

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: April 2, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Paolo Doino

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Serial No. 77077462

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Jed R. Friedman of Jed R. Friedman, P.A. for Paolo Doino.

Heather Biddulph, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

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Before Quinn, Kuhlke and Bergsman, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Paolo Doino, applicant, has filed an application to  
register the mark FIOR DI GRANO (in standard character  
form) for "pasta; alimentary paste; rolls; cakes; bread;  
bread sticks; refrigerated pasta; crackers; corn meal  
flour; tomato sauce; pasta sauces" in International Class  
30.<sup>1</sup>

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<sup>1</sup> Serial No. 77077462, filed January 6, 2007, under Trademark Act  
Section 1(a), 15 U.S.C. §1051(a), alleging September 26, 2005 as  
the date of first use and first use in commerce.

Registration has been refused based on applicant's failure to comply with the requirement to submit a specific English translation for the phrase FIOR DI GRANO. Trademark Rule 2.61(b); TMEP §809 (5<sup>th</sup> ed. 2007).

When the refusal was made final, applicant appealed and the appeal is fully briefed. We reverse the refusal.

During prosecution, the examining attorney, inter alia, required a translation for applicant's mark FIOR DI GRANO and a disclaimer of the word GRANO. In the refusal she suggested the English equivalent of applicant's mark is "corn marigold." Applicant responded by submitting the following translation: "flower of grain." In addition, applicant disclaimed the word "grano" apart from the mark as shown. The examining attorney entered the disclaimer but did not accept applicant's translation and maintained the refusal to register based on this requirement.

The examining attorney argues:

The foreign wording in the mark accurately translates to "corn marigold" because this translation is the English equivalent of the foreign phrase in the mark. An application to register a mark that includes non-English wording must include a statement translating the wording. See 37 C.F.R. §2.32(a) and TMEP § 809. The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language. In re Societe Des Parfums Schiaparelli, S.A., 122 USPQ 349 (TTAB 1959)

(holding that a satisfactory translation of "mais oui" must be some normal English expression that will be the equivalent in meaning of the term "mais oui" in French); TMEP §809.01. Thus, the ultimate goal is to provide a translation that reflects the true English meaning of the non-English wording in the mark and indicates the actual commercial impression made by the mark. TMEP § 809.01...

While an Italian speaker may find the individual elements suggestive of flowers and grain, the speaker would understand the entire phrase to identify a "corn marigold." ... Thus, here, the literal translation of the mark is not a clear and exact equivalent and obviates the actual commercial impression and meaning of the mark...

Applicant has failed to provide evidence that the combination of words "flower of grain" is a normal English expression with any real significance in the United States, while the Internet evidence shows that the phrase "corn marigold" is a normal English expression used to identify a flower. Further, although "flower of grain" may be "suggestive and symbolic of many aspects and qualities of Applicant's goods," the phrase "flower of grain" fails to provide a clear meaning to English speakers because it is not a normal English expression. Thus, printing translation of the phrase FIOR DI GRANO to the normal English phrase "corn marigold" is more appropriate than a translation to the curious English phrase "flower of grain" because "corn marigold" is a clear and exact translation of the foreign wording in the mark.

Br. pp. 3-6.

In support of her argument the examining attorney has submitted the following "declaration" from the USPTO's

Technical Translator:

I, Steven M. Spar, declare that I am fluent in the Italian language, that I am a Technical

Translator at the United States Patent and Trademark Office, and that the wording fior di grano means "corn marigold." In my belief, the above translation is accurate and true.

Attached to June 5, 2008 Office Action.

In addition, she submitted a definition for the English phrase "corn marigold," its synonym and its translation into English:

Corn Marigold 1. European herb with bright yellow flowers, a common weed in grain fields. Synonym: Field marigold. Modern Translation (alternative meanings in parentheses): Italian fior de grano (yellow ox-eye daisy).

Webster's Online Dictionary, attached to June 5, 2008 Office Action.<sup>2</sup>

In traversing the refusal, applicant submitted the declaration of Alessandro Rubinacci, a certified English/Italian translator. He declares, inter alia, as follows:

5. The literal translation of "FIOR DI GRANO" is "FLOWER OF GRAIN."
6. "FLOWER OF GRAIN" is the ordinary meaning of "FIOR DI GRANO" in Italian.
7. A common speaker of Italian would readily understand "FIOR DI GRANO" to mean "FLOWER OF GRAIN."

