

THIS DISPOSITION IS NOT CITABLE  
AS PRECEDENT OF THE TTAB DEC. 22, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

Kur-Und Verkehrsverein St. Moritz  
v.  
Carnival Creations of Mexico, S.A.

---

Opposition No. 93,527  
to application Serial No. 74/374,905  
filed on April 2, 1993

---

Stephen A. Hill of Rankin, Hill, Lewis & Clark for Kur-Und  
Verkehrsverein St. Moritz

Gary L. Bush of Mayor, Day, Caldwell & Keeton for Carnival  
Creations of Mexico, S.A.

---

Before Seeherman, Hanak and McLeod, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Carnival Creations of Mexico, S.A. (applicant) seeks to register in typed drawing form SAINT MORIS for "men's shoes; men's clothing, namely, bathing trunks, bath robes, belts for clothing, blazers, overcoats, knit shirts, suit coats, jackets, jeans, jogging suits, jump suits, neck ties, overalls, pajamas, pants, polo shirts, undershirts, shirts,

**Opposition No. 93527**

shorts, boxer shorts, gym shorts, slacks, sport coats, sport shirts, suits, bathing suits, sweat bands, sweat pants, sweat shirts, sweat suits, sweaters, t-shirts, tank tops, tennis shirts, tennis shorts, ties, trousers, underpants, thermal underwear, vests, vested suits, warm-up suits." The intent-to-use application was filed on April 2, 1993.

Kur-Und Verkehrsverein St. Moritz (opposer) has opposed the application on the basis that opposer is a collective organization organized under the laws of Switzerland; that opposer's members include businesses located in the town of St. Moritz, Switzerland; that St. Moritz is a community of world renown; that the community of St. Moritz includes various clothing retail stores and outlets and that St. Moritz is known for its clothing; that opposer owns registrations of ST. MORITZ and ST. MORITZ TOP OF THE WORLD and design; that applicant's use of its mark SAINT MORIS is likely to create confusion, mistake or deception; and that applicant's use of the mark SAINT MORIS is deceptive and/or is primarily geographically deceptively misdescriptive of applicant's goods by causing the public to believe that applicant's goods originate from or are associated with the town of St. Moritz, Switzerland.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition. Both parties filed briefs. Neither party requested a hearing.

**Opposition No. 93527**

The record in this case includes the depositions with exhibits of Hanspeter Danuser (opposer's managing director) and Moises Assa (applicant's president).

At the outset, we note that opposer has stated in its brief that the two issues in this proceeding are "whether applicant's mark SAINT MORIS is geographically deceptively misdescriptive; and whether applicant's mark SAINT MORIS is confusingly similar to opposer's registered mark ST. MORITZ". (Opposer's brief page 7). In its briefs, opposer has not argued that applicant's mark is deceptive, as opposer contended in its notice of opposition. Accordingly, we will give no consideration to the issue as to whether applicant's mark SAINT MORIS is deceptive.

We will consider first whether, as used in connection with their respective goods, applicant's mark SAINT MORIS is confusingly similar to opposer's mark ST. MORITZ and thus is prohibited from registration pursuant to Section 2(d) of the Trademark Act. Both parties have discussed at length the similarities and dissimilarities of the marks. However, both parties have also failed to adequately address a key threshold issue, namely, the particular goods and/or services for which opposer has prior rights in the mark ST. MORITZ, either through prior use or United States trademark registrations.

**Opposition No. 93527**

Opposer has properly made of record two of its United States registrations. The first is Registration No. 1,453,708 on the Supplemental Register for the mark ST. MORITZ in script form. The second is Registration No. 1,608,718 for ST. MORITZ TOP OF THE WORLD and design in the form shown below. This latter registration on the Principal Register contains the following disclaimer: "No claim is made to exclusive right to use 'St. Moritz,' apart from the mark as shown."

Both of opposer's registrations are for a wide array of goods. However, in its briefs opposer has not specified which of the goods set forth in these two registrations are most similar to the goods for which applicant seeks to register SAINT MORIS, namely, men's shoes and men's clothing. To the extent that opposer may be operating under the assumption that it has trademark (and service mark) rights in ST. MORITZ for all goods and services, opposer "overlooks the well-established principle that trademark rights, unlike statutory copyrights or patents, are not rights in gross or at large." American Footwear Corp. v.

**Opposition No. 93527**

General Footwear Ltd., 609 F.2d 655, 204 USPQ 609, 616 (2 Cir. 1979). See also United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918) ("There is no such thing as a property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.")

