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HRW

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      MARCH 21, 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 Belvedere International Inc.

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Serial Nos. 74/702,921 and 74/702,842

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Patrick R. Roche and Colleen Flynn Goss  
of Fay, Sharpe, Beall, Fagan, Minnich & McKee  
for Belvedere International Inc.

Doritt Carroll, Trademark Examining Attorney, Law Office  
115 (Tomas Vlcek, Managing Attorney).

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Before Simms, Wendel and Bucher, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Belvedere International Inc. filed applications to  
register the marks OUTBACK NATURAL'S (S.N. 74/702,921)<sup>1</sup> and

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<sup>1</sup> Serial No. 74/703,921, filed July 18, 1995, based on an  
allegation of a bona fide intention to use the mark in commerce  
and claiming a right of priority under Section 44(d) based on a  
Canadian application filed January 18, 1995.

**Ser No.** 74/702,921 and 74/702,842

DOWN UNDER NATURAL'S (S.N. 74/702,842)<sup>2</sup> for "skin care products, namely, lotion, foaming bath, face cream, bar soap, facial scrub, liquid soap, shower gel, skin toner; hair care products, namely, shampoo, conditioner, hair spray, mousse, gel spritzer."

Registration has been finally refused in the application for the mark OUTBACK NATURAL'S under Section 6(a), in view of applicant's failure to comply with the requirement that a disclaimer be made of the term NATURAL'S. Registration has been finally refused in the application for the mark DOWN UNDER NATURAL'S under Section 2(e)(3), on the ground that the mark is primarily geographically deceptively misdescriptive.

Applicant and the Examining Attorney filed separate briefs in each case, but the cases were joined for oral hearing. We find it in the interests of judicial economy to combine the two cases in this final decision, although we have necessarily issued separate holdings for each case.

Before reaching the merits of the separate cases, there is a matter common to both cases which must be resolved. In each case, applicant originally set forth two

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<sup>2</sup> Serial No. 74/702,842, filed July 18, 1995, based on an allegation of a bona fide intention to use the mark in commerce and claiming a right of priority under Section 44(d) based on a Canadian application filed January 18, 1995.

**Ser No.** 74/702,921 and 74/702,842

bases for registration, both Section 1(b) and Section 44(e).<sup>3</sup> On April 21, 1998, applicant filed a paper in each application submitting a certified copy of the Canadian registration which had issued for the involved mark and concurrently requested that all reference to a claim for registration under Section 1(b) be deleted. Applicant stated that it wished to proceed "exclusively under Section 44."

The Examining Attorney made the foreign registrations of record and noted that the basis for registration under Section 1(b) had been deleted. The cases went forward to appeal with no further reference to the foreign registrations.

On appeal, however, we have reviewed the foreign registrations and ascertained that the goods for which these registrations issued are not co-extensive with the goods listed in the present applications. Instead, each of the registrations lists the goods solely as "hair care products, namely, shampoos, conditioners, hairsprays, mousse, hair styling gels, spray gels, and spritzers." There is no mention of any skin care products. Thus,

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<sup>3</sup> The Office presumes that applicant is asserting Section 44(e) as a basis for registration when a claim of priority under Section 44(d) is made. TMEP § 1006.01.

**Ser No.** 74/702,921 and 74/702,842

there is no basis under Section 44(e) for registration of the marks here for the skin care products listed in the identification of goods.

When this deficiency was pointed out during the oral hearing, applicant's attorney requested that the applications be remanded for the purpose of reinstating the Section 1(b), if possible, or otherwise the identification of goods be amended to delete the skin care products.

Under TMEP § 1006.03, an applicant may only add a basis for registration and retain its original filing date if there has been a continuous valid basis for registration. After applicant deleted the Section 1(b) basis for registration, there no longer existed a valid basis for registration of the marks for the skin case products. Accordingly, applicant cannot now add, or reinstate, the Section 1(b) basis. Applicant's only option is to delete the skin care products from the goods. Since applicant's attorney agreed to such a deletion as an alternative, the identification of goods have been so amended. Our decisions are being made on the basis that the goods are limited to the hair care products identified in the two applications.

