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OF THE TTAB

Hearing:
June 27, 2002

Paper No. 13
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *New York Transit, Inc.*

Serial No. 75/923,790

Richard E. Backus for New York Transit, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before *Cissel*, Hanak and *Quinn*, Administrative Trademark
Judges.

Opinion by *Cissel*, Administrative Trademark Judge:

On February 18, 2000, applicant filed the above-identified application seeking registration of the mark "N Y TRANSIT" on the Principal Register for "earrings and other jewelry," in Class 14; "purses and handbags," in Class 18; and "gloves, belts, and hosiery," in Class 25. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods. Applicant claimed ownership of three other registrations

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and one other application for registration. Among these was Registration No. 1,350,643.

In his first Office Action, the Examining Attorney refused registration on the grounds that the mark is deceptive (although Section 2(a) of the Lanham Act was not cited), and also on the ground that the mark is primarily geographically deceptively misdescriptive within the meaning of Section 2(e)(3) of the Lanham Act, 15 U.S.C. Section 1052(e)(3).

Applicant responded to the refusal to register with argument that the refusal based on geographic deceptive misdescriptiveness asserted by the Examining Attorney is not appropriate in the instant case. The refusal based on deceptiveness alone was not mentioned.

With respect to the refusal under Section 2(e)(3) of the Act, applicant argued that the combination of "N Y" and "TRANSIT" does not have a primary significance which is geographic because the combination of these two terms would call to mind the well known subway system in the city of New York, and that prospective purchasers of applicant's products would certainly not believe that the New York transit system is in the business of selling earrings and jewelry, purses, handbags, gloves, belts or hosiery, which are the goods listed in the instant application. As such,

applicant argued that in connection with these products, applicant's mark would have an incongruous meaning.

Attached to applicant's response in support of this contention was an entry from Webster's New World College Dictionary, Third Edition, wherein the term "transit" is defined as "a system of urban public transportation (cf. RAPID TRANSIT)."

In his second Office Action, the Examining Attorney made final the refusal to register on both grounds asserted in the first Office Action, i.e., deceptiveness under Section 2(a) of the Act, and geographic deceptive misdescriptiveness under Section 2(e)(3) of the Act. Along with the final refusal, the Examining Attorney submitted excerpts from several trade publications which establish that New York is a center of activity in the fashion industry.

Applicant timely filed a Notice of Appeal, followed by a timely filed appeal brief. Submitted along with the brief were a copy of the previously submitted dictionary definition of the word "transit" and page retrieved from the web site of the New York City rapid transit system, which uses "New York City Transit" as the name of the system.

The Examining Attorney then filed his brief on appeal. In it, he withdrew the refusal to register based on deceptiveness under Section 2(a) of the Act, but presented arguments in support of the refusal to register under Section 2(e)(3) on the ground that the mark sought to be registered is primarily geographically deceptively misdescriptive in connection with the goods specified in this application.

Also in his appeal brief, he objected to the Board's consideration of the New York City Transit web site page applicant submitted with its brief. Citing Trademark Rule 2.142(d), he pointed out that submission of this evidence for the first time with applicant's appeal brief is prohibited. In its reply brief, applicant argued that the Examining Attorney had waived to his right to object to the submission of this evidence because, when applicant had previously argued that the significance of the mark is as a reference to the New York City transit system, the Examining Attorney had not disputed this claim.

We sustain the objection of the Examining Attorney to the untimely submission of this evidence. Trademark Rule 2.142(d) provides that the record should be complete prior to the filing of the Notice of Appeal, and specifies the procedure by which either applicant or the Examining

Attorney may request the Board to allow submission of evidence after that time. Applicant did not follow this procedure and the Board did not grant applicant permission to submit this evidence with its brief, so that evidence has not been considered.

