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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 22, 00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Save Venice New York, Inc.

Serial No. 75/222,218

Bradley B. Geist of Baker & Botts LLP for Save Venice New
York, Inc.

Kimberly Krehely, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Quinn, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Save Venice New York, Inc. has applied to register the
following composite mark:



for goods in a multiplicity of classes, as follows:

"potpourri, sachets" in International Class 3;

"tableware, namely, spoons, forks, knives made of precious and nonprecious metal; carving knives" in International Class 8;

"electric lighting fixtures for residential use; lamps, lamp shades" in International Class 11;

"clocks, serving platters of precious metal, napkin rings of precious metal, candle holders of precious metal, ashtrays of precious metals" in International Class 14;

"art prints and reproductions; paper napkins, paper towels, coasters made of paper, place mats of plastic; place mats of paper; table cloths of paper, table napkins of paper" in International Class 16;

"residential furniture, namely, beds, chairs, stools, bookcases, cabinets, chests, desks, mirrors, sofas, tables; outdoor furniture" in International Class 20;

"bakeware; dinnerware, namely bowls, cups, plates, saucers, butter dishes; cookware, namely pots, frying pans, non-electric kettles; ice buckets, wine buckets, napkins holders, salt shakers, pepper mills, serving platters, salad bowls, soup tureens, serving trays, tea kettles, metal cooking pans" in International Class 21;

"bed sheets, pillow cases, towels, bed blankets, bed spreads, fabric bath mats, textile place mats, pot holders, table cloths not of paper, textile napkins; non-hand-woven upholstery fabrics" in International Class 24; and,

"rugs, carpets" in International Class 27.¹

The Trademark Examining Attorney has refused registration under Section 2(e)(3) of the Trademark Act on the ground that

¹ Application Serial No. 75/222,218, filed January 7, 1997, alleging a *bona fide* intention to use the mark in commerce.

the mark as a whole, if applied to the goods, would be primarily geographically deceptively misdescriptive of them.

Applicant has appealed the final refusal to register. The case was fully briefed, and an oral hearing was held before the Board. We affirm the refusal to register.

Section 2(e)(3) of the Trademark Act provides in relevant part as follows:

Sec. 2 (15 U.S.C. §1052):

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ...

(e) Consists of a mark which ...

(3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them...

In order to establish a *prima facie* case for refusal of registration under Section 2(e)(3), the Trademark Examining Attorney must show that the primary significance of applicant's composite mark is its geographical connotation, and that members of the public would believe that the goods for which the mark is sought to be registered originate in the geographic place named in the mark when, in fact, the goods do not originate in that geographic place. See *The Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992); *In re Societe Generale des Eaux Minerals de Vittel*

S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In re Loew's Theaters, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982). In the instant case, applicant acknowledges that the goods as currently listed in this application do not originate in Venice.

In support of her *prima facie* case, the Trademark Examining Attorney offered evidence to show (1) that the presence of the city name, "VENICE," twice in the mark establishes the overall geographic significance of the total mark; (2) that the Lion of St. Mark depicted prominently in the composite mark is a well-known civic symbol of Venice and the surrounding region; and (3) that the city of Venice is a well-known center for the manufacture of glass, lace,² art objects, jewelry, cotton and silk textiles, as well as the printing and publishing trades.³

However, applicant contends that the first time the word "VENICE" appears in the mark it modifies the word "Collection," and the second time it appears in the context of applicant's previously registered mark,⁴ and that the lion

² *The New Encyclopedia Britannica*, Macropaedia, Vol. 29, Fifteenth Edition, p. 501 (Chicago 1988).

³ *The Columbia Lippincott Gazetteer of the World*, p. 2014.

⁴ Reg. No. 1,639,071, issued on March 26, 1991, for "SAVE VENICE" ("Venice" disclaimed) in International Classes 16 and 36, claiming dates of first use in both classes of December 1970; §8 affidavit accepted and §15 affidavit received.

design is not geographically descriptive of Venice. Hence, applicant argues, the overall mark does not have a geographical significance. Furthermore, applicant argues there is no goods/place association inasmuch as its goods are quite different from traditional Venetian arts and crafts.

