

**THIS OPINION IS  
NOT A PRECEDENT  
OF THE T.T.A.B.**

Mailed:  
December 3, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Style Asia Inc.

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Serial No. 78885852

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Myron Amer, of Myron Amer, P.C. for Style Asia Inc.

Bernice Middleton, Trademark Examining Attorney, Law Office  
106 (Mary Sparrow, Managing Attorney).

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Before Holtzman, Zervas and Mermelstein, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Style Asia Inc. filed, on May 17, 2006, an application  
to register on the Principal Register the mark



for goods in several International Classes including  
International Class 14, with the International Class 14

goods ultimately identified as "watches and clocks."<sup>1</sup> The application is based on Trademark Act Section 1(a), 15 U.S.C. §1051(a), and asserts first use anywhere and first use in commerce on January 9, 2006 for the International Class 14 goods. Applicant has disclaimed the word SWISS. The colors red, white and black are claimed as a feature of the mark.

The examining attorney has issued a final refusal to register the International Class 14 goods on the grounds (i) that applicant has failed to comply with her request for information under Trademark Rule 2.61(b), 37 C.F.R. §2.61(b); and (ii) that the mark is primarily geographically deceptively misdescriptive of the goods and thus unregistrable under Trademark Act Section 2(e)(3), 15 U.S.C. §1052(e)(3).

Applicant has appealed the final refusal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register on both grounds.

We turn first to the refusal pursuant to Trademark Rule 2.61(b). That rule provides that "[t]he examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper

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<sup>1</sup> Applicant also seeks registration for goods in International Classes 8, 9, 16 and 18.

examination of the application." If an applicant fails to comply with the examining attorney's requirement under Trademark Rule 2.61(b), registration of applicant's mark may be refused on that basis. See *In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003).

In each of her Office actions, the examining attorney required applicant to provide information regarding the geographic origin of applicant's goods. In her initial and final Office actions, the examining attorney stated:

"Applicant must specifically state whether its goods are or will be manufactured, produced or sold in, or have any other connection with, the geographic place named in the mark." In its responses to the first two Office actions, applicant did not even acknowledge the requirement and did not comply with it.

In its first request for reconsideration, however, applicant stated, "[t]he goods identified by the mark [are] imported from Switzerland." The examining attorney responded that "[t]he importation location does not address the origin of the goods" and "Applicant should indicat[e] whether the goods are manufactured or produced in Switzerland," and continued her requirement for additional information.

Applicant then filed a second request for reconsideration in which applicant stated as follows, limiting its comments to the goods in International Class 8, which were also the subject of the final refusal at that time:

Please note of record [sic] that applicant's SWISS MANICURE SETS originate in Switzerland, but it is not known if said goods are manufactured or produced in Switzerland. It is more accurate to say that said goods are available for sale in Switzerland, and that applicant is a purchaser of such goods.

(Capitalization in the original.) After this statement, the examining attorney did not continue her refusals regarding the International Class 8 goods. She did, however, deny the request for reconsideration as it pertained to the International Class 14 goods and continued the Rule 2.61(b) and Section 2(e)(3) refusals, noting that "[n]o statement was made regarding the Class 014 watches and clocks".

Applicant, in its appeal brief, did not acknowledge the requirement for additional information with respect to the International Class 14 goods but merely pointed out that it had responded to the examining attorney's information requirement with respect to "Swiss Manicure Sets" in International Class 8. Brief at p. 1. Applicant

did not address the information requirement in its reply brief at all.

We find that the examining attorney's requirement for information was proper under Trademark Rule 2.61(b). Such information is directly relevant to the issue of whether the goods do not or will not originate in the place named and thus "may be reasonably necessary to the proper examination of the application," as required by the rule. Applicant has not contended otherwise.

We also find that applicant has failed to comply with the examining attorney's Trademark Rule 2.61(b) requirement. After ignoring the examining attorney's requirement in its first and second responses, applicant offered the indefinite response that "[t]he goods identified by the mark [are] imported from Switzerland."<sup>2</sup> It does appear to us that applicant has avoided making a complete response. After the examining attorney informed applicant that its response was not sufficient, applicant ignored the examining attorney's requirement as it pertains to its International Class 14 goods in the three succeeding papers applicant filed. Applicant has not asserted that its response as it pertains to the International Class 14

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<sup>2</sup> We interpret applicant's statement as encompassing the situation where the goods travel through Switzerland to the

goods was sufficient, even in its briefs. Thus, applicant's noncompliance with the examining attorney's requirement under Trademark Rule 2.61(b) warrants rejection of the application.

