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PRECEDENT OF THE TTAB

Oral Hearing: June 19, 2014

Mailed: July 23, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tigerland-Foxland of NY, Inc.

Serial No. 85130889

David Landau for Tigerland-Foxland of NY, Inc., appearing pro se.

Susan C. Hayash, Senior Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Bucher, Ritchie and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Tigerland-Foxland of NY, Inc. (“Applicant”) seeks registration on the Principal Register of the mark VENEZIA-MILANO (in standard characters) for “Women’s clothing, namely, blouses, sweaters, shirts, t-shirts, dresses, trousers, shorts, scarves, coats, jackets, hats; women’s lingerie, namely, pajamas, robes, bras, underpants; men’s clothing, namely, shirts, t-shirts, trousers, ties, shorts, scarves, coats, jackets” in International Class 25.¹

¹ Application Serial No. 85130889 was filed on September 16, 2010, based on an allegation of first use and first use in commerce of December 11, 2002.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), on the ground that Applicant's mark is geographically deceptively misdescriptive of the goods.² The Examining Attorney also rejected applicant's showing of acquired distinctiveness under Trademark Act § 2(f), 15 U.S.C. § 1052(f), as being insufficient. After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm.

Evidentiary Issues

Before proceeding to the merits of the refusal, we address the Examining Attorney's objection to third-party registrations and to materials presented during the oral hearing.

We sustain the objection to the third-party registrations which were presented for the first time as attachments to Applicant's appeal brief. The record in an application should be complete before the appeal is taken, and we will not consider evidence that has not been submitted during prosecution of the application. Trademark Rule 2.142(d), 37 CFR 2.142(d), makes this clear:

(d) The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may

² On appeal is the Examining Attorney's refusal to register Applicant's mark under Section 2(e)(3), 15 U.S.C. § 1052(e)(3). The refusal under Section 2(a), 15 U.S.C. § 1052(a), has been withdrawn. The refusal under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), was not pursued in the Examining Attorney's Appeal Brief and we consider it withdrawn.

request the Board to suspend the appeal and to remand the application for further examination.

Accordingly, we have not considered the third-party registrations.

For these same reasons, we have not considered the evidence of labeling of Applicant's clothing introduced at the oral hearing, and sustain the Examining Attorney's objection thereto. *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (exhibits in booklet submitted at oral hearing which had not previously been made of record were not considered).

On the other hand, we have considered the incomplete copies of third-party applications and registrations, attached to Applicant's January 12, 2012 request for reconsideration, as the Examining Attorney's objection thereto was withdrawn at oral hearing. These printouts have very little probative value, however, as two of them relate to international registrations and the remaining four are not shown by the printouts to have issued to registration. "The Board has long held that third-party applications are evidence only of the fact that they were filed; they have no other probative value." *In Re Kent Pedersen*, 109 USPQ2d 1185, n. 45 (TTAB 2013), citing *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694 (TTAB 1992). See also *Glamorene Prods. Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (applications are evidence only of the fact that the applications were filed and nothing else). The printouts are thus of value only for what they show on their face and are not evidence that the marks therein have been registered or are in use. *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1560 (TTAB 2012).

Applicable Law – Geographic Terms

Under Section 2(e)(3) of the Trademark Act, a mark is primarily geographically deceptively misdescriptive if:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the goods or services for which applicant seeks registration do not originate in the place identified in the mark;
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place named in the mark; and
- (4) the misrepresentation is a material factor in the purchaser's decision to buy the goods or use the services in question.

In re Miracle Tuesday, LLC, 695 F.3d 1339, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012); *In re Spirits International, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1490-95 (Fed. Cir. 2009); *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003); TMEP § 1210.01(b) and (c).

The primary significance of VENEZIA-MILANO is a generally known geographic location

Applicant's mark is VENEZIA-MILANO. Because Italian is a common language in the United States, consumers are likely to stop and translate the mark into English. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) ("Under the doctrine of foreign equivalents, foreign words from common languages are translated into English"); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009) (ordinary American purchaser sufficiently familiar with Russian would

likely translate MOSKOVSKAYA to “of or from Moscow”). The dictionary definitions submitted by the Examining Attorney show that “Milano” is the Italian name for “Milan” and “Venezia” is the Italian name for Venice.³ Applicant recognizes this translation and has entered a translation statement reading: The English translation of “VENEZIA-MILANO” in the mark is “VENICE-MILAN”. Relevant purchasers will readily perceive the mark as “Venice-Milan.”

