THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

September 17,2002
Paper No.12
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re Ruffin Gaming, LLC

_____

Serial No. 75/899,518

_____

Richard J. Musgrave of Husch & Eppenberger, LLC. for Ruffin Gaming, LLC.

Florentina Blandu, Trademark Examining Attorney, Law Office 112 (Janis O'Lear, Managing Attorney).

_____

Before Hohein, Walters and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Ruffin Gaming, LLC has filed an application to register the term "COIT TOWER" for "entertainment [services], namely, live performances by a musical band, amusement arcades, casino services, theatrical performances, vaudevilles and comedy performances" in International Class 41 and "hotel services,

restaurant services, nightclub services, café services and providing convention facilities" in International Class 42.[1]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the term "COIT TOWER" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the

[1] Ser. No. 75/899,518, filed on January 20, 2000, based upon an allegation of a bona fide intention to use such term in commerce. The

abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant, while acknowledging that a purpose behind the statutory prohibition against registration of terms which, when used in connection with particular goods or services, are merely descriptive thereof "is to prevent others from monopolizing descriptive terms in relation to the [goods or] services," argues that "[t]here would be no breach of policy by allowing the Appellant to register COIT TOWER for a casino complex ... operating games of chance, restaurants, ... hotel services, entertainment services and the like." In particular, applicant contends that:

> No one will be put at a competitive disadvantage in the casino industry by being unable to use COIT TOWER to describe their casino complex .... The Appellant will not be inhibiting competition ... if it receives registration of the COIT TOWER mark. It

---

word "TOWER" is disclaimed.

> would be an anomaly for people in the industry to use COIT TOWER to describe the aforementioned services. The reason and public policy behind the non-registrability of [merely] descriptive marks would not be breached by allowing the Appellant registration of its mark in this case.

Furthermore, as to the Examining Attorney's specific contention that the term "COIT TOWER" is merely descriptive of applicant's services because such services are likely to depict or feature the well known, if not famous, Coit Tower landmark in San Francisco, applicant asserts that the Examining Attorney "committed error by reviewing Appellant's service mark in relation to the theme rather than to the services."[2] According to applicant:

---

[2] Applicant, in its brief, additionally refers to a list of third-party registrations which it submitted with its request for reconsideration. Applicant maintains that the list demonstrates that "the United States Patent and Trademark Office [('PTO')] has allowed registrations to exist on the Principal Register for, *inter alia*, PARK AVENUE," as well as such other terms as "BOURBON STREET," "SOUTH BEACH," "SAHARA" and "RIVIERA." In particular, applicant insists that "the Principal Register contains numerous registrations containing locations, places or things as part of the marks used in relation to, *inter alia*, casino services." While recognizing that "each mark must be evaluated on its own merits," applicant urges that "it is entitled to consistency in ... practice and procedure" from the PTO and that "its mark is just as entitled to receive trademark protection as any of these other marks." Although the Examining Attorney has not addressed any of applicant's contentions in this regard, it is pointed out that, inasmuch as the Board does not take judicial notice of third-party registrations, the submission at this stage of a mere list thereof "is insufficient to make them of record." In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). The proper procedure, instead, for making information concerning third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the PTO's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 n. 3 (TTAB 1995); In re

> The services for which the Appellant has applied to register the mark relate to a casino complex ... operating games of chance, restaurants, ... hotel services, entertainment services and the like. The services rendered ... in no way relate to the "Coit Tower" in San Francisco. The San Francisco Coit Tower is a piece of public art built in 1933 replacing a tower used relative to shipping which was located on the same site. This tower has no relationship whatsoever with the services for which the mark COIT TOWER is sought to be registered by Appellant. Appellant's services relate to hotel, gaming, entertainment and restaurant services and in no way constitute public art. The Coit Tower does not in fact designate services but rather a thing; Appellant's services in no way depict the Coit Tower. As indicated above, the use of the terms COIT TOWER for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is merely to evoke the theme of Appellant's facility. Although ... COIT TOWER is not a "coined" or fanciful mark, Appellant is still entitled