Application Serial No. 74/702,921

In this case, the only issue is whether the term NATURAL'S is merely descriptive when used in connection with applicant's hair care products and accordingly must be disclaimed. In making this determination, we are guided by the general principle that a word or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, purpose, function or feature of the goods with which it is being used. Furthermore, whether or not a particular term is merely descriptive is not determined in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is being used, and the significance the mark is likely to have, because of the manner in which it is used, to the average purchaser as he or she encounters the goods bearing the mark. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Nibco Inc.*, 195 USPQ 180 (TTAB 1977) and the cases cited therein.

As evidence of the descriptiveness of NATURAL'S in applicant's mark, the Examining Attorney relies both upon dictionary definitions for the term "naturals" and the fact that the term has been disclaimed in several third-party registrations for similar goods. She further argues that

Ser No. 74/702,921 and 74/702,842

the addition of the apostrophe does not alter the meaning of the term and that purchasers would perceive NATURAL'S as the equivalent of the descriptive word "naturals."

Applicant contends that NATURAL'S does not immediately convey the idea of hair care products or personal hygiene products in general; that numerous registrations have issued or applications have been published for marks used with similar goods in which the term "natural" or formatives thereof have not been disclaimed;<sup>4</sup> and that there are other meanings which may be attributed to the term "natural" as used in its mark. During the course of the prosecution, applicant stated that if its use of the term NATURAL'S had been "merely in association with, say, organic skin care products, the Examiner's objection would certainly seem to be appropriate," but since its goods were of a much broader range, the term is not merely descriptive.

The dictionary definitions for "naturals" which the Examining Attorney introduced with her brief include meanings such as "natural as distinguished from

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<sup>4</sup> Applicant has submitted with its brief a greatly expanded collection of third-party registrations and applications from those made of record earlier in the prosecution of its case. The Examining Attorney has made no objection to this late-filed evidence, but rather had referred to the same. Accordingly, we have also taken it under consideration.

unnatural..." and "the natural form or condition of an animate object (as a flower)." We consider an even more appropriate definition to be that found in *The Random House Dictionary of the English Language* (2<sup>nd</sup> Ed. 1987) wherein "naturals" is defined as "a natural substance or a product made with such a substance; *an ointment containing mink oil and other naturals.*"<sup>5</sup> Thus, we find it a reasonable conclusion that when used in connection with hair care products or personal hygiene products in general, the term "naturals" would immediately convey the information that natural substances or natural ingredients have been used in the formulation of these products. Applicant has introduced no other meaning for the term "naturals" which would be more applicable.

The fact applicant's goods are not described as "organic" products in the identification of goods is inconsequential. The absence of any such qualification does not preclude applicant from using its mark with "organic" products or products made from natural ingredients; the broad identification of goods adopted by applicant encompasses products of all types of

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<sup>5</sup> The Board may take judicial notice of dictionary definitions and thus may both refer to definitions *sua sponte* and consider definitions first alluded to by the Examining Attorney in her brief.

**Ser No.** 74/702,921 and 74/702,842

compositions. Furthermore, despite applicant's arguments to the contrary, the test for descriptiveness is not what will be conjured up in purchasers' minds upon seeing the mark OUTBACK NATURAL'S in the abstract, but rather what will be their perception upon seeing the mark OUTBACK NATURAL'S displayed on or in connection with applicant's various hair care products.

The Examining Attorney has made of record third-party registrations containing disclaimers as evidence that the descriptive nature of the term "Naturals," when used in connection with a variety of skin care and hair care products, has been recognized and acknowledged by others. It is true that applicant has produced its own collection of third-party registrations and applications in which the term "naturals" has not been disclaimed. Although at first blush, applicant's showing appears to be of much greater weight, we find that this is actually not the case. While applicant has produced 216 registrations and applications for marks containing the formative "natural," only a very few of these marks contain the specific term "naturals." Most involve the words "natural" or "naturally," and many use these words in a unitary phrase or in a manner which would impart a different connotation to the word "natural." When a true comparison is made between the registrations

**Ser No.** 74/702,921 and 74/702,842

with and without a disclaimer of the term "naturals," we find the numbers to be close to even.<sup>6</sup> We also note that there appears to be at least a slight leaning toward disclaimers in more recent years. This we consider to be in line with the well-known and ever-growing trend to emphasize the natural, or in some instances "organic," formulations of many products, including skin care products, hair care products, and the like, as positive attributes thereof.

