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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Flanders Corporation

Serial No. 76475934

Robert W. Adams of Nixon & Vanderhye, P.C. for Flanders Corporation.

Vivian Micznik First, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Quinn, Holtzman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 17, 2002, applicant Flanders Corporation applied to register on the Principal Register the mark "SWISSAIRE" in typed form for "air filters for industrial installations" in Class 11.¹

The examining attorney ultimately refused to register applicant's mark on the grounds that (1) the mark is primarily geographically descriptive of applicant's goods

¹ The application is based on an allegation of dates of first use anywhere and in commerce of December 10, 2002.

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under Section 2(e)(2) of the Trademark Act (15 U.S.C. § 1052(2)(e)(2)), and (2) the drawing of the mark is materially different from the mark in the specimen (37 CFR § 2.51(a)(1)). Applicant now seeks review of the examining attorney's refusals.

The examining attorney argues that the "primary significance of the word SWISS is to indicate that something or somebody is from Switzerland. Applicant has not suggested an alternative meaning for the term." Brief at unnumbered page 3. Furthermore, the examining attorney maintains that the "term AIRE (or AIR) is merely descriptive of the purpose and use of the applicant's filters, i.e., to filter air." Brief at unnumbered page 4. As a result, the examining attorney concludes that "the mark is primarily geographically descriptive of Swiss-made industrial filters used to filter air." Id. Regarding the second issue, the examining attorney argues (Brief at unnumbered page 5, footnote and parenthetical omitted) as follows:

The applicant's drawing page displays the mark as SWISSAIRE and the specimen shows the mark as SWISS+AIRE. The "+" design that separates the words SWISS and AIRE in the specimen is identical to the "+" design on the Swiss flag. The presentation of the mark in the drawing is an unacceptable mutilation of the applicant's mark because the applicant seeks registration of something less than the totality of [its] trademark.

Applicant responds to the geographically descriptive refusal (Reply Brief at 1) as follows:²

No one disputes that "SWISS" connotes Switzerland. However, when the overall mark is considered, applicant respectfully submits that SWISSAIRE is not geographically descriptive of anything other than "air from or in the country of Switzerland." However, air from Switzerland is not the goods of the applicant. Rather, applicant['s] goods are quite limited to just "air filters for industrial installations." Consequently, when looking at the overall mark, the mark is not merely descriptive of a geographic location.

Regarding the second refusal, applicant argues that the "simple 'plus' symbol is a common geometric shape that adds nothing to the registrability of the mark... Therefore, applicant submits that the 'plus' symbol will be ignored by ordinary consumers." Reply Brief at 2.

We begin our analysis by addressing the first issue, i.e., whether applicant's mark is primarily geographically descriptive of the identified goods. In these cases, we apply the following test:

[I]n order to justify a refusal under Section 2(e)(2) of the Act, this Office must show that the mark sought to be registered is the name of a place generally known to the public and that the public would make a services/place association, i.e., believe that the

² We sustain the examining attorney's objection to the copies of registrations that applicant submitted for the first time with its brief. In re SPX Corp., 63 USPQ2d 1592, 1593 n.2 (TTAB 2002) ("With its brief applicant submitted copies of third-party registrations for trademarks containing design forms of the letter "E." The Examining Attorney has objected to these submissions as untimely. We agree"). See also 37 CFR § 2.142(d).

[goods or] services for which the mark is being registered originate in that place. Moreover, if a geographic term in a mark is neither remote nor obscure and the geographic significance is the primary connotation of the term, and where the goods or services actually originate from the geographic place designated in the mark, a public association of the goods or services with the place may ordinarily be presumed.

In re Carolina Apparel, 48 USPQ2d 1542, 1543 (TTAB 1998).

We note that in this case there is no question but that applicant's goods come from Switzerland. Applicant's specimen contains the following statement: "The Swiss have a reputation for quality and precision and the SA600-G10, made in Switzerland, continues the tradition." Applicant agrees that the term "'Swiss' connotes Switzerland." Reply Brief at 1.

As requested by the examining attorney, we take judicial notice³ of the following definitions:

Swiss: Of or relating to Switzerland or its people or culture."

Switzerland: A country of west-central Europe. It became part of the Holy Roman Empire in the 10th century but by 1499 had achieved independence as a confederation of cantons. Switzerland later adopted a federal constitution (1848) and maintained a policy of neutrality through both World Wars. Bern is the capital and Zurich the largest city. Population 6,455,900.