---

Smith & Mehaffey, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); and In re Melville Corp., 18 USPQ2d 1386, 1388 n. 2 (TTAB 1991). In any event, even if such information were to be considered, given the indication by applicant that the terms listed, in each instance, form only "part of" rather than the actual marks which are the subjects of the third-party registrations, and inasmuch as there is no way of knowing on this record whether the registrations issued with or without either a disclaimer of the particular term under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), or pursuant to a claim of acquired distinctiveness in accordance with Section 2(f) of such Act, 15 U.S.C. §1052(f), the information furnished by applicant is essentially of no probative value. Furthermore, as applicant has correctly acknowledged, each case must be determined on its own merits. See, e.g., In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court"]; In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1514 (TTAB 2001); and In re Pennzoil Products Co., 20 USQP2d 1753, 1758 (TTAB 1991).

> to registration for its service mark used in conjunction with the services listed above.
>
> The San Francisco Coit Tower is not a service and does not relate to the services in question, nor are such services in any way described by the term "Coit Tower." .... "Coit Tower" is no more inherently related to the services in question than the mark XYZ would be. Coit Tower is not [merely] descriptive of a casino complex offering gambling, ... restaurants, ... hotel services, entertainment services and the like.

Finally, applicant urges that the term "COIT TOWER" is an arbitrary mark when used in connection with its services.[3] Applicant reiterates, in view thereof, that it "will not be inhibiting competition for the aforementioned services by receiving registration of the COIT TOWER mark." Applicant argues, by analogy, that "just because an APPLE® computer has an apple icon thereon or an apple theme does not make the APPLE® mark descriptive of computers" and, thus, "[t]he owner of the APPLE® mark is not inhibiting competition in the sale of computers."

[3] At first blush, it would appear contradictory for applicant to argue that, while the term "COIT TOWER" is an "arbitrary" mark which "in no way relate[s]" to its services, such term, as noted previously, "is not a 'coined' or fanciful mark." It is assumed, however, that by the latter applicant acknowledges that the name "Coit Tower" is an actual location or area of San Francisco, instead of a contrived or fictitious place, but that the use of such name in connection with its services, admittedly so as "to evoke the theme of Appellant's facility," somehow is nonetheless "arbitrary."

The Examining Attorney, on the other hand, contends that the term "COIT TOWER" merely "describes a feature and significant characteristic of the applicant's services" because, when "consumers encounter the proposed mark ... in connection with the applicant's services, they will immediately know that the theme of the premises is that of San Francisco's famous landmark, the COIT TOWER." Applicant, the Examining Attorney points out, "has stated that the proposed mark will be used in connection with a section of its casino and that the use of the term COIT TOWER is merely to evoke the theme of the applicant's facility."

In particular, we note that in reply to three inquires which, pursuant to Trademark Rule 2.61(b), were raised by the Examining Attorney in her initial Office Action, applicant responded as follows:

> a. What is the theme of the places where the services are rendered?
>
> The services will be rendered in the context of a hotel and casino facility located in Las Vegas, Nevada. The theme of such facility will be the City of San Francisco. This is similar to hotel-casinos in Las Vegas using the themes of the City of New York (New York, New York), the City of Paris (Paris) and similar city themes. Accordingly, various areas within the casino may be designated with the names of well known San Francisco landmarks.
>
> b. Are the services in any way depicting the "COIT TOWER" in San Francisco?

> The services rendered herein in no way relate to the "Coit Tower" in San Francisco. .... Applicant's services in no way depict the COIT TOWER. As indicated above, the use of the term COIT TOWER for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is merely to evoke the theme of Applicant's facility.
>
> c. What is the meaning of the mark when used in connection with the services?
>
> The mark COIT TOWER has no specific meaning in relation to the services .... Rather, its intent, as is discussed above, is merely to evoke the theme of the facility planned by Applicant.

Significantly, applicant also admitted in such response that "the mark will be used for such items as an area of a gaming facility, restaurant, bank of hotel rooms or entertainment venue where the various entertainment services are presented." In addition, with respect to "the services of a hotel casino and its related gaming areas, restaurants, entertainment and hotel rooms," applicant conceded in its initial response that "in Las Vegas, Nevada ... there are significantly large numbers of other facilities with the facility itself and parts thereof named for or evoking other geographical items ...."

