

This Opinion is not a  
Precedent of the TTAB

Mailed: October 11, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Pearl 9 Group LLC*

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Serial No. 86539117

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Nathan Gugliotta of Law Offices of John D. Gugliotta P.E. Esq. LPA,  
for Pearl 9 Group LLC.

Caroline E. Wood, Trademark Examining Attorney, Law Office 110,  
Chris A.F. Pedersen, Managing Attorney.

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Before Kuhlke, Cataldo, and Ritchie,  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Pearl 9 Group LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark I.W. SUISSE for goods ultimately identified as “Clocks and watches; Parts for watches; Watch bands and straps; all of which are of Swiss origin as defined by the Swiss Ordinance governing the use of the appellation

‘Switzerland’ or ‘Swiss’ for watches, timepiece dial faces, and parts for timepieces made in Switzerland,” in International Class 14.<sup>1</sup>

The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a prior registration of the certification mark SWISS, in typed drawing form,<sup>2</sup> for “Horological and chronometric instruments, namely, watches, clocks and their component parts and fittings thereof” in Class A.<sup>3</sup> The registration contains a certification statement that “[t]he certification mark, as used by persons authorized by the certifier, certifies geographical origin of the goods in Switzerland.”

After the Examining Attorney made the refusal final,<sup>4</sup> Applicant filed a request for reconsideration and an appeal. When the request for reconsideration was denied, the appeal was resumed. Both Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

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<sup>1</sup> Serial No. 86539117, filed on February 19, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1(a), alleging a date of first use on January 1, 1987, and first use in commerce on June 2, 2002, disclaiming the exclusive right to use the term “SUISSE” apart from the mark as a whole, and claiming acquired distinctiveness of the mark as shown.

<sup>2</sup> “Prior to November 2, 2003, ‘standard character’ drawings were known as ‘typed’ drawings. The mark on a typed drawing was required to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark.” TMEP § 807.03(i) (Oct. 2017).

<sup>3</sup> Registration No. 3047277, registered January 24, 2006 to the Federation of the Swiss Watch Industry. Sections 8 and Section 15 accepted and acknowledged. Renewed.

<sup>4</sup> Other requirements by the Examining Attorney were considered to be satisfied and no other refusals were made final.

## I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). As noted above, the cited registration is for a certification mark. The applicable section of the Trademark Act dictates that certification marks “shall be registrable under this chapter, in the same manner and with the same effect as are trademarks.” Trademark Act Section 4, 15 U.S.C. § 1054. The Section states further that: “[a]pplications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.”

Our precedent further clarifies that the classification as a certification mark “has very little effect on our determination as to whether or not there is a likelihood of confusion.” *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012). As further stated in that case:

The test for determining likelihood of confusion with respect to certification marks is the same as that applied to trademarks, *i.e.*, the *du Pont* analysis. However, because the certification mark owner does not itself use the mark, the question of whether there is a likelihood of confusion is based on a comparison of the mark as applied to the goods or services of the certification mark users. (citations omitted). Other issues relating to the goods and services, including the channels of trade and purchasers therefor, are determined from the standpoint of the users as well.

*Id.*; quoting *Motion Picture Ass’n of America, Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559 (TTAB 2007).

Thus, in considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014). “Not all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir 2010)).

#### A. The Goods, Trade Channels and Purchasers

We consider first the similarities or dissimilarities between the respective goods as identified in the application and the certified goods of the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (goods as identified in involved application and cited registration compared); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant identifies:

Clocks and watches; Parts for watches; Watch bands and straps; all of which are of Swiss origin as defined by the Swiss Ordinance governing the use of the appellation ‘Switzerland’ or ‘Swiss’ for watches, timepiece dial faces, and parts for timepieces made in Switzerland.

The cited registration also identifies:

Horological and chronometric instruments, namely, watches, clocks and their component parts and fittings thereof;

with the certification statement that:

The certification mark, as used by persons authorized by the certifier, certifies geographical origin of the goods in Switzerland.

Thus the goods are legally identical.

When the respective identifications of goods are legally identical and without restrictions as to nature, type, channels of trade, or classes of purchasers, as is the case here, the identified goods are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983) (“[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”). Thus, we presume the trade channels and classes of purchasers are the same for both Applicant’s goods and the goods certified by Registrant, and Applicant has not disputed these presumptions.<sup>5</sup>

## B. The Marks

We now compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison,

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<sup>5</sup> Applicant did not dispute that the goods and the channels of trade are identical, but instead focused on the marks, arguing, with regard to *du Pont* factors two and three, “this Board need not concern itself with this analysis.” 7 TTABVue 8-9.

but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. Vv. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). In fact, 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 re Nat'l Data Corp.*, 224 USPQ at 751. Moreover, where, as in the present case, the marks would appear on legally identical goods, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The mark in the cited registration is SWISS, and Applicant's mark is I.W. SUISSE, both in standard character or typed drawing form. The following definitions are of record:

Suisse: (Placename) The French name for Switzerland; Switzerland: a republic in central Europe.<sup>6</sup>

Swiss: 1a. a native or inhabitant of Switzerland; b. one that is of Swiss descent.<sup>7</sup>

Thus, the term "SUISSE" is understood as referring to the country of Switzerland, from which Swiss things come. Applicant does not dispute this, but argues that while the terms are "no doubt related," they are "not *identical*."<sup>8</sup> In this regard, Applicant argues that the marks are not "confusingly similar" because the mark in the cited

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<sup>6</sup> Thefreedictionary.com. Attached to February 9, 2017 Office Action, at 4.