To establish the first prong of the test for whether this matter is primarily geographically deceptively misdescriptive when applied to applicant's goods, the Patent and Trademark Office must show that the mark has as its primary significance the connotation of a generally known geographic place.

Clearly, the words "The Venice Collection" are the most prominent portion of this mark. The size and placement of this term create for the consumer an immediate and unmistakable reference to the city of Venice, Italy. The balance of the wording on the lower portion of the mark repeats the reference to the city of Venice. However, it is in the context of the primary significance of the overall composite mark that applicant and the Trademark Examining Attorney have spent a great deal of time discussing the importance of the image of the winged lion at the center of this mark in reaching our determination on this first prong of the test.

Applicant argues that Venice is awash in lions, winged and unwinged, thereby diminishing the distinctiveness of any

one pose. Because a winged lion is the symbol of St. Mark, the Evangelist, applicant argues that rather than being a civic symbol, this is primarily a religious symbol. In this vein, applicant contends that there is no indication that modern day consumers from the United States would make a mental connection between this design and the city of Venice, Italy. On the other hand, the Trademark Examining Attorney contends that this particular pose of the winged lion is substantially the same as one sees displayed prominently throughout Venice, whether it be in the form of statuary, building reliefs, artistic drawings or Venetian area flags.

We are convinced by the Trademark Examining Attorney's evidence that this image of the Lion of St. Mark simply reinforces the geographical significance of the overall mark as primarily connoting Venice, Italy.⁵ This conclusion rests upon the continuing prominence of this symbolic lion throughout the art and culture of Venice. In reaching this conclusion, we do not find it necessary to plumb the religious history of the symbol of Mark the Evangelist or to require that consumers from the United States must know that St. Mark is the patron saint of Venice.

⁵ See In re Perry Manufacturing Co. 12 USPQ2d 1751 (TTAB 1989), where the design of the New York skyline reinforces the connotation of the words "New York."

As to the second critical prong, the Trademark Examining Attorney must establish that the public associates the goods with the place that the mark names. The factual question is whether the mark is used to identify products that purchasers are likely to believe mistakenly are connected in some way with that location. See Institut National Des Appellations D'Origine v. Vintners Int'l Co., *supra*. The mark must be judged on the basis of its role in the marketplace. In re Nantucket, Inc., *supra*. As the late Judge Nies said in her concurring opinion in Nantucket: "What meaning, if any, does the term convey to the public with respect to the goods on which the name is used?"

For this composite mark to be "primarily geographically deceptively misdescriptive," Venice itself would have to be associated with the products herein in such a way that the consuming public would be likely to assume that Venice was the place in which the goods originated.

In this regard, the record shows that Venice, Italy is a large metropolitan area, whose buildings, monuments, art treasures, canals and gondolas make this a popular tourist destination. Many consumers, upon seeing "The Venice Collection" within the context of this composite mark will make an association with the city of Venice - a place where

fine art objects, glassware and exquisite decorative items have been designed, crafted, and sold for centuries.

Based upon the current record, we certainly have no problem finding a goods/place association between Venice and items such as glass, lace, art objects and/or jewelry. To the extent applicant's identified goods overlap with these traditional Venetian products, a goods/place association has been shown. We would be hard pressed to find a clear line, for example, separating "art objects" from applicant's tableware and other decorative items made of precious metals; or to conclude that "cotton and silk textiles" could not include items composed of fabrics that are listed in several classes of applicant's goods.⁶

Beyond the items listed above (e.g., glass, lace, art objects and/or jewelry), there is no direct evidence in the file as to an association with applicant's specific goods. As a result, applicant argues that with its submission of the declarations of Beatrice H. Guthrie, it has been able to rebut the *prima facie* evidence of a goods/place association made by

⁶ The Trademark Examining Attorney does not argue that the goods marketed by companies under license from applicant are themselves items of antiquity, that they would be confused with original objects of Venetian art, or even that Venice is a prominent manufacturing center. Rather, she contends that the goods listed in the identification of goods are "ancillary products related to the traditional crafts and industries of Venice." (Trademark Examining Attorney's appeal brief, p. 9, and Attachment 1).

the Trademark Examining Attorney.⁷ However, we have several concerns about Ms. Guthrie's declarations. First, as the Trademark Examining Attorney points out, Ms. Guthrie is the Executive Director of Save Venice New York, Inc. Given this position with applicant, she has a definite self interest in supporting this position. A related concern has to do with how well she represents the relevant purchasing public for this range of consumer goods -- ordinary consumers from the United States of America. Given her expertise in these matters, she hardly falls within this group of the relevant purchasing public, and her personal knowledge has not been shown to be reflective of the understandings of the purchasing public in the United States.