We note additionally that with its reply brief, applicant submitted a copy of one of the registrations of which applicant had claimed ownership in the application which is the subject of this appeal, as it was originally filed. Under these circumstances, we have considered Registration No. 1,350,643, which is a registration on the Principal Register of the mark here sought to be registered. The goods listed therein originally included handbags, which are also listed in the instant application, but reference to these products was stricken from the registration, leaving the following goods: "shoes and men's and women's woven knit clothing, namely, pants, shorts, belts, jumpsuits, tops, parkas, jackets, socks."

Although we have considered this registration, it has very little probative value and does not compel a result different from the one we would have reached without it. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether

applicant's mark here sought to be registered is barred by the statutory provision cited by the Examining Attorney. As is often stated, each case must be decided on its own merits. See, e.g., *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001). Neither the current Examining Attorney nor the Board is bound by the prior action of the Examining Attorney who examined applicant's earlier-filed application which resulted in the registration of record. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

We thus turn to consideration of the merits of the appeal before us. The test for determining whether a mark must be refused registration under Section 2(e)(3) of the Act because it is primarily geographically misdescriptive is well settled and is not disputed by either applicant or the Examining Attorney in the case at hand. A mark is unregistrable under this section of the Act if: (1) its primary significance is that of a generally known geographic place; (2) it is used in connection with goods or services which prospective purchasers are likely to associate with the place named in the mark; and (3) the goods or services do not originate from the place named in the mark. *In re Wada*, 194 Fed.3d 1297, 52 USPQ2d 1539

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(Fed. Cir. 1999), and *In re Loew's Theaters, Inc.*, 769 Fed.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

In the case at hand, the refusal to register is not well taken because this mark fails to satisfy the first element of the test under Section 2(e)(3) of the Act. The significance of the mark, when considered in its entirety, is not primarily that of a geographic place. Simply put, we agree with applicant that the addition of the word "TRANSIT" to the letters "N Y," which indisputably stand for "New York," results in a composite term that would be understood as a reference to the transit system in that city, rather than to the city itself. The evidence made of record by the Examining Attorney establishes that New York is a well-known geographic place, and that prospective purchasers of the goods listed in the application would be likely to make an association between New York and the fashion accessories listed in the application. Further, it is not disputed that the goods with which applicant intends to use this mark will not emanate from New York. The mark is nonetheless registrable because this record does not establish that the primary significance of the mark as a whole is the place named in the mark, rather than the transit system that operates there.

In the Wada case, cited above, "NEW YORK WAYS GALLERY" was held unregistrable for various types of bags, backpacks, purses and so forth, and the case of *In re Handler Fenton Westerns*, 214 USPQ 848 (TTAB 1982), "DENVER WESTERNS" was found to be unregistrable for western style shirts. Similarly, in the case of *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986), the Board held that the significance of "CAMBRIDGE DIGITAL," as applied to computer systems, was primarily that of the place named in the mark.

In each of these cases, the terminology combined with the place name related to the products in question, i.e., "WESTERN" characterizes western style shirts; "DIGITAL" has descriptive significance in connection with computers, etc.

The primary significance of the mark in the case at hand, however, is unrelated to the goods specified in the application. As applicant points out, the transit system in the city of New York would not be expected to be the source of jewelry, purses, handbags, gloves, belts or hosiery. Moreover, this record does not establish the existence of any connection whatsoever between the New York transit system and goods of this kind. Fashion items like the ones listed in the application are not designed by the transit authority of New York; they are not purchased for use in or by the transit system. The record does not show

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them to be especially popular on the system or even in use on the trains which are operated within the system. Contrary to the above-cited cases, in the case at hand, the word combined with the geographic descriptor has no connection with the involved goods, so its source-identifying significance is not subsumed by the place name with which it is combined.

In summary, the refusal to register in this case is not well taken because the record does not establish that the primary significance of the mark "N Y TRANSIT," when considered in its entirety and in connection these products, would be as a reference to city of New York.

DECISION: The refusal to register under Section 2(e)(3) is reversed.

Quinn, Administrative Trademark Judge, dissenting:

I would affirm the refusal to register under Section 2(e)(3) of the Trademark Act and, accordingly, I respectfully dissent.

