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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nature's Youth, Inc.

Serial No. 85747419

Jeffrey M. Furr, Esq. of Furr Law Firm, for Nature's Youth, Inc.

Paul Fahrenkopf, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Wellington, Wolfson, and Adlin,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Nature's Youth, Inc. has filed an application to register the mark **NY** (in standard character form) on the Principal Register for "Cosmetics; Face creams; Lotions for cosmetic purposes" in International Class 3.¹

¹ Application Serial No. 85747419, filed October 5, 2012, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use the mark in commerce on the identified goods.

The examining attorney has refused registration of the proposed mark under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), on the ground that applicant's mark is geographically deceptive, and under Trademark Act Section 2(e)(3), 15 U.S.C. § 1052(e)(3), on the ground that applicant's mark is primarily geographically deceptively misdescriptive. In addition, the examining attorney refused registration on the ground that applicant did not respond to or otherwise comply with a request for information concerning the identified goods, pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b).

Applicant concurrently filed a request for reconsideration and appeal of the refusals. The examining attorney denied the request for reconsideration and this appeal proceeded. Briefs have been filed.

Requirement for Further Information

In the first Office action, the examining attorney instructed applicant that it "must provide a written statement explaining whether the goods are or will be manufactured, packaged, shipped from, sold in or have any other connection with the geographic location named in the mark," citing to 37 C.F.R. § 2.61(b). Given the necessary elements for refusing registration based on the geographic nature of the proposed mark (as discussed *infra*), we find

the examining attorney's request for this information was necessary to permit proper examination. See *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); and TMEP § 814 (Oct. 2013).

Applicant did not respond to or even address the request for information in its response to the first Office action. The examining attorney then made this requirement final in the second Office action. Applicant, without explanation, again failed to respond to this requirement in its request for reconsideration. While it would have been too late comply with this requirement once applicant filed its appeal, we do note that applicant continued to side-step the information request in its appeal brief by neither confirming or denying whether its goods will come from New York.

Accordingly, we affirm the refusal to register applicant's proposed mark on the ground that applicant has failed to comply with the examining attorney's request for information, under 37 C.F.R. § 2.61(b).

We turn now to the substantive refusal to register.

Proper Statutory Basis for Geographic Refusal

As a preliminary matter, we point out that the sole ground for refusing registration in this case is that

applicant's mark is primarily geographically deceptively misdescriptive, under Trademark Act Section 2(e)(3), 15 U.S.C. § 1052(e)(3). Although it was appropriate for the examining attorney in the first Office action to assert both that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3), and that the mark is geographically deceptive under Section 2(a), it was inappropriate to continue, and make final, both bases in view of applicant's response to that Office action. Specifically, the Trademark Manual of Examining Procedure (TMEP) instructs that "[i]f the applicant's response does not claim use or acquired distinctiveness prior to December 8, 1993, the examining attorney must withdraw the §2(a) refusal and issue a final refusal under §2(e)(3), if otherwise appropriate." TMEP Section 1210.05(d)(i) (3rd ed., Revision 2, 2013). Applicant neither amended the application to claim that the mark has acquired distinctiveness under Section 2(f) nor sought registration on the Supplemental Register.² The Board has also previously advised that, based on the guidance of our primary reviewing court, the appropriate refusal under

² Indeed, as noted in the previous footnote, the involved application is based on an intent to use the mark in commerce; thus, applicant could not amend the application to claim that the mark has acquired distinctiveness under Section 2(f) or seek registration on the Supplemental Register.

circumstances such as those presented herein is that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3). *In re South Park Cigar Inc.*, 82 USPQ2d 1507, 1509 (TTAB 2007), citing to *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 and 1858 (Fed. Cir. 2003) ("NAFTA and its implementing legislation obliterated the distinction between geographically deceptive marks and primarily geographically deceptively misdescriptive marks," and, therefore, "this court anticipates that the PTO will usually address geographically deceptive marks under subsection (e)(3) of the amended Lanham Act rather than subsection (a)."). See also, *In re Spirits International N.V.*, 86 USPQ2d 1078, fn.3 (TTAB 2008), *reversed and remanded on other grounds*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009).

