

This Opinion is not a
Precedent of the TTAB

Mailed: January 26, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Luvanis S.A.
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Serial No. 86294633
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John L. Welch of Wolf, Greenfield & Sacks, P.C.
for Luvanis S.A.

Patty Evanko, Trademark Examining Attorney, Law Office 119,
J. Brett Golden, Acting Managing Attorney.

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Before Zervas, Cataldo and Ritchie,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Luvanis S.A. (“Applicant”) seeks registration on the Principal Register of the mark shown below for “Backpacks; Bags for packaging of leather; Beach bags; Briefcases; Business card cases; Clutch purses; Credit card cases; Garment bags for travel; Handbags; Key-cases; Leather and imitation leather; Leather shopping bags; Luggage; Purses; Rucksacks; School bags; Suitcases; Travel cases; Traveling bags;

Trunks; Umbrellas; Vanity cases sold empty; Wallets” in International Class 18.¹ The application includes a translation statement providing that an English translation of “AUX ETATS UNIS” is “TO THE UNITED STATES” and a disclaimer of “ETATS UNIS” and “1845”:



The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(e)(3), 15 U.S.C. § 1052(e)(3).² After the Examining

¹ Application Serial No. 86294633, filed May 29, 2014, under Trademark Act § 44(e), 15 U.S.C. § 1126(e).

Applicant entered a description of the mark, which states: “The mark consists of an overall design featuring diamond-shaped groups of four small diamonds in beige against a brown background with the stylized wording “AUX ETATS UNIS 1845” in beige arranged to form a diamond shape.”

² The Final Office Action also included a request for information pursuant to Trademark Rule 2.65. In its Brief, Applicant states, “Applicant states that it intends that the goods will be sold in the United States (comporting with the requirement for any Section 44(e) application), but not manufactured, packaged, or shipped from the United States, nor will they have ‘any connection’ with the United States, as far as Applicant can understand that particular inquiry.” Applicant's Brief at 6, 7 TTABVUE 7. Because the Examining Attorney does not further discuss the requirement for additional information in her Brief, we consider the requirement for additional information to have been satisfied and withdrawn.

Attorney issued a Final Office Action, Applicant filed an appeal. Both Applicant and the Examining Attorney have filed briefs.

I. Analysis

It is the examining attorney's burden to establish the *prima facie* case in support of the refusal of registration. A *prima facie* case for refusal under Section 2(e)(3) that the mark is primarily geographically deceptively misdescriptive of the goods requires a showing that:

- 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 would be a material factor in a substantial portion of the relevant consumers' decision to buy the goods or use the services.

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); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1842 (TTAB 2012).

The Examining Attorney argues that the mark has geographic significance because it includes the French term "Étas Unis" as "United States"; that adding matter to the geographic term does not diminish its primary geographic

significance; and that “aux” is a French term which can be translated as “the.”³ “Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). For support, the Examining Attorney relies on results from Internet translators⁴ submitted with the First Office Action which translate “aux” to “the.” At p. 8 of her Brief, the Examining Attorney also asks us to take judicial notice of three “references” which translate the phrase “aux Etas Unis” as “in the United States.” Only links to the “references” are provided in the Brief (the Examining Attorney did not submit the actual web pages), and there is no indication that these “references” are available in a printed format, are the electronic equivalent of a print reference work, or have regular fixed editions. *See Trademark Trial and Appeal Board Manual of Procedure* (“TBMP”) § 1208.04 (June 2015) and cases cited therein. We therefore decline to take judicial notice of these “references.”

Applicant states, “There is no dispute that the literal portion of Applicant’s mark comprises a three-word French phrase – AUX ETATS UNIS – nor is it disputed that French is a common, modern language.”⁵ Applicant also does not dispute that the mark should be translated under the doctrine of foreign equivalents; Applicant

³ Examining Attorney’s Brief at 6-8, 12 TTABVUE 7-9.

⁴ The translators are at <<https://translate.google.com>>, <<http://www.translate.net/>> and <<http://translation.babylon.com/>>.

⁵ Applicant's Brief at 4, 7 TTABVUE 5.

does, however, contest the translation to be accorded to AUX ETAS UNIS. According to Applicant, the mark should be translated as “to the United States.” Applicant relies on definitions of “aux” and “to” from *Le Robert & Collins Super Senior Grand Dictionnaire*:⁶

French to English (definition of “aux”):

à

à + les = aux

- déplacement, direction

à Lille/au Canada/aux Açores – to go to Lille/Canada/the Azores

English to French (definition of “to”):

to

- direction, movement à

à + les = aux

with geographical names

to + pl country/group of islands aux – to the United States/the West

Indies aux Etats-Unis/Antilles

We find the translation evidence which the Examining Attorney relies on to have limited probative value. The Internet translators are not standard, authoritative dictionaries. They do not provide detailed definitions, usage notes, etymologies, alternative meanings, or other information that might be provided by an

⁶ Submitted with response to First Office Action.

authoritative dictionary. Further, there is no explanation why a dictionary in print format provides a translation different from that provided by the automated translators, why one Internet translator offers translations that the others do not offer, and whether in the phrase “aux Etas Unis,” “aux” is translated differently from “aux” alone. In any event, Applicant’s dictionary evidence establishes that an accepted meaning of “aux Etas Unis” is “to the United States.”

