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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Eastern Watch Company

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Serial No. 78402643

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Edward A. Sokolski, Esq. for Eastern Watch Company.

John T. Lincoski, Trademark Examining Attorney, Law Office  
113 (Odette Bonnet, Managing Attorney).

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Before Bucher, Rogers and Drost, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

Eastern Watch Company (applicant) seeks to register on  
the Principal Register, in standard character form, the mark  
SWISSGOLD for goods ultimately identified as "wrist watches,  
stop watches, pocket watches, watch bands, watch cases, watch  
chains, watch fobs, watch straps, and watches containing a  
game function, all wholly or partially of gold; watch  
movements, parts for watches, alarm clocks, wall clocks,  
clocks not comprised wholly or partially of gold" in Class

14. The intent-to-use application was filed on April 15, 2004.

Citing Sections 2(a) and 2(e)(3) of the Trademark Act, the examining attorney refused registration on the basis that applicant's mark, as applied to applicant's goods, is deceptive and primarily geographically deceptively misdescriptive. When the refusals to register were made final, applicant appealed to this board.

In order to establish that a mark is deceptive as applied to the goods for which registration is sought, the examining attorney must meet a three-part test. First, it must be shown that the mark misdescribes a characteristic or quality of the relevant goods. Second, it must be shown that prospective purchasers are likely to believe that the misdescription actually describes the relevant goods. Finally, it must also be shown that the misdescription is likely to materially affect the decision to purchase the relevant goods. In re Budge Manufacturing Co. Inc., 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988); In re Berman Bros. Harlem Furniture Inc., 26 USPQ2d 1514, 1515 (TTAB 1993).

In order to establish that a mark is primarily geographically deceptively misdescriptive of the relevant goods, a four-part test must be met. First, it must be shown

that the primary significance of the mark is a generally known geographic location. Second, it must be shown that the goods for which applicant seeks registration do not originate in the place identified in the mark, in essence, that the proposed mark misdescribes the geographic origin of the goods. Third, it must be shown that the consuming public is likely to believe that the goods originate in the geographic place identified in the mark. Fourth, it must be demonstrated that the misrepresentation is a material factor in the purchaser's decision to buy the goods. In re Les Halles de Paris J.V., 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003). See also, In re California Innovations, Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003). To be clear, the Federal Circuit in Les Halles and California Innovations combined factors two and three into one.

We note that the Federal Circuit has explained that as a result of changes to the Lanham Act, a Section 2(a) refusal relating to a geographic term and a Section 2(e)(3) refusal are essentially the same:

As a result of the NAFTA changes to the Lanham Act, geographic deception is specifically dealt with in subsection (e)(3), while deception in general continues to be addressed under subsection (a). Consequently, this court anticipates that the PTO will usually address geographically deceptive marks under subsection (e)(3) of the amended Lanham Act rather than subsection (a). While there are identical legal standards for deception

in each section, subsection (e)(3) specifically involves deception involving geographic marks.

California Innovations, 66 USPQ2d at 1858.<sup>1</sup>

However, in this case, the examining attorney has also maintained that, in addition to the term "Swiss" making the mark geographically deceptive, the mark is also deceptive on the ground that the term "Gold" when used in association with non-gold goods will be deceptive. Therefore, we will consider this refusal separately.

The examining attorney has made of record a significant amount of evidence establishing the following facts that have not been contested by the applicant. First, the examining attorney has shown that the SWISS portion of applicant's mark means "of or relating to Switzerland or its people or

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<sup>1</sup>In addition, TMEP § 1210.05 provides that:

Although the test for determining whether a mark is primarily geographically deceptively misdescriptive under § 2(e)(3) is now the same as the test for determining whether a mark is deceptive under § 2(a), the statutory provisions with respect to registrability on the Supplemental Register and on the Principal Register under § 2(f) are different...

[B]ecause the statute expressly prohibits registration of deceptive marks on the Supplemental Register or on the Principal Register under § 2(f), the examining attorney will initially refuse registration of geographically deceptive marks under both §§ 2(a) and 2(e)(3). If the applicant alleges use in commerce prior to December 8, 1993 and amends to the Supplemental Register, or establishes that the proposed mark acquired distinctiveness under § 2(f) before December 8, 1993, the examining attorney will withdraw the § 2(e)(3) refusal, but will not withdraw the § 2(a) refusal.

In this case, there is no allegation that applicant has used its mark in commerce prior to December 8, 1993.

culture.” The American Heritage Dictionary of the English Language (3d ed. 1992). Second, the examining attorney has established that Switzerland is one of the world’s leading manufacturers of higher quality watches and clocks including those comprised in part of the precious metal gold. Third, the examining attorney has established that Switzerland is world renowned for its high quality watches and clocks including those made, in part, of gold. Finally, the examining attorney has established that the word GOLD in applicant’s mark refers to a precious metal, and that it is often used in the manufacture of higher quality watches. Indeed, the evidence establishes that gold is a sought after component in watches. We would like to reiterate that the applicant has never taken issue with any of the foregoing facts established by the examining attorney. Accordingly, we see no point in reviewing in detail the evidence that the examining attorney has submitted to establish these facts.

Applicant readily concedes that none of its watches and clocks (and accessories and parts therefor) are made in Switzerland. Indeed, at page 2 of its brief, applicant notes that its advertising materials emphasize that all of its goods are “made in China.” (original emphasis).

Based upon the foregoing, we find that applicant's mark SWISSGOLD is both deceptive and primarily geographically deceptively misdescriptive as applied to applicant's goods.