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 purchasers are likely to believe

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mistakenly are connected with that location. Institut National Des Appellations D'Origine v. Vintners International Co., 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992).

In the present case, applicant concedes that the goods do not originate in the place identified in the mark. (brief, p. 4).

Further, applicant recognizes that "N Y" has the geographic meaning of "New York." (brief, p. 4). Indeed, the majority states that the letters "N Y" "indisputably stand for 'New York.'" (majority opinion, p. 7). There is nothing obscure, minor or remote about the geographic meaning of the letters "N Y." In fact, it is hard to imagine a geographic location in the world that is as well known as New York City.

In addition, the evidence of record bearing on a goods/place association establishes that New York City is well known as a place for the design, manufacture and sale of goods of the type listed in the application.

I differ from the majority in that I find that the mark, when viewed in its entirety, projects a primarily geographic significance, with the addition of the word "TRANSIT" to "N Y" not detracting from this primary geographic significance of the mark. Applicant simply has

not provided any facts as to why the primary geographic significance of the mark is lost by the addition of the word. As stated in prior cases, the determination of registrability under Section 2(e)(3) should not depend on whether the mark is unitary or composite. See, e.g.: In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889, 893 at n. 7 (CCPA 1982); and In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986).

I believe that affirmance of the refusal here squares with the reasoning and holding in the case of In re Wada, 194 F.2d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999), *aff'g* 48 USPQ2d 1689 (TTAB 1998) [NEW YORK WAYS GALLERY is primarily geographically deceptively misdescriptive of leather bags, luggage, back packs, wallets, tote bags, and the like not originating in New York]. See also: In re Save Venice New York Inc., 259 F.3d 1346, 59 USPQ2d 1778, 1783 (Fed. Cir. 2001) [mark consisting of the phrases THE VENICE COLLECTION and SAVE VENICE INC. and an image of the winged Lion of St. Mark is geographically misdescriptive when applied to a variety of goods, and consumers would not associate the mark with the fundraising activities of applicant rather than with the city of Venice]; and In re Perry Manufacturing Co., 12 USPQ2d 1751 (TTAB 1989) [PERRY NEW YORK and a silhouette of the New York City skyline for

women's clothing is deceptive]. In the present case, given the renown of New York City as a fashion center, I can only conclude that consumers would assume a connection with New York when encountering the mark N Y TRANSIT on applicant's jewelry, purses, handbags, gloves, belts and hosiery. 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. McCarthy, McCarthy on Trademarks and Unfair Competition, § 14:11 (4th ed. 2001).

Simply put, the primary geographic significance of the term New York, and the goods/place association between New York and items such as jewelry, handbags and belts are not lost when "N Y" is combined with "TRANSIT." There is no properly introduced evidence that "N Y Transit" is recognized and understood as the name of New York's public transportation system. That is, the record does not establish that to the purchasing public the primary connotation of the term "N Y Transit" is the public transportation system. I hasten to add that even if there were evidence showing that "N Y Transit" identifies the public transportation system in New York City, I would reach the same result here as in the cases of PERRY NEW YORK and NEW YORK WAYS GALLERY.

An applicant should not be able to register a geographically misdescriptive term by combining it with another term that does not change the primary geographic meaning. For example, PARIS METRO or LONDON TUBE (aside from any possible Section 2(a) false suggestion of a connection problem with the entities running the subways located in those cities) for goods of the type involved here would still have a primary geographic significance, and purchasers would be likely to believe that the goods are connected with Paris and London, respectively.

As to the issuance of applicant's earlier registration, I agree with the majority that this fact is of no consequence in deciding this appeal. Further, the goods in the present application are more expansive, with the only overlapping items being "belts" and "hosiery" ("socks"). See: In re Save Venice New York Inc., supra at 1783 ["A registered mark on goods other than those previously registered carries no presumption of distinctiveness"]; and In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) ["Nothing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration."].

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I am not persuaded, based on this record, that purchasers, when confronting applicant's mark, would not think that applicant's jewelry, handbags and belts come from New York City.