

## **Submission of the United States of America**

### **Case Law Examples on Country Names**

#### **ADMINISTRATIVE BOARD CASES – REFUSAL AFFIRMED – EX PARTE APPEAL**

**NOT MADE IN FRANCE** for clothing – serial no. 78/263738 – refusal affirmed on 12/3/04 under Section 2(e)(1) that mark is merely descriptive of the goods. Appeal to Court of Appeals for Federal Circuit withdrawn:

“Based on the record before us, we find that the mark sought to be registered is merely descriptive. As applicant readily concedes, its clothing items likely will not originate in France; thus, the phrase “not made in France,” on its face, immediately describes this fact. The mark immediately informs, without speculation or conjecture, prospective customers that applicant’s goods are not made in France.

Applicant’s principal argument is, of course, that the average consumer will not perceive the mark as descriptive, but rather that the consumer will view the mark as a satirical or humorous play on the country of origin labels applied to clothing. The argument essentially is that the mark has a double entendre by virtue of the current state of affairs in Franco-American relations.

Applicant’s main argument is not persuasive. As pointed out by the examining attorney, the question of mere descriptiveness is determined on the basis of the mark itself, and not on the basis of intended usage with other ornamental slogans, designs or icons. The proposed mark fails, on its face, to produce the additional meaning suggested by applicant. The effect of other indicia (that might appear on the clothing) on consumer perceptions cannot be considered in our determination of mere descriptiveness. *See In re Wells Fargo & Co.*, 231 USPQ 95(TTAB 1986). In the absence of these other indicia, such as the humorous sayings regarding Franco-American relations to which applicant refers, we find it unlikely that the average consumer will make the association suggested by applicant. TMEP §1213.05(c) (3d ed. rev. 2 2003).”

<http://ttabvue.uspto.gov/ttabvue/ttabvue-78263738-EXA-9.pdf>

**SWISSGOLD** for watches, etc. – serial no. 78/402643 – refusal affirmed on 12/27/06 under Sections 2(a) and 2(e)(3) as deceptive and primarily geographically deceptively misdescriptive:

“Based upon the foregoing, we find that applicant’s mark SWISSGOLD is both deceptive and primarily geographically deceptively misdescriptive as applied to applicant’s goods.

With regard to the tests for both refusals, the SWISS portion of applicant’s mark misdescribes all of applicant’s goods, including those goods not comprised wholly or partially of gold. The term SWISS is so highly associated with watches and clocks that its misdescriptiveness is not eliminated by its combination with the word GOLD.

March 12, 2012  
United States of America

As for the second part of the test for deceptiveness, and third part of the test for geographic deceptive misdescriptiveness, it is clear to us that prospective purchasers are most certainly likely to believe that the proposed mark actually describes the relevant goods given the fact that Switzerland is so extremely well known for watches and clocks (and accessories and parts therefor), and because some of these products are made in whole or in part of gold. Finally, in regard to the materiality prong of the respective tests, given the high quality of Swiss watches and clocks, purchasers would be materially influenced into purchasing clocks and watches bearing the mark SWISSGOLD because of the SWISS element of the proposed mark, regardless of the actual composition of the goods.”

<http://www.uspto.gov/web/offices/com/sol/foia/ttab/2aissues/2006/78402643.pdf>

**COLOMBIANO COFFEE HOUSE** – for providing food and drink – serial no. 77522433 – refusal affirmed on 2/22/12 under Section 2(d) for a likelihood of confusion with a registered certification mark, and under Section 2(e)(2) as descriptive of services of coffee house selling Colombian coffee:

#### **Likelihood of confusion**

“Upon consideration of all the du Pont factors on which there is evidence or argument, we find that applicant's use of the mark COLOMBIANO COFFEE HOUSE for “providing of food and drink” is likely to cause confusion with the registered certification mark COLOMBIAN for coffee. Purchasers familiar with registrant’s certification mark COLOMBIAN for coffee, upon encountering applicant’s coffee house services offered under the very similar mark COLOMBIANO COFFEEHOUSE, are likely to believe that registrant is authorizing applicant’s use of the mark, and assume that applicant’s services are therefore licensed by or in some way associated with registrant.”

#### **Descriptive**

“The certification mark registration cited as the basis for the examining attorney’s likelihood of confusion refusal also underscores the importance of the terminology and the actual fact that coffee from Colombia is referred to as “Colombian.” As described in the registration and corroborated by internet evidence submitted by the examining attorney, Colombian coffee is regarded as possessing certain distinctive qualities and characteristics due to factors associated with that region, including its flavor, aroma and body. Based on the aforementioned evidence, we find that consumers encountering applicant’s mark in connection with the recited services will immediately understand the term COLOMBIANO as describing a particular type of coffee that will be served in the coffee house, that is, coffee having certain qualities and characteristics that are associated with authentic Colombian coffee. Ultimately, the entire mark describes the nature and key features of applicant’s recited services.”