Both Venice and Milan are well known cities located in Italy; Venice is the “provincial capital of Veneto”⁴ and Milan is “an industrial city in central Lombardy.”⁵ Applicant argues that the primary significance of the mark as a whole is not that of a “generally known geographic location” because there is no actual place known as “Venice-Milan” and purchasers will not dissect the mark. We agree with Applicant that the applied-for mark must be evaluated as a whole, but “[i]t is not improper ... to give greater weight to the dominant feature of a composite mark in the course of evaluating the mark as a whole.” *In re Compania de Licores Internacionales S.A.* 102 USPQ2d 1841 (TTAB 2012) (OLD HAVANA for “rum” held primarily geographically deceptively misdescriptive where rum did not originate in Cuba; primary component of mark was HAVANA, not OLD), *citing In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1541 (Fed. Cir. 1999) (primary geographic significance of mark NEW YORK WAYS GALLERY “is not lost by the addition of WAYS GALLERY to NEW YORK.”) *Cf. In re National Data Corp.*, 753 F.2d 1056, 224

³ At <http://dictionary.reference.com>; attached to April 21, 2011 Office Action.

⁴ At <http://www.definitions.net/definition/venezia>; attached to April 21, 2011 Office Action.

⁵ At <http://dictionary.reference.com/browse/milano>; attached to April 21, 2011 Office Action.

USPQ 749, 751 (Fed. Cir. 1985) (when comparing marks for likelihood of confusion purposes, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties.”).

In this case, the dominant feature of the mark is the term MILANO, because of its stronger connection with the involved goods, the fashion industry in general and women’s fashion in particular. The addition of VENEZIA to Applicant’s mark simply reinforces the perception that the goods emanate from a city in Italy. Even if the mark were viewed as a combination of two Italian city names, without either being considered dominant, the impression of the mark as a whole would still be that of a location in the country of Italy.

Moreover, the fact that there is no actual place known as “Venice-Milan” does not detract from the fact that the primary significance of the mark is to name a geographic location that is not obscure, minor, remote, or not likely to be connected with the goods. As explained by the Board in *In re London & Edinburgh Insurance Group Ltd.*, where refusal to registration of the mark LONDON & EDINBURGH for insurance underwriting services was made:

Consumers will still regard the mark as referring to the cities of London and Edinburgh, rather than to some mythical place called “London & Edinburgh.” Nor can London & Edinburgh be considered such an odd or incongruous combination of geographic place names that consumers will view it as an arbitrary combination without a geographic significance to the whole, in the way that, perhaps, “Borneo & Bulgaria” might be. London and Edinburgh are, respectively, the capitals of England and Scotland, and these two bordering countries are, in turn, part of the United Kingdom. Because of the natural

association between these two capital cities of the United Kingdom, and their geographical proximity, consumers are likely to view the phrase LONDON & EDINBURGH as having a geographic significance. In the context of a mark used for insurance underwriting services, that significance will be of services which are rendered in or originate from both of these cities.

London & Edinburgh, 36 USPQ2d 1367, 1369 (TTAB 1995). See also, *In re Narada Productions, Inc.*, 57 USPQ2d 1801 (TTAB 2001) (CUBA L.A. primarily geographically deceptively misdescriptive of musical recordings and live musical performances that do not originate in either Cuba or Los Angeles).

In considering whether the primary significance of the mark is a generally known geographic location, the fact that it names two locations does not alter the geographic significance of the mark as a whole; taken together, they suggest that the goods originate in Italy, specifically Milan and/or Venice. There is a natural association between these two cities, such as was found in *London & Edinburgh*. Because consumers will perceive the primary significance of VENEZIA-MILANO to be a geographic location, the first prong of the four-part test for deceptive misdescriptiveness is satisfied.

The goods or services for which applicant seeks registration do not originate in Venice or Milan

Applicant's goods are not made in either Milan or Venice. They are made in China.⁶ Thus, the second prong of the test has been met.

⁶ Response to Office Action dated July 18, 2011, p. 5. Applicant states that it "clearly marked its goods as emanating from China, which further clarifies the origin of Applicant's goods to the consumer."

Purchasers would be likely to believe that the goods or services originate in Venice or Milan

The third prong of the test requires that there be a “goods-place association,” that is, a relationship between the goods and the place named in the mark. There is a goods-place association between a mark and the goods on which the mark appears where the place named in the mark is known for producing the product. *Miracle Tuesday*, 104 USPQ2d at 1330. The court in *Miracle Tuesday* explained that the Office is not required to establish “an ‘actual goods/place association’” (internal quotations omitted) but need only establish “a reasonable predicate for its conclusion that the public would be likely to make the particular goods/place association on which it relies.” Here, the Examining Attorney has shown that Milan is known as a center for fashion and design in relation to clothing⁷ and that Venice is known as “one of Italy’s major ports and a famous tourist attraction.”⁸ *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (“[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product.”).