Accordingly, the examining attorney's refusal based on the proposed mark being primarily geographically deceptively misdescriptive, under Section 2(e)(3), is the proper, and only, ground for refusal on appeal.

Primarily Geographically Deceptively Misdescriptive

The following elements must be present for a mark to be refused registration as either geographically deceptive or primarily geographically deceptively misdescriptive:³

- 1) The primary significance of the mark is a generally known geographic place;
- 2) The goods or services 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 identified in the mark; and
- 4) The misrepresentation is a material factor for a substantial portion of relevant consumers in deciding whether to buy the goods or use the services.

In re Spirits International, 90 USPQ2d at 1490-95; *In re California Innovations*, 66 USPQ2d at 1858.

As to the evidentiary record for this appeal, it can best be described as meager. The examining attorney submitted the following from four websites:⁴

- Printouts from a Wikipedia entry for "New York City";
- Printouts from the "Acronym Finder" website with title "What does NY stand for?";
- Printouts from the "Beauty Packaging" website containing a 2006 article titled "Top 20 Global Beauty Companies"; and

³ We note this is the same legal test for determining whether a mark is geographically deceptive.

⁴ Attached to Office action dated February 15, 2013.

- Printouts from the Examiner.com website of an article titled "Getting to know your New York City based cosmetic companies."

Applicant submitted the following pages from two websites:⁵

- Printouts from the website www.abbreviations.com providing a list of meanings for the abbreviation "NY"; and
- Printout from "The Free Dictionary" website providing a list of meanings for the abbreviation "NY".

As to the elements for establishing that NY is primarily geographically deceptively misdescriptive, we initially note again that applicant has not disputed the examining attorney's contention that the identified goods will not come from New York. Applicant itself is from Tennessee and makes no representation that the goods will have any connection to New York. In addition, because we found that applicant failed to respond to the request for information pertaining to the goods' origin, we may make the presumption that had applicant responded to the examining attorney's inquiry, the response would have been unfavorable, *i.e.*, that applicant's identified goods do not or will not originate in New York. *See, In re AOP LLC*, 107 USPQ2d at 1651, citing *In re Cheezswhe.com Inc.*, 85 USPQ2d

⁵ Attached to applicant's request for reconsideration filed on July 29, 2013.

1917, 1919 (TTAB 2008). We therefore find that the second element has been met and the goods do not or will not originate in New York.

Applicant does take issue with the examining attorney's conclusions concerning the remaining three elements. In particular, applicant asserts that the primary significance of NY is not a known geographic place:

... The mark consists of the initials of the applicant, which is Nature's Youth... Furthermore, NY stands as an abbreviation for many words and phrases in addition to Nature's Youth and New York. The site www.acronyms.thefreedictionary.com shows NY as an abbreviation for not yet, new year, navy yard, Neil Young, not yours, North Yorkshire and North York in addition to New York and the site www.abbreviations.com shows NY as an abbreviation for next year, nylon, not you, north York, nytronics, nune yesayan, native yard, nadia yap, not yet, nose to Y-axis and normal to Y-axis in addition to New York.

Brief, pp. 1-2.

Applicant references and relies on different possible meanings set forth in the submitted lists of meanings for the term "NY." However, the printout from the website "Acronym Finder" submitted by the examining attorney shows "New York (US Postal abbreviation)" as the first result of a search for "What does NY stand for?," followed by other possible meanings, such as "Not Yet... New Year... Navy Yard... Neil Young (rock musician)... Not Yours... North Yorkshire." The website "The Free Dictionary" appears to

mirror the Acronym Finder list and the printout submitted by applicant from the website www.abbreviations.com also lists "New York" as the first possible meaning following by "Next Year...New Year...Nylon...Not You..."

This evidence shows that the term "NY" will be primarily understood as a reference to New York. The other possible meanings are relatively obscure whereas New York, the state or the city, is certainly well-known to everyone within the United States. Moreover, applicant has not shown how any of the other possible meanings relate to the involved goods, i.e., cosmetics, face creams and lotions for cosmetic purposes. In light of the evidence, we find that consumers viewing applicant's proposed mark NY on or in connection with the identified goods will understand this as an abbreviation for New York.

