

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
South of Market Merchants' and
Individuals' Lifestyle Events (aka
SMMILE)

RESPONSE TO OFFICE ACTION

Mark: **FOLSOM**

Class: 5

Serial No. 77/394,737

Filed: February 12, 2008

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Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attn: John Hwang, Esq.

Dear Mr. Hwang:

Applicant responds to the Office Action dated May 22, 2008 issued in the above-identified application. In that Action, the Examining Attorney refused registration based on geographic descriptiveness. Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2). Applicant respectfully disagrees with the Examining Attorney's assessment and requests reconsideration of his refusal.

REMARKS

The search of the Office records found no similar registered marks that would bar registration under Trademark Act Section 2(d). The Examiner has refused registration

because the proposed mark appears to be primarily geographically descriptive of the origin of Applicant's goods.

A. Applicant's Mark is not Geographically Descriptive

The test of geographic descriptiveness or misdescriptiveness is whether a place name is *primarily merely* descriptive or misdescriptive. Lanham Act Section 2(e)(2). While Applicant does not deny that there are places called "Folsom," (most famously Folsom Prison), Applicant disputes that any are known for personal lubricants or that the term is not a proper mark for personal lubricants. The refusal is based on the assumption that the primary significance of the term FOLSOM to the consuming public would be a place known for personal lubricants. However, because the goods have no connection with any particular place, the public is not likely to believe that the geographic term identifies the place from which the goods originate.

The Trademark Attorney's Google search disclosed listings for Folsom Street Fair and references to Folsom Street in San Francisco, and included a print out from Applicant's own website discussing its Folsom Street Fair. There is nothing in the Examiner's evidence to show that Folsom Street in San Francisco is known for personal lubricants. To the contrary, the fact that Applicant's own FOLSOM STREET EVENTS mark (federal Registration No. 3,204,955) was prominently featured indicates that it is an indicator of source.

In addition, there are other "Folsom" references, not included in the Examiner's evidence, that are more readily known to the consuming public. The most pertinent reference, certainly more so than the name of a street in San Francisco, is Folsom, California known primarily for its Folsom Prison, which was also the title of a famous song by Johnny Cash in the early 1950's (Exhibits A and B). As with the street in San Francisco, there is nothing to suggest that Folsom, California is known for personal lubricants.

In In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) the CAFC considered registration of the mark DURANGO, which was used for chewing tobacco and other tobacco products. The Trademark Attorney noted the fact that "Durango" is a city or region in Mexico that grows tobacco and therefore refused registration because the mark was either geographically descriptive or geographically misdescriptive. The teachings of that case do not appear to be applicable to this situation. Nothing in the evidence cited by the Trademark Attorney points to "Folsom" or "Folsom Street" as a place that produces personal lubricants or related products or is well-known for such goods.

Apart from this, even assuming that "Folsom" has a geographically descriptive meaning, its primary meaning in the context of personal lubricants is not geographically descriptive. Applicant's proposed use of FOLSOM for personal lubricants is arbitrary. Names of places that are considerably more well-known than Folsom are registrable, including ST. TROPEZ (clothing) RODEO DRIVE (clothing and perfume), FIFTH AVENUE (candy bar), MEADERY OF THE ROCKIES (honey wine), YELLOWSTONE VALLEY BREWING (beer) and YOSEMITE BEER (beer).

It is well established that marks consisting of place names are registrable if there is no goods-place association between the products and the mark. See, e.g., In re Nantucket, Inc. 677 F.2d 95, 106, 213 USPQ 889, 898 (CCPA 1982) (mark NANTUCKET registrable because although persons can buy clothes in Nantucket, the island is not known for its shirt manufactory); In re Gale Hayman Inc. 15 USPQ2d 1478 (TTAB 1990) (SUNSET BOULEVARD registrable for cosmetics and perfume because no known manufacture of such products on Sunset Boulevard).

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Based on the foregoing, Applicant submits that the FOLSOM mark is not geographically descriptive and requests withdrawal of the refusal.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Anne Haring Hocking". The signature is written in black ink on a white background.

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