Exhibits

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Schweizerischerbankeverein

Serial No.: 75/508,698

Filing Date: 6/17/98

Mark: SWISS BANK CORPORATION

04-01-2002

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #61

APPLICANT'S APPEAL BRIEF

OF COUNSEL:

Jennifer M. Hampton

Attorneys for Applicant
SCHWEIZERISCHERBANKEVEREIN

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PRELIMINARY STATEMENT

Applicant, Schweizerischerbankverein, seeks to register the mark SWISS BANK CORPORATION in connection with the following:

> "Casting products made of gold-based alloys, silver-based alloys and platinum-based alloys, sold in bulk; ingots of precious metal; jewelry; and monetary and non-monetary coins of precious metal" **in International Class 14**;
>
> "Underwriting consumer credit insurance, surety insurance, liability insurance, life insurance, loss insurance and reinsurance, insurance consultation, insurance brokerage; financial forecasting, financial planning; banking services; stock market services, namely, stock brokerage; real estate affairs, namely, real estate appraisal, real estate investment, and real estate brokerage; financial portfolio management; security brokerage; institutional asset management; fiscal assessments and evaluation; financial sponsorship of cultural events, sporting events and research" **in International Class 36**; and
>
> Legal services for third parties in the field of setting up and administration of a company; scientific research, computer programming for others; leasing of electronic, optical and magnetic recording media, software, data processing equipment, remote data transmission equipment, and administration and exploitation of intellectual property rights, namely, licensing of patent rights, trademark rights and copyright" **in International Class 42**.

The Examining Attorney has refused registration under § 2(e)(1) of the Lanham Act, alleging that Applicant's mark is geographically descriptive of Applicant's goods. On December 26, 2001, Applicant filed a Request for Reconsideration along with its Notice of Appeal. The Examining Attorney denied said Request on January 24, 2002, and on January 30th, 2002, sent a letter to Applicant advising of said denial. With this communication of January 30th, appeal proceedings were resumed. Pursuant to 37 C.F.R. § 2.64, Applicant herewith appeals the decision of the Examining Attorney, and asserts that, when all known circumstances relevant to the use of the proposed mark are considered, SWISS BANK CORPORATION will be shown to be a distinctive designator of Applicant's goods.

ARGUMENT

A. Applicant's Mark Has Acquired Secondary Meaning

Applicant respectfully reasserts its argument that SWISS BANK CORPORATION has acquired secondary meaning through over twenty years of use in the United States, and is thus not primarily geographically descriptive as the Examiner contends. Applicant respectfully submits that the subject mark has acquired secondary meaning in the marketplace.

Descriptive marks may acquire distinctiveness which will allow them to be protected under the Lanham Act. An applicant may, in support of registrability, proffer evidence that the mark has become distinctive of the goods and/or services as recited in the application. 37 CFR § 2.41, TMEP § 1212.03. As proof of this mark's long and continuous use, Applicant attaches hereto and incorporates herein by reference as Exhibit 1 numerous articles, dating back to 1994 (the earliest date available on the WESTLAW database) in which the subject mark is featured in connection with Applicant's goods and services. Applicant notes that a search of the subject mark resulted in nearly eight hundred articles published from 1999 to present, and nearly two thousand articles published between 1994 and 1998. Clearly, then, Applicant's mark is a famous one which has been in use for a considerable period of time.

Alternatively, proof of substantially exclusive and continuous use of a mark in commerce for five years preceding the date of claim of distinctiveness may be accepted as prima facie evidence of secondary meaning. 15 U.S.C.S. §1052 (5); TMEP § 1212.05 (a). Applicant submits that the mark SWISS BANK CORPORATION has been in use since at least October 28, 1977, and has thus undisputedly acquired secondary meaning. A Section 2(f) Affidavit attesting to this long and continuous use is forthcoming, although, applicant submits the evidence set forth above in Exhibit 1 should be sufficient proof of longstanding use.

B. Alternatively, Applicant Requests Registration of Mark for Certain Goods/Services

Applicant has submitted the above evidence of acquired distinctiveness notwithstanding its assertion that SWISS BANK CORPORATION is not geographically descriptive of most, if not all, of the goods and services covered by the subject mark. Unlike French perfume or wine, Puerto Rican rum, Idaho potatoes or Cuban cigars, there is no goods-place association between Switzerland and, for example, ingots of precious metal; financial sponsorship of cultural events, sporting events and research; leasing of electronic, optical and magnetic recording media, software, data processing equipment, remote data transmission equipment, and administration and exploitation of intellectual property rights, or other goods and services covered by the subject application. See Philip Morris Inc. v. Reemstsma Cigarettenfabriken GmbH, 14 U.S.P.Q.2d 1487, 1490 (TTAB 1990) (the geographic term "PARK AVENUE" held neither primarily descriptively, nor deceptively misdescriptive because there was no showing of goods/place association between the mark and tobacco products); V&V Food Products, Inc. v. Cacique Cheese Co., Inc., 683 F.Supp. 662, 670-671 (N.D. Ill. 1988) (Insufficient evidence of geographic misdescriptiveness to invalidate mark in view of other evidence indicating no immediate or primary connection between the Mexican region "CHIHUAHUA" and brand of cheese); In re Circus Ices, 158 U.S.P.Q. 64 (TTAB 1968) (No evidence that Hawaii is noted for flavored ice products, and, thus, "HAWAIIAN" held not primarily geographically descriptive or deceptively misdescriptive as applied to applicant's goods); In re Nantucket, 677 F.2d at 101. ("NANTUCKET" held not primarily geographically deceptively misdescriptive of shirts that do not originate on Nantucket Island, based on lack of evidence that consumers would expect shirts labeled NANTUCKET to have come from Nantucket).

If for some reason the Board finds the evidence set forth above in Section A insufficient, Applicant requests that the Board permit the subject mark to proceed to registration covering those goods and services the Board deems to lack geographic descriptiveness. While Applicant contends that Switzerland is not immediately associated in the minds of consumers with any of the goods or services set forth in the subject application, the Board may believe this is the case for only certain of the goods of services covered. If this is the case, Applicant requests that the Board permit registration of the subject mark in connection with those goods and services it deems appropriate.

C. *Any Doubt Should be Resolved In Favor of Applicant*

To the extent there is any doubt as to the distinctiveness of Applicant's mark, such doubt should be resolved in Applicant's favor. In re Atavio, 25 U.S.P.Q.2d 1361, 1363 (T.T.A.B. 1992). Any party who believes that it will be damaged by the registration of SWISS BANK CORPORATION will have the opportunity, under § 13 of the Lanham Act, to oppose registration of the mark. See In re Gracious Lady Service, Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972).

CONCLUSION

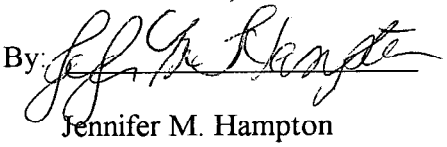
In light of the foregoing, Applicant respectfully requests that the Trademark Trial and

Appeal Board reverse the decision of the Examining Attorney and approve the registration of its mark SWISS BANK CORPORATION.

Dated: New York, New York
April 1, 2002

Respectfully submitted,

WHITE & CASE, LLP

By: 

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Date of Deposit: April 1, 2002

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Name: Jennifer M. Hampton

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