Finally, we note applicant's reliance on its registration for the mark NATURE'S YOUTH,⁶ but are not persuaded by its argument that NY will be understood as a reference to the registered mark (or applicant's company

⁶ Registration No. 2928340 for "drinking water" issued on February 22, 2005. Applicant also owned Registration No. 2719391 for the mark NATURE'S YOUTH "Vitamins, Vitamin Supplements, mineral supplements, herbal supplements, amino acid supplements, and nutritional protein supplements, all sold separately and in combination," but this registration was cancelled on January 3, 2014.

name) simply because the proposed mark "would be used on the Nature's Youth line of goods and in conjunction with the name Nature's Youth." Brief, p. 2. As the examining attorney has pointed out, the registered mark is not incorporated into the proposed mark and thus its presence on packaging or marketing materials is irrelevant to our consideration. Applicant's assertions regarding its manner of use of the proposed mark have no binding effect; in other words, we must assume the mark will be used on the identified goods without any mention or proximate use of applicant's company name or the house mark NATURE'S YOUTH. Moreover, there is no evidence showing that NY has been actively or extensively promoted as an abbreviation for applicant's company name; even if such evidence exists, it must be shown that these efforts offset the proposed mark's geographical significance in the minds of the relevant purchasing public.

We turn now to the third element involving the "goods/place" association; that is, we must determine whether there is a relationship between New York and applicant's goods such that consumers are likely to believe that the identified goods emanate from New York. This element does not have a high evidentiary threshold, but

"often requires little more than a showing that the consumer identifies the place as a known source of the product." *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003); see also, *In re Miracle Tuesday, LLC*, 695 F.3d 1339, 1344, 104 USPQ2d 1330, 1333 (Fed. Cir. 2012). In this regard, we find the record suffices for purposes of showing a goods/place association. In particular, in addition to New York being a major metropolis, the evidence shows that several of the world's largest "beauty companies" (a ranking based, in part, on 2005 sales of cosmetics, fragrance and personal care items) are located in New York, New York, e.g., Estee Lauder, Avon Products, and Coty. This evidence shows that New York is a known source of cosmetics.

Accordingly, we find a goods/place association exists between New York and the goods identified in the application.

Finally, we address the element that essentially gives rise to the deceptive nature of a refusal that a mark is primarily geographically deceptively misdescriptive. Here, the Office must establish a reasonable predicate that the misrepresentation of the geographic origin of the goods would be a material consideration in the minds of a substantial composite of the relevant consumers in deciding

to purchase the goods. *Spirits Int'l*, 90 USPQ2d at 1490-95; *California Innovations*, 66 USPQ2d 1853 (adding materiality requirement). In other words, and particular to this proceeding, although we find that consumers are likely to mistakenly believe that applicant's goods come from New York based on their perception that the primary significance of the mark NY as used on the goods is that of New York, the evidence must also show that this mistaken belief is material to their decision to purchase the goods.

In determining "materiality," the Board looks for evidence regarding the probable reaction of purchasers to a particular geographic term when it is used in connection with the goods. Generally, the burden to prove materiality will be satisfied if there is evidence showing that the place named in the mark is well known for the goods; or the goods are a principal product of the place named in the mark; or the goods are, or are related to, the traditional products of the place named in the mark, or are an expansion of the traditional products of the place named in the mark. See *In re California Innovations Inc.*, 66 USPQ2d at 1857; *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1850 (TTAB

2012); *In re House of Windsor, Inc.*, 221 USPQ 53, 57 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984).

In the *Compania de Licores* decision, the Board expounded on the type of evidence that may be useful:

In support of the refusal, the Office should submit evidence showing that the association between the goods and the geographic place would be a material consideration in a consumer's decision to purchase the goods. Searches that combine the place name with the name of the goods and terms such as "famous," "renowned," "well known," "noted for," "principal or traditional" may be useful to establish materiality.

