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**YOU AREN'T GOING TO BELIEVE THIS!
DECEPTION, MISDESCRIPTION AND MATERIALITY
IN TRADEMARK LAW***

*By Anne Gilson LaLonde***

I. INTRODUCTION

I sat in my cramped office, my forehead planted on the desk. While this allowed me to stop staring obsessively at the blank computer screen, it accomplished little else.

My law school classmate Ezat Crispe had just made partner at his firm. Ezat had taken me out to lunch. Between sips of his three-olive martini, he had informed me that the key to his promotion had been publishing a groundbreaking article on contributory dilutive naked licensing of scent trademarks. So here I was, trying desperately to come up with a groundbreaking topic of my own.

Someone cleared her throat. I knew that sound. It could only be Molly York. I lifted my head off of the desk.

“Ben, you need to stop staring at your desk. You know it’s not billable.” She frowned, fingering one of her diamond earrings. “Got a new client I don’t have time for. Mason something. He’s an idea man. Wants to sell something weird.” She rolled her eyes. “Get me a memo by tomorrow morning.” She turned and walked briskly down the hall.

I reached for a pad of paper and a pen as Tammy knocked on my open door. “Mr. Plato Mason here to see you.”

Mr. Mason entered the room and we shook hands. He was a tall, large-bellied man in his fifties, wearing a wrinkled, chocolate brown suit. I gestured to a chair and he closed the door behind him and sat.

“So what can York, Sandalow and Griffin do for you today, Mr. Mason?”

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Mr. Mason glanced back at the closed door then leaned forward. “Well, young man, here’s my great idea. Energy drinks. Made with . . . wait for it . . . gunpowder. I’ll call them GUNPOWDER. Here’s the slogan: Explode with Extra Energy. I’m going to need a patent, a copyright, a trademark, a trade secret, whatever else you can think of so no one steals my inspired concept.”

“Okay, Mr. Mason. Let’s just slow down for a minute. I don’t think it would be a good idea to use the trademark GUNPOWDER when the drink is made with gunpowder because that’s considered descriptive. It just describes an ingredient of the drink. The Patent and Trademark Office won’t register it because anyone else who might use gunpowder as an ingredient needs to be able to use that word to describe their product.”

“That’s just silly,” said Mr. Mason. “Why can’t I tell people what’s in my drink?”

“You can, sir, but just not as the trademark. And—wait, is gunpowder actually safe for human consumption?”

Mr. Mason glared at me. “I put it in my coffee every morning. And I’m perfectly fine.”

“Uh huh. Well, I think we could run into some issues with the Food and Drug Administration on that front . . .”

“Fine, fine.” He tapped his fingers on the arm of his chair. “Hypothetically, what if I take out the gunpowder, put in extra caffeine, and still call it GUNPOWDER? Catchy name. Perfect for an energy drink.”

“Sorry, but it would probably be found to be deceptive or deceptively misdescriptive, and those types of marks are difficult to impossible to register.”

“You’re telling me I can’t call these drinks GUNPOWDER if I put gunpowder in them and I can’t call them GUNPOWDER if I don’t put gunpowder in them?” Mr. Mason crossed his arms and leaned far back in his chair. “You lawyers are so frustrating.”

“Well, Mr. Mason, I’m just explaining to you what the law is . . .”

“All right. Let’s try another idea. My wife suggested this one: NEW YORK CITY Energy Drinks—Be Like the City That Never Sleeps!”

I rubbed my face with my hands. “Are you going to make the drinks in New York?”

“No, right here in the great Midwest. I’m making them in my basement a few miles away.”

“Unfortunately, the NEW YORK CITY mark just might be rejected as primarily geographically deceptively misdescriptive.”

Mr. Mason stood up abruptly and shook his fist at me. “That’s not a real thing! You’re just mocking me now, and I don’t appreciate it!”

It was going to be a long meeting with Mr. Mason, but at least I had found a topic for my article.

Our young associate is not only correct to be suspicious of any beverage containing a potentially explosive substance. He is also right to warn Mr. Mason about the pitfalls of descriptiveness, deceptive misdescriptiveness, deceptiveness, and especially the agonizingly named primarily geographically deceptive misdescriptiveness.

This article will analyze deceptively misdescriptive terms and deceptive and primarily geographically deceptively misdescriptive marks as bars to registration in the United States, and will propose changes to the Lanham Act to bring some needed clarity. It will also discuss the application of Section 43(a) of the Act to trademarks that are deceptive.

II. THE PROBLEM

Trademarks tell us where products and services come from. We rely on them as guideposts for consistency, quality and social status. They can inspire fierce loyalty and enable us to quickly scan supermarket shelves for what we want.

But trademarks also have . . . a dark side. They can be full of trickery, misleading consumers about where products come from, what they’re made of, and who makes them. So, for example, consumers are likely to be deceived by the use of HENEGHAN CONTRACTING CORPORATION into believing it to be run by the same people as HENEGAN CONSTRUCTION COMPANY.¹ Or take another case, this one recently in the news. The individual who filed an application in the U.S. to register BLUE IVY CARTER NYC just days after the birth of Jay-Z and Beyonce’s distinctively named baby, Blue Ivy, could have deceived consumers into thinking there was a connection with the famous newborn—though, because the applicant lacked permission from the baby and her parents, he was unable to register the mark.²

Advertising, though potentially informative, certainly has its dark side as well. A hypothetical company advertising fitness equipment that uses an unauthorized picture of soccer star David

1. Henegan Construction Co. v. Heneghan Contracting Corp., 63 U.S.P.Q.2d 1984 (S.D.N.Y. 2004).

2. U.S. Ser. No. 85513502 (filed January 11, 2012) (abandoned January 24, 2012).

Beckham showing off his famous abdominal muscles may deceive consumers into believing Beckham endorses the goods. This practice would not be allowed under United States law.

Deceptive, indeed. But trademark law not only protects consumers from likely confusion as to source or sponsorship. It also protects them from deception that comes from trademarks themselves when they falsely suggest characteristics of goods or services. It is this more narrow type of deception that will concern us in this article.

U.S. federal trademark law prohibits the registration of deceptive trademarks. So far, so good. It also prohibits the registration of “deceptively misdescriptive” trademarks. A casual reader of the statute can be forgiven for assuming that terms that fall into that category are also deceptive. The phrase has the word “deceptive” in it, and generally words mean the same thing throughout a statute. But not in this case. “Deceptively misdescriptive” terms are unregistrable because they lack distinctiveness, not because they mislead consumers.

And then there’s the ban on registering “primarily geographically deceptively misdescriptive” trademarks. It’s an ugly phrase, to be sure. But “deceptively misdescriptive” in that phrase means the same as it does in the ban on registering “deceptively misdescriptive” terms, right? Sadly, no. “Primarily geographically deceptively misdescriptive” is on no less than its fourth meaning to the federal courts and the United States Patent and Trademark Office (USPTO) and is unrelated to “deceptive misdescriptiveness.”

The prohibitions on deceptive marks are themselves deceptive? The irony is delicious.

This article will examine each of these three statutory prohibitions in depth and examine how they work in practice and in theory. It will also look at how the false advertising section of the Lanham Act prohibits the use of deceptive trademarks, as well as the role the reasonable consumer should play in a determination of deceptiveness. Finally, the article will propose statutory solutions to illuminate this murky area.

III. BARS TO FEDERAL REGISTRATION

Trademarks that misdescribe goods and services can fall into a wide range of categories, depending on whether they are misleading or simply inapt. They may be arbitrary, suggestive, misdescriptive, deceptively misdescriptive, deceptive or primarily geographically deceptively misdescriptive. Arbitrary, suggestive and merely misdescriptive marks are immediately valid and registrable; deceptively misdescriptive terms are only valid and registrable with a showing of secondary meaning; and deceptive and primarily geographically deceptively misdescriptive marks are

never valid or registrable. So the category a misdescriptive trademark falls into is vital.

Section 2 of the Lanham Act provides in relevant part:

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

(a) consists of or comprises . . . **deceptive . . . matter . . .** [or]

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or **deceptively misdescriptive** of them . . . [or] (3) when used on or in connection with the goods of the applicant is **primarily geographically deceptively misdescriptive** of them.³

The highlighted language contains the three bases for refusal that are relevant to misdescriptiveness:

- (1) deceptive matter,
- (2) a term that is “deceptively misdescriptive” of the applicant’s goods and
- (3) a mark that is “primarily geographically deceptively misdescriptive” of the applicant’s goods.

This article will look at these three bars to registration, beginning with deceptive misdescriptiveness, the least “damning” of the three because those alone may be eligible for registration.⁴

Section 2(a) also prohibits registration of geographical indications that identify a place other than the origin of the goods, but only when those indications are used on or in connection with wines or spirits.⁵ This special wine-and-spirits provision, added in 1994 by the Uruguay Round Agreements Act, tracks the primarily geographically deceptively misdescriptive refusal and this article will not treat it separately.⁶

3. 15 U.S.C. § 1052(a), (e) (emphases added).

4. Ken Germain, *Trademark Registration Under Sections 2(a) and 2(e) of the Lanham Act: The Deception Decision*, 66 TMR 97, 98-99 (1976) (“While it . . . appears that a mark that violates either Section 2(a) or 2(e) cannot be registered, there is hope for Section 2(e) violators because Section 2(f) permits registration of certain marks, including deceptively misdescriptive marks, that have ‘become distinctive of the applicant’s goods in commerce.’ . . . For Section 2(a) violators, however, there is no salvation whatsoever: no amount of ‘distinctiveness’ will purge the defect. For this reason, it has aptly been said that Section 2(a) is ‘more damning’ than Section 2(e).”) (footnotes omitted), quoting *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313 (T.T.A.B. 1965), *aff’d*, 377 F.2d 1001 (C.C.P.A. 1967).

5. 15 U.S.C. § 1052(a).

6. See TMEP § 1210.08(a) (describing a prima facie case under this provision); *In re Bacardi & Co.*, 1997 TTAB LEXIS 169 (T.T.A.B. 1997) (finding HAVANA STYLE for rum primarily geographically deceptively misdescriptive and discussing the Uruguay Round

Another portion of Section 2 mentions deception. Section 2(d) bars registration of any mark that

so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, **or to deceive.**⁷

Here, deception means no more than confusion as to the source or sponsorship of the attached goods and does not refer to deception about the characteristics of those goods. The USPTO notes: “As a practical matter, this provision is rarely applied in examination, because deceptiveness involves intent and would be difficult to prove in an *ex parte* proceeding.”⁸ Before 1962, the statute barred registration of a mark that was so similar as “to deceive purchasers,”⁹ and a few cases had found confusingly similar marks also likely to deceive purchasers, calling them “deceptively similar.”¹⁰

A. Deceptively Misdescriptive Terms

1. What is a Deceptively Misdescriptive Term?

The USPTO uses a two-part test to determine whether a term is deceptively misdescriptive under Section 2(e)(1):

Agreements). The provision does not apply to geographic indications that were first used in commerce in connection with wines or spirits before January 1, 1996.

7. 15 U.S.C. § 1052(d) (emphasis added).

See, e.g., Grandpa Pidgeon’s of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 587-88 (C.C.P.A. 1973) (finding that “the overall commercial impression created by appellee’s mark is sufficiently similar to that created by appellant’s mark as to be likely to cause confusion, mistake or deception”); AMF, Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 1405 (C.C.P.A. 1973) (finding GOLDFISH for sailboats to “so resemble” SUNFISH for sailboats “as to be likely to cause confusion, mistake or to deceive”); Consolidated Cigar Corp. v. M. Landaw Ltd., 474 F.2d 1402, 1403 (C.C.P.A. 1973) (“To those who habitually call for DUTCH MASTERS, the appearance of LITTLE DUTCHMAN cigars at the vending source would more than likely connote and convey the impression that they derive from the same source, thus causing confusion, mistake or deception.”); Clairol, Inc. v. Roux Labs., Inc., 442 F.2d 980, 982 (C.C.P.A. 1971) (affirming TTAB finding that mark PLATINUM PUFF for hair dye was “likely to cause confusion, mistake or deception” with PLATINUMPLUS for same goods).

8. TMEP § 1207.02. Showing that a trademark deceives consumers about the goods or services themselves does not require a showing of intent to deceive. *See* § III[B][3][c] *infra*.

9. P.L. 87-772 § 2.

10. *E.g.,* Eureka Williams Corp. v. McCorquodale, 205 F.2d 155, 159 (C.C.P.A. 1953) (“[W]hether trade confusion will likely result from the concurrent trade usage of two or more marks alleged to be deceptively similar is largely a matter of individual judgment, and such factors as appearance, sound, and significance must be appropriately weighed.”); Order of Owls v. Owls Club of McKees Rocks, 99 F. Supp. 555, 563 (W.D. Pa. 1951) (“The name ‘Owls Club of McKees Rocks, Pennsylvania,’ is deceptively similar to the name ‘Order of Owls’ and will likely cause confusion to the public, and may deceive and induce persons to join the defendant corporation in the belief that it is the well known plaintiff association.”).

- First, does it misdescribe the goods or services?
- Second, are consumers likely to believe that the misdescription is true?¹¹

Put another way, a term is deceptively misdescriptive if it immediately conveys the “idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services . . . [and] the idea is false, although plausible.”¹² The misdescription does not need to be a material factor in the purchase of the goods,¹³ nor need it confuse consumers as to the source of the goods.¹⁴

The following terms or phrases have been found to be deceptively misdescriptive:

- FURNITURE MAKERS for retail furniture store services that do not include the manufacture of furniture¹⁵
- BLACK FLEECE for various clothing items not made of fleece¹⁶
- PORTERHOUSE STEAK TREATS for pet food and pet treats that do not contain porterhouse steak or porterhouse steak flavor¹⁷
- TITANIUM for recreational vehicles that do not contain titanium¹⁸
- CASSIA for pillows and fiber beds that do not contain the spice cassia (but the mark was *not* deceptively misdescriptive of comforters, blankets, and mattress pads)¹⁹

11. TMEP § 1209.04; *In re Quady Winery, Inc.*, 221 U.S.P.Q. 1213 (T.T.A.B. 1984). See Anne Gilson LaLonde, 1 Gilson on Trademarks § 3.04[6][b][iii].

12. *In re Retail Brand Alliance, Inc.*, 2011 TTAB LEXIS 306 (T.T.A.B. 2011) (nonprecedential). See also *Bayer Aktiengesellschaft v. Mouratidis*, 2010 TTAB LEXIS 218 (T.T.A.B. 2010) (“[F]or a term to misdescribe goods, the term must be merely descriptive of a significant aspect of the goods which the goods could plausibly possess but in fact do not.”); *Anheuser-Busch, Inc. v. Holt*, 92 U.S.P.Q.2d 1101 (T.T.A.B. 2009) (“In order for a mark to be found deceptively misdescriptive within the meaning of Section 2(e)(1) of the Trademark Act, . . . and thus unregistrable, it must immediately convey an idea about the goods or services, but that idea, though plausible, must be false.”); *In re Ox-Yoke Originals, Inc.*, 222 U.S.P.Q. 352 (T.T.A.B. 1983) (“The idea conveyed by the mark is false, although plausible. The term is therefore deceptively misdescriptive.”).

13. See TMEP § 1209.04 and § III[A][3][d] *infra*.

14. See *Astra Pharmaceutical Prods., Inc. v. Pharmaton, S.A.*, 345 F.2d 189 (C.C.P.A. 1965) (“While there is an element of confusion to be considered where a mark is alleged to be deceptively misdescriptive, that is not our concern here.”); *Glendale Int’l Corp. v. United States PTO*, 374 F. Supp. 2d 479, 485-86 (E.D. Va. 2005) (holding that “the misdescription need not . . . result in consumer confusion as to the source of the goods”).

15. *In re Berman Bros. Harlem Furniture, Inc.*, 26 U.S.P.Q.2d 1514 (T.T.A.B. 1993).

16. *In re Retail Brand Alliance, Inc.*, 2011 TTAB LEXIS 306 (T.T.A.B. 2011) (nonprecedential).

17. *In re Midwestern Pet Foods, Inc.*, 2009 TTAB LEXIS 206 (T.T.A.B. 2009) (nonprecedential).

18. *Glendale Int’l Corp. v. United States PTO*, 374 F. Supp. 2d 479 (E.D. Va. 2005).

- G.I. for “gun cleaning patches, gun cleaning rods, gun cleaning brushes, gun cleaning solvents and gun cleaning oils”²⁰ (G.I. as abbreviation for “government issue” and nickname for an American soldier in WWII)

The following marks have been found not deceptively misdescriptive:

- ONE BEER, BEER 1 and BEER 1 MMVII & design for beer²¹ because the marks do not convey to consumers the idea that applicant’s beer is ranked number one, thus they do not misdescribe applicant’s goods
- THE FIRST NAME IN FLOORCARE for electric vacuum cleaners²² because the mark could suggest general familiarity such as being on a “first name” basis rather than suggesting a position of preeminence in the industry that the mark owner did not hold
- AUTOMATIC RADIO for air conditioners, ignition systems and antennas²³ because the mark was not “likely to deceive anyone”
- ICE CREAM for chewing gum²⁴ because the mark was “so incongruous and ludicrous as to be arbitrary”
- UNBURN for “medical preparation for minor skin irritations, burns and injuries”²⁵ because the mark was “suggestive of a desired result rather than merely descriptive or deceptively misdescriptive of its goods”

2. Why Does it Matter if You Have a Deceptively Misdescriptive Term?

Though deceptively misdescriptive terms are barred from registration by Section 2(e)(1), there is some good news for users of such terms: This particular bar is qualified, not absolute. Deceptively misdescriptive terms are registrable if they have acquired distinctiveness, pursuant to Section 2(f).²⁶ As we shall see, these terms are equivalent to descriptive terms in their lack of

19. *In re Pacific Coast Feather Co.*, 2007 TTAB LEXIS 484 (T.T.A.B. 2007) (nonprecedential).

20. *In re Ox-Yoke Originals, Inc.*, 222 U.S.P.Q. 352 (T.T.A.B. 1983).