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<sup>2</sup> The origin and relevance of the other two website excerpts submitted by the examining attorney are unclear and their probative value on the question of translation for purposes of this trademark application is minimal at best. One may be a translation website wherein "fior di grano" is translated into English as "corn marigold" and the other a French website that lists seed names.

8. "FIOR DI GRANO" is also the Italian name for the weed known in English as corn marigold.

9. The phrase "fior di grano" appears to be suggestive of the weed's flower-like appearance and the fact that it appears in grain fields.

Applicant argues that:

In this case, "flower of grain" has significance in the United States as the equivalent of "fior di grano." Indeed, Dr. Rubinacci stated - without rebuttal - that "flower of grain" is both the "literal translation" and "ordinary meaning" of "fior di grano." While acknowledging that the weed known in English as "corn marigold" is another possible reference, he stated, in paragraph 9, that the phrase "fior di grano" appears to be suggestive of the weed's flower-like appearance and the fact that it appears in grain fields." ...

Here, however, a literal translation would convey the primary and true meaning of "fior di grano." The point that "flower of grain" "has no meaning in English" is inaccurate. It can be suggestive or symbolic of many aspects and qualities of the goods. Even if "flower of grain" were to have "no meaning in English" such a "Meaningless" trademark would have good company among the most prominent and valuable arbitrary and fanciful trademarks in the world.

Br. pp. 3-4.

Applicant further argues that the translation he provided is "undisputed by the Declaration submitted in support of the Trademark Examining Attorney's position."

Br. p. 2.

Finally, in response to the first Office Action, applicant stated in the alternative that "both the Examiner's suggested translation and the Applicant's should

appear, as both have significance." April 25, 2008  
Response.

Trademark Rule 2.32(a)(9), 37 C.F.R. §2.32(a), provides, "The application must be in English and include the following: If the mark includes non-English wording, an English translation of that wording." In addition, an examining attorney "may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." Trademark Rule 2.61(b), 37 C.F.R. §2.61(b). The purpose of this requirement is that "[k]nowledge of the meaning of non-English words in marks is necessary for proper examination, because a non-English term is regarded in the same way as its English equivalent in determining descriptiveness, requiring disclaimer, and citing marks under §2(d) of the Act." TMEP § 809. "The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language." TMEP §809.01. "Sometimes translations that are not precise, or that give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are useful for informational purposes, not all such matter is appropriate

for printing in the Official Gazette or on the certificate of registration. Only a translation that is the clear and exact equivalent should be printed. This normally means only one translation, because the existence of a variety of alternative translations or general explanations usually indicates a lack of a clearly recognized equivalent meaning. If an applicant submits a translation that is too verbose or vague to be appropriate for printing in the Official Gazette and on the registration certificate, the examining attorney must require a clear, concise translation." TMEP §809.02.

The examining attorney insists that the phrase "fior di grano" has only one English equivalent, "corn marigold." This conclusion would indicate that "fior di grano" is a unitary phrase.<sup>3</sup> However, she also insists on a disclaimer of the word "grano" from the literal translation of "grain." Either "fior di grano" is a unitary phrase and has only one translation, and, therefore, no disclaimer is required, or it has an ordinary meaning and a disclaimer is required. Of course the third possibility is that it has both meanings, and the connotation would depend on the context. In this case, it is more likely that applicant

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<sup>3</sup> A mark is unitary if the whole is something more than the sum of its parts. TMEP §1213.05.

seeks to evoke the idea that the pasta is the "flower of grain" rather than a weed. In any event, as applicant points out, the declaration of this translator indicating the phrase has both meanings to "a common speaker of Italian," stands un rebutted.

The TMEP indicates that only a clear and exact equivalent translation should be printed and normally this means only one translation. This language contemplates circumstances where it may be appropriate to include more than one; however, the examining attorney insists on only one. Therefore, based on this record where there is a dispute, applicant's evidence of two ordinary meanings stands un rebutted, and applicant's translation makes more sense in the context of the goods, we defer to applicant's translation.<sup>4</sup>

In view of the above, applicant's submission "flower of grain" satisfied the requirement under Trademark Rule 2.61(b).

**Decision:** The refusal based on the requirement for a translation is reversed.

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<sup>4</sup> We note further that the underlying purpose of the translation requirement is to facilitate substantive examination for likelihood of confusion and descriptiveness. As discussed above, the examining attorney relied on the ordinary meaning in making the disclaimer requirement. We add that more relevant citations under Section 2(d) may be found based on the translation "flower of grain" than "corn marigold" in the context of these goods.