We note, however, that Applicant’s dictionary evidence also establishes that an additional accepted meaning of “aux Etas Unis” is “in the United States.” *See* second entry for “à”:

b position, localisation in • **habiter à Paris/au Canada/ à Bali** to live in Paris/in Canada/in Bali • **on s'est arrete à Toulouse** we stopped in Toulouse • **je suis à la cuisine** I'm in the kitchen. **il faisait chaud à l'eglise/au theatre** it was hot in church/in the theatre

Due to the reference to the United States in the mark, and especially when translated as “in the United States,” we find that the primary significance of the mark is a generally known geographic place. The appearance of “1845” does not change the primary significance of the mark as it is a numeral, likely referring to a year, and it appears below the wording in the mark.

Turning to the next *Spirits* factor, Applicant has acknowledged that the goods do *not* originate in the United States. Thus, there is no dispute regarding the origin of the goods.

We now turn to the final two *Spirits* factors. The Examining Attorney relies on the same evidence to establish that (i) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark, and (ii) the misrepresentation would be a material factor in a substantial portion of the relevant consumers' decision to buy the goods. None of this evidence, however, concerns the issue of whether a substantial portion of the relevant consuming public would likely be deceived by a non-English place name. *Trademark Manual of Examining Procedure* ("TMEP") § 1210.05(b) states:

In cases under the doctrine of foreign equivalents, where the place name in the mark appears in a foreign language, the requirement that a substantial portion of the relevant consuming public would likely be deceived raises special issues. To make a determination about "a substantial portion" in such cases, the examining attorney must consider whether the foreign language place name would be recognizable as such to consumers who do not speak the foreign language, and/or whether consumers who speak the foreign language could constitute a substantial portion of the relevant consumers (e.g., because they are the "target audience"). *Spirits*, 563 F.3d at 1353, 90 USPQ2d at 1493; *see Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1097 (TTAB 2012).

The Examining Attorney has not addressed this requirement in her Brief, and there is no evidence in the record which we can look to which supports this requirement. In other words, there is nothing in the record from which we can determine whether (i) U.S. consumers who do not speak French would recognize "aux Etas Unis" as referring to "in the United States" or "to the United States," or

(ii) U.S. consumers who speak French are a substantial portion of the relevant consuming public, and would be deceived by the asserted misrepresentation in the mark.⁷

As noted above, Applicant does not dispute that French is a common, modern language.⁸ Lest there be any doubt, we do not view this concession as an acknowledgement that those who speak French in the United States are a substantial composite of the consuming public of Applicant's goods.

In sum the Examining Attorney has not submitted evidence on a critical element of her refusal of a mark involving a foreign geographic term. Inasmuch as the Examining Attorney has the burden of establishing a *prima facie* case that the mark is primarily geographically deceptively misdescriptive, the refusal to register is reversed.

⁷ Even if the Examining Attorney had submitted evidence establishing that U.S. consumers who speak French are a substantial portion of the relevant consuming public, we would not find that the Examining Attorney sustained her burden of establishing that the misrepresentation would be a material factor in a substantial portion of the relevant consumers' decision to buy the goods. The Examining Attorney's evidence establishes a preference for U.S. made products of the type identified in the identification of goods for patriotic reasons (americansworking.com - "[At] Prideority we look for ways to show our patriotism and pride in America. We're honored that you've chosen to visit our website and check-out our handbags that we believe are a wonderful way to show that American pride. We hope you'll enjoy viewing our merchandise and that you'll decide to display your pride in America by purchasing one or more of our red, white and blue patriotic handbags to proudly demonstrate your allegiance to this great country we are so blessed to live in."), reflects consumer preferences overseas (bloomberg.com - "Made-in-USA Luxury Brands Win Fans in China"), is generally unhelpful to the Examining Attorney's contention (poshglam.com - "Made in the USA is not something we see on tags very often, especially when it comes to high fashion.") or is otherwise insufficient in quantity to be persuasive.

⁸ Applicant's Brief at 4, 7 TTABVUE 5.

Decision: The refusal to register Applicant's mark under Section 2(e)(3) is reversed.