102 USPQ2d at 1850; *see also*, TMEP 1210.05(c)(i), providing similar guidance. In that case, the Board found that Cuba and its capital city Havana are "famous for rum" and, consequently, if rum originates from Cuba it would be a material consideration to consumers in deciding whether to purchase. In discussing the record, the Board made the following finding:

As discussed above, Cuba is known for its rum, even being called "The Island of Rum," and Havana in particular is a leading production center for rum. The following examples support this point: "And what can one say about Havana's famous rum, savoured straight or on the rocks, or mixed in fabulous cocktails, renowned as the best in the world." "Cuban rum has a worldwide reputation." "The excellence of Cuban rum, a product of its unique aging process, has made Cuban cocktails a perennial favorite the world over." "While you're there [Havana, Cuba], be sure to visit the Havana Rum factory to see how they make the best rum in the world." "Rum is the most famous alcohol product of Cuba." "Official sources reported the Cuban Havana Club Rum Museum is one of the main tourist attractions in Havana, since it has already

welcomed one million visitors from the whole world throughout its nine years."

102 USPQ2d at 1851 (internal citations to evidence omitted).

In contrast to *Compania de Licores* decision, the limited record before us does not support a finding that New York is famous for cosmetics, or even that cosmetics are a principal or traditional product of New York. The only evidentiary submissions that may have relevance to the materiality element are: the Wikipedia entry describing New York City as a "major center for ... fashion"; a 2006 online article from the "Beauty Packaging" website listing five companies with a New York address as being in the "Top 20 Global Beauty Companies"; and the "Examiner.com" article titled "Getting to know your New York City based cosmetic companies." Relying thereon, the examining attorney asserts:

[T]he evidence of record demonstrates that a significant portion of the relevant consumers would be materially influenced in the decision to purchase applicant's product by the geographic meaning of the mark because New York is famous as a source of cosmetics, being headquarters to 25% of the world's leading cosmetic companies... and cosmetics are also related to one of New York's most famous industries, the fashion industry.

Brief at p. 8.

For several reasons, we find the record lacking and cannot come to the same conclusion as the examining attorney. First, the "beauty companies" list is not necessarily a ranking of the "world's leading cosmetic companies." According to the article, the list was based on 2005 sales figures for goods that not only included cosmetics but also various other items such as "fragrance and personal care items (hair care, skin care, soap, deodorant, etc.)." Second, it has not been shown that the "fashion industry" is synonymous or encompasses the cosmetic industry.⁷ While there may be evidence available to show a relationship between the fashion and cosmetics industries, we simply do not have this evidence before us. Finally, the Examiner.com article identifies several New York City-based cosmetic companies and thus is probative; however, it is clearly written with an eye on persons interested in "supporting your community and the goods they produce and that spirit can be applied to your makeup bag." In other words, the impetus of the article is shopping locally (in this case, New York) and supporting locally-made products. This article does not indicate whether

⁷ In this regard, we take judicial notice that "fashion" is defined as "a popular way of dressing during a particular time or among a particular group of people." *Merriam-Webster Online Dictionary*, based on print version of *Merriam-Webster's Collegiate Dictionary, Eleventh Edition*.

cosmetics coming from New York will play a role in the minds of consumers living outside of New York. And, while the article does state that "New York City is home to many of the top cosmetic producers including Estee Lauder and also quite a few smaller companies with amazing products being created and sold right in your proverbial backyard," this is merely one online article.

On this record, we do not find that New York is so well-known for cosmetics as to be a material consideration in the minds of a significant portion of the relevant consuming public. In other words, although applicant's mark may lead consumers to mistakenly believe that applicant's goods emanate from New York, it has not been shown that this would play a significant role in their decision to purchase the goods. Without a showing of materiality, we cannot find that applicant's proposed mark, NY, is primarily geographically deceptively misdescriptive of the identified goods.

Decision

The refusal to register is affirmed based on applicant's failure to comply with the information requirement.

The primarily geographically deceptively misdescriptive refusal is reversed.