21. *Anheuser-Busch, Inc. v. Holt*, 92 U.S.P.Q.2d 1101 (T.T.A.B. 2009).

22. *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357 (Fed. Cir. 2001).

23. *In re Automatic Radio*, 404 F.2d 1391 (C.C.P.A. 1969).

24. *Borden, Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. 447 (T.T.A.B. 1972).

25. *Norwich Pharmacal Co. v. Chas. Pfizer & Co.*, 165 U.S.P.Q. 644 (T.T.A.B. 1970).

26. 15 U.S.C. § 1052(f).

inherent distinctiveness, which is the basis on which they must initially be refused registration.²⁷

Despite the qualified nature of the bar, however, the prohibition will still stop many applicants in their tracks. The burden of proving that a term has acquired distinctiveness may be substantial.²⁸ For purposes of federal registration, an applicant must show proof of “substantially exclusive and continuous use” for five years to present prima facie evidence that the term has acquired distinctiveness for applicant’s goods or services.²⁹ The USPTO’s Trademark Manual of Examining Procedure (TMEP) states that for terms that are deceptively misdescriptive, “whether the statement of five years’ use is sufficient in and of itself to establish acquired distinctiveness depends on the degree to which the mark is descriptive or misdescriptive. If the mark is highly descriptive or misdescriptive of the goods or services named in the application, the statement of five years’ use alone will be deemed insufficient to establish acquired distinctiveness.”³⁰

A registered trademark used for five years that has become incontestable due to the filing of an affidavit may not be cancelled on the ground that it is deceptively misdescriptive.³¹ Deceptively misdescriptive terms may also be registered on the supplemental register.³²

3. Analysis of the USPTO’s Test for Deceptive Misdescriptiveness

a. Misdescriptiveness

First, what does the mark convey to consumers about the goods, if anything? An applicant may convince the USPTO that the mark does not describe the goods at all, as when the Trademark Trial and Appeal Board (TTAB or Board) found that WOOLRICH for apparel “has the look of a surname” rather than the meaning of fabric that is “rich” in wool.³³ On the other hand, the USPTO may find that the mark gives the impression that the goods have

27. See § III[A][4] *infra*.

28. *E.g.*, Test Masters Educational Servs., Inc. v. Singh, 428 F.3d 559, 567 (5th Cir. 2005) (“The burden is substantial and requires a high degree of proof.”); Boston Beer Co. v. Slesar Bros. Brewing Co., 9 F.3d 175, 181-82 (1st Cir. 1993) (holding that proof of secondary meaning entails “vigorous evidentiary requirements”). See generally 1 Gilson on Trademarks § 2.09[3].

29. 15 U.S.C. § 1052(f).

30. TMEP § 1212.05(a).

31. 15 U.S.C. § 1064(3).

32. See 15 U.S.C. § 1091(a).

33. *In re Woolrich Woolen Mills Inc.*, 13 U.S.P.Q.2d 1235 (T.T.A.B. 1989) (noting “that a number of well-known people have had surnames beginning with ‘wool’ or ending with ‘rich,’ e.g., Frank Woolworth, Alexander Woollcott, and Samuel Goodrich”).

certain characteristics, like the mark BLACK FLEECE, which the Board found to evoke clothing made of black fleece.³⁴

Second, once it is determined what the mark conveys, is that description true? This question is generally not a contested factor. BLACK FLEECE brand clothing, for example, simply lacked fleece, black or otherwise.

Applicants do sometimes refuse to provide the examining attorney with information about the ingredients or characteristics of their product or whether the trademark has any significance in the relevant market. They likely do so in order to avoid a deceptive misdescriptiveness (or descriptiveness) refusal, but that tactic will not succeed. The failure to provide such information when requested can itself be the basis for a refusal to register.³⁵ As the Board has said: “Information as to the exact nature of applicant’s services and how it promotes its services is often very helpful in evaluating whether the mark describes a feature or characteristic of the identified services.”³⁶

In an example of this no-win situation, one applicant had tried to register SILVER BIRCH for various skin and body care preparations.³⁷ The applicant refused to tell the examining attorney whether or not its cosmetics, soaps and lotions in fact

34. *In re* Retail Brand Alliance, Inc., 2011 TTAB LEXIS 306 (T.T.A.B. 2011) (nonprecedential).

35. 37 C.F.R. § 2.61(b) (“The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.”); TMEP § 814 (“Sometimes, it is necessary for the examining attorney to request additional information from an applicant in order to examine the application properly, pursuant to 37 C.F.R. §2.61(b). If the applicant does not comply with a requirement for information, registration may be refused.”).

See also, e.g., In re Planalytics, Inc., 70 U.S.P.Q.2d 1453 (T.T.A.B. 2004) (applicant failed to respond sufficiently to examining attorney’s request to explain whether mark GASBUYER had significance in the trade or any relationship to applicant’s services; refusal to register the mark for failure to comply with requirement was proper); *In re* DTI Partnership LLP, 67 U.S.P.Q.2d 1699 (T.T.A.B. 2003) (holding that “failure to comply with a request for information is grounds for refusal of registration”); *In re* SPX Corp., 63 U.S.P.Q.2d 1592 (T.T.A.B. 2002) (“Trademark Rule 2.61(b) provides that the Examining Attorney may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.”) (affirming refusal “based on applicant’s failure to comply with the requirement for information concerning its goods”); *In re* Page, 51 U.S.P.Q.2d 1660 (T.T.A.B. 1999) (“The Trademark Rules of Practice have the effect of law and failure to comply with a request for information is grounds for refusal of registration.”).

36. *In re* Planalytics, Inc., 70 U.S.P.Q.2d 1453 (T.T.A.B. 2004). *See also In re* Page, 51 U.S.P.Q.2d 1660 (T.T.A.B. 1999) (“We agree with the Examining Attorney that applicant’s failure to respond completely to the Examining Attorney’s requests for information required the Examining Attorney to proceed with an incomplete understanding of how applicant’s asserted mark is or will be used, and without materials which would have allowed the Examining Attorney to conduct a more thorough and informed evaluation of the issue of mere descriptiveness.”).

37. *In re* Victoria Principal Prods., 2009 TTAB LEXIS 233 (T.T.A.B. 2009) (nonprecedential).

contained the extract from a silver birch tree. So the Board refused registration on two alternate grounds. If the goods *did* contain silver birch extract, the mark was merely descriptive under Section 2(e)(1) because it conveyed information about a significant feature, characteristic or ingredient of the goods. Silver birch extract, according to evidence from the examining attorney, is thought to have therapeutic value, and the Board found that “informed consumers paying the price for [applicant’s] skin care products will know about the[se] therapeutic claims” On the other hand, if the goods *did not* contain silver birch extract, the mark was deceptive under Section 2(a) because it misdescribed the composition of the goods. Prospective consumers would likely believe the misdescription actually describes the goods, and the misdescription would likely affect their purchasing decision.³⁸ Although this is a deceptiveness case, the upshot is the same: Applicants must provide information to the USPTO about their products so that the Office can determine if the mark describes or misdescribes the goods.

b. Plausibility

The most important question in a deceptive misdescriptiveness case is *plausibility*: whether consumers are likely to believe the misdescription is true.³⁹ A USPTO examining attorney can show plausibility by “demonstrating that consumers regularly encounter goods or services that contain the features or characteristics in the mark.”⁴⁰ For example, do consumers encounter clothing containing fleece so that they might assume that a trademark with the word “fleece” in it for clothing describes an attribute of the clothing?

The USPTO lacks the ability to survey consumers, so it must rely on indirect evidence that implies facts about consumer perception. This evidence may include the applicant’s advertising and product information, articles linking the features with the goods, or a showing that these goods with those features are in fact for sale. In a case rejecting registration, for example, a court found PHEROMONE for perfume that did not contain pheromones to be deceptively misdescriptive “particularly in light of the fact that

38. *Id.* (“Given the extraordinary cosmetic and medicinal benefits allegedly imparted by these ingredients, informed and intelligent prospective purchasers are the ones most likely to believe that the misdescription actually describes applicant’s goods. . . . With ever more scientific information about the range of benefits of these extracts, including as treatment for deadly melanomas and HIV/AIDS, the perceived benefits of ‘Silver Birch’ as an ingredient in the identified goods also promise to increase beyond its current elevated level. Accordingly, we find that such a misdescription is likely to affect the decision to purchase the goods.”).

39. *In re Quady Winery, Inc.*, 221 U.S.P.Q. 1213 (T.T.A.B. 1984).

40. TMEP § 1209.04.

fragrance products . . . do exist [that] purport to contain pheromones.”⁴¹

The goods at issue need not actually be for sale by others in a form that includes the misdescribed features so long as it would be *plausible* for a consumer to think that they could be for sale. This situation occurred in one case where the Board affirmed a refusal to register TITANIUM for recreation vehicles.⁴² The Board found substantial evidence in the record that consumers could believe that TITANIUM brand recreational vehicles in fact contained titanium, even without evidence that any on the market actually did. The examining attorney had collected over twenty-five articles mentioning “the use or potential use of titanium in the automotive industry”:

While the bulk of these articles appeared in industry and trade publications, eight, by plaintiff’s own count, appeared in broader-circulation, popular-audience periodicals. From these articles, the Examining Attorney sensibly reasoned that because consumers were regularly exposed to the idea of titanium in different types of vehicles, it would not be “a leap in logic” for consumers to assume that a towed or mounted vehicle like plaintiff’s might also be made with titanium, particularly when it is advertised—in boldface no less—as possessing one of titanium’s principal characteristics, namely light weight.⁴³

It is a stretch to find that the existence of eight articles in popular periodicals meant that “consumers were regularly exposed to the idea” of titanium in vehicles. Nevertheless, the Board’s ultimate conclusion that consumers could believe a large, expensive recreational vehicle contains some titanium is correct.

In another case with a correct result, the examining attorney had refused to register TEJO for a certain outdoor activity game on the basis of deceptive misdescriptiveness.⁴⁴ The examiner claimed that the term referred to a sport played in Colombia where a plate is thrown at a target containing gunpowder, and applicant’s U.S. goods did not contain any explosive material. The applicant succeeded in convincing the Board to overturn this refusal by showing that potential U.S. purchasers would not be familiar with the Colombian game, and even if they were, they would not expect applicant’s goods to contain explosive material

41. Marilyn Miglin Model Makeup, Inc. v. Jovan, Inc., 1984 U.S. Dist. LEXIS 14699 (N.D. Ill. 1984).

42. Glendale Int’l Corp. v. United States PTO, 374 F. Supp. 2d 479 (E.D. Va. 2005). The district court granted the USPTO’s motion for summary judgment against the applicant.

43. *Id.* at 486.

44. *In re Corrington*, 2010 TTAB LEXIS 324 (T.T.A.B. 2010) (nonprecedential).

because the sale of explosives is “highly regulated in the United States.”

Just as with potentially descriptive terms, the examining attorney analyses a potentially deceptively misdescriptive term as it relates to the applicant’s goods or services.⁴⁵ In one case, the Board found a term deceptively misdescriptive as it related to some goods but not others.⁴⁶ It agreed with the examining attorney that consumers were likely to believe that pillows and fiber beds contained the cinnamon-like spice cassia, refusing to register CASSIA as a mark for those goods because it was deceptively misdescriptive. The examining attorney had presented evidence of web pages showing cassia as an ingredient in therapeutic pillows and had demonstrated that the word “cassia” was “fairly well known” as it appeared in lists of common spices. She also showed that consumers were familiar with the idea that pillows and related goods could contain spices “added for their soothing or healing properties.” Thus, concluded the Board, “cassia” was a plausible misdescription of those goods. The Board, however, found no evidence that consumers would expect that the other goods in applicant’s application—comforters, blankets and mattress pads—would contain spices. It therefore determined that CASSIA could be registered as to those goods.

The CASSIA opinion also brings up the issue of how many potential purchasers should find the misdescription plausible for the registration to be rejected. The Board in that case found from the evidence that “at least some consumers would be familiar with the meaning of CASSIA as a form of cinnamon and are accustomed to seeing pillows that contain herbal ingredients including cassia.”

The standard here should not be whether “at least some consumers” would know the term. Because of the consequences of non-registration, there should be at least a significant portion of consumers who would understand the trademark as plausibly misdescribing the goods connected to it.⁴⁷

c. “Deceptive” Misdescriptiveness

The legislative history of this section suggests that the law in draft form barred registration of marks that were “merely descriptive or misdescriptive” as applied to goods. One legislator urged the inclusion of “deceptively” before “misdescriptive” because barring all “misdescriptive” marks would prohibit registration of

45. 15 U.S.C. § 1052(e)(1) (barring registration of “a mark which . . . when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them”). See also TMEP § 1209.04.

46. *In re Pacific Coast Feather Co.*, 2007 TTAB LEXIS 484 (T.T.A.B. 2007) (nonprecedential).

47. For more on the role of the consumer, see § V *infra*.

arbitrary and suggestive marks as well, giving the example of IVORY for soap.⁴⁸ There was some discussion over whether “deceptively” should be added and whether it was unnecessarily repetitive of “deceptive” in Section 2(a); the term was ultimately included.

Are trademarks that are merely misdescriptive going to be registrable as long as they are not “deceptive”? Absolutely. In fact, those marks may be among the most desirable. Those are arbitrary or suggestive marks: They misdescribe the product or service, but in a way that will not mislead consumers. DOVE for ice cream bars is misdescriptive, but even the most gullible consumers would not expect bird meat inside their chocolate coating. PENGUIN for publishing services is misdescriptive, but no one thinks aquatic, flightless birds are editing, proofreading and printing books. Though they may be misdescriptive, suggestive or arbitrary marks are not *deceptively* misdescriptive as that term has come to be understood.⁴⁹

A few marks challenged as deceptively misdescriptive or even deceptive have been found to be suggestive, as with ICE CREAM for chewing gum, opposition to which prompted the Board to state that “although ‘Ice Cream’ is misdescriptive of applicant’s chewing gum, it is so incongruous and ludicrous as to be arbitrary as applied thereto and hence is not deceptively misdescriptive thereof.”⁵⁰ KOOLER KIOSK was suggestive rather than deceptively misdescriptive for a “water cooler attachment for storing, holding and displaying articles”; the Board found “kiosk” to merely suggest an attribute of the goods rather than misdescribing them.⁵¹ And PARIS BEACH CLUB for t-shirts and sweatshirts was suggestive, not deceptive, because it was a humorous phrase, “a take-off on the fact that the city of Paris is known for haute couture.”⁵² The Board did not, however, agree with the applicant for SUPER SILK for shirts made of “silk-like

48. Hearings on H.R. 102, H.R. 5461, and S. 895 before the Subcommittee on Trademarks of the House Committee on Patents, 77th Cong., 1st Sess. 83-86 (1941), reprinted in 7 Gilson on Trademarks pp. 2-144 to 2-147.

49. See, e.g., *In re Automatic Radio*, 404 F.2d 1391, 1396 (C.C.P.A. 1969) (reversing rejection of AUTOMATIC RADIO for “air conditioners, ignition systems and antennas”) (“The proscription is not against misdescriptive terms unless they are also deceptive. We do not think AUTOMATIC RADIO on an air conditioner, an ignition system, or an antenna, is likely to deceive anyone.”); *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047 (T.T.A.B. 2002) (“[W]e observe that in order for a term to misdescribe goods or services, the term must be merely descriptive, rather than suggestive, of a significant aspect of the goods or services which the goods or services plausibly possess but in fact do not.”).

50. *Borden, Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. 447 (T.T.A.B. 1972).

51. *In re Cemco, Inc.*, 2010 TTAB LEXIS 259 (T.T.A.B. 2010) (nonprecedential).

52. *In re Sharky’s Drygoods Co.*, 23 U.S.P.Q.2d 1061 (T.T.A.B. 1992).

fabric” that the mark suggested a fabric that was similar yet superior to silk.⁵³

d. Materiality is Not a Factor

The difference between deceptive marks and deceptively misdescriptive terms is *materiality*. For a mark to be found deceptive, as discussed below, the misdescription must be material to the purchasing decision of a substantial portion of customers.⁵⁴ This is not a requirement for deceptively misdescriptive terms.

The obvious question here is, why forbid registration of misdescriptive terms where the misdescription is not material to the consumer’s purchasing decision? Rejection is not necessary to protect the consumer, given that she does not base her purchasing decision on the misdescription. In fact, rejection cannot protect consumers because the mark can be freely used even if not registered. Refusal is also unnecessary for the protection of competitors, given that the misdescription is not material to consumers and thus competitors would not need to use the misdescription to attract them. Perhaps materiality is not a factor because of the government’s reluctance to lend its approval to a term or phrase that is in some way misleading, whether or not the general public cares that it is. Scandalous marks, for example, may offend the general public, giving a government agency like the USPTO a reason to avoid registering them.⁵⁵ A mark that is not misleading in a *material* way does not, however, bother the public.

No, the real reason for not registering deceptively misdescriptive terms is this: They are not inherently distinctive and therefore they are not trademarks. The next section gets to the heart of this issue, central to any deceptive misdescriptiveness refusal.

4. Deceptive Misdescriptiveness and Acquired Distinctiveness

Deceptively misdescriptive terms are registrable with a showing of acquired distinctiveness.⁵⁶ But shouldn’t terms that trick consumers about goods and services *never* be registrable? Despite a handful of findings by the Board to the contrary,⁵⁷ the

53. *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047 (T.T.A.B. 2002).

54. *See infra* § III[B][3][a] discussing how a mark can be plausibly false yet not be material to the purchasing decision.

55. Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TMR 1476, 1482-83 (2011).

56. 15 U.S.C. § 1052(f).

57. *In re Woolrich Woolen Mills, Inc.*, 13 U.S.P.Q.2d 1235 (T.T.A.B. 1989) (finding the mark WOOLRICH not misdescriptive for goods not made of wool in part due to the long use of the mark and “recognition by consumers and the trade”; holding that the evidence showed

fact that consumers associate a misdescriptive term with a single source does not cause it to describe the goods any more accurately.

