

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JAN. 28, 00  
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Eurovirtuel, S.A.

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Serial No. 75/216,946

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William C. Fuess for Eurovirtuel, S.A.

Dominick J. Salemi, Trademark Examining Attorney, Law  
Office 107 (Thomas Lamone, Managing Attorney).

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Before Hanak, Wendel and Rogers, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Eurovirtuel, S.A. (applicant) seeks to register SAINT-TROPEZ in typed drawing form for "computer services, namely providing access time to an online data base in the field of geographic-specific location and destination information concerning attractions, businesses and events for tourists, travelers and residents." The application was filed on

**Ser No.** 75/216,946

December 23, 1996 with a claimed first use date of August 29, 1996.

The Examining Attorney has refused registration on two grounds, namely, that pursuant to Section 2(e)(2) of the Trademark Act applicant's mark is primarily geographically descriptive of applicant's services, and that pursuant to Section 2(e)(1) of the Trademark Act applicant's mark is merely descriptive of applicant's services.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We will consider first whether applicant's mark is primarily geographically descriptive of applicant's services and thus is barred from registration pursuant to Section 2(e)(2) of the Trademark Act. Our primary reviewing Court has established a two-part test for determining whether a mark is primarily geographically descriptive. The Court has stated "that a prima facie case of unregistrability cannot be made out simply by evidence showing that the mark sought to be registered is the name of a place known generally to the public; it is also necessary to show that the public would make a goods [services]/place association, i.e., believe that the goods

[or services] for which the mark is sought to be registered originate in that place." In re Societe Generale, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987).

Applicant's own evidence demonstrates that the first part of the two-part test has been met. Applicant made of record the affidavit of Olivier Demacon, an employee of applicant. In paragraph 2 of his affidavit, Mr. Demacon states that "the city and locale of Saint-Tropez, France is a world-famous resort and tourism destination." Moreover, the Examining Attorney has made of record a large number of stories appearing in United States newspapers and magazines which demonstrate that the city of Saint-Tropez has received widespread publicity in the United States. Thus, the city of Saint-Tropez is clearly "a place known generally to the [United States] public." 3 USPQ2d at 1452.

Turning to the second part of the two-part test, applicant has conceded that its "services do come, in part, from Saint-Tropez, France." (Applicant's paper dated September 9, 1997 at page 4, original emphasis). Thus, given the fact that applicant's services do originate from Saint-Tropez, the public would make a services/place association, i.e., believe that the services for which the

mark is sought to be registered originate in the place named (Saint-Tropez).

In response, applicant argues that while the services of travel and tourism might well be associated with Saint-Tropez, that "the city of Saint-Tropez is not a 'computer service' type of city..." (Applicant's paper dated September 9, 1997 at page 7, original emphasis).

We simply note that in this age of the Internet, computers and computer services are extremely ubiquitous and that any city would be perceived as offering computer services. Moreover, applicant's particular computer services, which provide information to tourists and travelers, are especially appropriate for resort and tourism destinations. Indeed, we seriously doubt that any city or even town could maintain its status as a world famous resort if it did not offer computer services. Computer services are the exact opposite of "smokestack industries."

Moreover, as its specimens of use, applicant submitted what it described as copies of its "home page presented on the World Wide Web of the Internet." At the top of applicant's home page there appears applicant's mark SAINT-TROPEZ followed by such subject categories as hotels, real estate and local information. We firmly believe that

United States consumers viewing applicant's home page would clearly make a services/place association, that is, assume that this home page originated from a concern located in Saint-Tropez. Indeed, applicant's specimen of use does not discuss any geographic location other than Saint-Tropez.

We turn now to a consideration of whether applicant's mark is also merely descriptive of applicant's services and thus is barred from registration pursuant to Section 2(e)(1) of the Trademark Act. At the outset, we will acknowledge that this is a highly unusual case in that rarely is a mark held to be both merely descriptive and primarily geographically descriptive. However, given the unusual facts of this case, we find that applicant's mark SAINT-TROPEZ is both merely descriptive and primarily geographically descriptive. The fact that applicant's mark is primarily geographically descriptive does not preclude it from also being merely descriptive. This is because in order to be held merely descriptive, a mark need not describe all of the characteristics of the services for which registration is sought. Meehanite Metal v. International Nickel, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

It is well established that whether a term is merely descriptive is not determined in the abstract, but rather

**Ser No.** 75/216,946

is determined in relationship to the goods or services for which registration is sought. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). As previously noted, applicant's services as described are "computer services, namely providing access time to an online data base in the field of geographic-specific location and destination information concerning attractions, businesses and events for tourists, travelers and residents." (emphasis added). If a United States consumer was informed that the services in question were the foregoing, and then was informed that the mark in question was SAINT-TROPEZ, we have little doubt that this United States consumer would immediately perceive that the geographic-specific location was indeed the world famous resort city of Saint-Tropez. In other words, while applicant's mark SAINT-TROPEZ does not necessarily describe every characteristic of applicant's services, it clearly describes a significant characteristic of applicant's services (i.e. the specific subject matter/geographic location), and thus, under the unusual facts of this

**Ser No.** 75/216,946

particular case, is likewise merely descriptive in addition to being primarily geographically descriptive.

Decision: The refusal to register is sustained on both grounds.

E. W. Hanak

H. R. Wendel

G. F. Rogers  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board