³ University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The American Heritage Dictionary of the English Language (3d ed. 1992). There is no argument that the country of Switzerland is remote or obscure. Nor is there any argument that the term "Swiss" would have any other meaning. Inasmuch as applicant's goods come from the country of Switzerland and there is no argument that this location is remote or obscure, the term "Swiss" is geographically descriptive of applicant's goods that come from the country of Switzerland.

In this case, applicant's mark is not simply the word "Swiss" but it is the compound term SWISSAIRE. Therefore, we must consider whether combining the geographically descriptive term "Swiss" with the term "Aire" results in a mark that is primarily geographically descriptive. "Air" is at least a highly descriptive term when used with filters for air. The term "Aire" is simply a misspelling of the term "air."

Other cases have recognized that a slight misspelling does not change a merely descriptive term into a suggestive term. See Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315 (1938) (NU-ENAMEL; NU found equivalent of "new"); In re Quik-Print Copy Shops, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) (QUIK-PRINT held descriptive; "There is no legally significant difference here between 'quik' and 'quick'"); Hi-Shear Corp. v. National Automotive Parts Association, 152 USPQ 341, 343 (TTAB 1966) (HI-TORQUE "is the phonetic equivalent of the words 'HIGH TORQUE'"); and In re Organik Technologies Inc., 41 USPQ2d 1690, 1694 (TTAB 1997) ("ORGANIK, which is the

phonetic equivalent of the term 'organic,' is deceptive").

In re Planalytics Inc., 70 USPQ2d 1453, 1455 (TTAB 2004).

In addition to being a misspelling of the descriptive term "Air," the examining attorney has introduced registrations that show that this misspelled term has itself been frequently disclaimed. See, e.g., Registration No. 1,225,894 (AERO AIRE for "aircraft air conditioning systems," "Aire" disclaimed); No. 1,309,870 (AIRE WRAP for heating and cooling systems; "AIRE" disclaimed); No. 1,292,081 (READY AIRE for "heaters, heater cores and heat exchangers for automobiles and trucks;" "Aire" disclaimed); No. 1,299,430 (MAGIC AIRE for exhaust fans and ventilating blowers; "Aire" disclaimed); No. 1,372,376 (PEERLESS AIRE for vent registers, vent grilles, and ventilation air circulators; "Aire" disclaimed); No. 2,164,531 (KEY WEST AIRE and design for fans; "Key West Aire" disclaimed).⁴ We can use third-party registrations as a form of a dictionary definition to illustrate how the term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). These registrations show that the

⁴ In light of these registrations, it is not clear why the examining attorney referred to AIRE as "a novel spelling of the word AIR." Brief at unnumbered page 2.

term "Aire" and "Air" would be perceived similarly and that they would be highly descriptive when used on air filters.

The question then is whether the combined term SWISSAIRE is primarily geographically descriptive for applicant's goods. Applicant argues that the examining attorney "fails to limit her rejection to a geographically descriptiveness basis." Reply Brief at 1. Applicant goes on to argue that the examining attorney "has abandoned the 'geographically descriptiveness' argument and she has shifted to a 'merely descriptiveness' argument." Reply Brief at 2. We disagree. It is well established that "the addition of highly descriptive matter to a geographic term does not detract from the mark's primary significance as being geographically descriptive." In re Monograms America Inc., 51 USPQ2d 1317, 1319 (TTAB 1999)(MONOGRAMS AMERICA for consultation services for owners of monogramming shops held primarily geographically descriptive as it simply signifies United States origin and/or geographical scope). See also In re Handler Fenton Westerns, Inc., 214 USPQ 848, 850 (TTAB 1982) (The "mark 'DENVER WESTERNS,' when applied to western-style shirts that, according to the application, have their geographical origin in Denver, is primarily geographically descriptive"); In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986)("[W]e do not

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believe that the addition of the highly descriptive word DIGITAL and the design detract from the primary geographic significance of the mark, CAMBRIDGE being the dominant origin-indicating feature of the mark"); In re Chalk's International Airlines Inc., 21 USPQ2d 1637, 1639 (TTAB 1991)(PARADISE ISLAND AIRLINES held primarily geographically descriptive of transporting passengers and goods by air); and In re U.S. Cargo Inc., 49 USPQ2d 1702, 1704 (TTAB 1998) (U.S. CARGO held primarily geographically descriptive for towable trailers for carrying cargo and vehicles for commercial purposes).