The reason acquired distinctiveness allows registration has nothing to do with the fact that deceptively misdescriptive terms may mislead. Instead, it is because they lack distinctiveness.

Descriptive names, geographically descriptive terms, laudatory terms, surnames, product design and color marks are generally denied registration absent acquired distinctiveness.⁵⁸ The rationale is that consumers are unlikely to see these terms or visual marks as source identifiers, at least not without a substantial period of exposure to them as trademarks. Rather than being automatic source indicators, these designations give information about the product or services.

Consumers would initially see a bottle, for example, even an unusual one, as a container for a product rather than as an indicator of the source of that product.⁵⁹ They would see GARDEN STATE TOYS as an indication that the toys came from New Jersey rather than from a particular producer using a source-indicating mark.⁶⁰ SUPERIOR BARBECUE SAUCE may sound tasty, but “superior” does not immediately function as a source indicator.⁶¹ JOHNSON HARDWARE would connote a hardware store run by someone with the surname Johnson but, supposedly, not with any particular person or source.⁶²

With arbitrary, fanciful or suggestive marks, on the other hand, the public sees them as immediately conveying trademark meaning. There is no significant non-trademark meaning that detracts from the association between the product and its source.

In time, through extensive use and advertising, terms and visuals that lack inherent or immediate distinctiveness may take on a secondary meaning. They may come to be seen by consumers as designating the source of products and distinguishing them from the products of others. They have come to serve as trademarks.

that “any descriptive or misdescriptive significance that the term may have had when first adopted has been largely replaced by trademark significance as a result of applicant’s long and extensive use”); *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313 (T.T.A.B. 1965) (holding that, as a result of extensive use and advertising for over twenty-five years, consumers saw the mark TUFIDE as an indication of origin for non-leather goods “and are not deceived or misled by said mark in purchasing [the] goods on the belief that they are made of leather”), *aff’d*, 377 F.2d 1001 (C.C.P.A. 1967).

58. For more on acquired distinctiveness, see 1 Gilson on Trademarks § 2.09.

59. For more on distinctiveness and product design trade dress, see *id.* at § 2A.03[1][b].

60. For more on geographic terms, see *id.* at § 2.03[4][c].

61. For more on laudatory terms, see *id.* at § 2.03[3].

62. For more on personal names, see *id.* at § 2.03[4][d]. For less common names in particular, this assumption that surnames lack inherent distinctiveness is not entirely convincing. However, personal names are treated as descriptive marks in the United States.

Like these other types of aspiring marks, a deceptively misdescriptive term is not inherently distinctive. It seems to the consumer to plausibly describe a feature or characteristic of the product or service, yet it does not. *Deceptive misdescriptiveness is the flip side of descriptiveness.* A deceptively misdescriptive term looks to the consumer just like a descriptive term. It appears to describe how a product functions, what it looks, tastes or feels like, or what its desirable aspects are. It does *not* appear to be a source indicator. Thus, the reason acquired distinctiveness is necessary for registering these terms is that they are not inherently distinctive. The fact that they may mislead the public is not what drives the rejection.

This reasoning may not be immediately apparent because of the use of the loaded term “deceptively” to describe these terms. This adjective is not appropriate in Section 2(e)(1) because the term need not be deceptive in the sense in which that word is used in Section 2(a). The focus is not on whether the term *tricks* the public. It should instead be on whether the misdescription is plausible so that the term appears to be descriptive and thus not distinctive. When asking whether a mark is “deceptively misdescriptive,” to use the statutory language, the Board and courts should ask whether it would be categorized as a descriptive term if the misdescription were in fact true.

B. Deceptive Trademarks

1. What is a Deceptive Trademark?

Section 2(a) of the Lanham Act prohibits registration of “deceptive matter.”⁶³ The Federal Circuit has set out a three-part test for determining whether a trademark is deceptive:

- Is the mark misdescriptive of the character, quality, function, composition or use of the goods?
- Are prospective purchasers likely to believe that the misdescription actually describes the goods?
- Is the misdescription material to the purchasing decision or likely to affect the decision to purchase of a significant portion of the relevant consumers?⁶⁴

The first two prongs of the test for deceptive marks—is it misdescriptive of the goods and are prospective purchasers likely to believe the misdescription—are *identical* to the entire test for deceptively misdescriptive marks. The difference is that the

63. 15 U.S.C. § 1052(a). See 1 Gilson on Trademarks § 3.04[6][a][iv][A].

64. *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988), as clarified/modified by *In re Spirits Int'l, N.V.*, 563 F.3d 1347 (Fed. Cir. 2009).

misdescription by deceptive marks is material to the purchasing decision.

The statute bars registration of “deceptive matter” regardless of the goods or services of the applicant, as distinguished from later bases for refusal in that section that bar certain matter that is misdescriptive “when applied to the goods of the applicant.” This omission makes no sense. A trademark cannot be deceptive in a vacuum, but only in relation to goods and services, just as a term cannot be generic, descriptive, misdescriptive, suggestive or arbitrary except in relation to goods and services.⁶⁵ Thus, courts and the USPTO in fact look at the goods and services when determining whether a mark is deceptive, as they should.

The following marks have been found deceptive and unregistrable:

- LOVEE LAMB for synthetic fiber automobile-seat covers⁶⁶
- ORGANIK for clothing from cotton that was not organically grown or free of chemical processing⁶⁷
- ORGANIC ASPIRIN for dietary supplements for human consumption that were synthetic and did not contain acetylsalicylic acid⁶⁸
- ECODOWN for pillows that did not contain down⁶⁹
- CEDAR RIDGE for hardboard siding not made of cedar⁷⁰
- SILKEASE for clothing not made of silk⁷¹
- THE PRESIDENTS FORMULA for vitamins that were not made from a formula prescribed for the President of the United States⁷²

The following marks were found *not* deceptive:

- AMERICAN HERITAGE for wines⁷³ because the examining attorney did not show that consumers would see the mark as describing a significant ingredient of wines

65. 1 Gilson on Trademarks § 2.01[1] (“It is vital to understand that the distinctiveness analysis must look at the mark in context. . . . For example, PUMPKIN would be generic for the round orange gourd, descriptive of pumpkin-scented hand lotion, suggestive of Halloween costumes, and arbitrary for toilet paper or ironing boards. Thus, the word PUMPKIN *by itself* cannot be said to be generic, descriptive, suggestive or arbitrary.”).

66. *In re* Budge Mfg. Co., 857 F.2d at 777.

67. *In re* Organik Techs. Inc., 41 U.S.P.Q.2d 1690 (T.T.A.B. 1997).

68. Bayer Aktiengesellschaft v. Mouratidis, 2010 TTAB LEXIS 218 (T.T.A.B. 2010) (mark also found to be deceptively misdescriptive).

69. *In re* Fisi Fibre Sintetiche S.P.A., 2007 TTAB LEXIS 517 (T.T.A.B. 2007) (nonprecedential) (mark also found to be deceptively misdescriptive).

70. Evans Prods. Co. v. Boise Cascade Corp., 218 U.S.P.Q. 160 (T.T.A.B. 1983).

71. *In re* Shapely, Inc., 231 U.S.P.Q. 72 (T.T.A.B. 1986).

72. *Ex parte* Makers of Kal, Inc., 114 U.S.P.Q. 504 (Comm’r Pats 1957).

73. *In re* Oliver Wine Co., 2011 TTAB LEXIS 131 (T.T.A.B. 2011) (nonprecedential).

- SMART MONEY for “stock brokerage, security brokerage, investment banking, investment brokerage, investment consultation, financial planning, financial research, financial management, [and] investment management”⁷⁴ because the opposer did not show that the mark misdescribes applicant’s financial services; “Rather, it appears to be a phrase that vaguely suggests, as in advertising puffery, longevity in offering financial services to knowledgeable investors.”
- THE REAL YELLOW PAGES for classified directories⁷⁵ because the Board could not “say that the mark as a whole immediately describes any specific feature, quality or characteristic of applicant’s goods. . . . Rather, the phrase as a whole appears to us to be a suggestive mark lacking in specific meaning or definite informational quality.”
- WHITE SABLE for artists’ paint brushes⁷⁶ because sable fur is black and also the Board found that consumers would not see “sable” in connection with artists’ brushes as literally a brush made from the hair or fur of a sable animal
- COPY CALF for wallets of synthetic and plastic material made to simulate leather⁷⁷ because the mark was an obvious play on the expression “copy cat” and suggested to purchasers that the goods were imitations of goods made of calf skin

2. Why Does it Matter if You Have a Deceptive Trademark?

Section 2(a) of the Lanham Act provides for an absolute bar against registration of deceptive trademarks.⁷⁸ Neither acquired distinctiveness⁷⁹ nor a disclaimer of the deceptive matter⁸⁰ can make a deceptive mark registrable. Deceptive marks that have

74. *Beneficial Franchise Company, Inc. v. Ladenburg Thalmann & Co. Inc.*, 2005 TTAB LEXIS 847 (T.T.A.B. 2005) (nonprecedential).

75. *U.S. West, Inc. v. BellSouth Corp.*, 1990 TTAB LEXIS 71 (T.T.A.B. 1990).

76. *In re Robert Simmons, Inc.*, 192 U.S.P.Q. 331 (T.T.A.B. 1976).

77. *A. F. Gallun & Sons Corp. v. Aristocrat Leather Products, Inc.*, 135 U.S.P.Q. 459 (T.T.A.B. 1962).

78. 15 U.S.C. § 1052(a).

79. 15 U.S.C. § 1064(3); TMEP § 1203.02. *See* Germain, 66 TMR at 98-99 (“For Section 2(a) violators, . . . there is no salvation whatsoever: no amount of ‘distinctiveness’ will purge the defect.”).

80. *In re Wada*, 194 F.3d 1297, 1301 (Fed. Cir. 1999) (“A disclaimer of deceptive terms does not permit registrability of a mark that is deceptive.”).

been registered may be cancelled at any time.⁸¹ And deceptive marks cannot be registered on the supplemental register.⁸²

A deceptive trademark may violate the Lanham Act prohibitions against false and misleading representations in commerce typically applied in false advertising cases.⁸³ The deceptiveness of a trademark may also be the basis for an unclean hands defense in a trademark infringement case, preventing the owner of a deceptive mark from obtaining relief, though this is a rare claim. As early as 1903, the Supreme Court found that a plaintiff was unable to invoke the aid of a court of equity because of its own “plainly deceptive” mark.⁸⁴ The plaintiff had named its laxative SYRUP OF FIGS, though the preparation in fact contained no figs. A century later, the Ninth Circuit noted the defense, though found it lacked merit in that case.⁸⁵ It stated: “Trademark law’s unclean hands defense springs from the rationale that the plaintiff should not in his trade mark, or in his

81. 15 U.S.C. § 1064(3) (“A petition to cancel a registration of a mark . . . may . . . be filed . . . [a]t any time if the . . . registration was . . . contrary to the provisions of . . . subsection (a), (b), or (c) of section 2 for a registration under this Act . . .”); TMEP § 1203.02.

82. 15 U.S.C. § 1091(a).

83. *E.g.*, *Nester’s Map & Guide Corp. v. Hagstrom Map Co.*, 760 F. Supp. 36 (E.D.N.Y. 1991) (holding that plaintiff’s use of the word “official” in the title of its taxi driver’s guide violated Section 43(a)). *See* § IV *infra* for more on Section 43(a) and deceptive marks.

84. *Worden v. California Fig Syrup Co.*, 187 U.S. 516, 540 (1903). *See also* *Worthington v. Anderson*, 386 F.3d 1314, 1320 (10th Cir. 2004) (“Historically, courts have recognized two types of ‘related conduct’ that will permit application of the unclean hands doctrine in a trademark case. The first involves inequitable conduct toward the public, such as deception in or misuse of the trademark itself, resulting in harm to the public such that it would be wrong for a court of equity to reward the plaintiff’s conduct by granting relief.”); *R.J. Reynolds Tobacco Co. v. Premium Tobacco Stores, Inc.*, 2001 U.S. Dist. LEXIS 8896 (N.D. Ill. 2001) (“[C]ourts have almost unanimously required a party seeking to use the unclean hands defense to demonstrate that the trademark itself, as opposed to advertising or promotion of the trademarked product, was deceptive.”).

Compare *Holeproof Hosiery Co. v. Wallach Bros.*, 172 F. 859, 860 (2d Cir. 1909) (finding complainant to be entitled to relief in a court of equity where its hosiery was called HOLEPROOF; “No one surely could be misled into the belief that holes will not appear in complainant’s socks if they are worn long enough It is a boastful and fanciful word, easily to be distinguished from the ‘Syrup of Figs’ and similar cases where the name or description involved misstatements as to the manufacture of the advertised product.”).

85. *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 870-72 (9th Cir. 2002). There, the plaintiff used the trade name JAPAN TELECOM, INC., and the defendant had argued that the name suggested a company of Japanese origin, which plaintiff was not. The appellate court found disputed issues of fact over whether the trade name was primarily geographically deceptively misdescriptive. It questioned, first, whether JAPAN TELECOM refers to a geographic location or to a business that caters to Japanese-speaking customers and second, whether customers would actually believe that plaintiff, a business that installs and maintains telephone and computer networking equipment in the United States, is based in Japan: “Because Japan Telecom can only perform its services in person and on customer premises, it is hard to see how a reasonable customer could conclude that the technician installing his new phone wiring just came off a jet from Tokyo, equipped with the very latest in Japanese wiring know-how.”

advertisements and business, be himself guilty of misleading representation.”⁸⁶

3. Analysis of the USPTO’s Test for Deceptiveness

The statute does not explain the difference between deceptively misdescriptive and deceptive marks, except for allowing the first to register with acquired distinctiveness and completely barring the second from registration.⁸⁷ Courts and the Board have determined that the difference between deceptive marks and deceptively misdescriptive marks is whether the misdescription is material to the purchasing decision.⁸⁸ In other words, deceptive marks are those that affirmatively mislead the public into purchasing something that is not what they think it is.

a. What Makes a Misdescription Material?

The TMEP instructs examining attorneys that, to show materiality of a misdescription, they must provide evidence that “the misdescriptive quality or characteristic would make the product or service more appealing or desirable to prospective purchasers.”⁸⁹ The Manual lists some objective criteria, including superior quality, enhanced performance or function, difference in price, health benefits, or comportment with a religious practice or social policy such as calling a product “kosher” or “vegan.”⁹⁰

The focus is on “objective standards” rather than subjective.⁹¹ Personal preference alone is not enough to make a misrepresentation material, such as partiality to spearmint gum, lavender dish soap or blue bicycles.⁹² At first, these examples appear strange. It would surely be material to a consumer what

86. *But see* Hako-Med USA, Inc. v. Axiom Worldwide, Inc., 2006 U.S. Dist. LEXIS 91889 n.4 (M.D. Fla. 2006) (“Defendant has cited no authority, nor has the Court located any, in which deceptive misdescription has been used as a defense in a trademark infringement action. It is more commonly used in opposition to a petition for trademark registration.”).

87. Germain, 66 TMR at 99 (“The problem, of course, is to distinguish between Section 2(a) ‘deceptive’ marks and Section 2(e) ‘deceptively misdescriptive’ marks. However, the statutory formulation lends little further guidance and indeed, some confusion: although the consequences which attend disqualifications on these two deception grounds clearly differ, the statute nowhere indicates the substance of the differences between the disqualifications themselves.”).

88. *E.g.*, TMEP § 1203.02(c) (“The third inquiry, whether the misdescription is likely to affect the decision to purchase, distinguishes marks that are deceptive under §2(a) from marks that are deceptively misdescriptive under §2(e)(1).”).

89. TMEP § 1203.02(d).

90. TMEP § 1203.02(d)(i).

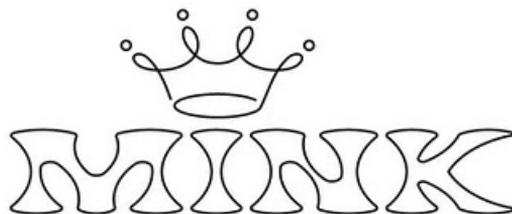
91. TMEP § 1203.02(d).

92. TMEP § 1203.02(d)(ii).

flavor her gum is, for instance. But while peach-flavored gum may be different from spearmint gum, it is not objectively worse.

Evidence of materiality must “suffice to indicate that the misdescriptive quality or characteristic would affect the purchasing decision of a significant portion of the relevant consumers.”⁹³ Similarly, the Restatement (Third) of Unfair Competition states: “If the inaccurate information conveyed by a misdescriptive designation is likely to influence the purchasing decisions of a significant number of prospective consumers, the designation is also ‘deceptive.’”⁹⁴

The Board, for example, found the mark LONDON LONDON for jackets, skirts, shirts and pants to be deceptive under Section 2(a) because of “London’s reputation as a center of fashionable apparel” and the “cachet attached to the clothes made and sold there.”⁹⁵ The following mark was also found deceptive for clothing, headgear and footwear made of non-animal products:⁹⁶



The Board accepted evidence that mink is a desirable material for the applicant’s goods as well as “a luxury item that imbues the owner with status.” Thus, the assumption that the goods contained mink would materially affect the purchasing decision.

On the other hand, the Board found SWEDEN not deceptive for artificial kidneys because nothing in the record showed that Sweden is noted for producing artificial kidneys or that people would want their artificial kidneys to be from Sweden.⁹⁷ Instead,

93. TMEP § 1203.02(d)(i).

94. Restatement (Third) of Unfair Competition § 14 cmt. c.

95. *In re Juleigh Jeans Sportswear, Inc.*, 24 U.S.P.Q.2d 1694 (T.T.A.B. 1992). If this case were being decided now, the USPTO would probably find the mark to be primarily geographically deceptively misdescriptive, a phrase which, after statutory amendments in 1993, simply means geographically deceptive. See § III[C][1] *infra*.

96. *In re Brough*, Ser. No. 78680981, *petition for reconsideration denied*, 2008 TTAB LEXIS 302 (T.T.A.B. 2008) (nonprecedential).