Thus, as a whole, we find the evidence sufficient to establish that purchasers, upon viewing the term NATURAL'S in applicant's mark OUTBACK NATURAL'S in connection with hair care products, would immediately be lead to believe that these products fall within the class of products containing natural substances or categorized as being "naturals."

Finally, we agree with the Examining Attorney that the use by applicant of the possessive form of the word "naturals" does not detract from the descriptive significance of the term. A slight misspelling or variation of a descriptive word which would still be

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<sup>6</sup> By our count, there are nine registrations on either side. Of the applications cited by applicant, several were presently the subject of extensions of time to oppose and have not been considered.

**Ser No.** 74/702,921 and 74/702,842

perceived by purchasers as the equivalent of the descriptive word is subject to the same proscriptions as the unaltered word. See *In re State Chemical Manufacturing Co.*, 225 USPQ 687 (TTAB 1985) and the cases cited therein.

Accordingly, the refusal to register the mark OUTBACK NATURAL'S without a disclaimer of the term NATURAL'S is affirmed. Pursuant to Trademark Rule 2.142(g), this decision will be set aside and the mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits a disclaimer of the term NATURAL'S apart from the mark as a whole.

Application Serial No. 74/702,842

Here, the issue is whether the mark DOWN UNDER NATURAL'S as a whole is primarily geographically deceptively misdescriptive under Section 2(e)(3). The determination of whether a mark is primarily geographically deceptively misdescriptive requires analysis under the following two-prong test:

- (1) whether the primary significance of the mark as it is used is a generally known geographic place; and
- (2) whether the public would make a goods/place association, i.e., believe the goods for which the mark is sought to be registered originate in that place.

**Ser No.** 74/702,921 and 74/702,842

Institut National des Appellations D'origine v. Vinters International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992), citing In re Societe Generale des Eaux Minerales de Vittel, S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982); In re Bacardi & Co, 48 USPQ2d 1031 (TTAB 1997).

Needless to say, a preliminary requirement is that the goods with which the mark is being used do not originate from the named place. Since applicant is a Canadian corporation and has made no claim that its goods originate from other than Canada, we assume this to be the case.

Looking to the first prong of the test, the Examining Attorney has made of record dictionary definitions for "Down Under" as a term used to refer to Australia or New Zealand. Applicant, on the other hand, although acknowledging that "Down Under" may be used as an informal reference to these countries, argues that the words "down" and "under" have many other meanings which are equally applicable. Even if considered as a single term, applicant has introduced copies of twenty-some third-party registrations in which the phrase "down under" was neither

**Ser No.** 74/702,921 and 74/702,842

required to be disclaimed nor held unregistrable because of geographic descriptiveness.

We find the evidence submitted by the Examining Attorney adequate to establish that the primary significance of the term DOWN UNDER as it is being used in the mark DOWN UNDER NATURAL'S is as a name for either Australia or New Zealand. Even though DOWN UNDER may be characterized as an informal name or nickname for these countries, the significance of the term is still primarily as a geographic designation. See *In re Carolina Apparel*, 48 USPQ2d 1542 (CAROLINA used to indicate either state of North Carolina or South Carolina); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238 (TTAB 1976)(OLD DOMINION geographic designation for the state of Virginia). The fact that other registrations may have issued without recognition of the geographic connotation of "Down Under" or in which the primary significance of the term was other than geographical cannot dissuade us of the import of DOWN UNDER in the present mark, when used with hair care products.<sup>7</sup>

Turning to the second prong of the test, whether a goods/place association would be made, the Examining

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<sup>7</sup> Only two of the third-party registrations introduced by applicant are for Class 3 goods.