Finally, because the Trademark Examining Attorney has not clearly demonstrated that certain industries are indeed centered in Venice, based upon this entire record, we cannot be sure that any of those goods as listed in applicant's identification of goods are actually of a type currently *produced* in the area surrounding Venice. However, in spite of the statements in the Guthrie declarations that the listed

⁷ For example, in her July 1, 1998 declaration, for each of the individual classes of goods listed in this application, Ms. Guthrie has declared in separately numbered paragraphs as follows: "Based on my knowledge of Venice and its economy as previously set forth, I am aware of no industry in Venice, for which Venice can be said to be known or associated, that involves the manufacture or sale of

items are not for "sale" in Venice, we question the credibility of this conclusion. Rather, Venetian retail stores and shops must undoubtedly offer for sale many of the consumer items listed in this trademark application. Given that the area is world-renowned for its art, it strains credulity to believe there are not numerous sites in the city of Venice that sell at least some of these items (e.g., "...that involve the ... sale of art prints and reproductions.").⁸ For these reasons, we find the Guthrie declarations to be of limited probative value.

In order to demonstrate a goods/place association, the Trademark Examining Attorney must show that the public is likely to believe mistakenly that the mark identifies a place connected with the goods. See In re Nantucket, Inc., *supra* at 892. The objects and furnishings sold under applicant's mark, by companies having licensing arrangements with applicant, reflect product types, decorative themes and material

[identified goods], or any other reason for a purchaser to expect said goods to originate from Venice." (emphasis in original).

⁸ As to the specific goods listed in the application, it is clear that other businesses have or are likely to have legitimate interests in using a geographic designation similar to that claimed by the applicant. In this regard, we find that for the goods set forth in the application, the city of Venice is analogous to the nation of France for items of clothing. See In re Compagnie Generale Maritime, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993) [viz. the "French Line" case, where "The Board [in a non-published decision] found that because France is 'a major manufacturing and commercial nation,' the applied-for goods and services would be associated with the country." (emphasis supplied)].

compositions many consumers would associate with the city of Venice.⁹ Accordingly, we agree with the Trademark Examining Attorney that this mark is not being applied to these artifacts in a fanciful or arbitrary manner. Rather, consumers will be inclined to make a mental association between applicant's goods and the city of Venice.

Finally, while applicant has disclaimed the word "VENICE" in prior registrations, composite marks can no longer be rendered registrable with a disclaimer of the geographically deceptively misdescriptive component(s). With the North American Free Trade Agreement (NAFTA) Implementation Act amendments to the Lanham Act in 1993, marks found to be primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act were precluded from registration. See 15 U.S.C. Section 1052(f)(1994).¹⁰ Since this statutory change, it has been the position of the U. S. Patent and Trademark Office that any mark that is primarily

⁹ "THE VENICE COLLECTION and design mark evokes the artistry and beauty one associates with the treasures for which Venice is world renown... [P]urchasers will recognize THE VENICE COLLECTION and design mark as primarily representative of the history, art, culture and beauty of Venice... Applicant's goods may incorporate various Venetian themes, motifs, architectural designs, etc..." Applicant's response of October 18, 1997, pp. 9 - 10.

¹⁰ Public Law 103-182, 107 Stat. 2057. A primarily geographically deceptively misdescriptive mark may not be registered on the Supplemental Register, nor may it be registered on the Principal Register under the provisions of Section 2(f), unless it became distinctive of the applicant's goods or services before December 8, 1993.

geographically deceptively misdescriptive (and not grandfathered under the statute) cannot be salvaged by a disclaimer of the geographically deceptively misdescriptive components. This policy is consistent with the 1993 amendments to the Lanham Act and has received the imprimatur of our principal reviewing court. In re Wada, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

Decision: The refusal to register is affirmed.

T. J. Quinn

G. D. Hohein

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal Board