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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Ruffin Gaming, LLC

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Serial No. 75/900,788

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

Allison Holtz, Trademark Examining Attorney, Law Office 112 (Janis O'Lear, Managing Attorney).

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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 "LOMBARD STREET" 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 "LOMBARD STREET" 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. 75/900,788, filed on January 20, 2000, based upon an allegation of a bona fide intention to use such term in commerce.

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 LOMBARD STREET 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 LOMBARD STREET to describe their casino complex .... The Appellant will not be inhibiting competition ... if it receives registration of the LOMBARD STREET mark. It would be an anomaly for people in

> the industry to use LOMBARD STREET 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 "LOMBARD STREET" is merely descriptive of applicant's services because such services are likely to depict or feature the well known, if not famous, Lombard Street 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:

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[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." The Examining Attorney, citing in re Scholastic Testing Service, Inc., 196 USPQ 517, 519 (TTAB 1977) and TMEP §1209.03(a), properly notes in her brief that "[t]hird-party registrations are not conclusive on the question of descriptiveness" and that "[a] mark which is merely descriptive is not registrable merely because other similar marks appear on the register." In addition, it is pointed out that because 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

> 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 "Lombard Street" in San Francisco. The San Francisco Lombard Street is a public way with a unique physical geography. This public street has no relationship whatsoever with the services for which the mark LOMBARD STREET is sought to be registered by the Appellant. Lombard Street in San Francisco is, to the best of the knowledge of Appellant, zoned for residential uses, and uses of this type would not be permitted there. Appellant's services relate to hotel, gaming, entertainment and restaurant services and do not constitute a public way. Lombard Street does not in fact designate services but rather a thing; Appellant's services in no way depict Lombard Street. As indicated above, the use of the term

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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 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).

> LOMBARD STREET for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is merely to evoke the ambiance of Appellant's facility. Although ... LOMBARD STREET is not a "coined" or fanciful mark, Appellant is still entitled to registration for its service mark used in conjunction with the services listed above. The term Lombard Street is no more inherently related to the services in question than the mark XYZ. LOMBARD STREET is not [merely] descriptive of a casino complex ... operating games of chance, restaurants, ... hotel services, entertainment services and the like.

Finally, applicant urges that the term "LOMBARD STREET" 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 LOMBARD STREET 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 "LOMBARD STREET" 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 "Lombard Street" 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 ambiance of Appellant's facility," somehow is nonetheless "arbitrary."

The Examining Attorney, on the other hand, contends that "the applicant's proposed mark LOMBARD STREET is merely descriptive of the identified services because it immediately conveys to the average prospective consumer of the services a characteristic or feature of the services." Specifically, the Examining Attorney argues that "the supporting evidence shows that the theme of the services is famous San Francisco landmarks, including Lombard Street," and maintains that "the theme of the services IS a feature of the services." As to applicant's argument that the term "LOMBARD STREET" is arbitrary when used in connection with its services, the Examining Attorney asserts that such contention is "unpersuasive in light of the fact that the theme of the applicant's casino complex, famous San Francisco landmarks, specifically includes Lombard Street." In particular, with respect to applicant's analogy to the mark "APPLE" for computers, she urges that "if computers looked like apples, the mark would not be arbitrary and this examining attorney would have refused registration." In essence, the Examining Attorney maintains that the refusal on the ground of mere descriptiveness is proper because:

> The applicant's services are rendered in a facility specifically designed to look like Lombard Street in San Francisco. The appearance of the facility is a feature or characteristic of the services. Therefore, "LOMBARD STREET is [merely] descriptive of a feature or characteristic of the services.

Among other things, we observe that the record shows that applicant, in response to the initial Office Action, admitted that "[t]he use of the term LOMBARD STREET for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is ... merely to evoke the theme of Applicant's facility." In particular, we note that in reply to the following three inquires which, pursuant to Trademark Rule 2.61(b), were raised in the 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 "Lombard Street" in San Francisco?
>
> The services rendered herein in no way relate to the "Lombard Street" in San Francisco. .... Applicant's services in no way depict Lombard Street. The use of the term LOMBARD STREET for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is clearly arbitrary and is used 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 LOMBARD STREET 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 "[i]t is a common custom to name casino hotels and parts thereof after various geographical terms which relate to the theme of the given hotel casino complex." As examples thereof, applicant noted that, besides the previously mentioned properties named after the cities of New York and Paris, "there are in existence in Las Vegas, Nevada casino hotel facilities using [the] geographic descriptions of: ... Santa Fe; Rio (a reference to Rio de Janeiro); Barbary Coast (an area in San Francisco); Sahara (a reference to the Sahara Desert)[;] and others."