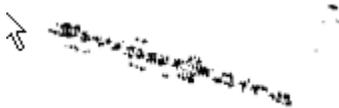
In this case, the geographically descriptive term "Swiss" has been combined with the highly descriptive term "Aire." The resulting term, SWISSAIRE, for air filters for industrial installations remains primarily geographically descriptive. While applicant argues that "air from Switzerland is not the goods of applicant," when we are dealing with questions of descriptiveness, we must view the mark in the context of the goods. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)("Appellant's proposed abstract test is deficient -- not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as

required by the statute"). See also In re MCO Properties Inc., 38 USPQ2d 1154, 1156 (TTAB 1995) ("Whether there is an association between the name of the place and the services is determined not in the abstract, but rather in connection with the services with which the mark is used"). In the context of air filters (applicant's goods), the term SWISSAIRE would not be understood to refer to air from Switzerland. Instead, it would refer to air filters from Switzerland, which is exactly what applicant's goods are. We conclude that when the highly descriptive term "Aire" is combined with the geographically descriptive term "Swiss," the resulting term is primarily geographically descriptive.

The next question we address is whether the term in applicant's drawing is a substantially exact representation of the mark on applicant's specimen. The "drawing depicts the mark sought to be registered." 37 CFR § 2.52. "In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services." 37 CFR § 2.51(a). See also In re Hacot-Columbier, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997) ("The regulation's term 'substantially' permits some inconsequential variation from the 'exact representation' standard"). If an amended drawing is submitted, the test

is whether the amended drawing is a material alteration. In re Who? Vision Systems Inc., 57 USPQ2d 1211, 1217-18 (TTAB 2000)("[U]nder the new rules, any and all proposed amendments are subject to the material alteration standard, and no amendment is permissible if it materially alters the mark sought to be registered, i.e., the mark depicted on the drawing").

The drawing in this case depicts the mark as SWISSAIRE. The specimen and applicant's literature show two representations of the mark SWISSAIRE.



While the depictions of the marks are difficult to determine from these representations, both the examining attorney and applicant agree that the mark on the specimen is shown with the words "Swiss" and "Aire" connected by a "+" design. Examining Attorney's Brief at unnumbered page 5 ("The '+' design that separates the words SWISS and AIRE in the specimen is identical to the '+' design on the Swiss flag") and Applicant's Reply Brief at 2 ("[I]n arguing that the drawing does not match the specimens, the Examining Attorney attempts to change a simple '+' symbol into 'the cross design from the Swiss flag.' This is not accurate.

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The applicant's drawing [specimen?] has the commonly used geometric '+' symbol. It does not have the distinctive, wide cross design of the Swiss flag") (parenthetical omitted).

The examining attorney argues that the mark "in the specimen includes a design element that is inextricably bound to the literal portion of the mark because it is physically joined with the words in the mark, and it also enforces the meaning of the word SWISS in the mark." Brief at unnumbered page 5.

The record shows that the mark SWISSAIRE in applicant's specimen is displayed with the words "Swiss" and "Aire" connected by a plus sign. We agree with the examining attorney that the "plus" sign is similar to the cross design in the Swiss flag. See Final Office action (attachment):



The "mark on the drawing must be a complete mark, as evidenced by the specimen." TMEP § 807.12(d) (4th ed. 2005). However, if "a mark creates a separate commercial impression and does not fall under any of the statutory prohibitions, it is registrable." In re The Library Restaurant, Inc., 194 USPQ 446, 447 (TTAB 1977). Our case

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law acknowledges that a question of this type is "assuredly a subjective one." In re R.J. Reynolds Tobacco Co., 222 USPQ 552, 552 (TTAB 1984). See also TMEP § 807.12(e) (4th ed. April 2005) ("A compound word mark may be presented as one unitary term (e.g., BOOKCHOICE) or as two words (e.g., BOOK CHOICE) on the drawing. The examining attorney should determine whether the mark may be presented as separate words based on its commercial impression, taking into account any specimen(s) of record").

Cases dealing with these questions have looked to the specific facts of the case to determine if the mark is a substantially exact representation or the slightly different question of whether the mark can be amended. See In re DeWitt International Corp., 21 USPQ2d 1620, 1623 (Comm'r 1991):

Although the design element cannot be added to the mark under Section 7, it does not necessarily follow that a specimen showing use of a composite mark comprised of both word and design elements is insufficient to show current use of the registered mark for purposes of renewal. Where the registered mark is currently used as one of several elements of a composite mark, the decision as to the sufficiency of the renewal specimen requires consideration of whether the registered mark makes an impression apart from the other elements of the mark now in use. If the display of the composite is such that the essence of the registered mark does make a separate impression, then the specimen may be sufficient to support the renewal application.