With regard to the tests for both refusals, the SWISS portion of applicant's mark misdescribes all of applicant's goods, including those goods not comprised wholly or partially of gold. The term SWISS is so highly associated with watches and clocks that its misdescriptiveness is not eliminated by its combination with the word GOLD.

As for the second part of the test for deceptiveness, and third part of the test for geographic deceptive misdescriptiveness, it is clear to us that prospective purchasers are most certainly likely to believe that the proposed mark actually describes the relevant goods given the fact that Switzerland is so extremely well known for watches and clocks (and accessories and parts therefor), and because some of these products are made in whole or in part of gold.

Finally, in regard to the materiality prong of the respective tests, given the high quality of Swiss watches and clocks, purchasers would be materially influenced into purchasing clocks and watches bearing the mark SWISSGOLD because of the SWISS element of the proposed mark, regardless of the actual composition of the goods.

With regard to the four-part test for determining whether applicant's mark SWISSGOLD is primarily geographically deceptively misdescriptive of applicant's goods, we find that all four of the parts have been met. Obviously, the term SWISS is not just a generally known term but instead is an extremely well-known term to United States consumers signifying, among other things, products produced in Switzerland. Each of the other factors in this test have been discussed above.

Applicant's argument as to why its mark SWISSGOLD is not primarily geographically deceptively misdescriptive (and presumably not deceptive) is best summarized at page 2 of applicant's brief as follows: "The mark SWISSGOLD suggests that the goods sold under the mark are of a high quality but does not infer that the gold in the goods comes from Switzerland or that the watches sold under the mark are made in Switzerland." We find applicant's reasoning to be without merit.

Moreover, at page 2 of its brief, applicant argues that "there has been no attempt, whatsoever, by applicant to lead potential consumers into believing that [its] watches come from Switzerland." In this regard, applicant makes reference to a flyer that states beneath its mark SWISSGOLD the

following in small print: "Quality Watches made in China." There are three problems with applicant's "argument." First, the issues before this Board are whether the mark SWISSGOLD per se is deceptive and primarily geographically deceptively misdescriptive of applicant's goods. Even assuming for the sake of argument that such flyers always accompany applicant's watches and further assuming that consumers notice the "fine print," this is of no legal relevance to the issue before this Board. Second, in any event, there is certainly no requirement or guarantee that such a flyer will forever accompany applicant's watches and clocks, and there is certainly no guarantee that consumers will notice the "fine print" disclaimer. Third, applicant's intent not to deceive prospective purchasers does not establish that applicant's term is registrable. Certainly, prospective purchasers will not be aware of this intent. We are concerned with whether prospective purchasers who encounter the mark, SWISSGOLD, for watches and similar products not from Switzerland will be materially influenced to purchase these products thinking the goods are of Swiss origin.

Therefore, inasmuch as the term "Swiss" is geographically deceptively misdescriptive and deceptive, we affirm the examining attorney's refusals to register.

Regarding the separate refusal to register on the ground that the term "Gold" is deceptive, we begin by noting that many of applicant's goods are not covered by this refusal.<sup>2</sup> Applicant's "*wrist watches, stop watches, pocket watches, watch bands, watch cases, watch chains, watch fobs, watch straps, and watches containing a game function*" are all modified by the phrase "all wholly or partially of gold." Therefore, the deceptiveness refusal would not apply to these goods inasmuch as they are properly described by the term "Gold." However, even if the mark (SWISSGOLD) were not deceptive for some of applicant's goods, it could still be refused registration if it were deceptive for any of the remaining goods. Cf. In re Analog Devices, Inc., 6 USPQ2d 1808, 1809 (TTAB 1988).

The question then is whether the term "Gold" is deceptive when it is used with "watch movements, parts for watches, alarm clocks, wall clocks, [and] clocks not comprised wholly or partially of gold." We begin by observing that the examining attorney does not cite any case nor are we aware of any case that holds that there is a

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<sup>2</sup>Inasmuch as we have already determined that applicant's mark is deceptive because it contains the term "Swiss" for watches and similar products not made in Switzerland, this application would not be entitled to register regardless of our independent determination of the effect of the inclusion of the term "Gold."

per se rule that the term "Gold" is deceptive for all goods if they were at one time or could have been made of or coated with gold.<sup>3</sup> Second, we need some evidence to support our conclusion that "prospective purchasers are likely to believe that the misdescription actually describes the relevant goods." In this case, most of the evidence is directed toward watches being made of gold. Inasmuch as applicant's watches are similarly made of gold, this evidence does not support the refusal for the non-gold goods. The examining attorney does refer to an article that reports that "[c]locks were made of solid gold and were melted down as soon as finances waned." Brief at unnumbered page 14. This article does not demonstrate that consumers today would believe that the term "gold" used for alarm clocks indicates that the clocks are made of gold. However, applicant's goods include "parts for watches." It has been clearly established that watches are sometimes made of gold. It follows, based on this evidence that watches are made of gold, that parts of watches, particularly external replacement parts, may similarly be made of gold. Therefore, inasmuch as applicant's parts are not made of gold, the term "gold" would

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<sup>3</sup> Indeed, the difference in goods likely explains the two registrations to which applicant refers for the mark SWISS GOLD for nail and cuticle revitalizer and chocolates.

deceive potential purchasers who were seeking gold replacement parts for their gold watches. In addition, we note that this misdescription of the composition of these goods not made of gold would not necessarily be apparent from inspection of the goods because these parts not made of gold may nonetheless look like they were made of gold.

Moreover, because of the desirability of the identified products when they are made of gold, the GOLD element of the proposed mark would also be material to purchasing decisions of prospective purchasers.

Decision: The refusals to register are affirmed on both grounds.