<sup>7</sup> Merriam-webster.com. Attached to March 29, 2018 Denial of Request for Reconsideration, at 2.

<sup>8</sup> 7 TTABVUE 4.

registration refers to the “*people*” while the Applicant’s mark refers to the “*region*.”<sup>9</sup> We find, nevertheless, that the commercial impression is highly similar, with both giving the commercial impression of clocks, watches, and their component parts that are Swiss, because they originate from Switzerland.

Regarding the pronunciation, our case law dictates that there is no correct pronunciation of a trademark. *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014) (“There is no correct pronunciation of a trademark that is not a recognized word.”) (*citing In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969)); *In re Allegiance Staffing*, 115 USPQ2d 1319, 1325 (TTAB 2015) (no correct pronunciation of mark that is coined term). We find that SUISSE may be pronounced the same as SWISS.

Applicant argues that nevertheless its mark is a composite of “I.W.” and “SUISSE” and that the first term is most likely to be noticed and remembered. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692 (Fed. Cir. 2005); *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). In this regard, Applicant argues that:

Here, the Mark’s “I.W.” element is short for “International Watchman,” the name of Applicant’s company. International Watchman is a well-known and very successful brand in the watch and watch band industry.<sup>10</sup>

Rather, our precedent dictates that the addition of a house mark does not necessarily avoid likelihood of confusion. “[S]uch addition may actually be an aggravation of the

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<sup>9</sup> 7 TTABVUE 4.

<sup>10</sup> 7 TTABVUE 5.

likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion.” *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (citations omitted) (finding LE CACHET DE DIOR confusingly similar to CACHET). *See also In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558, 559 (CCPA 1972) (stating that addition of a trade name will make consumers think that products have a common origin or that the companies have merged); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1201-02 (TTAB 2007) (applying principle that “the addition of a trade name or house mark or other such matter to one of two otherwise similar marks will not serve to avoid a likelihood of confusion.”).<sup>11</sup>

Applicant also argues that the mark in the cited registration is weak because the term SWISS is “merely descriptive.”<sup>12</sup> However, Section 2(e)(2) of the Trademark Act, which bars registration of terms that are “primarily geographically descriptive,” specifically exempts “indications of regional origin.” 15 U.S.C. § 1052(e)(2). Thus, Section 4 of the Trademark Act, 15 U.S.C. § 1054, provides for registration of certification marks, “including indications of regional origin.”<sup>13</sup>

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<sup>11</sup> Applicant’s citation to a Second Circuit case, *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 USPQ 969, 976 (2d Cir. 1981) is inapposite, as it involves an infringement action, and the court examined the marks as they are displayed in the marketplace rather than as they are registered.

<sup>12</sup> 7 TTABVUE 7.

<sup>13</sup> Indeed, a challenge against the cited mark was rejected by the Board in the 2012 case *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731 (TTAB 2012). The plaintiff in that case petitioned to cancel two certification marks owned by the Federation of the Swiss Watch Industry, including Registration No. 3047277, when plaintiff’s application SWISS LEGEND was refused by the PTO on the ground of likelihood of confusion. The Board denied the cancellation, finding that plaintiff had not sufficiently proven any of the alleged grounds, including that registrant does not have legitimate control over the terms SWISS and SWISS MADE; that registrant has improperly permitted and encouraged use of its marks for purposes other than to certify; that registrant discriminates in the granting of

Overall, when considered as a whole, we find the marks to be more similar than different in sight, sound, and commercial impression. We find that, particularly since the goods are identical, consumers are likely to understand Applicant's mark I.W. SUISSE as a variant on the certification mark SWISS for the same goods. This *du Pont* factor also favors finding a likelihood of confusion.

### C. Conclusion

After considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that Applicant's goods are legally identical to the goods certified by the certification mark in the cited registration, and we presume that they would travel through the same channels of trade to some of the same general consumers. We further find that the marks as a whole are similar in sight, sound, connotation, and commercial impression. Accordingly, we find a likelihood of confusion between Applicant's mark I.W. SUISSE and the certification mark in the cited registration SWISS for all of the goods identified.

**Decision:** The Section 2(d) refusal to register Applicant's mark is affirmed.

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use of its certification marks; and that the terms SWISS and SWISS MADE cannot function as certification marks because they have become generic for horological and chronometric instruments. *Id.*, at 1746. That was, furthermore, an inter partes action, and Applicant here cannot bring a collateral attack on the mark via this ex parte case. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Fiesta Palms*, 85 USPQ2d 1360, 1363 (TTAB 2007).