The Examining Attorney, in support of her position, has made of record a number of excerpts from her search of the "NEXIS" electronic database showing that "Coit Tower" is a well known, if not famous, landmark in San Francisco. She also has

made of record printouts from three website articles which indicate that applicant, as well as two other developers, intend to build San Francisco-themed hotel casino entertainment complexes which will include replicating various landmarks unique to or often associated with San Francisco, such as Coit Tower, Lombard Street, Fisherman's Wharf, Alcatraz, the Golden Gate Bridge and cable cars. One such article, which appears at http://www.casinomagazine.com and is entitled "FREE SPEECH I Lost My Shirt in San Francisco," reports in relevant part that:

> Developers have plans to build three more San Franciscos, and where else but in Las Vegas, a city where anything worth doing is worth overdoing, including another city.
>
> Naturally, Las Vegas' multiple San Francisco disorder has led to arguments and rumblings of lawsuits about which developer thought of copying San Francisco first.
>
> In 1997, Las Vegas developer Mark Advent, who conceived of the New York-New York hotel-casino, announced his intention to build a $500 million "San Francisco-themed" casino on the strip.
>
> By 1999, Advent's budget had grown to $1 billion and the plan called for a replica of the Bay with little boats sailing to an Alcatraz replica in the middle, a miniature Golden Gate Bridge and seven specialty casinos reflecting themes of seven San Francisco neighborhoods.
>
> ....
>
> Last October San Francisco developer Luke Brugnara said he'd like to build a miniature City by the Bay by the desert, too. ....
>
> This week Kansas-based real estate man Phil Ruffin announced plans to build yet another way for rubes to leave their shirts in San Francisco. He wants to build a $700

million resort-casino called The City by the Bay featuring miniature versions of many of San Francisco's most famous tourist spots, including Napa Valley.

....

Let a hundred San Franciscos bloom in the desert, alongside other Las Vegas-class versions of world-class cities like New York, Paris and Venice. ....

But imitators shouldn't get huffy and claim to be the innovators who came up with the idea of a copy - unless their last name is Xerox.

Advent and Ruffin are acting like they invented the concept of a miniature San Francisco ....

"We have our own design," Ruffin was quoted as saying. "We didn't copy their stuff."

....

If there must be three different San Franciscos in Las Vegas, let them be three really different San Franciscos, like we have here. ....

Who wants to go to Vegas and see three fake Coit Towers, three fake North Beaches and three fake Chinatowns. ....

One San Francisco casino could represent the standard tourist San Francisco, with little bridges, cable cars and a tackier version of Fisherman's Wharf.

Another could represent the hip, high-tech San Francisco, with laptop slot machines in coffeehouses, restaurants with fusion buffets and blackjack dealers in black clothing and retro shoes.

Yet another could be the risqué San Francisco, with a miniature O'Farrell Theater, a small and safe Tenderloin and a cloned Castro.

This is the age of niche marketing, so why don't these hotshot developers think of things like this?

No, it's always the same old Alcatraz and Golden Gate Bridge. And then they say they came up with the idea.

> Lately Las Vegas has become one-stop shopping for world travel, a city of city imitations. ....

Another article, retrieved from 26/http://home.att.net, sets forth a history of the Frontier hotel (also known as the New Frontier) in Las Vegas and states, with respect to applicant's president, Phil Ruffin, and his plans for such hotel and its site, that:

> In October, 1997, Wichita businessman Phil Ruffin purchased the Frontier for $167 million ....
>
> ....
>
> On January 5, 2000, it was announced that the second lady of the Strip was to close her doors forever. Ruffin announced that he is going to implode the Frontier and build a replica of San Francisco, California - a casino named City By The Bay which would've been completed in September, 2002, containing 2,500 rooms at a cost of $700 million. .... Plans for the new resort include replicas of Chinatown, the Coit Tower and Lombard Street. There will be a walk-through Chinese pagoda, on to the Golden Gate Bridge which will then go to Fisherman's Wharf with boats in the water. There will also be the Alcatraz Restaurant and a Napa Valley winery.
>
> ....
>
> Mark Advent of Advent Communications and Entertainment who created the concept for New York-New York took legal action against Ruffin. Advent stated that he has been working with Ruffin for the past two years to create a San Francisco-themed megaresort, and copyrighted detailed plans, designs, concepts and other proprietary information with Ruffin .... Ruffin dismissed Advent's complaint stating "city themes are in the public domain."