97. *In re Sweden Freezer Mfg. Co.*, 159 U.S.P.Q. 246 (T.T.A.B. 1968). See also Germain, 66 TMR at 119 (“[I]f it is determined that members of the public believe that SWEDEN artificial kidney machines were made in Sweden, but it is further determined that they do not care whether they were made there or not, then Section 2(e) is appropriate; whereas, if it is determined that they do care—ostensibly because they believe that Swedish-make medical machinery is superior in some way—then Section 2(a) would be appropriate.”).

the Board was not persuaded that the mark “would possess any significance to purchasers of artificial kidney units in the United States other than as an indication of origin for applicant’s goods.” That Board opinion cited prior opinions finding that “deception is not present where a geographical trademark may involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible.”

In order to be found deceptive, the misdescription must suggest to a consumer that the product is more desirable than it actually is. If the mark instead simply holds the goods out as something other than what they are and not as something more desirable, that mark is *not* considered deceptive. In other words, confusion is not the same as deception. In one case, the applicant had applied to register P.T.E. for “a pediatric mixture of injectable trace element additives for intravenous nutrition.”⁹⁸ The examining attorney rejected the registration as deceptive, stating that P.T.E. is a medical acronym for parathyroid extract and the product was not parathyroid extract. However, the Board found:

The record makes it clear that the products are used in different medical situations for completely different purposes. . . . To a purchaser seeking pediatric trace elements, the misconception that applicant’s products contained parathyroid extract would obviously not bestow greater marketability or desirability on applicant’s product or be the inducement for the purchase of the product.

It explained that the examining attorney’s concern that purchasers searching for parathyroid extract could mistakenly purchase applicant’s product “is simply not relevant to the registrability of the mark under Section 2(a) of the Lanham Act.”

b. Relevance and Distinctiveness

This is how the TMEP differentiates between deceptively misdescriptive and deceptive marks:

To be deceptively misdescriptive under §2(e)(1), the misdescription must concern a feature that would be relevant to the decision to purchase the goods or use the services. If the misdescription is more than simply a relevant factor that may be considered in purchasing decisions, but is a material factor, the mark would be deceptive under §2(a) of the Trademark Act.⁹⁹

Interesting fact: Engineer Harvey Swenson invented both the artificial kidney machine and the automated soft ice cream dispenser, selling them both under the SWEDEN trademark. See <http://tinyurl.com/75y4lpr>.

98. *In re Lyphomed, Inc.*, 1 U.S.P.Q.2d 1430 (T.T.A.B. 1986).

99. TMEP § 1203.02(c). See also *In re Shniberg*, 79 U.S.P.Q.2d 1309 (T.T.A.B. 2006) (“If the misdescription is more than simply a relevant factor that may be considered in

So a misdescription is “relevant to the decision to purchase” for deceptively misdescriptive marks, but if it becomes “a material factor,” the mark would be deceptive. This seems to be a very fine line, indeed. When is a piece of information *relevant* to a decision yet not *material* to that decision? If this statement is an accurate description of the standard, then a deceptive mark would seem to be only a small degree of significance away from a deceptively misdescriptive mark.

To see how the USPTO’s relevance/materiality distinction may or may not work, let us look at a seminal deceptiveness case. In the 1955 *Gold Seal* case, a federal district court was tasked with determining whether the mark GLASS WAX was deceptively misdescriptive or deceptive as applied to a glass cleaner that did not contain wax.¹⁰⁰ It ruled that the mark was deceptively misdescriptive, finding that customers might believe it contained wax. The court nevertheless found the mark not to be deceptive:

The evidence does not establish that customers have been misled. To the contrary, it appears that the product satisfies the needs of the customers; that the average or ordinary customer cares little about, and knows little about, the scientific composition of the product. Certainly the fact that plaintiff has sold some ninety million units of its glass and metal cleaner, marked Glass Wax, betokens customer satisfaction and indicates that the product is a good product. The evidence does not show that the public has been influenced to purchase the product on account of believing that it contained wax, or that the product was simply a wax to be placed upon glass.¹⁰¹

Highlighting this finding as key to its holding of non-deceptiveness, the court went on to say:

[D]eception is found when an essential and material element is misrepresented, is distinctly false, and is the very element upon which the customer reasonably relies in purchasing one product over another. When, as here, the product contains an element which can only be known exactly by rigid scientific analysis, and such element does not appear as determinative in leading customers to buy the product, the mark is not deceptive.¹⁰²

With deceptively misdescriptive marks, consumers are likely to believe the misdescription could be true—say, that there could be

purchasing decisions but *is* a material factor, the mark would also be deceptive.”) (emphasis in the original).

100. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff’d sub nom.* S. C. Johnson & Son v. *Gold Seal Co.*, 230 F.2d 832 (D.C. Cir. 1956) (per curiam).

101. *Id.* at 934.

102. *Id.*

wax in GLASS WAX. Nonetheless, the misdescription was not material to the purchasing decision because consumers did not care whether the product had wax or not.

In the GLASS WAX case, the court found the misrepresentation *believable* but not material, which is different from *relevant* and not material. Consumers thought the product could have wax but did not care, which seems to mean that the ingredient of wax was not relevant to them. They may have been confused or misled as to certain characteristics of the product due to the deceptively misdescriptive trademark, but their confusion was not relevant to their purchasing decision.¹⁰³

Upon reflection, then, the term “relevant” used in the TMEP is inappropriate. The question is not whether consumers would find the factual implications of deceptively misdescriptive marks to be relevant to their purchasing decision. Rather, the question is whether the mark immediately conveys the idea of an ingredient, feature, purpose or use of the goods, and that idea ultimately turns out to be false. It does not matter that consumers do or do not find this ingredient or feature germane to their decision to buy.

c. Intent

Older federal case law and Board opinions have suggested that a finding of deceptiveness requires an intent to deceive.¹⁰⁴ However, the Board has made clear that it does not require a showing of the applicant’s intent to deceive in either deceptiveness or deceptive misdescriptiveness cases.¹⁰⁵

103. See *Marilyn Miglin Model Makeup, Inc. v. Jovan, Inc.*, 1984 U.S. Dist. LEXIS 14699 (N.D. Ill. 1984) (“Unlike the category of deceptive marks, . . . which deceive consumers into purchasing a product based on a misrepresentation of the product’s ingredients, a deceptively misdescriptive mark is one in which customer confusion as to ingredients, rather than mistaken reliance, is at issue.”).

104. See, e.g., *Schmidt v. Honeysweet Hams, Inc.*, 656 F. Supp. 92, 95 n.1 (N.D. Ga. 1986) (“In the absence . . . of any evidence that the misdescription was planned or designed to deceive the public, ‘deceptively misdescriptive’ marks are placed in the same category as descriptive marks”); *In re Amerise*, 160 U.S.P.Q. 687 (T.T.A.B. 1969) (“As to Section 2(a), this Board has . . . taken the position that a mark consisting of or compromising a geographical term is not deceptive under Section 2(a) unless it involves a false assertion calculated, either planned, designed, or implied to deceive the public as to the geographical origin of the goods bearing the mark. This contemplates situations where a party applies a geographical designation to a particular product knowing that it will bestow upon the product an appearance of greater quality or saleability not actually possessed by it with the intention thereby of inducing or misleading a particular class of consumers into purchasing this product.”).

105. *In re Napa Valley Foods, Inc.*, 2011 TTAB LEXIS 52 (T.T.A.B. 2011) (nonprecedential) (“[E]ven if applicant’s motives in adopting the mark were totally innocent, applicant may still not register a mark if it is primarily geographically deceptively misdescriptive.”); *In re Neurobotics, L.L.C.*, 2008 TTAB LEXIS 221 (T.T.A.B. 2008) (nonprecedential) (“[W]ith regard to the issue of intent, this is not part of the test.”) (finding mark deceptive regardless of lack of intent to deceive); *In re Eastern Watch Co.*, 2006 TTAB LEXIS 120 (T.T.A.B. 2006) (“[A]pplicant’s intent not to deceive prospective purchasers does

C. Primarily Geographically Deceptively Misdescriptive Trademarks

The confusion surrounding the protectability and validity of geographic marks under U.S. law is substantial. The fundamental ambiguity of the phrase “primarily geographically deceptively misdescriptive” was not improved when a 1993 statutory amendment changed the consequences of having such a mark, but the phrase itself remained the same. It did not help matters that it took the courts a decade to declare that the amendment changed the legal standard, and then announced another requirement a few years after that.

1. What is a Primarily Geographically Deceptively Misdescriptive Trademark?

A trademark is primarily geographically deceptively misdescriptive under the current understanding of that phrase if:

- its primary significance is a generally known geographic location
- consumers are likely to believe that the place identified by the mark indicates the origin of the goods bearing the mark and the goods do not in fact come from that place, and
- the misrepresentation was a material factor in the decision of a substantial portion of relevant consumers.¹⁰⁶

The following marks have been refused registration as being primarily geographically deceptively misdescriptive:

- FRENCH LINE for “a wide variety of goods and services in a multitude of classes” that did not come from France¹⁰⁷
- KUBA KUBA for cigars and cigar-related goods that did not come from Cuba¹⁰⁸

not establish that applicant’s term is registrable. Certainly, prospective purchasers will not be aware of this intent.”); *In re Ox-Yoke Originals, Inc.*, 222 U.S.P.Q. 352 (T.T.A.B. 1983) (“Intent is not . . . an essential element in a case under Section 2(a). If it is not critical to a refusal based on deceptiveness, it certainly is not necessary where the refusal is based on deceptive misdescriptiveness.”) (citation omitted).

See also *Evans Prods. Co. v. Boise Cascade Corp.*, 218 U.S.P.Q. 160 (T.T.A.B. 1983) (“Although intent is not an essential element to the finding of deceptiveness of a mark under Section 2(a) of the Act, . . . [i]t is clear . . . that applicant intended to adopt a mark which conveyed the impression of authentic cedar.”).

106. *In re California Innovations, Inc.*, 329 F.3d 1334, 1341 (Fed. Cir. 2003), *as clarified/modified by In re Spirits Int’l, N.V.*, 563 F.3d 1347 (Fed. Cir. 2009). *See* 1 Gilson on Trademarks § 3.04[6][a][iv][B].

107. *In re Compagnie Generale Maritime*, 993 F.2d 841 (Fed. Cir. 1993).

108. *In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011).

- NAPA FOODS for a wide variety of food including baking powder, coffee, canned peas and olive oil, not originating in Napa Valley, California¹⁰⁹
- FRENCH & FLIRTY for lingerie not originating in France¹¹⁰
- NORMANDIE CAMEMBERT for cheese presumably not made in Normandy, France¹¹¹
- The following mark for watches and clocks not made in Switzerland:¹¹²



- The following mark for restaurant services not offered in Colorado:¹¹³



- GUANTANAMERA for cigars not made in Guantanamo, Cuba¹¹⁴
- NEW YORK WAYS GALLERY for leather bags, luggage, back packs, wallets and tote bags that were not made in New York¹¹⁵
- The following mark for various items including potpourri, tableware made of precious and nonprecious metals, lamps,

109. *In re* Napa Valley Foods, Inc., 2011 TTAB LEXIS 52 (T.T.A.B. 2011) (nonprecedential).

110. *In re* Vanity Fair, Inc., 2007 TTAB LEXIS 348 (T.T.A.B. 2007) (nonprecedential).

111. *In re* Cheezwhse.com, Inc., 85 U.S.P.Q.2d 1917 (T.T.A.B. 2008) (applicant had refused to provide information about where the cheese was made, so the Board presumed that the goods would not originate from the place named in the mark).

112. *In re* Style Asia, Inc., 2008 TTAB LEXIS 454 (T.T.A.B. 2008) (nonprecedential).

113. *In re* Consolidated Specialty Restaurants, Inc., 71 U.S.P.Q.2d 1921 (T.T.A.B. 2004).

114. *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 U.S.P.Q.2d 1085 (T.T.A.B. 2012).

115. *In re* Wada, 194 F.3d 1297 (Fed. Cir. 1999).

clocks, art prints, paper products, residential furniture, dinnerware, glassware, bedding and carpets, almost none of which originated in Venice:¹¹⁶



The NEW YORK WAYS and VENICE COLLECTION marks above were refused registration before the Federal Circuit held that the Lanham Act had been changed in 1993 to require a showing of deceptiveness (see below). Nevertheless, the *California Innovations* court specifically noted that those marks met the newer standard for deceptiveness and were thus properly refused registration as primarily geographically deceptively misdescriptive.

The following marks were found *not* to be primarily geographically deceptively misdescriptive:

- COOPERSTOWN for restaurant services¹¹⁷ because the record did not show that the public associated Cooperstown, New York with restaurants
- The following mark for restaurant services not located in Chinatown¹¹⁸ because the incongruity of the elements of the mark means the primary significance of “Chinatown” is not a geographic location:



- LONDON SOHO NEW YORK for cosmetic bags¹¹⁹ because the evidence did not show a goods/place association in consumers’ minds between those cities and cosmetic bags

116. *In re Save Venice N.Y., Inc.*, 259 F.3d 1346 (Fed. Cir. 2001).

117. *In re Municipal Capital Mkts. Corp.*, 51 U.S.P.Q.2d 1369 (T.T.A.B. 1999).

118. *In re Lafayette Street Partners, LLC*, 2008 TTAB LEXIS 299 (T.T.A.B. 2008) (nonprecedential).

119. *In re Conair Corp.*, 2011 TTAB LEXIS 14 (T.T.A.B. 2011) (nonprecedential).

2. Why Does it Matter if You Have a Primarily Geographically Deceptively Misdescriptive Trademark?

When a mark is found to be primarily geographically deceptively misdescriptive, it can never be registered, whether or not it has acquired distinctiveness.¹²⁰ An applicant may not register its primarily geographically deceptively misdescriptive mark even if it disclaims the mark's deceptive components.¹²¹

However, if a primarily geographically deceptively misdescriptive mark acquired distinctiveness before December 8, 1993, the effective date of the North American Free Trade Agreement Act (NAFTA), then it is registrable on the principal register.¹²² Such a mark may be registered on the supplemental register if it was in use in commerce beginning before December 8, 1993.¹²³

3. History of the Statutory Language and Substance

As if the phrase itself were not already confusing enough, the meaning of the phrase "primarily geographically deceptively misdescriptive" changed three times before it came to have the meaning it has today. The second change, involving a strained interpretation of a statutory amendment, may or may not have been justified.

a. Primary Geographic Connotation Test— Used Until 1982

Until 1982, when determining whether a mark was primarily geographically deceptively misdescriptive, the Board would ask: (1) Does the mark have a "readily recognizable geographic

120. 15 U.S.C. § 1052(f); *In re Wada*, 194 F.3d 1297, 1301 (Fed. Cir. 1999) ("[W]ith the incorporation of the NAFTA amendments into the Lanham Act in 1993, primarily geographically deceptively misdescriptive marks were precluded from registration under all circumstances, even with a showing of secondary meaning.").

121. *Id.* ("[T]he Commissioner has adopted a policy that use of a disclaimer will not be permitted to salvage a mark that is primarily geographically deceptively misdescriptive. This policy is consistent with the NAFTA amendments to the Lanham Act . . ."); *In re Save Venice N.Y., Inc.*, 54 U.S.P.Q.2d 1106 (T.T.A.B. 2000).

122. 15 U.S.C. § 1052(f) ("Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act."). See § VI[E] *infra* for more on the meaning of this grandfather clause.

123. 15 U.S.C. § 1091(a) ("Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant's goods or services and not registrable on the principal register under this Act, that is declared to be unregistrable under section 2(e)(3), if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before the date of the enactment of the North American Free Trade Agreement Implementation Act.").

meaning”?¹²⁴ (2) If so, do the goods come from that place? If the mark was the name of a known place and the goods did not come from that place, the mark was primarily geographically deceptively misdescriptive. That was the extent of the very straightforward analysis. Say, for example, an applicant tried to register CANADA brand cat litter that was made in Idaho. It would have been out of luck, under this interpretation, simply because the mark named a place and the goods did not come from that place.

***b. Goods/Place Association Requirement—
Used Until 1993***

In 1982, the U.S. Court of Customs and Patent Appeals (predecessor to the Federal Circuit) required more to show that a mark was primarily geographically deceptively misdescriptive.¹²⁵ In the landmark case *In re Nantucket*, the court overruled the above test, which had been used by the Board to refuse registration for NANTUCKET for shirts as primarily geographically deceptively misdescriptive. The court found that the Board must also consider whether the public actually associates the relevant goods with the particular geographic area.¹²⁶ It described the prior test as doing no more than “rest[ing] mechanistically on the one question of whether the mark is recognizable, at least to some large segment of the public, as the name of a geographical area.”¹²⁷

The court found two flaws with the prior test. First, it had ignored the statutory limitation that the mark was to be evaluated “when applied to the goods of the applicant.” Failing to determine if the goods and the place had some connection did not properly take this limitation into account.¹²⁸ Second, emphasizing the word “deceptively” in the statutory phrase, the Board found that “there must be a reasonable basis for believing that purchasers are likely to be deceived.” For example: “Reasonable persons are unlikely to believe that bananas labeled ALASKA originated or were grown in Alaska. On the other hand, reasonable persons are quite likely to believe that salmon labeled ALASKA originated in the waters of that state.”¹²⁹ After *Nantucket*, therefore, courts and the Board have asked whether consumers were likely to believe that the place identified by the mark indicated the origin of the goods

124. *In re Nantucket, Inc.*, 677 F.2d 95, 97-98 (C.C.P.A. 1982), quoting and rev’g *In re Nantucket, Inc.*, 209 U.S.P.Q. 868 (T.T.A.B. 1981).

125. *Id.*

126. *Id.* at 99-101. This requirement is discussed at § III[C][4][b] *infra*.

127. *In re Nantucket*, 677 F.2d at 97.

128. *Id.* at 98.

129. *Id.* at 98 & n.5.

bearing the mark. In brief, the test became whether there was a goods-place association.