**Ser No.** 74/702,921 and 74/702,842

Attorney has made of record several Nexis database excerpts containing references to Australian companies involved in the manufacture of hair care products and cosmetics as well as to United States cosmetic companies such as Estee Lauder and Avon which have opened plants in Australia. One article specifically discusses the emergence of Australian hair care products and refers to the "supermarket shelves ...lined with products from down under. Products with names such as 'Wallaroo Shampoo,' 'Kiwi Cream Rinse'... ." (*The Seattle Times*, Sept. 26, 1996).

Applicant argues that almost any industrialized nation would have manufacturers of cosmetic or personal hygiene products and evidence of this nature is not sufficient to show that Australia is well-known for these products. But it is not necessary that the Office produce evidence that a place is well-known or noted for the goods at issue in order to establish a goods/place association. It is sufficient that the Office show a reasonable basis for concluding that the public would be likely to believe that the goods originate from the named place. See *In re Loew's Theatres, Inc.*, *supra*. We believe that the Examining Attorney has met this burden so as to make a *prima facie*

**Ser No.** 74/702,921 and 74/702,842

case that the mark DOWN UNDER NATURAL'S is primarily geographically deceptively misdescriptive.<sup>8</sup>

Applicant attempts to rebut any geographic significance of the term DOWN UNDER by arguments that the mark as a whole is not an ordinary or recognizable combination of words and, without dissection, would have no significance, geographic or otherwise. Here, as in the prior case, applicant argues that the term NATURAL'S is not descriptive of the goods with which it is being used.

As fully discussed *supra*, we find the term NATURAL'S to be merely descriptive when used in connection with hair care products. As such, the addition of this term to the geographic designation DOWN UNDER does not detract from the mark's primary significance as a whole as being geographic. See *In re U. S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986). Even if there were some doubt as to whether the term NATURAL'S were merely descriptive or only highly suggestive, the primary geographic significance of the mark as a whole would not be affected by the addition of this term. See *In re Wada*, 48 USPQ2d 1689 (TTAB 1998), *aff'd*,

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<sup>8</sup> The goods/place association supported by this evidence is between hair care products and the like and Australia, not New Zealand. Accordingly, our decision rests on the identification of Australia by the term "Down Under," and not New Zealand.

Ser No. 74/702,921 and 74/702,842

194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999)(mark NEW YORK WAYS GALLERY as a whole projects a primarily geographic significance, with additional words WAYS GALLERY (even if arbitrary) not detracting from this significance). We find no support for applicant's arguments that any geographic significance of the term DOWN UNDER is eliminated when used in its composite mark.<sup>9</sup>

Accordingly, the refusal to register the mark DOWN UNDER NATURAL'S on the ground of being primarily geographically deceptively misdescriptive is affirmed.<sup>10</sup>

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<sup>9</sup> We agree with the Examining Attorney that applicant has failed to submit any evidence which would lead us to seriously consider that its mark might be perceived as a reference to lotions or other cosmetic products used "down under" one's clothing.

<sup>10</sup> We note the endorsement of our reviewing court in *In re Wada*, *supra*, of the Office policy that a disclaimer may not be used to salvage a mark that is primarily geographically deceptively misdescriptive, in view of the NAFTA amendments to the Lanham Act. Applicant has no option of submitting a disclaimer of DOWN UNDER to overcome this refusal.

**Ser No.** 74/702,921 and 74/702,842

Decisions:

In Serial No. 74/702,921, the refusal to register the mark OUTBACK NATURAL'S without a disclaimer of the term NATURAL'S is affirmed, applicant being allowed thirty days to submit such a disclaimer.

In Serial No. 74/702,842, the refusal to register the mark DOWN UNDER NATURAL'S under Section 2(e)(3) is affirmed.

In both applications, the identification of goods has been amended to restrict the goods to the hair care products.

R. L. Simms

H. R. Wendel

D. E. Bucher

Administrative Trademark Judges,  
Trademark Trial and Appeal Board

**Ser No.** 74/702,921 and 74/702,842