<http://ttabvue.uspto.gov/ttabvue/v?pno=77522433&pty=EXA&eno=17>

March 12, 2012  
United States of America

**MEXICAN WATER** for bottled drinking water – serial no. 74/716067 – refusal affirmed on 12/17/98 under Section 2(e)(3) because mark is “primarily geographically deceptively misdescriptive of the goods:

“In sum, we find that purchasers and prospective purchasers encountering the asserted mark MEXICAN WATER for bottled drinking water are likely to believe, mistakenly as it turns out, that the goods have their origin in Mexico.”

<http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/1998/74716067.pdf>

**KUBA KUBA** for cigars, tobacco and related products, namely ... – serial no. 77/099522 – refusal affirmed on 1/28/11 under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“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.”

<http://ttabvue.uspto.gov/ttabvue/ttabvue-77099522-EXA-18.pdf>

**LINEA ITALIA** for furniture, namely...- serial no. 75/ 450847 – refusal affirmed on 10/11/00 under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“It is true that “if 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” on the ground that the mark is primarily geographically deceptively misdescriptive. *In re Nantucket, Inc., supra*, 213 USPQ at 893. However, as discussed above, the evidence of record in this case shows that consumers are likely to assume that a connection exists between the country of Italy and a line of furniture of the type identified in the application. The existence of that goods/place association belies applicant’s claim that its mark is arbitrary as applied to its goods.”

<http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/2000/75450847.pdf>

**AUSTRALIAN KINGDOM** for clothing for men, women and children, namely... - serial no. 75/410279 – refusal affirmed on 9/26/00 under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“In summary, the primary significance of the mark sought to be registered is geographic; a goods/place association would be made between the goods specified in the application and place named in the mark; and the goods will, in fact, not originate in the place named in the mark. Accordingly, the refusal to register under Section 2(e)(3) of the Lanham Act must be affirmed.”

<http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/2000/75410279.pdf>

March 12, 2012  
United States of America

**BRITISH POST OFFICE** for electrical, electronic and optical apparatus and instruments, all for use in handling processing and sorting of goods, namely ... - serial no. 74/523981 – refusal affirmed on 4/17/01 under Section 2(e)(2) as primarily geographically descriptive:

“Considering the first part of the test, we find the evidence clearly establishes that “BRITISH” is the name of a place known generally to the public. It identifies a specifically defined geographic area, albeit involving more than one political entity....

Further, the term “BRITISH POST OFFICE” retains the primarily geographic character of “BRITISH” because, in the context of the entire mark, it indicates the nation in which the involved “POST OFFICE” is located, and from which the goods and services would emanate.

This leads to a consideration of the second part of the test, and there is no dispute that applicant is a corporation of the United Kingdom (Great Britain) and is located there. Thus, applicant has a specific and clear legal connection to the place named in the mark, and in fact, applicant is the government entity empowered to offer the goods and services of a “post office” in Great Britain. Applicant does not dispute that, if it commences use of this mark for these goods and services, the goods and services would emanate from Great Britain. Thus, we presume a public association of the goods and services with the place from the fact that applicant’s goods and services would come from the geographical place named in the mark.

Because both parts of the enunciated test have been met, we find BRITISH POST OFFICE is primarily geographically descriptive.”

<http://www.uspto.gov/web/offices/com/sol/foia/ttab/other/2001/74523981.pdf>

**NEDERLAND** for beer – serial no. 75/853926 – refusal affirmed on 8/29/03 under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“The geographic dictionary published in the United States demonstrates that the primary significance of “NEDERLAND” in this country is geographic, *i.e.*, that it is synonymous with “the Netherlands.” The other evidence submitted by the Examining Attorney establishes that the Netherlands is well known as a source of beer. From this evidence we can conclude that beer purchasers in this country would associate beer with “NEDERLAND.” In that applicant admits that its beer will be produced there, the third prong of the test for geographic descriptiveness is plainly satisfied.”

<http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/2003/75853926.pdf>

#### **EXAMINING ATTORNEY REFUSALS**

**NOT MADE IN CHINA** for athletic clothing, namely ... serial no. 85184832 -- abandoned application after Examining Attorney refused under Section 2(a) as mark consists of or includes matter which may

March 12, 2012  
United States of America

disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols, namely, the country of China; and under Section 2(e)(1) as mark is merely descriptive of the goods.

<http://tdr.uspto.gov/search.action?sn=85184832#>