Of particular note are the several travel-related advertisements attached to the Office Action dated September 13, 2011:

- at <http://www.ultimategetaways.net>, Milan is advertised as “The Fashion Capital of the World”;
- at <http://www.hostelsclub.com>, Milan is touted as “the Fashion Capital”; and

⁷ See <http://dictionary.reference.com>, attached to April 21, 2011 Office Action.

⁸ At <http://www.definitions.net/definition/venezia>, attached to April 21, 2011 Office Action.

- at <http://blog.travelpod.com>, a map of southern Europe is shown under the heading “Fashion Capital Of The World – Milan!”

See also, attached to the April 21, 2011 Office Action, at Answers.com (webcache from April 21, 2011), the city of Milan is listed sixth in response to the question “Where is the fashion capital of the world?”

Because consumers will make a goods-place association between Applicant’s mark and the goods, and mistakenly believe that the goods come from Italy, specifically, either Milan or Venice, the third prong of the test for geographic deceptiveness has been met.

Materiality

The final prong of the test for geographic deceptive misdescriptiveness is whether or not a substantial portion of the relevant consumer group is likely to be deceived, that is, whether a purchaser’s mistaken belief that the goods come from the place named in the mark constitutes a material factor in his or her decision to purchase the goods. “Evidence that a place is famous as a source of the goods raises an inference in favor of materiality. ... Such evidence supports a presumption that a substantial portion of the relevant consumers is likely to be deceived.” *Compania de Licores*, 102 USPQ2d at 1850. See also *Miracle Tuesday*, 104 USPQ2d at 1334; *Les Halles de Paris*, 67 USPQ2d at 1542; *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 n.6 (Fed. Cir. 1985) (“[I]f the place is noted for the particular goods, a mark for such goods which do not originate there is likely to be deceptive ... and not registrable under any circumstances.”).

Because the evidence shows that Milan is famous for women's clothing, a substantial portion of consumers who care about fashion will be motivated to purchase Applicant's clothing because they mistakenly believe it comes from Milan. The additional city name of Venezia that has been added to the mark does not detract from its overall impression as the name of a fashion center; the reference to Milan is unmistakable. And while Applicant argued at the oral hearing that its goods were not expensive enough to be assumed to have come from Milan, there is no evidence in the record regarding conditions of sale, nor does the evidence supporting the fame of Milan as a fashion center suggest Milan is not known as a producer of moderately priced, as well as high end, clothing.

Applicant argues that buyers would not be deceived because its mark, as used on the goods, includes a label that reads "China." We do not agree. First, the additional matter on the label is not part of the mark sought for registration. The country of origin designation does not negate the primary geographically deceptive misdescriptiveness of the mark sought to be registered that is apparent when the mark is encountered in the marketplace. *Compania de Licores*, 102 USPQ2d at 1849 ("[E]vidence other than the mark on the label or matter found on a specimen providing further information as to source cannot negate the geographic deceptive misdescriptiveness that may be conveyed by the mark itself."); *Cf. In re E5 LLC*, 103 USPQ2d 1578, 1581 (TTAB 2012) ("We further note that any clarifying features of an applicant's advertising do not serve to overcome deceptiveness in a mark. Rather, the mark must stand on its own." [citing *In re Budge Manufacturing Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988)]). Moreover, the specimen

label of record also includes the marking “designation Italy.” This implies a connection with Italy and underscores the impact of the mark as identifying goods that emanate from Italy.

For the above reasons, we find that the deception is material and the fourth element of the test is satisfied.

Acquired distinctiveness

Applicant argues that its mark is not geographically deceptive, but rather merely descriptive, and seeks registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Applicant claims that its mark acquired distinctiveness as of July 2006.⁹

At oral hearing, the Examining Attorney conceded that if the mark were found to be merely descriptive or misdescriptive, but not primarily geographically deceptively misdescriptive, she would accept Applicant’s 2(f) statement. Because we find the mark precluded from registration under Section 2(e)(3), however, it is not eligible for registration even with a showing of acquired distinctiveness. As Section 2(f) itself provides, marks found to be primarily geographically deceptively misdescriptive may be registered only if they “became distinctive of the applicant’s goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act” (i.e., prior to December 8, 1993). Applicant cannot claim the benefit of this exception because its mark did not allegedly become distinctive until 2006.

⁹ Response to Office Action dated July 18, 2011.

Conclusion

We have carefully considered the entire record, including all arguments and the evidence submitted. We find that the mark VENEZIA-MILANO is primarily geographically deceptively misdescriptive and that Applicant's showing of acquired distinctiveness is legally insufficient to overcome the refusal because Applicant claims its mark acquired distinctiveness later than December 8, 1993.

Decision: The refusal to register applicant's mark VENEZIA-MILANO under Trademark Act § 2(e)(3) is affirmed.