The third article, also retrieved from the website 26/http://home.att.net, details plans by applicant's president concerning the "City By The Bay" project:

> Phil Ruffin is planning to build the City by the Bay Casino and Resort on the 25.5 acres where The New Frontier now sits.
>
> The City By The Bay will feature the renowned Fisherman's Wharf where visitors will be able to step out of the desert and into the legendary Bay area in which a carnivalesque mood will set the scene. A myriad of indoor and open-air seafood eateries will be available to satisfy every level of appetite .... Visitors will enjoy the atmosphere, and the aromas, of this ... fun-filled scenic setting for dining and shopping complete with curio shops and street performers. This spectacular attraction will include a pod of sea lions, Monterrey [sic] boats and a wave making machine to supply the sounds of the bay.
>
> Although Fisherman's Wharf will be the main attraction at The City By The Bay, it doesn't stop there. The project will pay tribute to many of the public domain icons of San Francisco including:
>
> *Chinatown* - .... Visitors will be able to delve into a world of exotic shops and markets, authentic restaurants and, at times, an indigenous festival.
>
> *Lombard Street* - A replica of "the crookedest street in the world[,]" you will be able to stroll your way up to the Coit Tower while enjoying the profusely landscaped grounds.
>
> *Coit Tower* - This fluted concrete shaft will rise approximately 300 feet from street level at the top of Lombard Street. ....
>
> *Alcatraz* - The infamous "Rock" will be the setting for a unique dining experience. .... Patrons may find themselves dining in "Cell Block A" on tin plates.
>
> *Napa Valley* - A fully operational winery featuring a selection of California's

> finest wines. Napa Valley will also offer gourmet dining and fine wines for tasting and purchase.
>
> The hotel will offer 2,512 guest rooms .... Convention and meeting space will cover 100,000 square feet of meeting and pre-function rooms. The casino area will encompass 100,000 square feet .... The Golden Gate Bridge will serve as a stately backdrop as it transports you from the strip throughout the property.
>
> The bay area known for it [sic] delectable dining and nightlife will be transformed to The City By the Bay with 10 specialty restaurants in addition to the 4 to 5 seafood options featured at Fisherman's Wharf. The tone of sweet seduction and romantic melodies will come alive with the musical style of Otis Redding and Al Green in the properties [sic] lounges and nightclub. The property will also house a 1,200 seat showroom featuring its own in-house production. Ruffin is looking at several propositions but has not committed to a specific production at this time. He is looking for the "perfect" high energy, musical and art form that will portray the infamous nightlife the bay area is known for.
>
> The project includes a ... retail area plus the specialty shops located in the Fisherman's Wharf and Chinatown. In addition, a short stroll over the Oakland Bridge and guests will find themselves in The Fashion Show Mall which houses approximately 145 outlets and focuses on high-end retail.

The Examining Attorney, based upon the evidence of record and the Board's decision in In re Busch Entertainment Corp., 60 USPQ2d 1130, 1133-34 (TTAB 2000), in which the term "EGYPT" was held merely descriptive of a significant feature, namely, "the Egyptian theme or motif," of the amusement park

services involved therein, accordingly reasons that, as previously noted, the term "COIT TOWER" is merely descriptive of applicant's services because:

> In *In re Busch* the Board agreed ... that [the record established that] it is customary for ... amusement parks ... to feature diverse names of places and then have those premises feature the [named place as the] pertinent theme. The Board noted that[,] therefore, the marks in question would serve as nothing more than information with respect to one of the salient features of the [services rendered under each] mark, namely, the theme.
>
> Similarly, in the present case, the mark in question does nothing more than to inform ... consumers about one of the features of the services, namely, that the theme in question is that of the famous San Francisco landmark, namely, the COIT TOWER. Therefore, the mark is clearly merely descriptive of one of the features of the [services rendered under the] mark and the refusal ... is warranted and should be upheld by the Board.