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The board previously held that the mark PADRES REPORT was not a substantially exact representation of the mark shown in the specimens in the manner similar to the typed representation below:

SAN DIEGO **padres**
REPORT

In re San Diego National League Baseball Club, Inc., 224

USPQ 1067 (TTAB 1983).⁵ In that case, the board held that:

The specimens show use of the terms "SAN DIEGO", "PADRES", and "REPORT" in three different sizes and styles of lettering; that the words "SAN DIEGO" and "PADRES" are grouped together on one line and "REPORT" is located on a separate line below them; and that "SAN DIEGO" and "PADRES" are much more similar in size than are "PADRES" and "REPORT". In view thereof, and since "SAN DIEGO" serves as a modifier, we agree with the finding of the Examining Attorney that the words "PADRES REPORT", as used on the specimens of record, do not create a commercial impression as a trademark separate and apart from the designation "SAN DIEGO PADRES REPORT" as a whole.

Id. at 1070.

In another case, the board found that the phrase KRAZY MIXED-UP was a unitary phrase and that the applicant was not permitted to register the word KRAZY alone. In re Semans, 193 USPQ 727 (TTAB 1976).

Other cases have allowed the registration of a mark even though other material appeared with the mark on the

⁵ We note that this case was overruled in part on another issue. See In re WNBA Enterprises LLC, 70 USPQ2d 1153 (TTAB 2003).

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specimen. The Federal Circuit has held that the mark CHABLIS WITH A TWIST was not a mutilation of the mark on the specimen that displayed the mark as CALIFORNIA CHABLIS WITH A TWIST. Institut National des Appellations D'Origine v. Vintners International Co., 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992). The Court found that "California" was a "geographically descriptive wholly devoid of trademark significance"). Id. at 1197. In another case, the board concluded that the mark BE MORE YOU was a substantially exact representation of the mark that was shown on the specimens like this: *Be-More-You*. R.J. Reynolds, 222 USPQ at 552. The board did not consider the hyphens in the mark to be important and it said its conclusion was bolstered by the fact that the applicant used the mark without hyphens even though the use was after the filing date. Id. Another relevant case involved an applicant's attempt to register the mark HY-LINE. In re Lear Siegler, Inc., 190 USPQ 317 (TTAB 1976). The specimens displayed the mark in the manner similar to the display below:

HY- X LINE

The "X" displayed on the specimens was actually a representation of crossed drill bits. "The crossed drill

bits which separate the elements of the 'HY-LINE' in the mark as used on the specimens are merely a pictorial representation of the goods and therefore have a minimum trademark significance." Id. at 317. The board went on to find that "the term 'HY-LINE' is the only literal portion of the mark and therefore it is the part of the mark which will be used to order and distinguish the goods. The term creates a commercial impression apart from the drill bits and, therefore, is eligible for registration." Id. at 317-18.

When we consider the mark in this case in light of the relevant case law, we conclude that the mark in the drawing is a substantially exact representation of the mark shown on the specimen. The "plus" sign, if it is considered as the examining attorney argues a part of the Swiss flag, does not add anything additional to the mark inasmuch as the term "Swiss" is clearly already a part of the mark. We note that in the Institut National case, even a geographical term that was not repeated in the mark did not prohibit the registration of the mark without the word "California." If it is considered to be a simple "plus" sign, this mathematical symbol would be similar to the hyphen that the board in R.J. Reynolds found to not be significant. Therefore, we reverse the examining

attorney's refusal to register on the ground that the mark is materially different from the mark in the specimen.⁶

Finally, we note that applicant "offers to amend (without prejudice) this application to the Supplemental Register." Brief at 5. It is not clear what an amendment to the Supplemental Register "without prejudice" means inasmuch as a registration on the Supplemental Register is an admission that the mark is descriptive. In re Consolidated Foods Corp., 200 USPQ 477, 478 n.2 (TTAB 1978) ("Registration of the same mark on the Supplemental Register is not prima facie evidence of distinctiveness; in fact, such a registration is an admission of descriptiveness"). See also Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972). Therefore, an amendment to the Supplemental Register cannot be without prejudice to an admission that the mark is merely descriptive or primarily geographically descriptive.

Decision: The refusal to register applicant's mark SWISSAIRE on the ground that applicant's mark is materially different from the mark in the specimen is reversed. The examining attorney's refusal to register on the ground the

⁶ Because of this conclusion, we do not need to address applicant's proposal to submit an amended drawing.

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mark is primarily geographically descriptive of applicant's goods is affirmed.