*c. No Materiality Component—
Until 1993 (Actually, 2003)*

The next change was purportedly statutory, and not announced by the Federal Circuit until a decade after the statute was amended. Amendments related to the primarily geographically deceptive misdescriptiveness ground for refusal caused that court to add a materiality component to the standard, effective December 8, 1993. The import of this change is that “primarily geographically deceptively misdescriptive” now means precisely the same thing as “deceptive,” though as applied to marks with a geographic component. This section will look first at the history behind the amendments and the court’s subsequent holding, and then will examine whether the judicial interpretation was justified.

The United States signed NAFTA in 1992. The Agreement provides in relevant part:

Each party [United States, Mexico, Canada] shall provide, in respect of geographical indications, the legal means for interested persons to prevent . . . the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a territory, region or locality other than the true place of origin, in a manner that misleads the public as to the geographical origin of the good Each Party shall, on its own initiative if its domestic law so permits or at the request of an interested person, refuse to register, or invalidate the registration of, a trademark containing or consisting of a geographical indication with respect to goods that do not originate in the indicated territory, region or locality, if use of the indication in the trademark for such goods is of such a nature as to mislead the public as to the geographical origin of the good.¹³⁰

On December 8, 1993, the U.S. enacted the NAFTA Implementation Act that amended the Lanham Act to conform to the agreement.¹³¹

Before the effective date of NAFTA, Section 2(e)(2) was the statutory section containing the refusal to register primarily geographically deceptively misdescriptive marks. Prior to that amendment, subsection (e)(2) required refusal of registration of a trademark that:

130. NAFTA, Dec. 17, 1992, art. 1712(1)(a) & (2), 32 I.L.M. 605, 698.

131. P.L. 103-182, Title III, Subtitle C, § 333(a) (Dec. 8, 1993).

(e) Consists of a mark which . . . (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 4 hereof

After the amendment, the phrase was moved to subsection (e)(3), and today the subsection reads in relevant part:

(e) Consists of a mark which . . . (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4, [or] (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them

“Primarily geographically deceptively misdescriptive” was moved from 2(e)(2) into its own subsection, 2(e)(3), so that it could be treated differently from geographically descriptive marks. New subsection 2(e)(3) was then singled out in Section 2(f), which excluded primarily geographically deceptively misdescriptive marks from those that could be registered on a showing of acquired distinctiveness.¹³²

The amendments also added the following language, grandfathering in those marks that had been registrable before NAFTA:

Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant’s goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.¹³³

All of those amendments apply to trademark applications filed on or after December 8, 1993.

In sum, before NAFTA, the two grounds for refusal under Section 2(e)(2) were for “primarily geographically descriptive” marks and “primarily geographically deceptively misdescriptive” marks. The Federal Circuit notes of the former Section 2(e)(2) grounds:

The law treated these two categories of geographic marks identically. Specifically, the PTO generally placed a “primarily geographically descriptive” or “deceptively misdescriptive” mark on the supplemental register. Upon a showing of

132. 15 U.S.C. § 1052(f).

133. 15 U.S.C. § 1052(f). For more on this clause, see § VI[E] *infra*.

acquired distinctiveness, these marks could qualify for the principal register.¹³⁴

Pre-NAFTA, then, a geographic mark could be descriptive or deceptively misdescriptive, either one registrable with proof of acquired distinctiveness. In 1993, the NAFTA Implementation Act provided that deceptively misdescriptive geographic marks could never be registered. The treatment of deceptive trademarks in Section 2(a) was left unchanged: no deceptive mark, geographic or not, could attain registration.¹³⁵

It was not until 2003 that the Federal Circuit declared that the NAFTA Implementation Act of 1993 had made a substantive change in the law. In *In re California Innovations*, the Federal Circuit held that the Board had been applying an outdated standard to determine whether marks were primarily geographically deceptively misdescriptive.¹³⁶ The applicant, a company based in Canada, had applied to register CALIFORNIA INNOVATIONS for thermal insulated bags and wraps. The Board had upheld an examining attorney's refusal to register on the ground that the mark was primarily geographically deceptively misdescriptive. The Federal Circuit vacated that decision, holding that NAFTA had raised the bar and now the law required a showing that the geographic association was material to a consumer's decision to purchase.

The court explained that, due to the NAFTA changes, the USPTO now had to deny registration under Section 2(e)(3) (the new location of "primary geographic deceptive misdescriptiveness") if (1) the primary significance of the mark was a generally known geographic location, (2) consumers were likely to believe that location was the origin of the goods and the goods did not come from that location *and* (3) the misrepresentation was a material factor in the consumer's decision.¹³⁷ The court concluded:

[T]he relatively easy burden of showing a naked goods-place association without proof that the association is material to the consumer's decision is no longer justified To ensure a showing of deceptiveness and misleading[ness] before imposing the penalty of non-registrability, the PTO may not deny registration without a showing that the goods-place association made by the consumer is material to the consumer's decision to purchase those goods. This addition of a materiality inquiry equates this test with the elevated standard applied under § 1052(a). . . . This also properly reflects the presence of the deceptiveness criterion often

134. See *In re California Innovations, Inc.*, 329 F.3d 1334, 1337 (Fed. Cir. 2003).

135. 15 U.S.C. § 1052(a).

136. *California Innovations*, 329 F.3d at 1337.

137. *Id.* at 1339.

overlooked in the “primarily geographically deceptively misdescriptive” provision of the statute.¹³⁸

And the court remanded the case to the Board to apply the new three-pronged standard.

But is the materiality standard appropriate under NAFTA and the NAFTA Implementation Act? NAFTA required the United States to refuse to register a mark “containing or consisting of a geographical indication with respect to goods that do not originate in the indicated territory, region or locality, *if use of the indication in the trademark for such goods is of such a nature as to mislead the public as to the geographical origin of the good.*”¹³⁹ The Agreement defined a “geographical indication” as “any indication that identifies a good as originating in the territory of a Party, or a region or locality in that territory, where a particular quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”¹⁴⁰

Thus, under NAFTA, where the reputation or quality of a certain good is attributable to its geographical origin, the United States cannot register a mark containing that location if it would mislead the public as to the geographical origin of goods sold under that mark. The NAFTA Implementation Act took this directive and simply provided that primarily geographically deceptively misdescriptive marks could no longer be registered.

Let us parse this out using an example. The U.S. state of Georgia is known for its luscious peaches. GEORGIA is a geographic indication where the reputation and high quality of peaches is attributable to it. The U.S. must refuse to register a mark containing or consisting of GEORGIA for peaches that do not originate in Georgia if use of that indication would mislead the public as to where the peaches came from. The questions to be asked are: (1) Is the reputation or quality of a product attributable to a particular geographic location? (2) Does use of that geographic location in a trademark mislead the public into believing that goods sold under that mark come from there, when in fact they do not? So, say, GEORGIA SWEET for peaches that did not come from Georgia would almost certainly be unregistrable under this standard.

Remember, “materiality” in a deceptiveness determination means that the misdescription makes the product or service more appealing to purchasers.¹⁴¹ Deceptive marks pass products and services off as something better than they actually are. NAFTA did not, by its terms, require the public to find the indication in the

138. *Id.* at 1340.

139. NAFTA, art. 1712(1)(a) (emphasis added).

140. NAFTA, art. 1721.

141. *See* § III[B][3][a] *supra*.

trademark to be material in a purchasing decision in this sense. It only required that the geographic mark signal a certain reputation or quality of the goods and mislead the public as to the goods' geographic origin.¹⁴² It did not require that the misleading information cause consumers to act in a certain way or make a product or service appear more desirable.

The *California Innovations* court nevertheless took the NAFTA Implementation Act to have changed the meaning of "primarily geographically deceptively misdescriptive" to require the higher showing of deceptiveness required by Section 2(a) because both types of marks were not registrable. It reasoned that its "addition of a materiality inquiry equates this test with the elevated standard applied under § 1052(a)."¹⁴³ In the end, however, the court's analysis simply duplicated what was already in Section 2(a) and did not follow the provisions of NAFTA.

Fortunately, as we shall see, the USPTO's determination of materiality focuses on the reputation of the geographic origin for the goods at issue, as NAFTA did.¹⁴⁴ It infers materiality from whether the geographic location is famous for the goods covered by the mark. While having to make a mental leap from fame to materiality may not be ideal, the reputation of the goods and the misleadingness of the mark should suffice under NAFTA to refuse registration of the mark.

d. "Substantial Portion of Relevant Consumers" Standard Made Explicit in 2009

In *In re Spirits International*, the Board had held that use of the mark MOSKOVSKAYA for vodka was primarily geographically deceptively misdescriptive.¹⁴⁵ It found that Russian is spoken by 706,000 people in the United States, equivalent to .25% of the population, and assumed that, because the misdescription would be relevant to that "appreciable number" of people, it was material to consumers' decisions to purchase the products.

In reversing, the Federal Circuit held in 2009 that the Board had failed to consider whether those Russian speakers were themselves a substantial portion of the intended audience for the product. If only a quarter of one percent of the population was

142. See Robert Brauneis & Roger E. Schechter, *Geographic Trademarks and the Protection of Competitor Communication*, 96 TMR 782, 833 (2006) ("We conclude, contrary to Federal Circuit case law, that Congress did not add a materiality test to the conditions for a mark to be classified as [primarily geographically deceptively misdescriptive]. Rather, it seems clear that its 1993 action permanently barred from registration all geographic marks that give rise to an inaccurate goods-place association.").

143. *California Innovations*, 329 F.3d at 1340.

144. See § III[C][4][c] *infra*.

145. *In re Spirits Int'l*, N.V., 86 U.S.P.Q.2d 1078 (T.T.A.B. 2008), *rev'd*, 563 F.3d 1347 (Fed. Cir. 2009).

deceived, said the appellate court, this number would not be a “substantial portion” of relevant consumers and the public’s belief in the misdescription would not be material. (After remand to the USPTO, the mark was soon approved for publication and the applicant has received several extensions of time to file a statement of use.¹⁴⁶)

4. Analysis of the USPTO’s Test for Primarily Geographically Deceptive Misdescriptiveness

a. Primarily Geographical

First, the mark must be *primarily geographical*, meaning that the public would foremost associate the mark with a particular physical location. As the TMEP puts it, a mark’s significance is primarily geographical “if it identifies a real and significant geographic location and the primary meaning of the mark is the geographic meaning.”¹⁴⁷ Most geographical references are found to be primarily geographical. Even misspelled geographic terms may be considered to be primarily geographical, such as KUBA KUBA, found primarily geographically deceptively misdescriptive for cigars because consumers would associate it with Cuba.¹⁴⁸

There have been some exceptions. Where consumers would not recognize the mark as designating a particular physical location, it cannot be primarily geographically deceptively misdescriptive. For example, the Board allowed registration of TAPATIO for hot sauce not made in Guadalajara because the geographical significance of the term as meaning a native of Guadalajara was so obscure as to make it, in effect, an arbitrary mark.¹⁴⁹ It found O-TOWN to be too obscure a reference to Orlando, Florida to be seen as a particular geographic reference.¹⁵⁰ In another case, the Federal Circuit found Vittel, a small town in the French Alps, to be similarly obscure in allowing registration of VITTEL for cosmetics and skin care

146. Ser. No. 74382759.

147. TMEP § 1210.02.

148. *In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011).

149. *ConAgra, Inc. v. Saavedra*, 4 U.S.P.Q.2d 1245 (T.T.A.B. 1987). *See also In re Wada*, 194 F.3d at 1300 (“A mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods. Thus, a mark with a geographic term used fancifully or arbitrarily may be registered like any other fanciful or arbitrary mark.”) (citation omitted); *In re Eastwood*, 2000 TTAB LEXIS 47 (T.T.A.B. 2000) (nonprecedential) (allowing registration of TEHAMA for audio recordings, watches, handbags, and apparel; though Tehama is a city in California, there was “no evidence indicating that the general public would understand TEHAMA as an indicator of geographic origin or that they would be aware of the geographic town or county named ‘Tehama’”); *In re Application of Brauerei Aying Franz Inselkammer KG*, 217 U.S.P.Q. 73 (T.T.A.B. 1983) (reversing refusal to register AYINGER BIER for beer; finding that Aying is a small, obscure German town not known to Americans).

150. *In re Trans Cont’l Records, Inc.*, 62 U.S.P.Q.2d 1541 (T.T.A.B. 2002).

products.¹⁵¹ The Ninth Circuit allowed registration of DUTCH BOY for paint not made in Holland because the word “Dutch” was used “in a fictitious, arbitrary and fanciful manner.”¹⁵² And the Federal Circuit found that consumers would see Chablis as the generic name for a type of wine rather than a reference to a region in France, affirming the Board’s dismissal of an opposition to registration of CHABLIS WITH A TWIST for citrus-flavored wine.¹⁵³

Why “primary” significance? This language is similar to that related to surnames, where a mark that is “primarily merely a surname” is only registrable upon a showing of acquired distinctiveness.¹⁵⁴ There, the “primarily” restriction allows for registration of marks that may be surnames, such as BIRD or KING, whose chief significance is not that of a personal name. With geographic marks, there may be a geographic significance that is not primary, as with marks that are literally a geographic location, but the physical place may not be their main significance to the public, such as GLOBAL or HOLLYWOOD.¹⁵⁵

b. Misdescriptive Goods/Place or Services/Place Association

Second, the purchaser must be *likely to associate the goods or services with the physical location*, what the USPTO calls a “goods/place association,”¹⁵⁶ and the goods must not actually come from that location.

The following goods and services have, for example, been found associated with the accompanying places: New York and clothing,¹⁵⁷ New York and luggage,¹⁵⁸ Paris and clothing,¹⁵⁹ Paris

151. *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957 (Fed. Cir. 1987).

152. *National Lead Co. v. Wolfe*, 223 F.2d 195, 199 (9th Cir. 1955).

153. *Institut Nat'l des Appellations d'Origine v. Vintners Int'l Co.*, 958 F.2d 1574 (Fed. Cir. 1992).

154. 15 U.S.C. § 1052(e)(4). See 1 Gilson on Trademarks § 2.03[4][d][iv] for more on federal registration of personal names.

155. TMEP § 1210.02(a), (b).

156. TMEP § 1210.04.

157. *In re Perry Mfg. Co.*, 12 U.S.P.Q.2d 1751 (T.T.A.B. 1989).

158. *In re Wada*, 194 F.3d 1297 (Fed. Cir. 1999).

159. *In re Miracle Tuesday, LLC*, 2011 TTAB LEXIS 32 (T.T.A.B. 2011) (nonprecedential) (rejecting design mark with JPK PARIS 75 for sunglasses, wallets, handbags, suitcases, belts and shoes); *In re Arley B. de Paris, Inc.*, 2001 TTAB LEXIS 202 (T.T.A.B. 2001) (nonprecedential) (“We . . . find that there is a goods/place relationship between Paris and clothing inasmuch as Paris is an international fashion center. . . . [I]t is clear that potential customers are likely to believe that clothing bearing the phrase ‘de Paris’ or its English equivalent originates in Paris.”) (denying registration to ARLEY B. DE PARIS for clothing not made in Paris).

and bread,¹⁶⁰ Napa Valley and food,¹⁶¹ Spain and citrus fruits,¹⁶² Venice for “glass, lace, art objects, jewelry, cotton and silk textiles, printing and publishing,”¹⁶³ and Monaco and hotels.¹⁶⁴

On the other hand, the Board found insufficient evidence to show a connection between empty cosmetic bags and London, Soho, or New York and allowed registration of LONDON SOHO NEW YORK for those goods.¹⁶⁵ Similarly, the Board allowed registration for COOPERSTOWN for restaurant services to be provided outside of Cooperstown, New York where the examining attorney did no more than show that there were restaurants in Cooperstown.¹⁶⁶ The Federal Circuit also found a lack of evidence demonstrating that consumers in New York City dining at LE MARAIS restaurant would associate those services with the LE MARAIS neighborhood in Paris.¹⁶⁷

The second element of this factor is that the goods or services *do not originate from that location*. The question of whether the goods come from the named location or not is generally not controversial.

As described above,¹⁶⁸ the goods/place requirement came into existence in 1982. In *In re Nantucket*, the court held that the Board must consider the public’s association of goods with a

160. *In re Paris Croissant Co.*, 2007 TTAB LEXIS 415 (T.T.A.B. 2007) (nonprecedential) (“The evidence of record in this case clearly establishes that consumers would identify Paris as a known source for the goods identified in applicant’s application as ‘bread,’ a term which encompasses baguettes.”) (denying registration to PARIS BAGUETTE with design for sandwiches, ice cream, cakes, bread, green tea and others, none of which come from Paris).

161. *In re Napa Valley Foods, Inc.*, 2011 TTAB LEXIS 52 (T.T.A.B. 2011) (nonprecedential) (refusal to register NAPA FOODS for various food items not made in Napa Valley); *In re Beaverton Foods, Inc.*, 84 U.S.P.Q.2d 1253 (T.T.A.B. 2007) (refusal to register NAPA VALLEY MUSTARD CO. for mustard made in Oregon).

162. *In re BrandMark LLC*, 2007 TTAB LEXIS 320 (T.T.A.B. 2007) (nonprecedential) (“Inasmuch as Spain is a major producer and exporter of fruit and fruit-based products, potential purchasers are likely to believe that the goods originate in Spain.”) (denying registration to ESPANA GROVE for fruit-based beverages not made in Spain).

163. *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1354-55 (Fed. Cir. 2001).

164. *In re Kimpton Hotel & Restaurant Gp., Inc.*, 55 U.S.P.Q.2d 1154 (T.T.A.B. 2000) (holding that “this record demonstrates a reasonable basis for concluding that consumers encountering applicant’s HOTEL MONACO hotel services will mistakenly believe that those services have their origin in Monaco, or are otherwise related in some way to a hotel or hotels located there”) (denying registration for HOTEL MONACO not located in the principality of Monaco).

165. *In re Conair Corp.*, 2011 TTAB LEXIS 14 (T.T.A.B. 2011) (nonprecedential).