While applicant thus concedes that "it is a common business practice in the hotel casino industry to name the facilities after geographic places upon which the theme [thereof] is based," applicant nonetheless insists that "using the mark LOMBARD STREET in [such] a facility or a portion thereof" is not merely descriptive of its services. The Examining Attorney, as indicated above, is of the opposite view and, in support of her position, notes that the record contains

a number of excerpts, the most pertinent of which are reproduced below, from a search of the "NEXIS" electronic database showing that "Lombard Street" is a well known, if not famous, landmark in San Francisco:

> "San Francisco, city by the bay, claims its Lombard Street is 'the Crookedest Street in the World.'
>
> The 1000 block of Lombard Street in San Francisco, paved with brick and garnished with blooming hydrangeas, has become as emblematic of the city as cable cars and the Golden Gate Bridge. Citizens across the world recognized the serpentine street from postcards, posters and movies ....
>
> ....
>
> * After seeing Lombard Street, you might want to examine other well-known San Francisco picture-postcard subjects." -- Fresno Bee , November 10, 1996; and

> "SAN FRANCISCO (AP) -- It took five months and 1.2 million for the city to straighten out the 'World's Crookedest Street.'
>
> That is, they fixed the aging pipes, missing bricks and other signs of wear and tear that had kept the famous one-block stretch of Lombard Street closed since May 30." -- Patriot Ledger (Quincy, MA), November 22, 1995.

The Examining Attorney further notes that the record contains printouts from several 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 Lombard Street, Coit

Tower, Fisherman's Wharf, Alcatraz, the Golden Gate Bridge and cable cars. One such article, which appears at http://www.-gamblingnewsletter.com and is entitled "San Francisco in Las Vegas?," reports in relevant part that:

> Businessman Phil Ruffin plans to build a $700 million, 2,500-room hotel-casino on the Las Vegas Strip with a San Francisco theme on the 25-acre site of the New Frontier Hotel which he purchased in 1998. Ruffin plans to implode the New Frontier hotel and begin construction on The City by the Bay resort by late 2000.
>
> The new resort will re-create San Francisco's Chinatown, the Coit Tower and Lombard Street, and feature a Napa Valley winery and an Alcatraz restaurant. ....
>
> The City by the Bay resort is scheduled to open September 2002.

Another article, appearing in the Las Vegas Sun and retrieved from http://www.lasvegassun.com, is headlined "New Frontier to be imploded this summer" and states, with respect to applicant's president, Phil Ruffin, and his plans for such hotel and its site, that:

> Real estate developer Phil Ruffin said today he plans to implode his New Frontier hotel-casino on the Las Vegas Strip and replace it with a $700 million San Francisco-themed resort.
>
> Two years after spending $165 million to acquire the aging, 1,000-room hotel-casino, Ruffin has decided to raze the structure and replace it with a sparkling new property called "City by the Bay."
>
> The mew resort, scheduled to open in fall 2002, will include replicas of such noted San Francisco landmarks as Lombard

> Street, Coit Tower, Alcatraz Island, Fisherman's Wharf and several restaurants.
>
> The 2,512 rooms will include 400 suites .... A water-filled "San Francisco Bay" fronting the Strip will feature sea lions, boats and a wave-making machine.
>
> ....
>
> "We have to do this to compete," Ruffin said. "The Strip won't be the same 10 years from now as it is today. Half of it will have to change to continue to draw new visitors."

Essentially the same article, but headlined "San Francisco is the Newest Theme for a Las Vegas Resort," also appeared at http://-www.frankscoblete.com.

A fourth article, published by the Las Vegas Review-Journal and retrieved from the website http://www.lvrj.com, details plans by applicant's president concerning the "City By The Bay" project and also discusses competitors' plans for San Francisco-themed hotel-casinos. The article, entitled "GAMING CHIPS: There's a story behind the hype of New Year's on the Strip," states in pertinent part that:

> WHO IS CYRUS MILANIAN? Few in Las Vegas had heard of Cyrus Milanian until last week, when he called to say he was the "mystery man" in the drama surrounding Phil Ruffin's plans to build the City by the Bay.
>
> Before we get to his story, let's set the scene. Ruffin announces plans for a San Francisco-themed resort to replace the New Frontier. Mark Advent of Las Vegas, whose company created the concept for New York-New York, says he created the idea for a San Francisco-themed hotel-casino and had worked for two years with Ruffin to create such a

