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Paper No. 9
AFD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arley B. de Paris, Inc.

Serial No. 75/618,459

Jay Begler of Buchanan Ingersoll for Arley B. de Paris,
Inc.

Hannah Fisher, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Simms, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 11, 1999, Arley B. de Paris. Inc.
(applicant) filed an intent-to-use application for the mark
ARLEY B. DE PARIS for goods ultimately identified as "adult
and children's clothing, namely, shirts, pants, dresses,
jackets, tights, socks, sweatshirts, sweatpants, scarves,
jeans, undergarments, vests, neckties, rainwear, leotards,
halter tops, hats, coverups, blouses, knickers, bodysuits,
overalls, tunics, baby bunting, bathing suits, shorts,

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cloth bibs, bonnets, booties, boots, caps, sweaters, diapers made of cloth, coats, dresses, skirts, gloves, jumpers, jumpsuits, kimonos, leggings, dungarees, mittens, muffs, pajamas, play suits, rompers, shoes, slippers, sleepwear, socks, snowsuits" in International Class 25.¹ Because this is an intent-to-use application, the Examining Attorney required applicant to disclaim the term "Paris" if the goods would come from Paris. If not, the Examining Attorney advised applicant that a refusal under 2(e)(3) of the Trademark Act would be made. Responding to this Office action, applicant disclaimed the term "Paris," but it also stated that "it is not yet known where the goods will be produced and manufactured." Applicant also advised the Examining Attorney that the mark is the French equivalent of the English phrase "Arley B. of Paris." Response dated Oct. 7, 1999. At this point, the Examining Attorney made the provisional refusal to register the mark under Section 2(e)(3) of the Trademark Act final because "it is possible that at least some of the goods will not originate from the renowned fashion center." Office Action dated Dec. 16, 1999.² After the refusal was made final, this appeal

¹ Serial No. 75/618,459.

² Applicant has not objected to the Examining Attorney making the refusal final at this point. TMEP 1105.04(e).

followed. Applicant and the Examining Attorney have submitted briefs. An oral argument was not requested.

Our primary reviewing court has set out the standard for determining whether a term is primarily geographically deceptively misdescriptive:

For a mark to be primarily geographically deceptively misdescriptive, the mark must (1) have as its primary significance a generally known geographic place, and (2) identify products that the purchasers are likely to believe mistakenly are connected with that location.

In re Wada, 194 F.3d 1297, 52 USPQ2d 1539, 1540 (Fed. Cir. 2000).

The Examining Attorney has submitted a page from Webster's New Geographical Dictionary, p. 927, which identifies Paris as a city in France that is the financial, commercial, transportation, artistic and intellectual center of France as well as "an international fashion center" and a major tourist center.³

Applicant has translated the mark as: "Arley B. of Paris." Applicant's Appeal Brief, p. 2. Applicant has also provided a disclaimer of the word "Paris." Id. In addition, applicant provided the following cryptic explanation of the mark: "The reference to Paris is simply

³ We also take official notice, as requested by the Examining Attorney, that fashion means "the prevailing style (as in a dress) . . . a garment in such a style." University Of Notre

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to the intended reference of an animal 'Arley B.' who is of Paris and all the design elements, creative elements emanate from Paris." Response dated Oct. 7, 1999, p. 1. The Examining Attorney understood the reference to Arley B. to be a reference to a fictitious animal character. Appeal Br. at pp. 2-3.

Because of the evidence of Paris as an international fashion center, a major tourist center, and its distinction as being the financial, commercial, transportation, artistic and intellectual center of France, we have no trouble with holding that Paris is a well-known geographic place. We also note that in In re Sharky's Drygoods Co., 23 USPQ2d 1061, 1062 (TTAB 1992), we took official notice that "Paris is a well-known geographical place." Therefore, it is clear that Paris is not a remote or obscure place, a point not disputed by the applicant.

We also find that there is a goods/place relationship between Paris and clothing inasmuch as Paris is an international fashion center. Again, it is clear that potential customers are likely to believe that clothing bearing the phrase "de Paris" or its English equivalent originates in Paris.

Dame du Lac v. J.C. Gourmet Food Imports, 213 USPQ 594, 596 (TTAB 1982), aff'd, 217 USPQ 505 (Fed. Cir. 1983).