166. *In re Municipal Capital Mkts. Corp.*, 51 U.S.P.Q.2d 1369 (T.T.A.B. 1999).

167. *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 1374 (Fed. Cir. 2003) (“[A] services-place association in a case dealing with restaurant services, such as the present case, requires a showing that the patrons of the restaurant are likely to believe the restaurant services have their origin in the location indicated by the mark.”).

168. See § III[C][3][a] *supra*.

particular area in deciding whether a mark was primarily geographically deceptively misdescriptive.¹⁶⁹ There, the court held:

As the courts have made plain, geographically deceptive misdescriptiveness cannot be determined without considering whether the public associates the goods with the place which the mark names. If the goods do not come from the place named, and the public makes no goods-place association, the public is not deceived and the mark is accordingly not geographically deceptively misdescriptive.¹⁷⁰

The *Nantucket* court focused improperly on whether customers are *deceived*. The goods/place analysis is analogous to the plausibility requirement for deceptively misdescriptive and deceptive marks. As with those marks, the focus should not be on deception, but instead on whether the mark is distinctive. The issue relevant to this factor is whether a mark like LONDON LONDON would be descriptive of clothing if it came from London. The court even cited two earlier cases that *did* properly focus on distinctiveness.¹⁷¹ And in fact, the *Nantucket* court recognized that the Restatement of Torts from 1938 had recognized that “arbitrary or fanciful geographic terms may serve as trademarks, and that public association is determinative of arbitrariness or fancifulness.”¹⁷²

c. Material Factor in the Purchasing Decision of a Substantial Portion of Relevant Consumers

Third and finally, the misdescription must be a *material factor in the purchasing decision of a substantial portion of relevant consumers*.¹⁷³ In order to determine materiality of geographic marks in cases involving goods, the USPTO looks to purchasers’ “probable reaction . . . to a particular geographical term when it is applied to particular goods.”¹⁷⁴ Assuming the other parts of the test have been met and the purchasers have made a goods/place

169. 677 F.2d 95, 99-101 (C.C.P.A. 1982).

170. *Id.* at 99.

171. *Id.*, citing *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 486 (5th Cir. 1971) (“[I]f there be no connection of the geographical meaning of the mark with the goods in the public mind, that is, if the mark is arbitrary when applied to the goods, registration should not be refused under § 2(e)(2).”); *National Lead Co. v. Wolfe*, 223 F.2d 195, 199 (9th Cir. 1955) (“[T]here is no likelihood that the use of the name ‘Dutch’ or ‘Dutch Boy’ in connection with the appellant’s goods would be understood by purchasers as representing that the goods or their constituent materials were produced or processed in Holland or that they are of the same distinctive kind or quality as those produced, processed or used in that place.”).

172. 677 F.2d at 100 n.8.

173. TMEP § 1210.01(b) (stating that “the misrepresentation is a material factor in a significant portion of the relevant consumer’s decision to buy the goods or use the services”). See § III[C][3][d] *supra*.

174. TMEP § 1210.05(c)(i).

association, the examining attorney asks whether the goods are “a principal product of that geographic area,” whether the goods are or are related to the “traditional products” of that geographic area, or whether the geographic area is famous as a source of those goods.¹⁷⁵ Any of these, according to the USPTO, may establish a prima facie case of materiality to a sufficient number of relevant purchasers.

The Board commonly infers that the demonstrated fame of a geographic area for a certain product, such as Cuba for cigars, means that a mark associated with that geographic area would be material in purchasing that product.¹⁷⁶ The Federal Circuit has stated that, for goods, it is proper to infer materiality when the place is well known as a source of the goods at issue.¹⁷⁷ It seems fair to assume that a belief that clothing comes from Paris would be a material factor in buying that clothing, more than a belief that clothing comes from, say, Peoria, Illinois, a city not known for its fashion. An applicant could attempt to introduce evidence that suggests otherwise in any given case.

The Board must be careful, however, not to simply assume that the existence of a goods/place association means that a substantial number of consumers would find the location to be a material reason for purchasing the goods. The factors the Board touts as signaling materiality are essentially those it already has looked at to decide if consumers will associate goods with a particular place: Consumers are likely to believe goods come from a particular place if the goods are a principal product of that place or related to its traditional products, or if the place is well known for those goods, the very factors listed in the TMEP to determine materiality.¹⁷⁸

Simply showing a goods-place association and inferring materiality is insufficient because of the severe consequences of having a mark labeled deceptive. The court in *California Innovations*, which imposed the new materiality factor, declared:

175. TMEP § 1210.05(c)(i).

176. *E.g.*, *In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011) (“In the present case, the evidence is sufficient to establish a reasonable predicate that a substantial portion of relevant consumers would understand that KUBA KUBA refers to Cuba, and thus we may infer from the evidence showing that Cuba is famous for cigars, that a substantial portion of relevant consumers would be deceived.”) (footnotes omitted); *In re Miracle Tuesday, LLC*, 2011 TTAB LEXIS 32 (T.T.A.B. 2011) (nonprecedential) (finding the evidence “sufficient to establish a reasonable predicate that a substantial portion of relevant consumers would understand that the reference to Paris in applicant’s mark refers to Paris, France, and thus we may infer from the evidence showing that Paris is a famous center for design and fashion, that a substantial portion of relevant consumers would be deceived”).

177. *In re Les Halles De Paris J.V.*, 334 F.3d 1371 (Fed. Cir. 2003) (“For goods, the PTO may raise an inference in favor of materiality with evidence that the place is famous as a source of the goods at issue.”).

178. TMEP § 1210.05(c)(i).

The second prong of the test represents the “goods-place association” between the mark and the goods at issue. This test raised an inference of deception based on the likelihood of a goods-place association that did not reflect the actual origin of the goods. A mere inference, however, is not enough to establish the deceptiveness that brings the harsh consequence of non-registrability under the amended Lanham Act. As noted, NAFTA and the amended Lanham Act place an emphasis on actual misleading of the public. . . . [T]he relatively easy burden of showing a naked goods-place association without proof that the association is material to the consumer’s decision is no longer justified¹⁷⁹

The USPTO must require something more than a goods-place association, then. What will that be?

The TMEP explains how the Board determines the difference between consumers making an association between a place and certain goods and consumers finding that association to be material to a purchasing decision:

[T]he Board . . . looks to evidence regarding the probable reaction of purchasers to a particular geographical term when it is applied to particular goods. If the evidence shows that the geographical area named in the mark is sufficiently known to lead purchasers to make a goods/place association, but the record does not show that the relevant goods are a principal product of that geographical area, the deception will most likely be found not to be material.¹⁸⁰

The TMEP draws another possibly unsupportable fine line here: A geographic area may be sufficiently well known for the goods that the public associates them with each other, but not sufficiently well known for the association to be material.

In just one case, the Board found a goods/place association not to be material. It held that VEGAS for playing cards that did not originate in Las Vegas, Nevada was not primarily geographically deceptively misdescriptive.¹⁸¹ There, the goods/place association between playing cards and Las Vegas was found to be “indirect” and “tenuous,” making it easy for the Board to find that the evidence did not show that consumers “are interested in purchasing playing cards that were manufactured or used in Las Vegas.”

179. *California Innovations*, 329 F.3d at 1340. See also *In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011) (holding that a “naked” goods-place association would not be enough to show materiality, but “a strong or heightened” association would be sufficient); *U.S. Playing Card Co. v. Harbro, LLC*, 81 U.S.P.Q.2d 1537 (T.T.A.B. 2006) (“[T]o raise an inference of materiality, opposer must show a ‘heightened’ association between the goods and the geographic location.”) (finding no such heightened association).

180. TMEP § 1210.05(c)(i) (citation omitted).

181. *U.S. Playing Card Co. v. Harbro, LLC*, 81 U.S.P.Q.2d 1537 (T.T.A.B. 2006).

In addition to finding that a place is well known for certain goods, and thus people would want to buy those goods from that place, the Board must determine that the assumed geographic origin of the mark is material *to a substantial portion of the relevant consumers*. It must determine who the relevant consumers are—this may be the entire United States population or may be limited to a much smaller group—and whether a substantial portion of them would find the place to be a material purchasing factor.

A federal district court pointed out that the Board needs to make these additional findings explicit and cannot simply hold that fame of a place for certain goods implies the materiality of that place to a purchasing decision. The case involves an attempt to register a mark related to Cuba for cigars. A bit of background: The Board has rejected several marks for registration that related somehow to Cuba for cigar or cigar-related goods that did not come from Cuba: KUBA KUBA for cigars and cigar-related goods,¹⁸² HAVANA TIME for tobacco and related items¹⁸³ and HAVANA CLUB for cigars.¹⁸⁴ Also rejected were YBOR GOLD for cigars and tobacco¹⁸⁵ and HAVANA SELECT, HABANA CLASICO, OLD HAVANA, HAVANA PRIMO and HAVANA CLIPPER for rum or rum drinks not from Cuba.¹⁸⁶ One representative opinion notes: “The evidence establishes that consumers of tobacco products highly value such products from Havana, Cuba. Accordingly, we conclude that the misrepresentation in the HAVANA TIME mark will be a material factor in the consumer’s decision to purchase the identified tobacco products.”¹⁸⁷

In this case, the Board originally refused registration for GUANTANAMERA for cigars on the ground that the mark was primarily geographically deceptively misdescriptive.¹⁸⁸ The Board had found that the mark referred to Guantanamo, Cuba and that the Florida-based applicant did not produce the cigars in Cuba. It also predictably found the misdescription to be material. The court

182. *In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011).

183. *In re G&R Brands*, 2010 TTAB LEXIS 241 (T.T.A.B. 2010) (nonprecedential).

184. *Corporacion Habanos S.A. v. Anncas Inc.*, 88 U.S.P.Q.2d 1785 (T.T.A.B. 2008).

185. *In re South Park Cigar, Inc.*, 82 U.S.P.Q.2d 1507 (T.T.A.B. 2007) (“This evidence suffices to establish the requisite ‘reasonable predicate’ for concluding that the relevant purchasing public is likely to make an association between cigars and Ybor City, *i.e.*, that they are likely to regard Ybor City as a ‘known source’ for cigars.”).

186. *In re Bacardi & Co. Ltd.*, 48 U.S.P.Q.2d 1031 (T.T.A.B. 1997).

187. *In re G&R Brands*, 2010 TTAB LEXIS 241 (T.T.A.B. 2010) (nonprecedential). *See also, e.g., In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011) (evidence submitted by the examining attorney “establishes not only that tobacco and cigars are produced in Cuba, but that cigars are an important product of Cuba, that Cuba is known for high quality tobacco and that Cuba is known for and famous for its cigars”).

188. *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 86 U.S.P.Q.2d 1473 (T.T.A.B. 2008).

agreed that the consuming public was likely to believe that the cigars originated in Cuba, but ruled that the Board erred in its analysis of the materiality factor.

The federal court remanded the case to the Board, comparing the case to *In re Spirits* and noting the “substantial portion” standard: “*Spirits* plainly demands more than a finding of Cuba’s reputation for high quality cigars,” the court found.¹⁸⁹ The Board had issued its opinion before the Federal Circuit’s opinion in *In re Spirits*, so had not had the benefit of the new “substantial portion” test. “In *Spirits*,” reasoned the court, “Moscow’s renown [sic] reputation for vodka was not enough to affirm the TTAB’s legal conclusion; likewise, Cuba’s renown [sic] reputation for cigars is not enough in this case.”

On remand, the Board went on to find “ample evidence” that a significant portion of consumers would be materially influenced by the geographic meaning of applicant’s mark in their decision to purchase cigars.¹⁹⁰ It first found that Spanish speakers are a substantial portion of the U.S. population and are a substantial portion of the intended purchasers of applicant’s cigars. It noted the district court’s ruling that Cuba’s reputation for cigars was insufficient to show materiality, but found that opposer’s evidence indirectly demonstrated materiality in addition to renown. The Board described advertisements for cigars that emphasized associations with Cuba and “suggest that Cuban cigar products are the standard against which certain merchants of non-Cuban cigars compare their products.” It also cited an expert report stating that cigar merchants refer to and evoke Cuba in order to highlight characteristics of their cigars that will help them to sell their goods. In sum, opposer had shown that those who sell non-Cuban cigars in the United States market those cigars “through branding and marketing associations with Cuba because they believe that consumers value associations with Cuba in making purchasing decisions.” Therefore, the association with Cuba suggested by the mark was material to consumers’ purchasing habits.

A Board opinion in a different case, refusing to register KUBA KUBA for cigars not made in Cuba, took issue with the district court’s holding in the *Guantanamera* case.¹⁹¹ It declared that it read *Spirits* as allowing “an inference of deception if the place named by the foreign language term is famous for the goods.” However, the federal court had made an important point. The Board, even with its limited fact-finding ability, must ask whether a substantial portion of relevant consumers will find the goods’

189. *Guantanamera Cigar Co. v. Corporacion Habanos, S.A.*, 729 F. Supp. 2d 246 (D.D.C. 2010).

190. *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 U.S.P.Q.2d 1085 (T.T.A.B. 2012).

191. *In re Jonathan Drew, Inc.*, 97 U.S.P.Q.2d 1640 (T.T.A.B. 2011).

geographic origin material. Perhaps the fame of the area will make the answer clear, but the Board must go further than a finding of fame and ask who the relevant consumers are and whether the seeming origin of the goods would be material to a substantial portion of them.

Finally, a services/place association is treated differently from a goods/place association. For restaurant services, for example, a consumer in Seattle is not going to believe that the local restaurant SHANGHAI DELIGHT is actually located in Shanghai.¹⁹² Thus, the Federal Circuit has held that, to raise an inference of materiality for a service mark, the USPTO has to show “some heightened association between the services and the relevant geographic denotation.”¹⁹³

In the COLORADO STEAKHOUSE case, the Board found that the evidence “clearly establishe[d]” that Colorado was known for its steaks and the public was aware of a connection between Colorado and “high quality steak.” It found this to be “a very strong services-place association” and a “heightened association.” The Board therefore refused registration of the mark, for restaurant services, as primarily geographically deceptively misdescriptive, finding that customers would patronize the restaurant because they believed the food came from Colorado.¹⁹⁴

This idea of requiring a “heightened” or “particularly strong” association for services seems odd. The Federal Circuit held that “a services-place association in a case dealing with restaurant services . . . requires a showing that the patrons of the restaurant are likely to believe the restaurant services have their origin in the location indicated by the mark.”¹⁹⁵ In what sense is this association “heightened” rather than just an association? Perhaps instead of looking for a “heightened” association, the Board should ask if consumers would believe a services-place association to be *plausible*, such as whether the Colorado Steakhouse could have sold steak from Colorado. Then it should ask whether such an association would, if true, lead consumers to seek out that particular service. This analysis, parallel to that of deceptive marks, seems more apt for the question of the materiality of services.

192. See *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 870-72 (9th Cir. 2002) (finding disputed issues of fact over whether plaintiff was using a primarily geographically deceptively misdescriptive service mark; “Because Japan Telecom can only perform its services in person and on customer premises, it is hard to see how a reasonable customer could conclude that the technician installing his new phone wiring just came off a jet from Tokyo, equipped with the very latest in Japanese wiring know-how.”).

193. *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 1374 (Fed. Cir. 2003).

194. *In re Consolidated Specialty Restaurants, Inc.*, 71 U.S.P.Q.2d 1921 (T.T.A.B. 2004).

195. *In re Les Halles*, 334 F.3d at 1374.

IV. SECTION 43(a) PROHIBITION OF FALSE OR MISLEADING REPRESENTATIONS

Section 43(a) of the Lanham Act is the core of legal protection for those injured by false advertising.¹⁹⁶ Section 43(a)(1)(B) protects specifically against false or misleading representations:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . .

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.¹⁹⁷

Courts have applied this language to a wide variety of written, visual and aural commercial conduct that contains a “false or misleading description of fact, or false or misleading representation of fact.”

Deceptive trademarks—geographic and non-geographic—are actionable under Section 43(a), if used in commerce.¹⁹⁸ The claim is not a common one, but it has been made and has succeeded, and is clearly covered by the statutory language.

By definition, deceptive marks are false or misleading as to the nature or origin of the goods. In a successful false advertising claim, the statement at issue must involve the “nature, characteristics, qualities or geographic origin” of the goods or services.¹⁹⁹ This requirement is similar to the requirement in deceptive misdescriptiveness refusals, that the mark must plausibly describe a quality or ingredient of the goods or services and that the description must be false. Literal falsehoods are actionable without proof of public reaction, as essentially *per se* false advertising, but a party claiming that representations are misleading or “implied falsehoods” must show proof of consumer deception.²⁰⁰

196. See 2 Gilson on Trademarks § 7.02[6].

197. 15 U.S.C. § 1125(a)(1)(B).

198. See 2 Gilson on Trademarks § 7.02[6][g]; J. Shahar Dillbary, *Trademarks as a Media for False Advertising*, 32 Cardozo L. Rev. 327, 328 (2009) (“[F]alse advertising using a descriptive mark . . . gives competitors a private cause of action under section 43(a)(1)(B) of the Trademark (Lanham) Act.”).

199. 15 U.S.C. § 1125(a)(1)(B). See 2 Gilson on Trademarks § 7.02[6][b][i][C].

200. See *id.* at § 7.02[6][b][i][A].

Trademarks that themselves constitute false advertising under Section 43(a) must convey a statement that is material to purchasing decisions, and the proof must demonstrate that a substantial portion of the relevant consumers were misled.²⁰¹ But they might instead be nonactionable puffery: over-the-top, nonfactual salesmanship that is assumed to be immaterial to consumers' decision to purchase.²⁰² A mark like AMERICA'S BEST PASTA might be literally misdescriptive, but not plausibly so, and such marks are most similar to suggestive marks.²⁰³

When Gold Seal Company applied to register the mark GLASS WAX, a glass and metal cleaner that did not contain wax, S.C. Johnson & Son opposed the application, which was denied. In 1955, a federal district court found that the mark was descriptive and, as there had been no showing of acquired distinctiveness, it was unregistrable.²⁰⁴ S.C. Johnson sought to enjoin Gold Seal's use of the phrase, invoking Section 43(a). The court found that Section 43(a) was intended to stop "wrongful diversion of trade resulting from false description of one's products," but that in that case S.C. Johnson had failed to show it was likely to be damaged by any false description or representation.