> resort. Ruffin didn't cut Advent in, and Advent says he's going to sure.
>
> Another player: Luke Brugnara, the San Francisco real estate investor who bought the Silver City Casino and adjacent shopping mall at Las Vegas Boulevard and Convention Center Drive.
>
> He plans to build his very own San Francisco-themed resort, no matter what Ruffin does. At least New York-New York is two New Yorks in name only. Could we stand two San Franciscos? And who would want to?
>
> Now, in a tale with as many curves as Lombard Street, along comes Milanian, who says he owns the trademark for, in his words, "San Francisco Hotel Resort Casino and Theme Park in Las Vegas Nevada." Quite a mouthful.
>
> The Pompano Beach, Fla., resident says he was expecting to do a joint venture in any project with a San Francisco theme and had spoken to Ruffin. The discussions were confidential, he adds, but "I'm not accepting his offer."
>
> Unlike Advent, however, Milanian says he has no plans to sue.
>
> "I would like to meet with everyone involved and see if we could work something out to everyone's satisfaction," he said.
>
> If that fails, Milanian says he would like to sit down at a poker table, "or play any game they choose," and winner take all, in the sense of owning the rights to the theme.

We note as the starting point for our analysis of the issue herein that, curiously, neither applicant's brief nor the Examining Attorney's brief contains any mention of the Board's decision in the analogous case of 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. However, in light of such precedent, we further observe that the Board, on the basis of a record substantially similar to the one presently before us, 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.[4] Specifically, the Board in its decision in In re Ruffin Gaming, LLC, ___ USPQ2d ___ (TTAB 2002), indicated among other things that (footnotes omitted):[5]

> 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

[4] Likewise, in another companion case involving applicant, the Board subsequently affirmed a final refusal, on the ground of mere descriptiveness, to register the term "COIT TOWER" for the same services as those which are the subject of this appeal.

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

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 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 "LOMBARD STREET," which will be built and decorated to evoke the ambiance or experience of the portion of Lombard Street, with its crooked or hairpin turns, which constitutes a landmark of such city. Moreover, while Lombard Street 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, such as sightseeing. 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 and Paris, through the use of various landmarks associated therewith.

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

"LOMBARD STREET" 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 three of the website articles plainly evidence, will replicate as a substantial portion of its San Francisco-themed facility the ambiance or experience of the Lombard Street locality of that city. Lombard Street, as the "NEXIS" excerpts show, is a well known--if not famous--San Francisco landmark which, like such others as Fisherman's Wharf, Coit Tower, 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 'Lombard Street' in San Francisco" because such services "do not constitute a public way," we find significant applicant's admissions that the use of the term "LOMBARD STREET" in connection with its services "is merely to evoke the ambiance of Appellant's facility" and "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 "LOMBARD STREET" 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 Lombard Street 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 and casino facility [to be] located in Las Vegas, Nevada"; that "[t]he theme of such facility will be 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." Applicant also significantly concedes that, as previously noted, "[i]t is a common custom to name casino hotels and parts thereof after various geographical terms which relate to the theme of the given hotel casino complex," listing among the examples thereof, in Las Vegas alone, the "geographic descriptions" of: New York, New York; Paris; Santa Fe; and Rio. 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 "LOMBARD STREET," 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 LOMBARD STREET to describe the aforementioned services," it is plain that competitors of applicant may desire to use the "LOMBARD STREET" theme in connection with their San Francisco-themed services and will be disadvantaged in their ability to compete in the marketplace for hotel casino entertainment facilities if applicant is recognized as owning the exclusive right to the term "LOMBARD STREET." 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 Lombard Street, they plainly should be entitled to refer to or otherwise describe that section by the term "LOMBARD STREET," 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 points out in

her brief, inasmuch as a characteristic or feature of applicant's services is that they will be "rendered in a facility specifically designed to look like Lombard Street in San Francisco," the term "LOMBARD STREET" is merely descriptive of such services. 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 "LOMBARD STREET" 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 LOMBARD STREET for a section of a casino, entertainment venue, restaurant or bank of hotel rooms is merely to evoke the ambiance of Appellant'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 "LOMBARD STREET" 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 "LOMBARD STREET" 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 "LOMBARD STREET" 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 Lombard Street landmark of San

Francisco.[6] Instead, the purchasing public, which continues to watch the proliferation of city and other geographical themes for hotel casino entertainment complexes, would readily and unequivocally perceive the term "LOMBARD STREET" as designating the theme or motif of applicant's services instead of their source or origin.

Accordingly, because the term "LOMBARD STREET" 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

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[6] 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).

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.