The Board, on the basis of a substantially identical record, recently held in a companion case involving applicant's attempt to register the term "FISHERMAN"S WHARF" for the same services as those herein, that such term was merely descriptive of the theme of applicant's services. Among other things, the Board in its decision in In re Ruffin Gaming, LLC, ___ USPQ2d ___ (TTAB 2002), indicated that (footnotes omitted):[4]

[4] As in the above-cited case, we judicially notice that The Random House Dictionary of the English Language (2d ed. 1987) at 1966 defines

> As a general proposition, we note that a term which otherwise would be considered an arbitrary, fanciful or suggestive mark, when used in connection with goods or services to identify and distinguish the source thereof, does not lose such characterization or status, and become merely descriptive of the goods or services, simply because the term could literally designate a theme of the goods or services, e.g., the trade dress of a product or the décor of an entertainment facility, when so used. That is, just because such a term could thematically describe a trade dress or décor, that does not make the term merely descriptive if the trade dress or décor is arbitrary, fanciful or suggestive, but if the trade dress or décor is descriptive, then a term which describes such thematic manner of use is merely descriptive. See, e.g., Stork Restaurant, Inc. v. Sahati, 166 F.2d 348, 76 USPQ 374, 379 (9th Cir. 1948) ["THE STORK CLUB" for café and nightclub services "might well be described as 'odd', 'fanciful', 'strange', and 'truly arbitrary'" but "[i]t is in no way descriptive of the appellant's night club, for in its primary significance it would denote a club for storks," "[n]or is it likely that the sophisticates who are its most publicized customers are particularly interested in the stork"]; Taj Mahal Enterprises Ltd. v. Trump, 745 F. Supp. 240, 16 USPQ2d 1577, 1582 (D.N.J. 1990) ["TAJ MAHAL is clearly suggestive in the food service, casino and guest accommodations markets because it takes some imagination to link those services with the name of a

---

"theme" in pertinent part as "**2.** A unifying or dominant idea, motif, etc., as in a work of art." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

palatial crypt located in India"]; Trump v. Caesars World, Inc., 645 F. Supp. 1015, 230 USPQ 594, 599 and 595 (D.N.J. 1986), *aff'd in op. not for pub.*, 2 USPQ2d 1806 (3d Cir. 1987) ["CAESARS PALACE" and "PALACE" are "fanciful, nongeneric names when used in conjunction with casino hotels" which are "informed by a so-called 'Greco-Roman' theme"]; Caesars World, Inc. v. Caesar's Palace, Inc., 179 USPQ 14, 16 (D. Neb. 1973) ["CAESARS PALACE" is "arbitrary, unique and nondescriptive" when used in connection with hotel and convention center services]; and Real Property Management, Inc. v. Marina Bay Hotel, 221 USPQ 1187, 1190 (TTAB 1984) ["It seems obvious that 'MARINA,' whatever descriptive significance it may have in relation to other services or goods, would not per se operate to describe hotel and restaurant facilities, even those located on bodies of water"].

Each of the foregoing cases, of course, was determined on its own facts and, in particular, the significance which each of the subject marks had to the relevant public encountering the terms at issue in connection with the respective services. This appeal, however, is most analogous to the *Busch* case cited by the Examining Attorney and from which, for present purposes, the proposition may be extracted that, where the record reveals that it is the intent of an applicant and a practice or trend in the trade or industry to replicate or otherwise simulate the ambiance or experience of a place (in whole or meaningful part), then a term which names the place, when used as a theme of the goods or services, is generally considered to be merely descriptive of a significant feature or characteristic of the goods or services. See In re Busch Entertainment Corp., supra [in view of evidence demonstrating a trend in theme park industry of recreating the culture or history of foreign lands and showing that "EGYPT" is the name of the

> ninth land in the applicant's African-themed amusement park, "EGYPT" found merely descriptive of amusement park services inasmuch as term indicates subject matter or country being imitated, at least in part, and would be so recognized by consumers; as such, term identifies only an Egyptian theme or motif rather than the source or origin of the services].

(Slip op. at 12-15.)