In reviewing the goods set forth in opposer's two registrations, we are left to speculate that the goods which are closest to applicant's goods (men's shoes and men's clothing) are jewelry, watches, umbrellas and walking sticks. However, opposer has failed to make of record any evidence establishing the relationship, if any, between these goods (or any of the other goods in its two registrations) and men's shoes and men's clothing. Opposer's only discussion in its briefs as to the relationship between its goods and applicant's goods is the following sentence appearing at page 20 of its opening brief: "Opposer believes that the clothing items described in applicant's application are extreme [sic] similar to those sold with the St. Moritz mark, and, in part are identical."

As for opposer's possible common law trademark rights, in his deposition, Dr. Danuser described opposer as being the Tourist Board of St. Moritz, Switzerland. Dr. Danuser stated that opposer is a non-profit association that has over 400 members consisting of firms and individuals who

provide goods and services to residents and visitors of St. Moritz. Continuing, Dr. Danuser testified that about fifty of opposer's members were engaged in the sale of clothing and that some of these members sold clothing items bearing the St. Moritz name. Dr. Danuser also stated that one of opposer's members (Jet Set Clothing) was engaged in the manufacture of clothing. However, Dr. Danuser did not testify that any of opposer's members sold clothing in the United States bearing the mark ST. MORITZ. Indeed, as for Jet Set Clothing, Dr. Danuser testified that "as far as I know, Jet Set does not have any clothing stores in the U.S.A." (Danuser deposition page 44). Moreover, Dr. Danuser did not identify any licensees of opposer who sold clothing in the United States bearing the ST. MORITZ mark or name. Indeed, Dr. Danuser did not even provide copies of license agreements showing that the sale or manufacture of clothing bearing the mark ST. MORITZ in Switzerland inured to the benefit of opposer. Whatever trademark rights opposer may have in ST. MORITZ for clothing and shoes in Switzerland or other foreign countries are insufficient, by themselves, to establish opposer's trademark rights in ST. MORITZ for clothing and shoes in the United States. See Person's Co. Ltd v. Christman, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed Cir. 1990) and 4 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 29:1 (4<sup>th</sup> ed. 1999).

**Opposition No. 93527**

In sum, opposer has simply failed to establish that it has trademark rights in ST. MORITZ in the United States for clothing or shoes of any kind. Moreover, opposer has failed to establish any relationship between any of the goods listed in its two registrations (including jewelry, watches, umbrellas and walking sticks) and the goods for which applicant seeks to register SAINT MORIS, namely, men's clothing and men's shoes. However, we find that there is some possible relationship between certain of the goods set forth in opposer's two United States registrations (jewelry, watches, umbrellas and walking sticks) and applicant's goods (men's clothing and men's shoes) in that they all can be worn or carried by men.

Turning to consideration of the marks, we find that applicant's mark SAINT MORIS is so dissimilar from opposer's two registered marks such their use on goods which are, at most, only somewhat related, presents no likelihood of confusion. We recognize that applicant seeks to register SAINT MORIS in typed drawing form and therefore we must consider that applicant could depict this mark in all normal manners of presentation, including in script form. Of course, both of opposer's registrations depict ST. MORITZ in script form, either alone or with other wording and a design. However, even if applicant's mark were depicted in script form, it would still be quite dissimilar, in terms of

**Opposition No. 93527**

visual appearance, from opposer's marks ST. MORITZ and ST. MORITZ TOP OF THE WORLD and sun design.

Of course, depicting applicant's mark SAINT MORIS in script form would not alter its pronunciation or meaning, which we find to be clearly dissimilar from opposer's mark ST. MORITZ and opposer's mark ST. MORITZ TOP OF THE WORLD and sun design. As for pronunciation, opposer has not argued that the English pronunciation of its mark ST. MORITZ and the English pronunciation of applicant's mark are at all similar. Rather, opposer argues that "with respect to sound, the record demonstrates that the English pronunciation of applicant's proposed mark is identical to the common French pronunciation of opposer's registered marks." (Opposer's brief page 20). In this regard, Dr. Danuser testified that "the second word 'Moritz' [in opposer's mark] is a name and equivalent to the French name 'Maurice". which in pronunciation is almost identical to the English word Moris.'" (Danuser deposition page 18).