In addition, a federal district court in 1959 found that a party had stated a claim under Section 43(a) that NORMINK, for apparel not made of mink, was a false description or representation.²⁰⁵ The court denied plaintiff's motion for summary judgment, however, finding that there were issues of fact that required a trial, including the issue of whether the public was likely to be deceived. A federal district court in 1964 found the use of MOTEL for restaurant and private club services to violate Section 43(a), holding that "defendants' use of the word 'motel' with the trade name 'Travelodge' is a misrepresentation on the services rendered by defendants' establishment. This misrepresentation entitles the plaintiff to the relief sought."²⁰⁶

More recently, the Seventh Circuit found that RICELYTE for an oral electrolyte solution violated Section 43(a) because it falsely

201. *E.g.*, *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1355 (Fed. Cir. 2009) ("The courts have . . . recognized a proportionality requirement for materiality in false advertising cases, requiring that a substantial portion of the audience be deceived.").

202. For more on puffery, see 2 Gilson on Trademarks § 7.02[6][b][iii][B].

203. See *American Italian Pasta Co. v. New World Pasta Co.*, 371 F.3d 387 (8th Cir. 2004) (finding that phrase not actionable because it was puffery and an unverifiable statement of opinion).

204. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom.* *S. C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir. 1956) (*per curiam*).

205. *Mutation Mink Breeders Ass'n v. Lou Nierenberg Corp.*, 120 U.S.P.Q. 270 (S.D.N.Y. 1959).

206. *Travelodge Corp. v. Siragusa*, 228 F. Supp. 238 (N.D. Ala. 1964), *aff'd per curiam*, 352 F.2d 516 (5th Cir. 1965) and citing *Mutation Mink Breeders*, 120 U.S.P.Q. 270.

conveyed the message that the product contained rice.²⁰⁷ And the Third Circuit reversed a lower court's refusal to enjoin the use of BREATHASURE, holding that the mark violated Section 43(a) because "[t]he name falsely tells the consumer that he or she has assurance of fresher breath when ingesting one of the defendant's capsules. That is not true."²⁰⁸

V. ROLE OF THE CONSUMER

Along with the USPTO and the courts, the consumer obviously plays a role in determining whether a mark is deceptively misdescriptive, deceptive or false. A consumer understands certain information about products and services when she encounters them in the marketplace that may keep her from being deceived.

Where the USPTO has more information than the consumer, it performs an extremely useful function in refusing to register deceptively misdescriptive or deceptive marks. Consumers will not immediately know or easily discover if ORGANIC ASPIRIN dietary supplements are actually organic or contain aspirin, or if SYRUP OF FIGS contains figs. For all a purchaser knows, soft, glossy clothes sold under the SILKEASE brand may be made of silk. And surely some consumers could believe that HAVANA TIME cigars available in the U.S. were made in Cuba, despite the trade embargo with that country.

A USPTO examining attorney can investigate the relationship between the goods and the mark and prevent deception by refusing registration to misleading marks. Where customers would have to look carefully at accompanying labels, if any, to know that the goods were not what they purported to be, the mark may well be misdescriptive or deceptive.²⁰⁹ The SUPER SILK mark, for instance, was correctly denied registration because consumers buying clothing sold under that name might not check the label to determine the real fiber content and realize the garment did not

207. *Abbott Labs v. Mead Johnson & Co.*, 971 F.2d 6, 14 (7th Cir. 1992). *See also* *Kraft Gen'l Foods, Inc. v. Del Monte Corp.*, 28 U.S.P.Q.2d 1457 (S.D.N.Y. 1993) (finding GELATIN SNACKS violated the Lanham Act by falsely identifying gelatin as an ingredient).

208. *Warner-Lambert Co. v. Breathasure, Inc.*, 204 F.3d 87, 97 (3d Cir. 2000). *See also* *Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharms. Co.*, 129 F. Supp. 2d 351, 364 (D.N.J. 2000) ("[T]he product name, Mylanta 'Night Time Strength,' necessarily implies a false message: it falsely represents that it possesses a quality that is particularly efficacious for those suffering from heartburn at night. But that is not true.") (finding a violation of Section 43(a)), *aff'd*, 290 F.3d 578 (3d Cir. 2002).

209. TMEP § 1209.04 ("The mere fact that the true nature of the goods or services is revealed by other matter on the labels, advertisements, or other materials to which the mark is applied does not preclude a determination that a mark is deceptively misdescriptive.").

include silk.²¹⁰ Such marks are misdescriptive, rather than arbitrary.

On the other hand, when consumers have the same information as the USPTO, they should be far less likely to be deceived. Consumers can, for example, see for themselves whether the hypothetical VENETIAN NIGHTS, the restaurant in which they are enjoying spaghetti carbonara, is actually located in Venice, Italy. The TMEP specifies that federal law “does not prohibit the registration of misdescriptive terms unless they are deceptively misdescriptive, that is, unless persons *who encounter the mark, as used on or in connection with the goods or services in question*, are likely to believe the misrepresentation.”²¹¹ It is at the time consumers encounter the mark, then, that deception is measured. If circumstances are such that they will know the true features of the goods when they encounter the mark, the mark should not be found to be deceptive or deceptively misdescriptive.

This ability to perceive the truth about the goods or services may not save many marks from rejection, however. The TMEP gives the following advice to examining attorneys making refusals on the basis of deceptiveness under Section 2(a):

The argument that there is no deception because consumers will immediately discern the true nature of the goods and/or services when they encounter them is not persuasive. Deception can attach prior to seeing or encountering the goods or services, for example, based on advertising over the radio or Internet or via word of mouth.²¹²

The concern here is that consumers will encounter the *trademark* before they encounter the *products or services* connected to it, and at that point they may be misled about characteristics of the products or services.

In some circumstances, this seems like a fair generalization. The Board was probably correct when it affirmed a deceptive misdescriptiveness rejection of luxury clothing retailer Brooks Brothers’ mark BLACK FLEECE for “belts; blouses; boots; bottoms; coats; dresses; evening dresses; gloves; hats; hosiery; jackets; men’s suits, women’s suits; mufflers; neckties; pants; rainwear; scarves; shirts; shoes; shorts; skirts; socks; suits; suspenders; sweaters; ties; tops; trousers; and vests” that were not made of fleece.²¹³ It found, first, that “BLACK FLEECE clearly

210. *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047 (T.T.A.B. 2002) (“That applicant’s dress shirts and sports shirts made of silk-like fabric will disclose, when marketed under the term ‘SUPER SILK,’ the fact that the fabric from which such goods are manufactured is not genuine silk is . . . irrelevant and immaterial.”).

211. TMEP § 1209.04 (emphasis added).

212. TMEP § 1203.02(f)(ii).

213. *In re Retail Brand Alliance, Inc.*, 2011 TTAB LEXIS 306 (T.T.A.B. 2011) (nonprecedential). Brooks Brothers registered GOLDEN FLEECE on August 1, 1995, for

describes a type of clothing, and applicant's identification of goods states that its clothing is not of that type." Second, based on evidence from the examining attorney that clothing of the kind in the application is available from other retailers in actual black fleece, the Board found that "customers are likely to believe that BLACK FLEECE misdescribes the identified goods." The Board concluded, weakly, that not all clothing items are purchased with care and perhaps "ordinary purchasers with sufficient funds . . . regardless of their level of sophistication or familiarity with applicant and its goods and trademarks" might purchase them from a catalog or the Internet without first examining them. According to the Board, "catalogs and Internet postings do not necessarily describe or depict goods in such detail as to prevent consumers from believing that the goods are made of fleece."

True, it is difficult to believe that many people shopping for these luxury goods would find it plausible that these shirts or dresses are made from fleece of any color. Evidence that some other retailers sell fleece jackets, coats and pants does not mean that someone purchasing a business suit at Brooks Brothers will believe it to be made out of fleece. However, someone looking at a print ad for BLACK FLEECE that does not show the whole collection or hears someone talking about the new BLACK FLEECE clothes at Brooks Brothers could believe that the goods were made of black fleece. Some items in the collection are made of black fabric and people shopping over the Internet might not be able to tell that they were not made of black fleece. Because it was a deceptive misdescriptiveness refusal, Brooks Brothers may be able to register the mark with a stronger showing of acquired distinctiveness than it had made with this application.²¹⁴

In another case, however, the Board took its consumer deception assumption too far by denying registration to CAMEO for earrings, necklaces and bracelets that were not cameos on the ground that the mark was deceptively misdescriptive.²¹⁵ A cameo is a carved object with a raised image of some type, often a face or profile, such as this one:²¹⁶

various articles of clothing. Reg. No. 1980540. The online USPTO records do not go back far enough to discover whether this mark received an office action on the basis of deceptive misdescriptiveness.

214. In fact, after the Board's rejection, Brooks Brothers re-applied to register BLACK FLEECE for the same goods on the principal register, without the limitation "not made of fleece fabric." Ser. No. 85494511. It received an office action on January 5, 2012 that failed to mention the earlier refusal, refusing to register the mark as merely descriptive of the goods. Brooks Brothers also applied after the Board's rejection to register BLACK FLEECE BY BROOKS BROTHERS for the same goods. Ser. No. 85494521. It received an office action on January 5, 2012 from the same examining attorney, requiring a disclaimer of BLACK FLEECE.

215. *In re Woodward & Lothrop, Inc.*, 4 U.S.P.Q.2d 1412 (T.T.A.B. 1987).

216. http://en.wikipedia.org/wiki/File:Cammeo_autunno_med_001.jpg.



In that case, the examining attorney argued that “the fact that the purchaser is actually viewing the goods at or before the time of purchase will not avoid the deception, especially if the purchaser does not know what a cameo looks like.” He also claimed that purchasers would believe the applicant’s jewelry to be cameos because they were called CAMEO, and that a consumer “who is not familiar with cameos may believe that applicant’s goods actually contain cameos.”

Fortunately, the Board did not endorse the examining attorney’s untenable argument that people who did not know what cameos were could be deceived into believing that the goods were actually cameos. The Board did, though, err in dismissing applicant’s persuasive claims that “the reasonably informed consumer examining applicant’s jewelry would easily determine that applicant’s jewelry items are not cameos and that any misdescriptiveness would therefore not likely be believed by the purchaser.” It held instead that “a significant number of purchasers are likely to believe that applicant’s jewelry is cameo jewelry,” reasoning that it might be purchased from catalogs with inadequate descriptions or depictions of the goods, leading “a reasonable consumer” to expect the jewelry to contain cameos.

Realistically, a significant number of consumers would not purchase jewelry without at least seeing an image of what they are buying. While it may be theoretically possible for some people to do so, surely this is not more than a very small percentage of purchasers. The Board’s usual common sense approach to purchaser behavior failed it in this case; any deception would be de minimus.

In another case, the mark MINK BIKINI for various items of apparel, “excluding bikini swimwear, bikini underwear, and all other types of bikini clothing and all clothing made of mink,”²¹⁷ was incorrectly found to be deceptive. MINK BIKINI is an arbitrary mark for dresses, raincoats, hats and hosiery, a sample

217. *In re Closet Clothing Co.*, 2008 TTAB LEXIS 640 (T.T.A.B. 2008) (nonprecedential).

of the goods the applicant sought to register in connection with the mark. The Board found that “[t]he examining attorney’s evidence shows that the mark is not incongruous because bikinis made of mink and other furs are actually available, and have been exposed to the public through celebrities and well-distributed fashion photographs.” The fact that there may be mink bikinis for sale somewhere does not mean that a consumer will think the raincoat she is looking at will contain mink. As applied to the applicant’s goods in this case, the mark is incongruous and arbitrary and thus cannot be deceptive.²¹⁸

One opinion from a federal district court in Missouri got the deceptiveness analysis right.²¹⁹ The plaintiff, a fishing lure manufacturer, claimed rights in BEETLE, BEETLE SPIN, SUPER BEETLE and ORIGINAL BEETLE for fishing lures with a plastic body. It sued other fishing lure manufacturers for infringement, who argued in defense that plaintiff’s mark was either descriptive or deceptively misdescriptive of its product. As the court said, defendants were “apparently contending that . . . the name BEETLE . . . deceives the purchaser of the lure into believing that the lure looks like a natural beetle.” In its descriptiveness analysis, the court concluded that the plaintiff’s lure was not similar to a natural beetle “in either the larval or adult stage.” As for deceptive misdescriptiveness, plaintiff sold its lures inside clear plastic envelopes attached to cards, so that a potential purchaser could plainly see the lure before purchasing it and thus would not be deceived into believing that the lure resembled a natural beetle.

A thorny problem that seems to fall in the middle between BLACK FLEECE and CAMEO is the CAFETERIA case. The Board denied registration on the supplemental register to the mark CAFETERIA for full-service, sit-down restaurants that did not provide cafeteria-style service because it found the mark to be deceptive.²²⁰ It concluded that “at least some potential patrons are quite likely to believe that a restaurant calling itself CAFETERIA meets the common dictionary definition of a ‘cafeteria.’” Prospective patrons might, the Board reasoned, come across the

218. Another problem with this opinion is the Board’s insistence that the applicant did not exclude articles made of other types of fur or fake fur that could be confused with mink from its identification of goods. While this is true, the final office action and the examining attorney’s brief on appeal were not based on the premise that the goods could include any type of fur. In the final office action, the examining attorney clearly states that “the goods are neither bikini garments, nor contain or otherwise utilize fur.” June 25, 2007 Office Action, Ser. No. 76623748. The applicant had made clear in its appeal brief and in a previous response to an office action that its goods contained neither fur nor fake fur. The basis for the refusal was that women, knowing of the existence of mink bikinis, would see the mark “mink bikini” and would be “likely to believe the goods have some fur or faux fur element.” June 25, 2007 Office Action. This assumption goes too far.

219. *Bass Buster, Inc. v. Gapen Mfg. Co.*, 420 F. Supp. 144, 154 (W.D. Mo. 1976).

220. *In re ALP of South Beach, Inc.*, 79 U.S.P.Q.2d 1009 (T.T.A.B. 2006).

restaurant and enter it without having heard or read that it was a sit-down restaurant, and a few prospective customers apparently did have a misimpression of the nature of the services. “We really cannot be sure,” stated the Board, “what portion of prospective consumers, at some point, actually believed the deceptive misdescription.” The Board concluded by finding that prospective patrons would find it material whether the restaurant was actually a cafeteria: “The mere fact that one may have decided to go to applicant’s restaurant in order to patronize a true cafeteria, based solely upon applicant’s choice of a deceptively misdescriptive name for a restaurant, is sufficient to meet . . . the final prong of the . . . test for deceptiveness.”

It may well be true that “at least some potential patrons” would be misled by the mark. Hearing about CAFETERIA through word of mouth could be misleading, as it could be with BLACK FLEECE clothing (though it seems unlikely that someone recommending or mentioning a restaurant called “Cafeteria” would fail to mention that it was not in fact a cafeteria).

If only a few people were likely to hear the trademark alone and in a context where the type of restaurant was unclear, however, that misleadingness should not prevent registration.²²¹ Once encountering the mark and the services, passersby could see that the restaurant was not actually a cafeteria. The majority opinion posited that the applicant could change the exterior of its building to have windows with “smaller apertures having dark-tinted or heavily glazed glass that would make it impossible for prospective patrons to ascertain the set-up of the restaurant’s interior from the sidewalk,”²²² and then purchasers would not be able to observe that the restaurant was not a cafeteria. This bizarre, strained hypothetical pushes the boundaries of common sense.

The dissent in that case asked aptly: “Is there a sound basis in the law for protecting even the most gullible or careless consumer under Section 2(a) of the Act, or does the law require proof that even a reasonably prudent consumer would be deceived?”²²³ If the only people who are misled are those who are unable to tell whether a restaurant is actually a cafeteria, that should not suffice to show that the misdescription is deceptive.²²⁴ When the USPTO

221. See *id.* (Rogers, J., dissenting) (“It is not for this Board to speculate about numerous theoretical patrons who may not have voiced displeasure or misunderstanding, when the result is a permanent bar of registration of a functioning, successful mark.”).

222. *Id.* (majority opinion).

223. *Id.* (Rogers, J., dissenting).

224. Jonathan C. Cohen, *Clearly Descriptive and Deceptively Misdescriptive Trademarks in Canada and the United States and the Role of the Reasonable Man*, 67 TMR 631, 642 (1977) (“[M]any trademarks which are only fanciful or suggestive when viewed from the reasonable man’s point of view may be deceptively misdescriptive to the gullible or ignorant.”).

asks whether purchasers would be likely to believe something to be true, it should be asking whether reasonably prudent purchasers would be likely to do so.²²⁵ Ultimately, this case is such a close one that the Board should have resolved any doubts in favor of the applicant and against permanently barring registration.

Just one more point about the CAFETERIA case: Under the USPTO's standards, personal preference alone is not enough to render a misrepresentation material. The misrepresentation must make the service more desirable, and mere confusion about the services is insufficient. In that opinion, the Board said that "there are features of a cafeteria that some prospective patrons will prefer to those of a table-service restaurant."²²⁶ True, but that conclusion does not mean that a typical cafeteria is objectively better (or worse) than a table-service restaurant. The choice of restaurant seems to be a personal preference and the mark is not passing off the service as something objectively better than it is.

