UNITED STATES: The TTAB Did Not Love New York

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The Trademark Trial and Appeal Board (TTAB or Board) affirmed a refusal to register the mark NY for “Cosmetics; Face creams; Lotions for cosmetic purposes” in Class 3, but only because the applicant, Nature’s Youth, Inc., failed to timely comply with the trademark examiner's Rule 2.61(b) request for information regarding the identified goods. In re Nature’s Youth, Inc., Serial No. 85747419 (T.T.A.B. Mar. 13, 2014) (not precedential).

The U.S. Patent and Trademark Office had refused registration on three grounds: (1) the applicant failed to comply with the examiner's request, pursuant to Trademark Rule 2.61(b), for information on whether the goods would be "manufactured, packaged, shipped from, [or] sold in," or have any other connection with, New York; (2) the applied-for mark was geographically deceptive under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a); and (3) the mark was primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Act, 15 U.S.C. § 1052(e)(3).

On appeal, the TTAB quickly affirmed denial of registration based on Rule 2.61(b), as there was no dispute as to Nature’s Youth’s failure to comply. The Board also ruled that the examiner should have withdrawn the Section 2(a) objection: Nature’s Youth had failed to make the necessary response and, regardless, Section 2(e)(3) was the appropriate basis for refusal.

The TTAB noted that all of the following elements must be present for denial of registration under Section 2(e)(3):

1. The primary significance of the mark is a generally known geographic place;
2. The goods or services do not originate in the place identified in the mark;
3. Purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and
4. The misrepresentation is a material factor for a substantial portion of [the] relevant consumers in deciding where to buy the goods or use the services.


With respect to the first element, the Board found that NY was primarily understood to refer to New York. Although NY could be short for meanings such as New Year or Neil Young, the Board found them “relatively obscure.” Moreover, Nature’s Youth had not shown that any other meanings related to the applied-for goods, or that it had promoted NY as an abbreviation for “Nature’s Youth.”

As to the second element, the TTAB presumed the applied-for goods did not originate in New York, given Nature’s Youth’s silence when faced with the Rule 2.61 request, and there was no contrary evidence.

With regard to the third element, the Board found that consumers would be likely to believe that the applied-for goods originated in New York, New York, because New York City is a major metropolitan area and several large beauty companies are headquartered there.

Turning to the fourth element, however, the TTAB found insufficient evidence in what it termed “the limited record” to show that New York was “famous for cosmetics, or even that cosmetics [were] a principal or traditional product” there. While the evidence showed New York was a fashion mecca, the relationship between the fashion industry and cosmetics was attenuated, and the mark applied for would not be a material factor in the consumer’s purchasing decision.
This decision is noteworthy for the TTAB’s analysis of Section 2(e)(3) and its affirmation of denial of registration because of the applicant’s failure to comply with Rule 2.61(b).

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