Applying the above test, we find that, although presently still an intent-to-use application, applicant has admitted, and the evidence clearly supports, the fact that applicant's services are intended to be rendered in the context of a San Francisco-themed resort and that such facility will include a distinct area designated as "COIT TOWER," which will be built and decorated to evoke the ambiance or experience of the Coit Tower landmark in such city. Moreover, while Coit Tower is obviously not a country like Egypt, the record plainly demonstrates that it is a well known--if not famous--place, with readily identifiable features or characteristics, within San Francisco and, as a popular tourist attraction, plainly is not a place devoid of commercial activity. Furthermore, the record establishes that it is a practice or trend among hotel casino entertainment facilities to replicate or otherwise simulate the ambiance or experience of various geographical places, such as the cities of New York, Paris and Venice.

We therefore agree with the Examining Attorney that, as in ***Ruffin Gaming***, supra, the record in this case sufficiently establishes that customers for applicant's entertainment services, consisting of live performances by a musical band, amusement arcades, casino services, theatrical performances, vaudevilles and comedy performances, and its various hotel services, restaurant services, nightclub services, café services and the providing of convention facilities would immediately understand, without speculation or conjecture, that the term "COIT TOWER" merely describes a significant characteristic or feature thereof, namely, the theme or décor used in the rendering of the services. Collectively, as applicant has admitted, such services are all part of applicant's planned hotel casino entertainment complex which, as two of the website articles plainly evidence, will replicate as a substantial portion of its San Francisco-themed facility the ambiance or experience of the Coit Tower locality of that city. Coit Tower, as the "NEXIS" excerpts show, is a well known--if not famous--San Francisco landmark which, like such others as Fisherman's Wharf, Lombard Street, cable cars and the Golden Gate Bridge, serves as a readily, if not instantly, recognizable icon for the city itself. Consequently, while we appreciate applicant's contention that its services "in no way relate to the 'Coit Tower' in San Francisco" because such services "in no way

constitute public art," we find significant applicant's admission that the use of the term "COIT TOWER" in connection with its services "is merely to evoke the theme of the facility planned by Applicant." Just as the term "EGYPT" is evocative of the theme or motif of the Egyptian section of the African-themed amusement park services in *Busch*, so too will the term "COIT TOWER" be evocative of a San Francisco landmark which serves as a theme or motif for the services applicant intends to render.

Moreover, as similarly was the case in *Busch* with respect to third-party uses for amusement park services of the names of other foreign lands, the record herein not only contains evidence that applicant intends to imitate the Coit Tower landmark in connection with the services to be offered at its San Francisco-themed hotel casino entertainment facility, but that city imitations are commonplace in the field for services of the kinds applicant plans to provide. Applicant admits, as indicated earlier, that its services will be rendered in the context of a hotel casino entertainment complex to be located in Las Vegas, Nevada, with the theme of such facility being the City of San Francisco" and that, "[a]ccordingly, various areas within the casino may be designated with the names of well known San Francisco landmarks."

In particular, applicant concedes with respect to the term "COIT TOWER" that "the mark will be used for such items as

an area of a gaming facility, restaurant, bank of hotel rooms or entertainment venue where the various entertainment services are presented." Applicant further admits, as noted previously, that "[t]his is similar to hotel-casinos in Las Vegas using the themes of the City of New York (New York, New York), the City of Paris (Paris) and similar city themes." In fact, it is such a common business practice to name hotel casinos and parts thereof after various geographical terms which relate to the theme of "the services of a hotel casino and its related gaming areas, restaurants, entertainment and hotel rooms" that, as applicant concedes, "in Las Vegas, Nevada ... there are significantly large numbers of other facilities with the facility itself and parts thereof named for or evoking other geographical items ...." Clearly, on this record, there is no doubt that the theme or décor utilized in rendering services of the kinds typically provided by a hotel casino entertainment complex, such as those applicant intends to offer under the term "COIT TOWER," is a significant characteristic or feature thereof in that it accounts in large measure for the appeal of the facility's services to the consuming public.