We find that opposer's reasoning is simply not convincing, especially given the fact that Dr. Danuser repeatedly testified as to the world renown of opposer's mark and name ST. MORITZ. If ST. MORITZ is so extremely famous, as opposer contends, then we seriously doubt that people speaking English or any other language would pronounce it as SAINT MORIS. In addition, even if "Moritz"

**Opposition No. 93527**

is equivalent to the French name "Maurice" this does not mean the two are pronounced the same. Finally, even if we accept the accuracy of opposer's contention "that the English pronunciation of applicant's proposed mark is identical to the common French pronunciation of opposer's registered marks," this presumes that a more than de minimis number of United States consumers would be familiar with the French pronunciation of opposer's marks. Opposer has made of record no evidence demonstrating that such would be the case. Obviously, the issue before this Board is likelihood of confusion, not the mere theoretical possibility of confusion. Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

Finally, in terms of meaning or connotation, we accept the testimony of applicant's president that the mark SAINT MORIS was selected because it conjures up a mythical Catholic saint. In addition, given the great fame, according to opposer, of St. Moritz, we find that most United States consumers would view opposer's marks as indicating a town in Switzerland. Thus, in terms of connotation or meaning, applicant's mark, which conjures up the image of saint by the name of Saint Moris, is extremely different from opposer's marks ST. MORITZ and ST MORITZ TOP OF THE WORLD

and sun design which bring to mind a famous resort town in Switzerland.

In conclusion, we find that there is simply no likelihood of confusion resulting from the contemporaneous use of SAINT MORIS on men's clothing and men's shoes and ST. MORITZ and ST. MORITZ TOP OF THE WORLD and sun design on any goods for which opposer has registered these marks including in particular jewelry, watches, umbrellas and walking sticks.<sup>1</sup>

We turn now to the issue of whether applicant's mark SAINT MORIS is primarily geographically deceptively misdescriptive and thus is barred from registration pursuant Section 2(e)(3) of the Trademark Act. Opposer contends that

---

<sup>1</sup> Opposer has argued that applicant has a "well-known history of appropriating famous Swiss trademarks. One particularly egregious example involves applicant's registration and use in Mexico of the DAVIDOFF mark, a famous mark which is owned and used in various forms in many countries throughout the world including the United States, by Davidoff Cie. & S.A., a Swiss corporation." (Opposer's brief page 13). Apparently, opposer makes his argument in an attempt to show that the duPont factor of applicant's intent in adopting SAINT MORIS favors opposer. Opposer's only evidence that the DAVIDOFF mark is famous and is used in many countries by Davidoff & Cie are six United States trademark registrations of DAVIDOFF owned by Davidoff & Cie (Opposer's exhibits R, S, T, U, V and W). These six United Registrations do not prove that the DAVIDOFF mark is famous or is used in many countries. Moreover, opposer has presented no evidence regarding any other third-party Swiss trademarks used by applicant. In any event, applicant's actions with regard to the use and registration of the DAVIDOFF mark in Mexico certainly do not reflect any bad intent on the part of applicant in seeking to register the mark SAINT MORIS in the United States because said mark is decidedly different from opposer's mark ST. MORITZ.

applicant's mark is so barred because an "applicant cannot avoid a finding that a mark is geographically deceptively misdescriptive under Section 2(e)(3) of Trademark Act ... by slightly misspelling the geographic term [St. Moritz]." (Opposer's brief page 16).

Our primary reviewing Court has set forth a two-part test for determining whether a mark is primarily geographically deceptively misdescriptive. In re Jacques Bernier Inc., 894 F.2d 389, 13 USPQ2d 1725, 1726 (Fed. Cir. 1990) ("To establish a prima facie case for refusal to register a mark as 'primarily geographically deceptively misdescriptive,' it is not sufficient ... to establish simply that the mark is the name of place known generally by the public. ... The [opposer] must also establish that 'the public associates the goods with the place which the mark names.'").

To cut to the quick, applicant's mark SAINT MORIS is not primarily geographically deceptively misdescriptive because, at minimum, it fails to meet the first part of the aforementioned two-part test. Opposer has failed to establish that SAINT MORIS is the name of any geographic place, much less a place known generally by the United States public. Moreover, applicant's mark SAINT MORIS is simply not a slight misspelling of the geographic term St. Moritz, as contended by the opposer.

**Opposition No. 93527**

Decision: The opposition is dismissed as to both grounds.

E. J. Seeherman

E. W. Hanak

L. K. McLeod  
Administrative  
Trademark Judges  
Trademark Trial and  
Appeal Board