In some cases, simply looking at the identification of goods should enable the USPTO to find the mark not deceptively misdescriptive or deceptive, such as where the mark is arbitrary or suggestive. This would include seeing consumer electronics under the mark APPLE, for example. The Board has said that marks are not deceptively misdescriptive or deceptive where "merely contemplating the involved consumer items . . . would be sufficient to enable a reasonable consumer to draw a correct conclusion about the nature of the . . . products."²²⁷

If the misdescription is simply implausible because it plainly would not apply to the product or service, the mark will not be considered deceptively misdescriptive.²²⁸ For example, the Court of Customs and Patent Appeals, in a pre-Lanham Act decision, found ONE MINUTE for washing machines not deceptive in that it

225. See also, e.g., *In re Shapely, Inc.*, 231 U.S.P.Q. 72 (T.T.A.B. 1986) ("We do not share the Examining Attorney's observation that the degree of gullibility of the reasonably prudent purchaser is not a relevant factor in the determination of deceptiveness. . . . Gullibility, it seems to us, is a significant inquiry in determining whether a misrepresentation is or is not deceptive or deceptively misdescriptive because reasonably prudent purchasers are not apt to believe the misrepresentation."); *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 U.S.P.Q. 169 (T.T.A.B. 1985) ("On this evidence, we do not believe reasonably prudent purchasers are apt to be deceived."); Cohen, *Clearly Descriptive and Deceptively Misdescriptive Trademarks*, 67 TMR at 632 ("[I]t is extremely important to know whether or not the average or reasonable man on the one hand, or the foolish or ignorant man on the other hand would be considered when determining if marks were either clearly descriptive or deceptively misdescriptive.").

226. *In re ALP of South Beach*, 79 U.S.P.Q.2d 1009 (T.T.A.B. 2006).

227. *In re Robert Simmons, Inc.*, 192 U.S.P.Q. 331 (T.T.A.B. 1976). See also *In re Cord Crafts, Inc.*, 11 U.S.P.Q.2d 1157 (T.T.A.B. 1989) (finding that evidence showed that "silk flowers" is "a generic term for all fabric flowers, regardless of the actual fabric used" and allowing registration of SENSATIONAL "SILK" for artificial flowers not made of silk).

228. See Restatement (Third) of Unfair Competition § 14 cmt. c ("If . . . the descriptive connotations of the term are clearly inapplicable to the product, purchasers will likely view the designation as arbitrary or suggestive rather than as a description of the goods.").

would not mislead purchasers into believing that the machine would wash clothes properly in one minute: “[I]n order to understand the meaning intended to be conveyed by appellant’s trade-mark, it would be necessary for one to exercise his powers of perception and imagination, and that, by so doing, he would conclude that the trade-mark was merely intended to convey the idea that appellant’s machines were so constructed that they would wash clothes with celerity.”²²⁹ Similarly, a pre-Lanham Act Second Circuit found that no one would be misled by HOLEPROOF for hosiery, as it is no more than “a boastful and fanciful word.”²³⁰

In the WHITE SABLE case, the Board found that by simply contemplating the goods involved—paint brushes—consumers would be able to draw the correct conclusion that they were not made of sable fur.²³¹ There was evidence in that case that sable brushes are commonly known in that market to be made from the hair of animals other than the sable. While the WHITE SABLE Board noted that the brushes were sold from display racks noting “made with the miracle synthetic brush filament,” a later Board opinion found this statement “of minor significance” to the earlier opinion, holding that, if the mark had been deceptive under Section 2(a), “the information on the display rack could not have transformed it to a nondeceptive designation.”

Even if the identification of goods excludes goods that would be misleading under the mark, the mark could still be misleading to consumers. Merely looking at the goods and services listed in the CAMEO, BLACK FLEECE and CAFETERIA applications would have told a consumer that the mark was inapt for the goods. The CAMEO application was for “jewelry, namely earrings, necklaces and bracelets, not inclusive of cameos or cameo-like elements,” the BLACK FLEECE application was for various clothing items “not made of fleece fabric,” and CAFETERIA was for “restaurants providing full service to sit-down patrons, excluding cafeteria-style restaurants.” Nevertheless, applications whose descriptions exclude goods or services that are, in reality, *plausible* as with BLACK FLEECE may be deceptively misdescriptive or possibly deceptive.

VI. PROPOSALS FOR CHANGE

Having gone through each ground for refusal, let us return to the current language of the Lanham Act. As we have seen, the statutory language is inconsistent and confusing, and could benefit from some reworking.

229. *In re One Minute Washer Co.*, 95 F.2d 517 (C.C.P.A. 1938).

230. *Holeproof Hosiery Co. v. Wallach Bros.*, 172 F. 859, 860 (2d Cir. 1909).

231. *In re Robert Simmons, Inc.*, 192 U.S.P.Q. 331 (T.T.A.B. 1976).

A. “Deceptively Misdescriptive”

Section 2(e)(1) prohibits registration of a mark that “when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them.”²³² Compare “deceptive” in Section 2(a) with “deceptively misdescriptive” in Section 2(e)(1). Under the plain language of the statute, these categories both appear to include marks that are deceptive because they both contain that word. However, as we have seen, marks that are “deceptively misdescriptive” are not, in fact, deceptive.²³³ They are equivalent to descriptive terms, lacking inherent distinctiveness. In order to make the statute reflect how the marks are categorized, the phrase “deceptively misdescriptive” should be changed to “plausibly misdescriptive.”

B. “Primarily Geographically Deceptively Misdescriptive”

The plain language of the phrase “primarily geographically deceptively misdescriptive” in Section 2(e)(3) makes it appear to be a subset of “deceptively misdescriptive” marks in Section 2(e)(1). After the NAFTA amendments in 1993 and the *California Innovations* decision in 2003, however, the words “deceptively misdescriptive” do not mean the same thing in the ban on deceptively misdescriptive marks as they do in the ban on primarily geographically deceptively misdescriptive marks.²³⁴ Now, the phrase “deceptively misdescriptive” in “primarily geographically deceptively misdescriptive” means “deceptive.”²³⁵ Still, the Board holds that the appropriate ground for refusal of deceptive geographic marks is Section 2(e)(3), while all other deceptive marks are to be handled under Section 2(a).²³⁶

232. 15 U.S.C. § 1052(e)(1).

233. See § III[A][1] *supra* and Stephen L. Carter, *The Trouble with Trademark*, 99 Yale L.J. 759, 776 n.67 (1990) (“Without laboring one of the most subtle (and, some say, irrational) aspects of trademark law, ‘deceptively misdescriptive’ marks are not the same as ‘deceptive’ marks, which cannot be registered under any circumstances.”).

234. See § III[C][3][b].

235. See *In re California Innovations, Inc.*, 329 F.3d 1334, 1338 (Fed. Cir. 2003) (“NAFTA and its implementing legislation obliterated the distinction between geographically deceptive marks and primarily geographically deceptively misdescriptive marks.”).

236. *In re South Park Cigar, Inc.*, 82 U.S.P.Q.2d 1507 (T.T.A.B. 2007). See also *California Innovations*, 329 F.3d at 1341-42 (While there are “identical legal standards for deception in each section, subsection (e)(3) specifically involves deception involving geographic marks.”); *In re Style Asia, Inc.*, 2008 TTAB LEXIS 454 n.3 (T.T.A.B. 2008) (nonprecedential) (“The examining attorney has also refused registration under Section 2(a) of the Trademark Act. Because applicant’s mark involves an allegedly deceptive geographic designation, the pertinent ground for refusal in this case is that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3), and not that the mark is deceptive under Section 2(a).”); *In re Paris Croissant Co.*, 2007 TTAB LEXIS 415 (T.T.A.B.

To remedy this confusion, one possibility would be to eliminate Section 2(e)(3) altogether. Separate statutory mention of “primarily geographically deceptively misdescriptive” marks is not necessary because the ban on deceptive marks that happen to be geographic is covered by the ban on deceptive marks in general.²³⁷ As the TMEP makes clear, “the test for determining whether, post-NAFTA, a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a).”²³⁸ Section 2(a)’s bar on registration of deceptive marks has been used to reject geographically deceptive marks and could do so again. Before NAFTA, a mark could be shown to be “geographically deceptive” under Section 2(a) by requiring a showing of materiality for the misdescription. A Federal Circuit case from 1992 so held, though it did not find the mark at issue—CHABLIS WITH A TWIST for wine that did not come from the Chablis region of France—to be deceptive.²³⁹

However, the NAFTA amendments specifically require the United States to prevent, for geographical indications, “the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a territory, region or locality other than the true place of origin, in a manner that misleads the public as to the geographical origin of the good.”²⁴⁰ While it is true that simply refusing registration for deceptive trademarks would do the job, the fact that the NAFTA amendments refer specifically to geographical indications suggests that the Lanham Act provision should make some reference to them as well.

The statute could track NAFTA and prohibit, say, “the use of any geographical indication in a way that misleads the public as to the geographical origin of a good” and also define geographical indication as it is defined in NAFTA.²⁴¹ Using the NAFTA

2007) (nonprecedential) (“Initially, because applicant’s mark involves an allegedly deceptive geographic designation, we deem the pertinent ground for refusal in this case to be that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3), and not that the mark is deceptive under Section 2(a).”).

237. *California Innovations*, 329 F.3d at 1340 (“The amended Lanham Act gives geographically deceptively misdescriptive marks the same treatment as geographically deceptive marks under § 1052(a).”).

238. TMEP § 1210.05(a).

239. *Institut Nat’l Des Appellations D’Origine v. Vinters Int’l Co.*, 958 F.2d 1574 (Fed. Cir. 1992) (“A mark may be established as a geographically deceptive mark under § 2(a) by showing that it is primarily geographically deceptively misdescriptive under § 2(e)(2), and additionally showing that the geographic misrepresentation is material to the decision to purchase the goods so marked.”). In fact, the court agreed with the TTAB that CHABLIS was generic in the U.S. for wine with the characteristics of French chablis.

240. NAFTA, Dec. 17, 1992, art. 1712(1)(a) & (2), 32 I.L.M. 605, 698.

241. NAFTA, art. 1721 (The Agreement defined a “geographical indication” as “any indication that identifies a good as originating in the territory of a Party, or a region or

language would have the advantage of ensuring that the United States complies with its agreement. However, altering the statute to change the standard entirely, and to an apparently weaker standard than is currently used, is at least not the goal of this article. The aim here is to clarify the statutory language and enable courts and the Board to apply familiar standards under provisions that reflect what they actually mean.

Another possibility, then, would be to prohibit registration of marks that are “primarily geographically deceptive.” The word “primarily,” as we have seen, serves to emphasize the requirement that the geographic term appear to the public to be a geographic term and not an obscure, arbitrary term.²⁴² But is it necessary to include that term in the statute? Prospective purchasers would not be likely to believe that an obscure term actually describes the goods and would not find an incongruous connection material to their purchasing decision. For example, *TEBBETTS CHEESY CRACKERS* would not be found to be deceptive even if they did not originate in Tebbetts, Missouri. A court or the Board would not have to be told that *TEBBETTS* was not primarily geographic to the majority of Americans.

“Geographically deceptive” makes clear that the bar applies to marks with a recognizably geographic term that meet the test for deceptive marks. Courts and the Board would know what the phrase means and would be able to apply it seamlessly using post-2003 case law on primarily geographically deceptively misdescriptive trademarks.

C. “On or In Connection With”

Section 2(a) prohibits registration of marks that are scandalous, deceptive or immoral:

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 (a) consists of or comprises immoral, deceptive or scandalous matter²⁴³

In practice, courts and the Board look at marks in these categories as they are used on or in connection with the applicant's goods.²⁴⁴

locality in that territory, where a particular quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”).

242. See § III[C][4][a] *supra*.

243. 15 U.S.C. § 1052(a).

244. See § III[B][1] *supra* and LaLonde & Gilson, *Trademarks Laid Bare*, 101 TMR at 1490, 1492 (“The USPTO declares that it does not analyze whether a mark is per se scandalous. Instead, it considers the mark in the context of the goods or services presented in the application for registration. . . . [‘Scandalous’ and ‘immoral’] bookend the word ‘deceptive,’ a term that is meaningless unless measured against specific goods and services, much like the distinctiveness spectrum that is meaningless out of context.”).

Looking at scandalous or deceptive marks without the context of the goods makes no sense, and the statute should be changed to reflect that reality.

D. Incontestability

As the statute reads now, an incontestable mark may be challenged on the ground that it is deceptive under Section 2(a), *but not* on the ground that it is primarily geographically deceptively misdescriptive under Section 2(e)(3).²⁴⁵ Section 14 of the Act does not mention Section 2(e)(3) in the list of marks that may have a petition to cancel filed against their registrations “[a]t any time.”²⁴⁶ That inconsistency should be remedied, as primarily geographically deceptively misdescriptive marks are no more than deceptive marks that happen to include a geographic term.

E. Grandfather Clause

Section 2(f) contains the following sentence: “Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive, and which became distinctive of the applicant’s goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.”²⁴⁷ The problem here is that, because “primarily geographically deceptively misdescriptive” now means “deceptive,” this clause allows registration of deceptive marks. By contrast, Sections 2(a) and 2(e)(3) prohibit registration of deceptive marks, even with acquired distinctiveness. It is an inconsistency in the law, a loophole that should be closed.

Granted, applications for geographically deceptive marks that became distinctive before December 8, 1993 are probably not pouring into the USPTO. But the Board was, in fact, faced with such a situation in 2007.²⁴⁸ The applicant wanted to register NAPA VALLEY MUSTARD CO. for mustard made in Oregon from mustard seeds that did not originate from Napa Valley. It claimed that the mark had become distinctive before December 8, 1993. The Board upheld the rejection based on Section 2(a) deceptiveness grounds, finding that “the Section 2(f) grandfather clause does not protect those ‘geographically deceptive’ marks that would have been considered unregistrable under Section 2(a) prior to

245. 15 U.S.C. § 1064(3) (“A petition to cancel a registration of a mark . . . may . . . be filed . . . [a]t any time if the . . . registration was . . . contrary to the provisions of . . . subsection (a), (b), or (c) of section 2 for a registration under this Act . . .”).

246. See 15 U.S.C. § 1064(3).

247. 15 U.S.C. § 1052(f).

248. *In re Beaverton Foods, Inc.*, 84 U.S.P.Q.2d 1253 (T.T.A.B. 2007).

NAFTA.”²⁴⁹ It properly interpreted the clause as allowing only registration of marks whose geographic misdescriptiveness was not material to a purchasing decision and thus that could have been registered before the implementation of NAFTA.

However, in a similar case involving a 2(e)(3) refusal only, and *not* a refusal for deceptiveness under 2(a), the Board did consider the applicant’s evidence of acquired distinctiveness.²⁵⁰ The applicant had applied to register OLD HAVANA for rum, with a first use date in 1991. The Board found that the mark might have acquired distinctiveness before December 8, 1993, and held that the 2(f) claim was not barred. It emphasized that the 2(a) refusal had been withdrawn, and if it had not, the 2(f) claim would not have been available to the applicant. Ultimately, the Board found the evidence of acquired distinctiveness insufficient and affirmed the refusal to register.

Section 23(a) of the Lanham Act declares that marks capable of being distinctive but that are not registrable on the principal register may be registered on the supplemental register, excluding, among others, marks unregistrable under Section 2(a) and (e)(3). It, too, contains a grandfather clause similar to the one in 2(f):

Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this Act, that is declared to be unregistrable under section 2(e)(3), if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before the date of enactment of the North American Free Trade Agreement Implementation Act.²⁵¹

This language needs also to be changed because it would allow registration for marks that fall under Section 2(e)(3), which has been deemed to refer to deceptive marks.

F. Proposed Statutory Amendments

This article proposes the following changes to the Lanham Act:

15 U.S.C. § 1052 (Section 2)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused

249. *Id.* (“[T]he purpose of the grandfather clause in Section 2(f) is to allow registration of primarily geographically deceptively misdescriptive marks that would have been eligible for registration under Section 2(f) prior to the NAFTA amendments and not, as applicant’s interpretation would have it, to provide a windfall to applicants seeking to register marks that prior to the NAFTA amendments would have been unregistrable under Section 2(a).”).

250. *In re Compania de Licores Internacionales S.A.*, 2012 TTAB LEXIS 78 (T.T.A.B. 2012).

251. 15 U.S.C. § 1091(a).

registration on the principal register on account of its nature unless it

(a) consists of or comprises scandalous, deceptive, or immoral matter . . . **when used on or in connection with the goods of the applicant** [or] . . .

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or **plausibly misdescriptive** of them . . . [or] (3) when used on or in connection with the goods of the applicant is **geographically deceptive**. . . .

(f) . . . Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is **plausibly geographically misdescriptive**, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.

15 U.S.C. § 1064(3) (Section 14(3))

A petition to cancel a registration of a mark . . . may . . . be filed . . . [a]t any time if the . . . registration was . . . contrary to the provisions of . . . subsection (a), (b), (c), **or (e)(3)** of section 2 for a registration under this Act

15 U.S.C. § 1091(a) (Section 23(a))

Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant's goods or services and not registrable on the principal register under this Act, that is declared to be **plausibly geographically misdescriptive**, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before the date of enactment of the North American Free Trade Agreement Implementation Act.

VII. CONCLUSION

“Frankly, young man, I think I might just give up this whole energy drink idea and go into the theater. I hear there are open auditions this weekend for the touring company of ‘Cats.’”

“Sorry, Mr. Mason. I realize that all of this might be a little overwhelming. It’s pretty confusing for lawyers, too. But I think you’ll be able to find a great trademark for your drink.” I looked at all of the notes I had scribbled down. “Look, you can use a mark that suggests that the product is an energy drink. But you can’t call it by one of the main ingredients and you can’t call it something that it could be but isn’t, any more than you could call it just

ENERGY DRINK. Also, you should really avoid names of real places. If you make the drink there, it would be descriptive, and if you don't, it would be misdescriptive. And if you use the name of a place that people associate with the product, it might even be primarily geo—

“No! Don't say that phrase again!” Mr. Mason slumped in his chair. “Look, can we talk about something more straightforward, please? Like, I don't know, getting a patent?”

“Uh, Mr. Mason, would you like to order in some lunch? The Mongolian Grill down the street delivers.”

“All right. I assume they import their food from Mongolia?”

Maybe, I thought to myself, this isn't such a great idea for an article after all.