Accordingly, far from its being, as applicant asserts, "an anomaly for people in the industry to use COIT TOWER to describe the aforementioned services," we concur with the Examining Attorney that, as argued in her brief, "[c]ompetitors

may very well want to use the COIT TOWER theme in connection with their services and they will be disadvantaged if the applicant is given exclusive right of ownership in the mark in question." Indeed, the record shows that two other competitors of applicant have contemplated building hotel casino entertainment facilities which will feature a San Francisco theme. If they or any other competitor should choose to include, as part of such a facility, a replica of Coit Tower, they plainly should be entitled to refer to or otherwise describe that section by the term "COIT TOWER," since that term--being the proper noun or name by which that renowned geographical location and landmark of San Francisco is known--is obviously the most evocative or immediately informative designation therefor. As the Examining Attorney, for instance, further notes in her brief, use of "the term COIT TOWER for casinos decorated to look like San Francisco's COIT TOWER landmark, clearly does just that." See In re Gyulay, supra at 1010 ["APPLE PIE" merely describes scent of potpourri which simulates aroma of apple pie].

Thus, just as the designation "EGYPT" merely describes the theme or motif of the services offered in the section of an African-themed amusement park devoted in significant part to ancient Egyptian civilization, customers and prospective consumers for applicant's various San Francisco-themed services

similarly would understand and expect, upon encountering the term "COIT TOWER" used in connection therewith, that such term merely describes the décor or theme, in the sense of the ambiance or experience of the city area or landmark being simulated, rather than the source or origin of the services. Applicant concedes, in fact, that "the use of the term COIT TOWER for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is merely to evoke the theme of Applicant's facility." Plainly, when viewed in the context of the services which applicant's hotel casino entertainment facility will provide, there is nothing about the term "COIT TOWER" which is ambiguous, incongruous or susceptible, perhaps, to any plausible meaning other than immediately conveying information as to the theme of such services. Nothing requires the exercise of imagination, cogitation or mental processing or the gathering of further information in order for customers and potential consumers of applicant's services to readily perceive that, as is a common business practice in the industry, the term "COIT TOWER" names the particular theme of such services.

It is well established that, with respect to issues of descriptiveness, the placement or categorization of a term along the continuum of distinctiveness that ranges from arbitrary or fanciful to suggestive to merely descriptive to generic is a question of fact. See, e.g., In re Merrill Lynch, Pierce,

Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). It is clear on this record that, unlike applicant's example of the mark "APPLE" for computers which bear an apple icon (as opposed to those in the shape of an apple), the term "COIT TOWER" can scarcely be considered arbitrary or fanciful, or even just suggestive, when used in connection with the services which applicant's hotel casino entertainment complex will render to consumers in a facility designed to replicate or imitate the renowned Coit Tower landmark of San Francisco.[5] Rather, as applicant's president reportedly stated, "city themes are in the public domain," and the purchasing public, which continues to watch the proliferation of such themes for hotel casino entertainment complexes, would readily and unequivocally

[5] We are mindful, in so noting, that care is obviously required in extending the spectrum of categories of words as marks into the realm of shapes and images which words can describe or suggest. As Professor McCarthy has cautioned (*emphasis added*):

> A few courts have tried to apply to trade dress the traditional spectrum of marks categories which were created for word marks .... That is, these courts have tried to apply such categories as "arbitrary," "suggestive," and "descriptive" to shapes and images. Only in some cases does such a classification make sense. For example, a tomato juice container in the shape of a tomato might be classified as "descriptive" of the goods. While a commonly used, standard sized can used as a tomato juice container is not "descriptive" of the goods, it is hardly inherently distinctive. *The word spectrum of marks simply does not translate into the world of shapes and images.*

1 J. McCarthy, McCarthy on Trademarks & Unfair Competition §8:13 (4th ed. 2002).

perceive the term "COIT TOWER" as designating the theme or motif of applicant's services instead of their source or origin.

Accordingly, because the term "COIT TOWER" conveys forthwith significant information concerning a feature or characteristic of applicant's entertainment services, namely, live performances by a musical band, amusement arcades, casino services, theatrical performances, vaudevilles and comedy performances and its various hotel services, restaurant services, nightclub services, café services and providing of convention facilities, it is merely descriptive thereof within the meaning of the statute. See In re Ruffin Gaming, LLC, supra, and In re Busch Entertainment Corp., supra at 1134.

Decision: The refusal under Section 2(e)(1) is affirmed.