section 2(e)(3) of the Trademark Act. In her brief, in view of the *California Innovations* opinion, the Examining Attorney withdrew Section 2(a) of the Act as a basis for the refusal to register. Thus, the only issue remaining in this appeal is whether the Examining

Attorney has established that the mark herein is unregistrable under Section 2(e)(3) of the Act.

The Examining Attorney contends that the primary significance of US in applicant's mark is geographic because US is a commonly used abbreviation for United States, whether it appears with or without periods, *i.e.*, US or U.S.³; that the term WEAR in the mark "does not avoid the refusal ... [and] this term has been disclaimed by the applicant and is not at issue" [Brief, p. 4.]⁴; and that the mark identifies a geographic location that is not remote or obscure and, thus, there is a presumption of a goods-place association. The Examining Attorney noted that applicant is located in Canada and that applicant does not deny that its goods originate in Canada.

Regarding the materiality of the geographic location to the consumer's decision to purchase the goods identified herein, the Examining Attorney submitted excerpts of articles from the LEXIS/NEXIS database about "American clothing designers." She contends that this evidence

³ The Examining Attorney submitted an excerpt from the *American Heritage Dictionary of the English Language* (3rd ed. 1992) establishing that US and U.S. are abbreviations for United States. Additionally, she submitted the results of a Google search of the Internet (dated November 5, 2002), wherein US is used in a context clearly denoting United States.

⁴ The Examining Attorney contends that the specimens of record also support her position that the US portion of applicant's mark will be perceived as an abbreviation of United States rather than as the word "us" because US is capitalized and only the initial letter of "Wear" is capitalized on the specimen label, *i.e.*, US Wear.

"reveal[s] examples of a wide variety of American clothing designers" and that the evidence "was intended to show examples of references to various companies that produce clothing in the United States." [Brief, p. 7.] She draws the following conclusions [*id.*]:

Where specific goods such as clothing come from is extremely important to buyers. Many consumers will only purchase goods made in the United States to support the local economy and to evoke a sense of patriotism. Hence advertising campaigns such as BUY AMERICAN and labels that indicate MADE IN AMERICA, etc. Not only is the United States a large producer of clothing but consumers are likely to base their purchasing decision on the fact that the clothing is made in the United States.

Conversely, applicant contends that the primary significance of the US portion of its mark is not geographic; that US also means "us" (the objective case of "we"), as evidenced by the dictionary definition submitted by applicant; and that the primary significance of the composite mark, US WEAR, is not geographic, contending that the dominant portion of the mark is WEAR. Additionally, applicant argues that the Examining Attorney has not established that there is a goods/place association, that the goods do not originate from the United States or that the geographic origin of the goods would materially affect the purchasing decision. With its brief, applicant submitted excerpts from the web sites listed on the Google search results submitted by the Examining Attorney to show

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that the actual web sites used periods after each letter, *i.e.*, U.S., to abbreviate United States.

Whether Primary Significance of Mark is a Generally Known Geographic Location

With regard to the first prong of the test, there is no question that US is an abbreviation for "United States," which is the commonly recognized name of the United States of America, wherein registration of this mark is sought; or that this connotation will come to mind upon viewing the mark. Both the Google search results and the dictionary definition submitted by the Examining Attorney establish these facts. We are not persuaded otherwise by applicant's argument that the US portion of its mark US WEAR may also be perceived as the word "us" and, thus, it is not primarily geographic in connotation; or that the letters "U" and "S" must be followed by periods, *i.e.*, U.S., for US to be recognized as an abbreviation of United States.

Further, we conclude that coupling this geographic term with the additional term, WEAR, does not detract from the primary geographic significance of the composite mark. See *In re Bacardi & Company Limited*, 48 USPQ2d 1031 (TTAB 1997); and *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637, 1639 (TTAB 1991). As the Board has stated in the past, the determination of registrability under Section 2(e)(3) [previously, Section 2(e)(2)] should not depend on whether the mark is unitary or composite. See *In re*

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Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986).

Applicant gives no explanation for its conclusion that WEAR is the dominant portion of applicant's mark and we find that the merely descriptive term, while clearly part of the composite mark, does not detract from the geographic significance of the mark as a whole.

To summarize, the primary significance of the composite mark US WEAR is a generally known geographic location.

Goods/Place Association

We turn, next, to the question of whether purchasers are 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.⁵ We answer that question in the affirmative.

The following are excerpts from several of the articles from the LEXIS/NEXIS database submitted by the Examining Attorney:

On behalf of the Fashion Institute of Technology, Mrs. Lee edited "American Fashion: The Life and Times of Adrian, Mainbocher, McCardell, Norell, Trigere," a compilation of mid-century American clothing designers, published by the New York Times in 1975. [*The New York Times*, May 12, 2001.]

⁵ Applicant is a Canadian company located in Quebec, Canada. Contrary to applicant's statement in its brief that the filing was based on Section 1(b) of the Act, the application is based on use in a type of commerce regulable by Congress. In view of these facts, we can only conclude that the goods originate in Canada, and applicant does not contend otherwise.

A dozen blocks from the bright lights and big-city style of Bryant Park, where American clothing designers are showing their fall 2001 collections this week, novice designer Andrew Harmon was dealing with his own fashion dilemma. [*The Boston Herald*, February 14, 2001.]

Nautica is negotiating with 666 Fifth Ave. for a location for its flagship store. By landing the popular American clothing designer to fill a 23,000-square-foot space, the building's owner ... would cap off an \$18 million makeover of the office tower's retail space and lobby. [*Crain's New York Business*, January 19, 1998.]

... Keds, an American footwear classic in basic colors and styles with a reputation for being durable, washable and comfortable. This year the company, a division of Stride Rite Corp., decided to shake up its stolid image by letting American clothing designers have their way with the sneakers. The Keds Salutes Great American Design program began this fall with Todd Oldham. [*Chicago Tribune*, October 9, 1997.]

We find sufficient evidence herein to conclude that a goods/place association is likely to be made by purchasers between US, a common abbreviation of United States, and the clothing products identified in this application. Thus, purchasers are likely to believe that the clothing products sought to be registered in connection with the mark herein originate in the United States. Further, applicant concedes that clothing is designed and manufactured in the United States (Brief, p. 9).⁶

⁶ Applicant argues that the Examining Attorney has not established that the United States is well known for its clothing industry, or for the manufacture of the clothing identified in the application. However, such a showing is unnecessary to establish a goods/place association.

Materiality of Geographic Misrepresentation to Purchasing Decision

While the Examining Attorney has stated her opinion that the origin in the United States of the goods herein, and consumer products in general, is an important factor in the decision to purchase such goods, she has presented no evidence in support of these statements. Nor has the Examining Attorney established that the United States is well known or renowned for the products in this case, which would support a finding of materiality. See *In re California Innovations, Inc.*, *supra* at 1341, citing *In re House of Windsor*, 221 USPQ 53 (TTAB 1983). We have absolutely no basis upon which to conclude that the geographic origin of the identified goods, or the misrepresentation thereof, is a material factor in the consumer's decision to purchase those goods.

Therefore, we conclude that the Examining Attorney has established that the primary significance of the mark US WEAR is a generally known geographic location, and the consuming public is likely to mistakenly believe that the place identified by the mark, the United States, indicates the origin of the goods bearing the mark. However, the Examining Attorney has not established the third necessary factor, that the misrepresentation is a material factor in a consumer's purchasing decision. In conclusion, the Examining Attorney has not established that US WEAR is

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primarily geographically deceptively misdescriptive, under Section 2(e)(3) of the Act, in connection with the identified goods.

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