However, a mark that includes the word "Paris" would not be refused registration if the term is used fancifully or arbitrarily. Wada, 52 USPQ2d at 1540. In the Sharky's Drygoods case, we found that the mark PARIS BEACH CLUB for T-shirts and sweatshirts resulted in an incongruous phrase, and purchasers would likely view it as a "facetious rather than geographic reference." 23 USPQ2d at 1062. We do not see any similar incongruous use of the term Paris in this case. Applicant admits that the mark means Arley B. of Paris. Applicant submits that purchasers will believe that the character Arley B. comes from Paris, but they would not believe that the goods associated with the mark come from Paris. As in Wada, applicant has included the name of a city that is an international fashion center in its mark. It is hard to accept applicant's unsupported statement that the public would not believe that clothing sold under a mark that includes the phrase "de Paris" comes from Paris.

A mark is primarily geographically deceptively misdescriptive if "the public would likely believe the mark identifies the place from which the goods originate and that the goods do not come from there." In re Loew's Theaters, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985). We note that there is no evidence in the file to indicate how the goods will be marketed. However, even if we are to

assume that the public would associate Arley B. with Paris, it is not clear why the public would not also believe that clothing associated with the character from Paris comes from Paris. We note that applicant is seeking registration of its mark in a typed style without any animal figure associated with it. Its identification of goods includes a wide range of adults' and children's clothing. Therefore, as presented in this appeal, the public is likely to believe that when the mark "Arley B. de Paris" is used on adults' and children's clothes, the goods come from Paris and the mark is primarily geographically deceptively misdescriptive.⁴

We note that this is an intent to use application and applicant has not yet used the mark; however, a refusal under Section 2(e)(3) is still appropriate. See In re Compagnie Generale Maritime, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993) (French corporation, which had not used

⁴ With its reply brief, applicant presented four registrations that include the phrase "de Paris" or "of Paris." The Examining Attorney has objected to the introduction of these registrations because they were not timely submitted. Therefore, they are not properly of record. TMEP 1106.07(a). We note that even if some of the registrations supported applicant's argument, the "PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We also do not have the files in these cases and thus do not know what may have led to the allowance of these marks. A cursory review of these registrations indicates that most were issued prior to the changes to the Trademark Act required by NAFTA.

the mark, refused registration under section 2(e)(2) and alternatively under section 2(e)(3)). Because applicant is a New Jersey corporation, it is reasonable to assume that the goods would not come from Paris when applicant has not indicated that the goods would originate from Paris.⁵

While the term "Paris" is geographically misdescriptive, applicant has submitted a disclaimer of the term Paris. Prior to the passage of the North American Free Trade Act (NAFTA) (P.L. 103-182, 107 Stat. 2057), a disclaimer of the geographically misdescriptive term would have overcome the geographically misdescriptive refusal.

Prior to the implementation of the NAFTA amendments to the Lanham Act, marks that were primarily geographically deceptively misdescriptive could be registered if they had acquired secondary meaning. Additionally, even if the mark had not acquired secondary meaning, the mark could be registered with a disclaimer of the primarily geographically deceptively misdescriptive terms. . . . However, with the incorporation of the NAFTA amendments into the Lanham Act in 1993, primarily geographically deceptively misdescriptive marks were precluded from registration under all circumstances, even with a showing of secondary meaning.

Wada, 52 USPQ2d at 1541.

The U.S. Patent and Trademark Office adopted a policy that eliminated the ability to register primarily geographically deceptively misdescriptive marks that have

⁵ If the goods come from Paris, the Examining Attorney required, and the applicant provided, a disclaimer.

secondary meaning or with a disclaimer. TMEP 1210.06. The Federal Circuit found that:

Primarily geographically deceptively misdescriptive marks, like deceptive marks, mislead the public even with a disclaimer. This similarity between primarily geographically deceptively misdescriptive marks and deceptive marks justifies similar treatment with respect to disclaimers. . . . It would be anomalous to prohibit registration of a primarily geographically deceptively misdescriptive mark, but allow registration of the same geographically deceptively misdescriptive mark with a mere disclaimer of the geographic element.

Wada, 52 USPQ2d at 1542.

Likewise in this case, applicant has included the name of a city famous for fashion in its mark. The mark as a whole would lead the public to believe that the goods come from Paris. Therefore, it would be anomalous to permit the registration of applicant's mark with a disclaimer of the term Paris.

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