

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: July 19, 2007

Mailed: January 14, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Harajuku Lovers, LLC LTD

Serial No. 78544289

Jill M. Pietrini of Manatt, Phelps & Phillips for Harajuku Lovers, LLC LTD.

Renee McCray, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Walters, Bucher and Zervas, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark HARAJUKU LOVERS, in standard character form, for "jewelry; piggy banks made of precious metals; tie clips; watches; clocks; charms; watch fobs; ornamental lapel pins; sun dials; watch cases; watch bands; and watch

straps," in International Class 14.¹ Applicant is a business entity connected to the performer Gwen Stefani.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark in the absence of a disclaimer of HARAJUKU apart from the mark as a whole on the ground that it is primarily geographically descriptive. See Trademark Act Sections 2(e)(2) and 6(a), 15 U.S.C. §§1052(e)(2) and 6(a). The appeal is fully briefed. After careful consideration of the evidence and arguments of record, we reverse the refusal to register.²

In this case, the examining attorney initially also refused registration under Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), on the ground that the mark is

¹ Serial No. 78544289, filed January 7, 2005. The application was filed on the basis of intent-to-use under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Applicant requested in its responses and in its brief that, if it did not prevail in this appeal, it be allowed the opportunity to provide evidence of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. §1052(f). While the issue is moot, we advise applicant that it does not need to request permission to amend its application to assert a Section 2(f) claim. See TMEP §1212.02(a). Rather, applicant may do so at any time prior to appeal or in a timely request for reconsideration. Further, applicant will not be permitted to do so after an appeal decision is issued.

Applicant also noted that the examining attorney ignored its repeated requests to not communicate with applicant via email. Applicant has not contended that it did not receive any of the email communications. Therefore, while we agree that examining attorneys should follow such instructions, it is not an issue in this appeal.

primarily geographically deceptively misdescriptive.

Applicant submitted a response (February 21, 2006) arguing against both grounds for refusal and stating (p.6) that its identified goods do not originate, i.e., "they are not manufactured, produced or sold", in the Harajuku district of Tokyo or in Japan. In the final office action, the examining attorney withdrew, without explanation, the refusal under Section 2(e)(3) of the Act.

Also in the final office action, the examining attorney acknowledged applicant's statement that its goods do not originate in the Harajuku district of Tokyo or in Japan. However, the examining attorney, in her brief (unnumbered p. 5), makes the following statement:

Moreover, the fact that applicant's goods may not actually originate in HARAJUKU does not automatically mean that the term is no longer primarily geographically descriptive. [*In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652, 1655 (Fed. Cir. 1993)]. Rather, "it is the perception of the public as to the geographical significance of the mark which controls whether the registration should be refused pursuant to Section 2(e)(2), not whether an applicant renders the service or manufactures some of the goods outside of the geographical area named in the mark." *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988).

The examining attorney has submitted a substantial amount of evidence excerpted from articles retrieved from the LEXIS/NEXIS database and from internet websites in

support of her position that HARAJUKU is primarily geographically descriptive. The examining attorney contends that HARAJUKU is an actual geographic location known to American consumers as an avant-garde fashion district and the site of fashion boutiques which sell clothing, jewelry and accessories; and that, because of this reputation, and the fact that applicant actively fosters an association between its use of the term HARAJUKU and the HARAJUKU district in Tokyo, the requisite goods/place association is established.

Applicant contends that HARAJUKU is not *primarily* geographically descriptive, arguing that, while it is a precise geographic location, it is a location of which the "typical" American consumer would not be aware. Applicant takes issue with a number of the excerpted travel websites and fashion articles in the record, arguing that these websites and articles are not probative of the significance of the term HARAJUKU to the relevant American consumer. Applicant also argues that, despite the geographic connotation of HARAJUKU, its *primary* significance to American consumers is in association with Gwen Stefani's music and fashion.

A mark or portion of a mark is primarily geographically descriptive in connection with an

applicant's goods if the examining attorney establishes (i) that the primary significance of the mark or portion thereof is that of the name of a place generally known to the public and (ii) that the public would make a goods/place association, that is, believe that the goods which the mark or portion thereof is sought to be registered originate in that place. See, e.g., *In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, 1821 (TTAB 2006); *In re JT Tobacconists*, 59 USPQ2d 1080, 1081-82 (TTAB 2001); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988), citing *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987). Provided that these conditions are met, and the goods come from the place named by or in the mark or portion thereof, it is primarily geographically descriptive. See *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, (TTAB 1982).

The record contains strong evidence suggesting that HARAJUKU may be a known geographic location that is neither remote nor obscure and that there may be a goods/place association between HARAJUKU and applicant's identified goods. Moreover, applicant's arguments in opposition

appear to be not well taken. However, we do not even reach these questions, and we make no findings in this regard, because applicant has stated clearly that its goods are not manufactured, produced or sold in the HARAJUKU district of Tokyo or in Japan, its corporate headquarters are in the United States, and it has no apparent business in the HARAJUKU district of Tokyo. Implicit in the requirement for a goods/place association in connection with a Section 2(e)(2) refusal on the ground that a mark is primarily geographically descriptive is the requirement that the goods and/or applicant "originate" in the place named. Based on the facts herein, we cannot conclude that applicant and/or its goods come from or "originate" in HARAJUKU.

The cases relied upon by the examining attorney in support of her contention that a goods/place association exists, apparently regardless of where the goods and/or applicant originate, are inapposite. In *Compagnie Generale Maritime, supra*, the Federal Circuit affirmed the Board's conclusion that FRENCH LINE and design for myriad goods and services was primarily geographically descriptive if the goods and services actually come from France or primarily geographically misdescriptive if the goods and services do not come from France. Not only was this case decided when

these two grounds for refusal were both contained in Section 2(e)(2) of the Act, but the Board, as affirmed by the Court, specifically found the mark primarily geographically descriptive only if the goods and services came from France and noted, specifically, that the refusal would be that the mark is primarily geographically deceptively misdescriptive if the goods and services did not come from France.

The Board, in *California Pizza Kitchen, supra*, found that CALIFORNIA was primarily geographically descriptive under the prior Section 2(e)(2) provision where applicant's corporate business was in California and the identified restaurant services were rendered in many states, including California, i.e., the fact that the services were rendered in many states other than California did not negate a services/place association. The factual situation is entirely different from that involved in this case.

In conclusion, because neither applicant nor its identified goods come from or otherwise originate in the HARAJUKU district of Tokyo, the examining attorney has not established that HARAJUKU is primarily geographically descriptive in connection with the identified goods. Thus, the requirement of a disclaimer of HARAJUKU apart from the mark as a whole is not proper.

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Decision: The refusal to register is reversed.