We turn now to the merits of the examining attorney's Section 2(e)(3) refusal.<sup>3</sup> This refusal is proper if (i) the primary significance of the mark is the name of a generally-known geographic place, (ii) the applicant's goods do not or will not originate in the place named, (iii) purchasers would be likely to believe that the goods originate in the place named (i.e., that a good/place association exists), and (iv) the misrepresentation as to the geographic origin of the goods is or would be a material factor in the purchaser's decision to purchase the goods. *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007).

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United States. Goods may pass through several countries when imported to the United States.

<sup>3</sup> The examining attorney has also refused registration under Section 2(a) of the Trademark Act. Because applicant's mark involves an allegedly deceptive geographic designation, the pertinent ground for refusal in this case is that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3), and not that the mark is deceptive under Section 2(a). See *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003).

The examining attorney has made of record evidence that establishes the following facts which have not been contested by the applicant. First, the examining attorney has shown through her submission from the *Encarta World English Dictionary* that the SWISS portion of applicant's mark is an adjective that means "of Switzerland: relating to Switzerland, or to its peoples or cultures." Second, the examining attorney has established that Switzerland is one of the world's leading manufacturers of higher-quality watches and clocks. Third, the examining attorney has established that Switzerland is world-renowned for its high-quality watches and clocks. Because applicant has never challenged any of the foregoing facts established by the examining attorney, we do not set forth in this opinion the evidence that the examining attorney has submitted to establish these facts. We also find that the examining attorney has set forth sufficient evidence to establish factors (i), (iii) and (vi).<sup>4</sup>

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<sup>4</sup> Applicant has made an argument for the first time at pp. 1 - 2 of its reply brief regarding an absence of deception. It states that there is no deception in view of a "nexus between ... two events," with one event being "a 'watch/clock' in a point-of-sales display, and the second event [being] the mental association fostered by the word CONNECTION." To the extent we understand this argument, we do not find it to be persuasive. The term SWISS is in the mark, and the term has geographic significance.

As for factor (ii), whether applicant's goods do not or will not originate in the place named, the record reflects that applicant is a New York corporation with a New Jersey address. As noted above, the examining attorney in her first and final Office actions required applicant to specifically state "whether its goods are or will be manufactured, produced or sold in, or have any other connection with, the geographic place named in the mark." Applicant ignored the examining attorney's requirement but then eventually stated in its first request for reconsideration, "the goods identified by the mark [are] imported from Switzerland." The examining attorney found this to be an insufficient response.

The Board's recent decision in *In re Cheeswhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008) is instructive. In *Cheeswhse.com*, "despite repeated requests and reminders, applicant did not comply with or even acknowledge the Trademark Examining Attorney's requirement for information." *Id.* at 1919. Accordingly, the Board found that a presumption exists that the goods are not from the geographic area identified in the mark when the applicant failed to comply with the examining attorney's Rule 2.61(b) requirement for information regarding the geographic origin of applicant's goods. The Board stated that "[i]n such

circumstances, we deem it appropriate to presume, for purposes of this Section 2(e)(3) refusal ... that applicant's cheese in fact will not originate in or from Normandy, France. The third element of the Section 2(e)(3) refusal therefore is established." In the present appeal, we similarly find that applicant's failure (i) to respond to the examining attorney's inquiries in the first two Office actions, (ii) to challenge the examining attorney's contention that the importation location does not address the origin of the goods, and (iii) to address the origin of the International Class 14 goods in its briefs, as well as its unclear statement that the goods are "imported from Switzerland," raises the presumption that the goods do not originate in Switzerland. The third element of the Section 2(e)(3) refusal therefore is established.

Thus, we find that the evidence of record establishes each element of the alternative Section 2(e)(3) refusal. The primary significance of the mark is the name of a generally-known geographic location, i.e., Switzerland. A goods/place association exists between watches and clocks, and Switzerland. Applicant's goods do not or will not originate in or from Switzerland. The mark's misrepresentation of the geographic origin of the goods is or would be material to the decision to purchase the goods.

We therefore conclude that applicant's mark is primarily geographically deceptively misdescriptive of "watches and clocks," and that applicant's mark accordingly is unregistrable under Trademark Act Section 2(e)(3).

In summary, we affirm the examining attorney's refusal to register on both stated grounds. First, we affirm the refusal to register which is based on applicant's failure to comply with the examining attorney's proper Rule 2.61(b) requirement for information as to the geographic origin of applicant's goods. Second, based on our presumption that applicant's goods do not or will not originate in or from the place named in the mark, we find that applicant's mark is primarily geographically deceptively misdescriptive of applicant's goods, and therefore affirm the Section 2(e)(3) refusal.

**Decision:** The refusal to register as to Class 14 is affirmed on both grounds. The application will proceed in International Classes 8, 9, 16 and 18.